

# AUSTRALIA: REGISTERED DESIGNS REGISTRATION PROCESS

## **Registration Process Overview**

Australian designs law provides a registration process in which design applications can proceed quickly to registration, without substantive examination, provided they pass an initial formalities check. Typically a design application might pass through to registration within about four weeks after filing.

Examination is an optional step that can be requested at any time after the design has been registered. A design may remain registered, without being substantively examined, for its entire term. However, registered designs are not enforceable until they have been examined and certified.

Please see the appended flowcharts showing, in simplified form, typical processes for registration and examination of designs in Australia.

## **Application**

A design application consists of an electronic application form setting out basic details such as ownership of a design and the article in relation to which it is applied, and the representations of the design.

The representations must show the product including the visual features of the design for which protection is sought. The illustrations for a design application should be carefully prepared to ensure that the scope of protection sought is clearly illustrated without unnecessary or unintended limitations. It is worth noting that Australian designs law is quite flexible regarding the form of the representations.

Further, the article to which each design relates must be named. In Australia, unlike some other jurisdictions, the name of the product, as given in the application, may have an effect on the scope of protection and on validity issues. Accordingly, it is important to bear this in mind when naming the product.

Australian designs law is somewhat different to designs law in most other countries. In order to gain the best protection in Australia, the peculiarities of Australian designs law should be taken into account when preparing an application for filing.

For example, careful consideration should be given to the name of the product to which the design relates, to the representations (sometimes it may actually be best to omit one or more of the representations being filed in other jurisdictions), and to drafting of a 'statement of newness and distinctiveness' to designate features which should be given particular regard when comparing the design to other designs.

## **Formalities Check**

Registration must be requested within six months of the earliest priority date. We normally request examination when filing an application, but deferring the request for examination is sometimes used to slow progress of the application and defer publication. Soon after registration is requested, normally within a month or so, IP Australia conducts a formalities check to assess whether the application meets certain formal requirements.

### **Formalities Check cont.**

If the formal requirements are considered not to have been met, then a formalities check report issues, setting a two month deadline for correcting all noted formalities issues.

Notably the two month deadline is not a deadline for response to the formalities check report, but rather a deadline for successfully addressing all formalities issues.

The most common formalities issue, in our experience, is that the application includes more than one design. This is often as a result of a deliberate filing strategy, and 'further' (effectively divisional) applications may be filed for designs excluded from the original application, if desired. Once all formalities issues are addressed the application proceeds to registration. If all formalities issues are not addressed the application effectively lapses.

### **Registration**

Upon registration, a Certificate of Registration issues and the design is published.

### **Term of Registration**

Designs are initially registered for five years calculated from the filing date of the application. Registration may be renewed for a further five years. The maximum term of an Australian design registration is ten years from the filing date.

### **Substantive Examination**

Examination is an optional step that can be requested at any time after registration.

When examination is requested IP Australia assesses whether the design registration is valid under Australian law. This includes assessing newness and distinctiveness in view of the results of a search of the prior art base, which includes both Australian and overseas design applications and other publications. A major source of citations for designs examination is Internet publications originating from the proprietor. Notably, there is currently no grace period for Australian registered designs.

If the examiner is satisfied the design is registrable, a Certificate of Examination issues. The registration is then enforceable. Prior to issue of a Certificate of Examination, the registration is not enforceable, and threats made to a third party on the basis of the registration are considered 'unjustified threats' so that remedies (damages) may be available to the third party.

