



Authors

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Legal framework

Australia's design registration system is administered by IP Australia – a federal government agency.

Relevant legislation

The following legislation applies to design rights:

- for designs filed on or after June 17 2004:
 - the Designs Act 2003; and
 - the Designs Regulations 2004; and
- for designs filed before June 17 2004 and not transitioned to the 2003 act, the Designs Act 1906.

Applicable international conventions

The following international legislation applies to design rights:

- the Paris Convention;
- the Hague Convention Abolishing the Requirement of Legalisation for Foreign Public Documents;

- the Convention Establishing the World Intellectual Property Organisation; and
- the Locarno Agreement Establishing an International Classification for Industrial Designs.

Australia has not signed the Hague Agreement Concerning the International Registration of Industrial Designs.

Unregistered designs

No protection is afforded to unregistered designs under the Designs Act. Copyright protection may apply under the Copyright Act 1968.

Registered designs

Ownership

An applicant must be a natural or legal person (this includes an individual, body corporate or the trustee(s) of a trust).

The following are entitled to own a design registration:

- the creator(s) of a design;
- an employer or commissioner, if the design was created in the course of employment or under a contract, unless by agreement to

- the contrary; or
- a person who derives title to the design (eg, by assignment).

The applicant bears the onus of proving correct entitlement if its rights are challenged after registration. The act has no provision to correct entitlement after registration.

Design protection **Registrable designs**

The following are registrable:

- a 'design', defined as the overall appearance of a product resulting from one or more of its visual features;
- component parts of a complex product, if separately made from the product;
- the same design for multiple (different) products in the same Locarno class in a single application. A design registration cannot have multiple designs; and
- cross-sectional shapes of products varying in one or more dimensions (eg, cross-sections of extrusions).

A design must be new and distinctive in order to be validly registered.

'New' means that the design cannot be identical to any design previously disclosed anywhere in the world (including on the Internet), or have previously been used in Australia.

'Distinctive' means that the design cannot be substantially similar in overall impression to any design previously published anywhere in the world (including on the Internet), or have previously been used in Australia.

In assessing substantial similarity in overall impression, the standard of the 'informed user' is applied – that is, a person who is particularly familiar with the product, or similar products, to which the design relates.

Non-registrable designs: Two and three-dimensional designs are generally registrable, except for:

- designs that do not comply with the definition of a 'design' (as outlined above);
- designs that lack the required newness and distinctiveness;
- words or marks that comprise or resemble the acronym 'ANZAC' (Australian and New Zealand Army Corp);
- designs whose use would constitute

counterfeiting of current polymer money or Australian prescribed securities;

- medals;
- scandalous designs;
- designs that are protected under the Olympic Insignia Protection Act 1987; and
- an integrated circuit within the meaning of the Circuit Layouts Act 1989, part of an integrated circuit or a mask used to make an integrated circuit.

Design features that are not registrable include:

- the tactile feel of a product;
- transient visual effects;
- materials used for the product;
- any indefinite dimension; or
- more than one repeat of a repeating pattern.

Publication of a design anywhere in the world, or use of the design in Australia before the priority date, leads to invalid registration.

Official fees

The fee for filing an application is A\$250 per design identified in the application, if filed online; this increases to A\$350 if the application is filed by post, fax or in person.

It costs A\$420 to request examination.

If examination is requested by a third party, the third party pays half and the owner must pay the other half within two months of the request; otherwise, the registration is removed.

Term

There is a maximum 10-year term for design rights. A design is registered initially for five years, renewable for a further five years.

Under the 1906 act, the maximum term is 16 years. A design is registered initially for six years, renewable for two further five-year terms.

Procedures

Application process

Minimum filing requirements: The following information is required at the time of filing:

- confirmation that what is filed is intended to be a design application;
- the applicant's full legal name and address; and
- representations of the design(s) – drawings are preferred, although clear photographs are acceptable.

The application is deemed not filed if the above minimum filing requirements are not met.

Additional information required for registration or publication includes:

- the full legal name of each designer;
- confirmation of whether the application is for registration or publication of a design;
- conventional priority details (if any), including number, filing date and country. A certified copy of the priority application is not required at filing (but may be required during examination);
- a description of the article to which the design is applied; and
- an optional statement of newness and distinctiveness, outlining any features of the design considered to be particularly distinctive over known designs.

