

GUIDE TO:
**AUSTRALIAN
DESIGN REGISTRATION**



MARK MY WORDS

TRADEMARK SERVICES PTY LTD

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What is a Design?

A design is a form of intellectual property and covers the overall appearance of a product. This can be the shape, configuration or ornamentation of a product.

To be considered a registrable design, it must be new and distinctive. “New” basically means that it cannot already exist in the marketplace in Australia and it cannot have been published in any document anywhere in the world. If you release, sell or promote a design before applying you may not be able to gain rights to a registrable design and if someone else has registered the same design overseas, you may not be able to register in Australia. “Distinctive” means that it is not substantially similar in overall appearance to other products already in the public domain.

A design will not protect the materials used to produce the design or the ‘feel’ of any fabric or matter used, nor will it protect the concept behind the design. If your new product contains inventive or innovative functions then you should also consider the subject of Patents.

Some examples of registrable designs have included:

An oral care implement



Baby capsule



Women's Clothing



Things to consider before applying

Is your design registrable?

As noted on the previous page, a registrable design is one that is new and distinctive. As you will read further in this document, you may register a design relatively easily in Australia – however, to gain fully enforceable rights your design must be examined to ensure that these criteria are met, and, it is possible for another party to request this examination if they do not consider your design to be new and distinctive.

If you are wishing to protect a function of your design (rather than its appearance), then you should consult an attorney to determine if you may have valid patent rights within that function. If you wish to protect the brand name given to your design, then the subject of trademarks should be considered

Who is entitled to file?

Any person or legal entity may file a design application in their name. The doing so however is also providing confirmation to the Designs office that the person named is entitled to be listed as the owner of the design. As with any property, the applicant/owner must be a legal entity – e.g. an individual/s or incorporated body such as a Pty Ltd company. A business name cannot own property, as it is not a legal entity. The rights to property would lie with whoever owns the business name usually.

When filing a design application, in addition to the person/company listed to own the design, the actual designer's name is also required and is listed in the database.

Overseas Design Protection

If you have the need to secure rights to your design outside of Australia, you will have a limited amount of time to do so. As detailed earlier, a design is only valid when new, which includes that it has not been published anywhere in the world. When you file in Australia your design will be published in the database. You will have a six-month period from filing in Australia where you can safely file to most other countries and claim 'priority' based on your Australian design. This ensures that overseas offices (where priority claims are available) will consider the application as though filed on the same date as your Australian design application. This is a strict time-frame and if it is missed, your own Australian design could see your international design deemed invalid.

Search

It is a good idea to have searches carried out before filing design applications. Searches can consider whether your proposed design is too similar to a design that is already registered in Australia. This is important, as it will help identify whether:

- Your design is likely to be considered ‘new’ and ‘distinctive’, or whether;
- You will struggle to gain the level of protection desired; and
- Your design may actually infringe the rights of an already registered and certified design in Australia.

Intellectual Property rights apply country-by-country so searches should be carried out in Australia but also in any other country in which you may ultimately wish to promote your design.

If your design is too similar to one that is already registered you may face legal action for infringement. Such action is costly and time consuming. A paid search at the beginning of the process could see you avoid such action and cost in the future.

Registration or Publication?

There are a number of benefits to registering your design. As the registered owner you have rights that you won't otherwise have:

- The exclusive right to use the design that you have registered;
- The exclusive right to allow others to use the design (e.g. license it to them)
- Claim the design as ‘property’, which can be treated like any asset and may increase in value and be sold if desired.
- The ability to request examination and have your design certified, so that you may take legal action against others who infringe your design.

However, an alternative to registering your design is to request it be published instead. (You must request either registration or publication within 6 months of filing or your design application will lapse). Publication of a design does not provide any of the above mentioned rights, however it can be used to ensure no other person or party could gain certification for the same design in Australia, as it would no longer be considered new.



Application

It is possible to file a single application in Australia that covers multiple designs or products. One application form could be filed in any of the following instances:

- You have one design in relation to one product
- You have one design that's common across a number of products (for example, you might design a new a distinctive profile or pattern used on furniture, your application would show the one profile/pattern as the design, but may be shown on chairs, dining tables, coffee tables etc.)
- You have more than one design in relation to one product (for example, your product could be a dining table and one design is the shape of its legs and a second design covers the appearance of the table top);
- You have more than one design in relation to more than one product. You may only file a single application in this case if each product falls into the same category/class as provided by the World Intellectual Property Office.

Representing your Design

When you file a design, you must provide representations that depict the design. The representations must show an accurate and complete picture of the design you seek. The pictures should not include any matter that is not a part of the design. For example, if you provide photographs these should be against a plain background. If any other matter appears in the photograph, it may be taken to be a part of the design. Several perspectives of your design should be provided to ensure a complete picture is seen.

Statement of Newness & Distinctiveness

It is possible but not compulsory to include a statement of newness and distinctiveness when filing your design application. The statement can advise as to the particular features of the design that you consider to be new and distinctive. This can assist the Designs office also when assessing these criteria.

Important Note:

This statement cannot be added after your design is registered so it's best to do it at the same time you file your application.