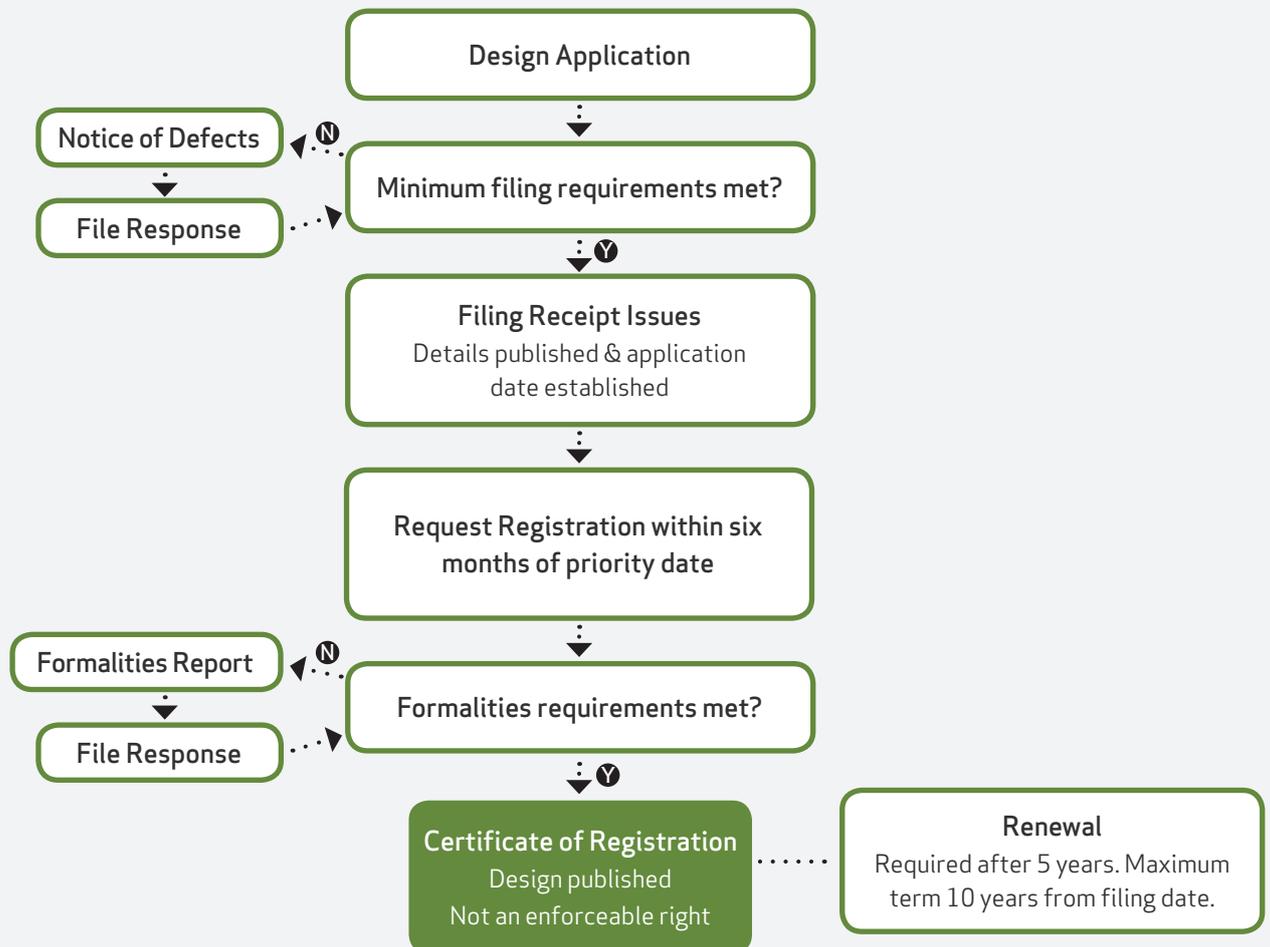
If the examiner believes that the design is not registrable, an adverse examination report will issue, typically setting a deadline of six months for overcoming the objections raised. Notably the six month deadline is not a deadline for responding to the examination report, but rather a deadline for successfully addressing all objections. If all objections are successfully addressed a Certificate of Examination issues. If objections remain outstanding after the deadline, the design registration is revoked.

Requesting (or not requesting) examination is generally a commercial consideration, in which factors such as the cost of examination (typically about A\$1500) and the possibility of revocation should be weighed against the benefits of having the registration certified and enforceable. Some design owners prefer to request examination as soon as their designs are registered, while many are happy to request examination only if and when a potential infringement is identified. Indeed a substantial majority of Australian registered designs have not been through the substantive examination process. We would be happy to discuss a suitable strategy with you regarding requesting examination.

# AUSTRALIAN REGISTERED DESIGNS

## TYPICAL PROCESSES FOR REGISTRATION AND EXAMINATION

### REGISTRATION



### EXAMINATION



\*Examination request may be filed any time after registration