

## Registered Designs in Australia

Registration of designs in Australia is governed by the Designs Act 2003, which commenced on 17 June 2004.

A registered design gives the owner of the design a monopoly right to the overall appearance of the product resulting from one or more visual features, such as the shape, configuration, pattern and ornamentation of the product. A product is any thing that is manufactured or handmade.

There is a clear distinction between the protection afforded by design registration and that given by a patent. Design protection is given only for the appearance of a product, whereas the product itself or the manner in which it operates may be protected by a patent. Notably, design registration does not provide protection for a method of construction or operation of a product. It is possible, of course, to have both design and patent protection for the same innovation.

### 1. Criteria for Registration

Not all designs are registrable. A design must be new and distinctive when compared to earlier designs, that is:

- “*New*” – it must be different from any design previously published anywhere in the world and any design previously used in Australia; and
- “*Distinctive*” – it must not be substantially similar in overall impression to any design previously published anywhere in the world and any design previously used in Australia.

An applicant should therefore ensure that, prior to filing its design application, it does not publish or use the design, as this will usually destroy the design’s newness or distinctiveness.

Designs that are not registrable include medals, Australian currency, integrated circuits and scandalous designs.

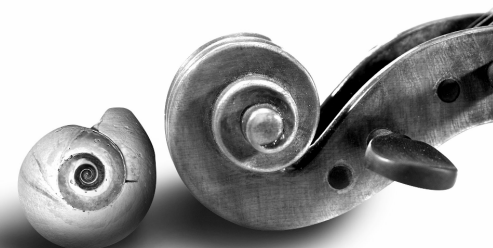
### 2. Applying for Design Registration

The registration process for a design begins with filing a design application at the Designs Office.

In most cases, an applicant will request registration of the design(s) in the application. Registration must be requested within 6 months of the “priority date” of the application and will usually be requested at the time of filing. Where convention priority is claimed, the “priority date” is the date of filing of the foreign application; where no convention priority is claimed, the “priority date” is the date of filing of the Australian application. It is also possible for an applicant to request publication only of a design. Publication results in the design being published in the Register but does not confer any rights.

A single design application may be in respect of:

- a) one design in relation to one product;
- b) one design that is a common design in relation to more than one product;
- c) more than one design in relation to one product; or



- d) more than one design in relation to more than one product, if each product belongs to the same Locarno Agreement class.

### Filing Requirements

In order to file a design application, we require the following:

- Representations (5 copies) of the product to which each design has been applied. Clear photographs are also acceptable. The representations should show a perspective view of the product and a view from every elevation.
- Name of the product to which each design relates.
- Full name and address of the applicant, together with the Australian Company Number (ACN) if the applicant is an Australian company.
- Full name of the designer or designers.
- Whether the applicant wishes to register or publish each design. We will assume that the applicant wishes to register each design unless we are specifically instructed to request publication only.

### Convention Applications

If the application is to claim convention priority, we also require the following:

- Details of the basic application from which priority is to be claimed including the country, application date, applicant and application number of the basic application.
- If the applicant is not the applicant of the basic application, details of how the applicant became entitled to claim priority of the basic application.
- A certified copy of the basic application and a verified translation (if the basic application is not in English); these documents do not need to be filed before registration, but will be required at the subsequent examination.
- The deadline for filing a convention application is 6 months from the priority date. If the anniversary of the priority date falls on a weekend or public holiday in Australia, the application can be filed on the next working day.

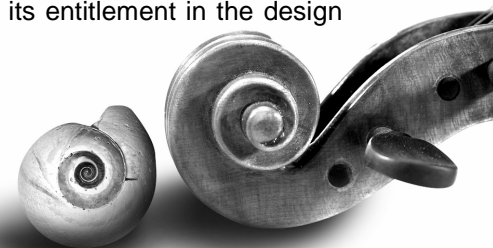
### Minimum Filing Requirements

We can file an application if you provide us with the following:

- A single copy of the representations showing the main views.
- The applicant's name and address details.
- Details of any basic application including the country, application number and date of the basic application.

### Forms

No forms need to be signed by the applicant or designer(s) in order to file an Australian design application. It is not necessary to lodge any document setting out how the applicant derived its entitlement in the design from the designer(s).



We can prepare and file all necessary forms on behalf of the applicant, provided that we are given the information and documents referred to above.

