

INFORMATION SHEET - REGISTERED DESIGNS IN AUSTRALIA V270422

Please find following an information sheet for registration of designs in Australia.

The information sheet is not exhaustive in any sense but covers common items during filing and we trust you find this information sheet helpful however if anything is unclear please let us know.

SAMPARK & CO IP LAWYERS
King George Chambers
Suite 415, 375 George Street
Sydney 2000 Australia

T +61 2 9299 7731
E office@spco.com.au
W www.spco.com.au

The time zone in Sydney is GMT + 11H (AESTDST) or GMT + 10H at other times. AESTDST commences the first Sunday in October and ends the first Sunday in April.

The current time in SYDNEY can be found at the following link | [SYDNEY TIME](#) |

TABLE OF CONTENTS (HYPERLINKED ENABLED)

NATURE AND SCOPE OF PROTECTION DESIGNS	2
PRIORITY DATE	2
FILING GRACE PERIOD	2
SEARCHES & INFRINGEMENT	3
OWNERSHIP	3
DESIGN APPLICATION FILING DATE AUSTRALIA	3
DRAWINGS PHOTOGRAPHS	3
PUBLICATION AS A RESULT OF REGISTRATION AUSTRALIA	4
MERE PUBLICATION INSTEAD OF REGISTRATION AUSTRALIA	4
FORMALITIES EXAMINATION AUSTRALIA	5
REGISTRATION MAXIMUM TERM AUSTRALIA	5
SUBSTANTIVE EXAMINATION AUSTRALIA	5
RETROSPECTIVE RIGHTS AUSTRALIA	5
INFORMATION WE REQUIRE TO PREPARE A DESIGN APPLICATION	6
SCHEDULE 1 INFORMATION REQUIRED TO PREPARE A DESIGN APPLICATION	6

NATURE AND SCOPE OF PROTECTION | DESIGNS

In Australia establishing legal rights in a design is a 2 stage process:

Stage 1 being a registration stage that establishes rights of ownership in the design upon registration but does not establish any enforceable rights against infringers, and

Stage 2 being an optional certification stage that establishes enforceable rights against infringers when the registration is certified after a substantive examination process.

Design registration protects the visual aspects of the design as applied to a product or article rather than protecting the article per se and consequently the protection is limited to the appearance of the various features of the article rather than the way the article works.

As the scope of protection provided by registered design is contingent on the visual aspects of the design the drawings or illustrations of the design in the design registration play an important pivotal role in defining the potential scope of protection provided by the registered design, therefore the drawings or photographs should be carefully prepared to clearly illustrate all the important visual aspects of the design.

While design registration can be very effective protection against unauthorised clones its effectiveness diminishes with respect to other designs as the visual differences between the other designs and the registered design increase.

Under Australian law we have separate design laws and copyright laws with some overlap occurring between the two protection regimes with respect to designs that also amount to an artistic work covered by the copyright laws.

However our copyright laws prevent simultaneous protection of some industrial designs under both regimes and effectively limit protection of these industrial designs to the design registration regime.

Therefore the appropriate protection regime in Australia for industrial designs is registration of the design rather than relying on copyright protection.

PRIORITY DATE

In order for a design to be registrable in Australia it must be new and distinctive in the requisite sense when compared to what at the 'priority date' of the design has been publicly available or published anywhere in the world ('the prior art'). The priority date can be established by filing an application for registration of the design with the Australian designs office.

Generally a new design must not be publicly disclosed or manufactured or used in a commercial context before a priority date is established otherwise those acts may compromise the validity of any design application that is later lodged. Therefore it would be prudent to keep the design secret and any commercial manufacture or dealings are delayed at least until a priority date is established.

FILING GRACE PERIOD

On 10 March 2022 a filing grace period was introduced in the Australian design law to help an applicant who may have made or is faced with an unauthorised premature prejudicial public disclosure of a design before a design application was filed for the design.

A design application filing grace period may be available if an application for a registered design is filed within 12 months of the 1st public disclosure of the design.

The grace period provisions only came into effect on 10 March 2022 and only applies to applications filed on or after this date, and prejudicial disclosures that occur on or after this date.

It is to be noted all countries provide a filing grace period and relying on grace period should be a remedy rather than a deliberate filing strategy.

