

Designs

What are Designs and how can I protect my Design Rights?

Design *per se* is the overall appearance of a product, both visual and aesthetic and can include the shape, configuration, pattern and ornamentation of a product whether it is bespoke or manufactured and that have an industrial or commercial use.

A design registration protects the appearance of a product, but not its function.

Design rights are different to copyright, which protects the intellectual property in artistic works, and patents which protect the functional features of a product. Design rights are registered under the *Designs Act (Cth) 2003*.

Design rights can exist in both 2D and 3D products. Examples of 2D products include wallpaper, wrapping materials, fabrics, particularly where there is a repeating pattern. Designs can also protect products that do not have fixed dimensions such as pipes, gutters and other extruded products.

There are however certain legal exclusions for which design registration is not available including medals such as service and Olympic medals, Australian currency and scandalous designs.

Where can I get a design registered and what is required?

In Australia, designs are registered by filing a design application at IP Australia.

When filing a design application the following information is required:

- Who is the applicant and their details including name and address details
- Is the applicant the actual owner / author of the design?
- If the applicant is not the owner or author on what basis is the applicant entitled to file the application? That is how, has the applicant derived entitlement from the owner / author?
- Name and address of the creator of the design.
- Representations of the design, preferably line drawings showing the various views of the product including: top, bottom, front, back, left and right hand side views, and front and rear perspective. In some cases photographs are permitted provided they clearly show all the features of the design.
- Description of the product on which the design is applied.
- Details of what features of the design are particularly distinctive over other similar designs (called a Statement of Newness and Distinctiveness)
- If the application originates from a foreign design application the Convention priority details

Can I disclose my design before filing a design application in Australia?

Currently Australia does **NOT** have a grace period that enables an applicant to publicly disclose their design before filing an application.

Accordingly, prior disclosure can potentially invalidate any subsequently filed design application and under current Australian law you must file your application first before disclosing or commercializing your design.

Public disclosure includes:

- publication anywhere in the world;
- manufacture within Australia; and
- any sale or offer to sell or publish the design or a product that includes the design

Whilst Australia does not allow prior disclosure of a design before filing an application some of our major trading partners do have grace periods and you can validly file a design application within the respective grace period without your application being invalid for prior disclosure or use. This option is available in at least the United States and Europe.

How do I go about registering a design and what is the procedure?

(1) *Filing the design*

The first step in the process is filing a design application with IP Australia, including all of the required details outline above along with the representations and/or photographic representations. The filing date is extremely important as it is used to determine the priority date of your design.

(2) *Formalities check*

Once an application is filed it is examined but only for formalities and if there are no objections, the design will be registered.

If any objections are raised the applicant has two months from the date of issuance of the report to address and overcome the objections. If the objections are not overcome the design application will lapse.

(3) *Registration*

Once the design application passes the formalities check, the design will be registered and advertised in the *Australian Official Journal of Designs*. Registration protects your design for five years from the date the application was filed and can be renewed for another five years. If you do not renew your application, your design passes into the public domain and is free for anyone to use.

(4) *Examination*

Once a design has been registered, you can request that it be examined at any time. It is important to note that third parties can also request examination of your registered design.

Although examination is optional in Australia, a design registration is not enforceable until it is examined and certified by the Design's Office. The examination process is to determine whether your design is 'new and distinctive'.

If any objections are raised the registered owner has six months from the date of the examination report to overcome all of the objections. If the objections are not overcome the applicant has the right to appeal the examiner's report. If the objections are not overcome then the registration is revoked.

(5) Certification

If the examiner is satisfied that there are no grounds of invalidity, your registered design will be certified. Once your design is certified, you have the exclusive right in your design and can legally enforce those rights and against third parties.

How much does it cost?

The cost involved in obtaining a design registration and certification vary depend on what you are seeking.

The Official Fee for filing a design application is \$250 per design. If additional designs are filed in the one application and identified as such by the Office then there is an additional fee of \$250 for each further design.. The Official Fees for requesting examination of a registered design by the registered owner is \$420. If examination is requested by a third party the registered owner is liable for half of the fee.

The associated attorney costs vary depending on the circumstances and can include the preparing of formal drawings.

We recommend obtaining a cost estimate in each case.

How do I know if my design is eligible to be registered?

Before submitting an application a prior art search of at least the Australian Design's database is recommended. This will help in determining whether your proposed design is 'new and distinctive' and whether filing application is warranted.

It is also worth conducting a search on the key national design databases, such as the European and United States design databases.

We also recommend image searching be performed on Google or other web based search engines.

International design applications

It is possible for an Australian design applicant / owner to apply for design protection in other jurisdictions by filing individual national applications. These applications must be made in accordance with the various national law and can claim Convention priority from the Australian application if filed with six months of the Australian filing date.

How do I start?

Please contact Krouzer IP either by mail, email, or telephone and we can advise you on how to proceed and what information we require. As each application is unique we require this information, in order to provide the most appropriate strategic approach and advise you as to the different cost options.