Power of attorney and authorisation of agent forms are not required.

Number of designs per application: An application may be in respect of:

- one design in relation to one product;
- one design that is a common design in relation to more than one product;
- more than one design in relation to one product; or
- more than one design in relation to more than one product if each product belongs to the same Locarno class.

If more than one design is identified in an application, the applicant can pay an extra filing fee for each additional identified design or limit the application to one of the designs identified. Each identified design receives its own application number before registration.

Convention priority or priority based on a reciprocal agreement with Australia can be claimed within six months of the filing date of the basic application.

No formal grace period is provided under the act.

Statement of newness and distinctiveness: A statement of newness and distinctiveness can be used to highlight one or more novel features of the design.

Representations: Representations must show

an accurate and complete picture of the design applied to the product, as the eye would see it.

An application must include at least one representation fully showing the product, which must be clear and free of extraneous matter (eg, labels, words, background objects, measurements).

A specific number of views is not required; however, the views provided must fully show exactly the same design. If an application includes a statement of newness and distinctiveness, the representations should be consistent with the statement. Perspective or isometric views and a view from each elevation are desirable. Line drawings are typically used, but clear photographs and rendered computer-aided design images are acceptable. Broken, dotted lines, shading and cross-hatching can be used. A schedule listing the view orientation may be filed, provided that each drawing is clearly identified.

Registration and publication: A design application will be registered or published if all formal registration requirements are met and registration or publication is requested within six months of the earliest of the Australian application or convention priority date; otherwise, the application lapses.

Postponement or deferment of publication cannot be formally requested.

Examination

A design registration must be examined and certified before actual or threatened enforcement.

Substantive examination can be requested at any time by the owner, a third party or the registrar for designs. Substantive examination assesses the registered design for newness and distinctiveness against:

- designs that are publicly used in Australia;
- designs that are published in a document within or outside Australia; and
- designs in relation to which each of the following criteria is satisfied:
 - disclosure of the design in a design application;
 - the fact that the design has an earlier priority date than the designated design; and
 - availability of the first-time documents

disclosing the design for public inspection on or after the priority date of the designated design.

Exclusions to the prior art base when assessing a design registration for novelty include the following:

- publication or use of a design derived from the owner (or predecessor in title) without the owner's consent – if the applicant is aware of publication or use, an application for registration must be filed within six months of the date of such publication or use;
- disclosures by or with the consent of the owner (or predecessor in title) to government (the Commonwealth, a state or territory or any person authorised by the government);
- publication or use of a design at an officially recognised exhibition (defined in Regulation 2.01 and within the meaning of Article 11 of the Paris Convention or Article 1 of the Convention Relating to International Conventions), provided that an application for registration is made within six months of the date of publication or use and a document from the authority organising the exhibition is filed with the application stating that the design has been exhibited, the date of opening of the exhibition and the actual date of publication or use; and
- use of an artistic work before the priority date of a design registration in which copyright subsists, if such use is non-commercial (ie, has not been applied industrially) and/or unauthorised.

During examination, more weight is given to similarities between prior art designs and the registered design. The examination process is ordinarily completed within six months of a first examination report.

Divisional applications are not permitted.

Opposition

There are no opposition provisions. Third parties may file objections in the form of documentary evidence during examination or re-examination.

Removal from the register

The Australian Designs Office can revoke a

registered design under the act following examination only where a ground for revocation has been identified. After certification, revocation can be sought only through the courts in appropriate circumstances:

- An interested party may seek revocation after the prescribed period if a compulsory licence has been granted through the courts;
- Any party may seek revocation of a design on the grounds that:
 - the design is not registrable;
 - one or more of the original registered owners was not an entitled person when the design was first registered;
 - one or more other persons were entitled in addition to the persons entered in the register as the original registered owners;
 - the registration of the design was obtained by fraud, false suggestion or misrepresentation; or
 - the design is a corresponding design to an artistic work, in which the copyright has expired; or
- An entry in the register has been wrongly made.