SEARCHES & INFRINGEMENT

A search for relevant prior art while voluntary is strongly recommended. A design literature search before the first design application is prepared may identify relevant prior art that may be problematic and can be taken into account at that time. In any event a search of the design office records should be conducted before you at least use the design in a commercial context in case registered designs are identified that maybe infringed by your proposed commercial activities.

The cost of searching is contingent on the types and extent of searching that is required and the results of the search. While several search strategies are available each having different scope and costs we can formulate at your request a search strategy and budget for your approval. The costs for a subject matter search starts from a minimum of \$1000.

It must be appreciated that a common limitation of any search is that the search is only ever conclusive if you find the very thing you are looking for, notwithstanding a search can provide the previously mentioned advantages.

OWNERSHIP

The only person entitled to apply for registration of the design is the owner of the design, and this can be the author of the design or someone who derives title from the author owner or who is entitled under law to the design.

If the owner of the design is not the author and the ownership has not been formalised by an effective written assignment then it would be prudent to formalise the ownership by way of a written assignment as soon as possible to avoid potential ownership disputes at a later time.

We can prepare suitable assignments to meet your situation.

DESIGN APPLICATION | FILING DATE | AUSTRALIA

Once a design application is lodged including suitable drawings/photographs and the official filing fees are paid and all the filing formalities are in order the application will receive a filing date.

DRAWINGS | PHOTOGRAPHS

As the drawings/photographs are a very important part of the application and will effectively define the scope of the protection if the design is registered the drawings/photographs should be carefully and thoughtfully prepared to ensure they clearly illustrate all the important features of the design.

Therefore it is preferable that any drawings or photographs are prepared and made available to us in a digital medium format such as high quality 'jpg' format or AUTOCAD 'dwg' format so they can be conveniently amended or manipulated by us as required.

The drawings/photographs should be of the final version or versions of the design that you propose to release into the market place.

PUBLICATION AS A RESULT OF REGISTRATION | AUSTRALIA

Details of the design illustrated in the application will not be available for viewing as a matter of public record until the design is registered or the applicant otherwise requests publication instead of registration.

Design applications filed before 10 March 2022

For design applications that were filed before 10 March 2022 the applicant must expressly request within 6 months of the priority date of the application that the design be registered if that was not included in the application at the time of filing.

If the applicant fails to do this then the design will not be registered or published.

Design applications filed on or after 10 March 2022

Design applications filed on or after 10 March 2022 are deemed to be for registration and the design will be published on registration.

MERE PUBLICATION INSTEAD OF REGISTRATION | AUSTRALIA

Design applications filed before 10 March 2022

For design applications that were filed before 10 March 2022 publication of a design can occur at an applicant's request without a desire for registration.

An application for mere publication is a defensive publication and does not confer any rights in the design but prevents others from registering the same design if they file a design application after publication.

If the applicant requires mere publication as an alternative to registration then the applicant must request within 6 months of the priority date of the application that the design be published and not registered otherwise the design will not be published or registered.

Once a request for mere publication without registration is filed in the application then the opportunity to seek registration for the same design will end when publication occurs.

Therefore if the applicant wants publication without registration then unless an applicant is confident they require mere publication without registration then a request for mere publication without registration should be deferred within the allowable time limit in case the applicant changes their mind in the interim and wants registration.

In any event lodging a request for registration generally is preferable to lodging a request for mere publication.

Design applications filed on or after 10 March 2022

Applications for publication without registration are no longer available as of 10 March 2022 as all design applications filed on or after 10 March 2022 are deemed to be for registration.

FORMALITIES EXAMINATION | AUSTRALIA

In the ordinary course of a design application, the design application will only receive a formalities check | examination before the design is registered and published.

If a formalities report issues the applicant will have 2 months from the date of the report to overcome all formalities objections raised in the report otherwise the application will lapse.

Substantive examination will only be undertaken after a design is registered and only if certification of the registration is voluntarily requested by the owner of the design or any other interested party.

Therefore, initial registration of the design is not contingent on substantive examination of the application.

REGISTRATION | MAXIMUM TERM | AUSTRALIA

Once a design is registered the initial term of registration is 5 years from the date the design was filed.

The duration of registration may be extended by another 5 year term by the payment of a renewal fee giving a maximum possible term of registration of 10 years.

SUBSTANTIVE EXAMINATION | AUSTRALIA

Substantive examination will only be undertaken after a design is registered and only if certification of the registration is voluntarily requested by the owner of the design or any other interested party.