Examination & Certification

As briefly touched on earlier, in order to gain legally enforceable rights to your design (so that you can take action against others who infringe your design) the design must be examined and certified. You cannot take this action, or even threaten such action if your design has not been certified. Premature action could in fact see action against you from another party for the making of threats you do not have the right to make.

Examination can be requested at any time by making the necessary request and paying the necessary fee. You may choose to do this early so as to not have to worry about it if the time comes where someone is copying your design, or, you may wish to wait until such an issue arises to know that you need to have the design certified to take action.

Once examined, you will be issued with a report if the examiner finds any issues that prevent your design from being certified in its current state. You will have the opportunity to reply and

attempt overcoming these issues. If you are unable to overcome the issues, your registration will be revoked. Alternatively, you will receive a certificate to show that your design has been examined and certified.

Examination can be requested by third parties. If for example, a competitor did not believe your design to be a 'registrable design' at the time of filing, they may request this examination stage in an attempt to have your design confirmed as invalid. In these cases, it's important to note that you will be expected to pay 50% of the examination costs. You are required to pay this because in the event your design is certified you are the one that benefits.

Important Note:

If you do not pay the required portion when a third party requests examination on your design – your registration will lapse.



Life Span & Renewals

The maximum registration of an Australian design is 10 years under the current design laws in operation.

The initial application and registration provides the first five years of registration. You will then need to meet renewal requirements to secure your registration for the further and final five year period.

The government Designs Office will send out a courtesy renewal reminder to the address listed for 'service' of documents on the design around 2 months prior to the due date. If you employ an agent, such as our office to file and attend to your design registration then the reminder notice will be sent to your agent. Our office has its own diarising system in place to ensure that you are notified of due dates around 3 months before the due date and will follow up with you to ensure the registration does not expire.

Important Note:

The designs office, as noted will send a reminder to you of the renewal due – however, if your address has changed and no longer current on their database they will not chase you up and the design will likely lapse if you don't have your own reminder in place.

You will have a six month grace period to renew your design, so if the due date is missed you may renew during the following six months – however, fees apply per month from the renewal date, and your design will be in an expired status until renewal requirements have been met. You will temporarily lose the rights of a fully registered design until the registration is restored.

Fees

The following fees apply during the course of a standard Australian design application/registration. All fees are inclusive of government fees, professional fees and GST and are current at the time of publication.

Searches

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| Ownership Searches - If you have particular competitors that you wish to know of their registered designs. | \$220.00 |
| Register Search – brief review of designs register for substantially similar designs | \$440.00 |
| Full availability & Infringement Search | \$880.00 |

Application

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|---|---------------|
| Single Application (with reg/publication request) | \$650.00 |
| Multiple Applications filed at the same time (with reg/publication request) | \$550.00 each |
| Request Registration/Publication separately to application being filed | \$55.00 |

Examination & Certification Request

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|-------------------------------------|---------------------|
| Request examination & certification | \$720.00 per design |
| Where third party makes the request | \$360.00 per design |

Fees - Continued

Renewal of Registration

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| Renewal for further/final five year period | \$495.00 |
| Late fees (per month past due date) | \$155.00 |

Other Common Fees – your instruction will always be sought. If not listed, please request a quote.

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| Hourly fee when applicable | \$250.00 |
| Extension of time (per month or part therefore) | \$155.00 |
| Extension of time (special circumstances) | \$205.00 (not per month) |
| Request assignment of ownership (Includes preparing simple letter of assignment) | \$155.00 |
| Opposition to an extension of time request | \$770.00 |



Important Notes

To sum up information detailed in this document, below are some of the most important notes to consider when you are registering a design in Australia:

Registration Period:

Australian design registration and protection lasts a maximum of 10 years.

New & Distinctive:

A design must be new and distinctive. If it's not, it may prove to be an invalid design registration; struggle to be certified in order to gain fully enforceable rights and may be challenged by others.

International Protection:

A proper strategy should be in place before applying or publishing your design in Australia, as strict time frames apply to seek valid protection overseas.

Searching:

A proper search prior to filing an application and/or marketing your design can prove a good investment to ensure you are not likely to face infringement action from the owner of a design in Australia. Searches should be considered for each country you wish to promote your design in.

Infringement:

If you have registered a design it must be examined and certified before you can instigate any action for infringement. This must occur before even putting a potential infringer on notice. Making threats of action or demands of other people before certification of your design has occurred could see action against you for the making of invalid threats.

If you receive any notice that you are infringing a registered design, ensure that the subject design has in fact gone through this process. Contact our office for further assistance on these matters.

More Information

As this guide demonstrates, there are a lot of aspects to Designs, Design registration and protection and the Design laws. If you have questions not answered in this guide – please contact our office:

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ADDITIONAL INFORMATION AVAILABLE:

- Trademark forms (Australia)
- Guide to Australian trademark registration
- Guide to international trademark registration
- Copyright
- Licensing & royalties
- Other types of intellectual property

Disclaimer:

Please note that this publication is provided for information purposes only and is not intended to be legal advice, nor should it be substituted for such advice. Areas of law are complex, and professional advice should be sought prior to the commencement of any action related to trademarks.

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