

INFORMATION SHEET - REGISTERED DESIGNS IN AUSTRALIA v020910

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PURPOSE OF THIS INFORMATION SHEET

The purpose of this information sheet is to provide general information about registration of designs to those with little or no relevant experience with registered designs so they can be aware of at least some of the fundamentals about registered designs and associated issues and considerations.

This information sheet should not be taken as being exhaustive in any sense however may help clarify, refine or articulate a novice’s registered designs requirements in preparation of further consultation with registered designs practitioners such as our firm so that the novice can maximise the benefit from a further consultation in relation to the novice’s specific registered designs requirements or issues.

We trust you find the information sheet helpful.

NATURE AND SCOPE OF PROTECTION

Registration of a design provides a way of protecting a new design from being commercially exploited by others in the country in which the design is registered.

Design registration protects the visual aspects of the design as applied to a product or article rather than protecting the article per say 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 between the two protection regimes with respect to designs that also amount to a artistic works 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.

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PRIORITY DATE OF THE DESIGN

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 used in Australia 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.

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.

OWNER OF THE DESIGN

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 - 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.

Once a design application is lodged the applicant must request within 6 months of the priority date of the application that the design be registered. If the applicant fails to do this then the design will not be registered or published. Generally an applicant will request registration at the same time an application is lodged unless the applicant wants to defer publication of the design pursuant to registration by deferring a request for registration.

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MERE PUBLICATION INSTEAD OF REGISTRATION - AUSTRALIA

It is also to be noted that publication of a design can occur at an applicants 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.

EXAMINATION - AUSTRALIA

In the ordinary course of a design application, the design application will only receive a formalities check before the design is registered and published and substantive examination will only be undertaken if voluntarily requested by the owner of the design or any other interested party.

Therefore initial registration of the design is not contingent on an earlier substantive examination of the application, however it is important to note that an unexamined design registration is not enforceable until it has successfully completed substantive examination by the issuance of a certificate of examination.

We generally as a matter of practice recommend that examination 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.

In a straightforward examination case a certificate of examination will issue after examination is requested however if an adverse examination report issues then all objections in the report must be successfully overcome by submissions and or amendments before the certificate of examination can issue.

The costs that are incurred if examination is requested will be a fixed cost for requesting examination and if any adverse examination reports issue during examination additional prosecution costs will also be incurred in attending to those adverse examination reports.

Prosecution costs can be highly variable as they are contingent on the nature and number of any objections that are raised during examination.

REGISTRATION & MAXIMUM PERIOD OF REGISTRATION - 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.

RETROSPECTIVE RIGHTS - AUSTRALIA

Even though the rights conferred by registration 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 in this Annexure will help prepare the design application and minimise costs. Schedule 1 also sets out the drawing/photograph requirements for the design application.

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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 can not 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.

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 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 drawings or photographs preferably are made available in digital file format in addition to printed format.

Drawings must:

- be of drafting quality or no less than high quality artistic sketches of clear and definite detail
- be presented on A4 white paper and have a border margin of at least 25 mm around the A4 page free of the drawings or drawing label around the page
- be presented in black ink or computer print equivalent
- 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)"
- 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.

Photographs must:

- be clear originals and not photocopies
- be a permanent image and not fade over time
- be mounted on A4 paper with suitable labels and have a border margin of at least 25 mm around the A4 page free of the photographs or label
- 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)"

It is recommended one draft set of the drawings or photographs is provided in the first instance so we can mark up the draft with changes if required. We will eventually require 9 sets of the final quality drawings or photographs before we can lodge the design application.