We generally as a matter of practice recommend that certification of the design registration is requested at the time the design application is lodged to put the owner of the design in a favourable position in case an infringement situation arises after registration as the owner then can threaten infringement proceedings once the design registration is certified.

In a straightforward case the registration will be certified after examination is completed.

However if an adverse examination report issues then all objections in the report must be successfully overcome within 6 months of the report otherwise the registration will cease.

If all the objections in the examination report are timely overcome the registration will be certified.

The costs that are incurred during examination can be highly variable as they are contingent on the nature and number of objections (if any) that are raised during examination.

RETROSPECTIVE RIGHTS | AUSTRALIA

Even though the rights conferred by registration and certification are retrospectively applied back to

the date the initial application was lodged damages or an account of profits may not be awarded against innocent infringers in some circumstances.

Therefore it is prudent that before a new design is disclosed, released or promoted in the market place that it is appropriately marked with a notice that the design has been registered or is the subject of a pending application as appropriate. In this way it reduces the prospects that a not so innocent commercial opportunist can successfully claim innocence.

INFORMATION WE REQUIRE TO PREPARE A DESIGN APPLICATION

The information requested in Schedule 1 following will help prepare the design application and minimise costs.

Schedule 1 also sets out the drawing/photograph requirements for the design application.

SCHEDULE 1 | INFORMATION REQUIRED TO PREPARE A DESIGN APPLICATION

Applicant/Owner details

The full name and address of each person, company or other legal entity in whose name the application is to be made.

Please provide the ACN, or the ARBN for any company that is an applicant.

In the case of more than one owner, the proportion of ownership of each owner.

Authors Details

The full name and address of each person who contributed to the authorship of the design, i.e. help create the design.

The authors cannot be companies they can only be people.

Basis of entitlement to ownership

If any of the owners of the design are not one of the authors please tell us the basis these owners have ownership by selecting one (or more) of the following:

- Was the author an employee of the owner and the design was authored for the employer during the ordinary course of employment?
- Did the author create the design for the owner pursuant to an order, agreement or contract for money or something else? If yes, please specify details.
- Did the owner buy the all rights to the design from the author pursuant to an assignment or contract? If yes, please specify details.
- Did the owner acquire all rights to the design from the author pursuant to some other entitlement or devolution in law? If yes, please specify details.

Evidence of entitlement to ownership

If any of the owners of the design are not one of the authors then has the entitlement to ownership been formalised in writing by an effective written assignment?

Please specify yes/no/not sure.

Priority claim | Earlier corresponding design applications

If an earlier corresponding design application has been filed in any country please give full

particular including filing date.

Specifications for drawings or photographs of design

The purpose of the drawings/photographs (representations) is to help illustrate and define the monopoly in the design so the quality and subject matter of the drawings/ photographs is a very important aspect of the application. The representations are to be provided in digital file format.

Representations must:

- be clear and of high quality;
- be consistent and only show one design;
- show the whole product with physical and tangible form
- include sufficient views to illustrate each feature forming part of the design including a least one perspective;
- include a label for each view either individually, eg “ Top Perspective” or collectively, eg “Full details (all views including perspective)”;
- only show the visual features of the design;
- be free of dimensions, or wording or trade mark material not being part of the design itself;
- be free of hidden detail;
- be free of drawing title blocks or borders;
- be against a neutral background if it is a photographic representation;

A 3D model (in the following formats: a 3D PDF encoded as a Universal 3D (U3D) 3rd edition format or Product Representation Compact (PRC) format) may also be submitted with the application however it will not form part of the application or have any legal impact on the application in any sense, as it will be used as a mere visual aid during the examination process only and of be of no other consequence.

Statement of Newness and Distinctiveness(SoND) | Optional

A Statement of Newness and Distinctiveness (SoND)

- is optional;
- can be used to highlight the new and distinctive visual features of a design;
- can inadvertently narrow the scope of the design if unduly narrowly drafted
- can work together with representations to highlight the new and distinctive features of a design for example
 1. solid lines in a representation can be used to highlight new and distinctive elements of the design
 2. dotted/dashed lines show the visual features of the entire product the design is applied
 3. the accompanying SoND is provided as “The shape and configuration of the product as shown by solid lines in the accompanying representations is new and distinctive.”.