### 3. Registration

After the application has been made, it undergoes a formalities examination; that is, it will be assessed as to whether all necessary information and documents have been supplied. The Designs Office will request any information or documents that are missing. If all information and documents are complete, the Designs Office will register the design and issue a Certificate of Registration.

After registration, words such as “registered design” or “regd” may be used in relation to products bearing the design. While such marking is not mandatory, it is recommended as it may prevent an infringer from claiming that its infringement was innocent.

### 4. Term

Once registered, a design can remain registered for up to 10 years from its Australian filing date. One renewal is due 5 years after the Australian filing date. We refer details of our client's registrations to Computer Patent Annuities Limited Partnership (CPA) unless instructed otherwise. CPA will then issue you with reminders and handle your renewal.

### 5. Examination and Enforceability

It is important to note that a design will be registered without substantive examination (that is, of its novelty and distinctiveness). However, the owner will not be able to enforce the design by infringement proceedings until the design has passed substantive examination and a Certificate of Examination has been issued by the Designs Office. It is a groundless threat to allege infringement of a design that has not been certified.

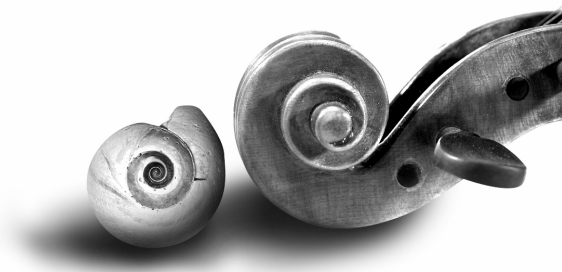
An owner may, at any time after registration, request that the design be examined by the Designs Office and pay the examination fee. Another person may also request examination of a registered design, in which case the other person will pay half of the examination fee and the owner must pay the other half. The other person may also lodge prior art material for consideration by the Designs Office.

The Designs Office will then undertake a prior art search to assess whether the design was new and distinctive at its priority date. If the Designs Office raises objections which are not overcome by the owner, the registration will be revoked. If there are no objections, or the objections are overcome, the Designs Office will issue a Certificate of Examination. Upon such certification, the design registration becomes enforceable (dating back to its filing date).

### 6. Infringement

Infringement can occur by making, importing, selling, offering to sell, hiring or using for trade any infringing design. The test for infringement is whether the infringing design is “substantially similar in overall impression” to the registered design.

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



Manufacturers, importers and suppliers of copy spare parts will however have a defence against design infringement if the copy spare parts are used for the purpose of repair of the complex product (the “spare parts defence”). The exact scope of the spare parts defence is however unclear, and advice should be sought in relation to its possible application to a specific fact situation.

A person also does not infringe a registered design if the person imports a product which was made with the licence or authority of the registered owner; that is, parallel imports of genuine products are permitted.

## 7. Copyright/Design Overlap

There is no “unregistered design right” in Australia. However, copyright may protect some unregistered designs, but only for a very limited class of designs and under very limited circumstances. Generally, artistic works commercially exploited as three-dimensional designs are denied copyright protection. Design protection generally remains available for two-dimensional designs, works of artistic craftsmanship and products not commercially exploited. The operation of these laws is complex and advice should be sought as to whether copyright protection is still available for an unregistered design in a specific situation.

As copyright protection will be unavailable for most designs, it is now imperative for intellectual property owners to register their designs in Australia if they plan to exploit them commercially.

## 8. Foreign Protection

Design registration, or similar protection, is available in many foreign countries. Applications filed in most of these countries within 6 months of the date of filing the same design in Australia will take the benefit of the Australian filing date. Please contact us if you require information regarding foreign design protection.

## 9. Designs Registered Under the Old Designs Act 1906

Designs which were registered under the old Designs Act 1906 continue to be governed by the old Act. Accordingly, such designs continue to be entitled to a 16 year maximum term and the rules of the old Act for validity and infringement continue to apply. For example, under the old Act, novelty was determined by a less strict local test and the infringement test was narrower. Please contact us if you require specific advice in relation to a design registered under the old Act.

Design applications filed prior to 17 June 2004 and not registered by that date can proceed under either the old Act or can be converted to the current Act. Please contact us if you require specific advice as to which Act a particular pending application should proceed under.

**For more information please visit our website  
[www.griffithhack.com.au](http://www.griffithhack.com.au)**