A court can order cancellation of an entry in the register and thereby revocation of design on grounds equivalent to those available in examination, plus additional grounds.

For registrations filed under the 1906 act, any interested party may at any time apply to the relevant court for cancellation of the registration on the ground that the design was published in the Commonwealth of Australia before the priority date.

Registrations lapse and are removed from the register if maintenance fees are not paid. Restoration for failure to pay a maintenance fee is possible.

Appeal

A decision to revoke a design registered under the act can be appealed to the Federal Court or Federal Magistrates Court.

Enforcement

When is a design registration infringed?

A certified design registration is infringed by manufacturing, importing, selling, offering to sell, hiring or using for trade, in Australia, a product that embodies the design.

The test for infringement includes assessing whether the infringing design is, through the eyes of the informed user, “substantially similar in overall impression” to the registered design.

There is no exemption from infringement on the basis of prior use. However, a defendant in infringement proceedings may counter-claim for rectification of the register on the basis that the design is not registrable if that design was publicly available in Australia before the priority date of the registration.

Spare parts and defence to infringement

A defence to design infringement exists for spare parts if the design-registered spare parts are used for the purpose of repair or restoration of a ‘complex product’.

Remedies

Remedies for infringement include an injunction restraining the infringing conduct, damages or an account of profits, and an order for payment of legal costs.

A defendant in infringement proceedings may seek revocation of the design alleged to have been infringed.

An aggrieved party threatened with infringement or similar proceedings may apply to the court for:

- a declaration that the threats are unjustifiable;
- an injunction against continuing threats; and
- the recovery of any damages sustained as a result of the threats.

No relief will be granted if the respondent satisfies the court that the acts relating to the threats made infringed or would infringe a claim that is not shown by the applicant for the relief to be invalid. Mere notification of a design registration or application does not constitute a threat of proceedings.

Parallel importation and customs provisions

The act has no customs provisions. Importing a product which embodies a design (or one substantially similar to it) is not an infringement if the design is embodied in the product with the registered owner’s consent or under licence. Counterfeit imports will infringe. If the design is owned outside Australia by a party other than that listed as

the registered owner, the defence for parallel imports will not apply.

Ownership changes and rights transfers **Assignments**

A registered design can be assigned. Any change of ownership should be recorded in the Designs Register. No legalisation of assignment deeds is required.

Licensing

A registered design can be licensed. For a registered design filed under the 2003 act, there is no provision to record a licence. A compulsory licence may be applied for at any time by any party after certification on the ground that the design is not applied in Australia to a reasonable extent.

For a registered design filed under the 1906 act, a licence must be registered. An interested party may apply for a compulsory licence at any time after registration on the ground that the design is applied by manufacture to any article outside Australia and is not so applied in Australia to a reasonable extent.

The courts have yet to establish what constitutes a ‘reasonable extent’.

Related rights

Design and copyright overlap

Certain goods may be eligible for dual design and copyright protection if they:

- constitute an ‘artistic work’ under the Copyright Act; and
- are registrable as a design under the Designs Act 2003.

Dual design and copyright protection: Dual design and copyright protection applies in the following circumstances:

- For registered designs –
 - a copyright owner which registers a design corresponding to the relevant artistic work (where that design relates to the two-dimensional pattern on a product) will retain copyright protection in the artistic work and potentially achieve dual protection; and
 - a copyright owner which registers a design corresponding to the relevant artistic work (where that design relates to the three-dimensional

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- shape of a product) will be prevented from enforcing its copyright against infringers and must rely on registered design protection; and
 - For unregistered designs or those unable to be registered, a copyright owner which commercially produces objects using the corresponding design will be unable to enforce its copyright (unless the work falls under specific exempted works, in which case copyright will still be enforceable).

Copyright: If copyright subsists in an artistic work and an application is made by the rights holder or with its consent to register a 'corresponding design' as a design, any use of the artistic work must be disregarded unless:

- the use consisted of, or included, the sale, letting for hire or exposing for sale or hire of products to which the design had been applied industrially; and
- the use was by the rights holder or with its consent.

Design and trademark overlap

Dual trademark and design protection is allowed. [WTR](#)

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