

IP GATEWAY – DESIGNS

IP Gateway's Designs Group helps crystallise our ongoing expertise in, and commitment to, assisting clients in obtaining registered design rights.

The designs group is headed by Daniel Rosenthal, with significant and ongoing contribution by IP Gateway's other experienced attorneys.

Daniel is a Patent Attorney with over 20 years' experience, who qualified in the UK as a British (Chartered) and European Patent Attorney before migrating to Australia.

IP Gateway's Wayne Slater is a well-known expert in the field of designs protection, and a member of the AIPPI standing committee on designs.

IP Gateway has filed significant numbers of registered design applications in Australia for well-known international companies such as Samsung and Caterpillar, and also coordinates programs of Australian and International design filings for local clients. Our expertise in designs is further demonstrated by contributions to the Australian chapter of the Wolters Kluwer publication, *Design Rights: Functionality and Scope of Protection*, teaching of designs law at WIPO-accredited Masters of Law level, and contributions to international designs conferences.

Australian designs law is somewhat different to designs law in most other countries, and our practice at IP Gateway is to carefully consider all instructions to file design applications (including application claiming priority from overseas applications) and develop a filing strategy for Australian that takes into account the peculiarities of Australian law. We take pride in proactively developing tailored filing strategies to maximise Australian protection, rather than acting as a 'mail box' for Australian filings. Typical examples of our input include: selection of representations in order to provide broad protection, rather than mechanically including all representations of a priority application; tailoring the name of the product with a view to avoiding unnecessary limitations in protection; and advising regarding statements of newness and distinctiveness. More unusual examples include formulating a strategy including representations showing the product as having indefinite length (including preparing the representations), and applying for and obtaining registrations for mirror image products in single registration. Typically this additional input is provided at a cost corresponding to the costs of many Australian firms' mail-box style filings.

Awareness of registered designs (and the US counterpart, design patents) has been significantly raised in recent years by some high profile cases, but in our opinion, this is still an under-utilised form of protection. Australian Designs law was overhauled in the early 2000s with the intention of providing stronger, more useful, rights. The outcomes of recent litigation of Australian registered designs indicates that this has been largely achieved, and that registered designs can provide commercially valuable protection in Australia.

Registered design protection can provide a useful enforceable right where no other registered IP right is available. Further, registered designs can complement both patent protection, for example, by providing a right which is relatively straightforward to enforce and which can be useful in restraining copy-cat versions of products, and trade mark protection, for example, by protecting the new shape of a product or packaging before sufficient reputation in the shape has been accrued to support registration of a shape trade mark.

IP Gateway's Designs Group is committed to continue its focus and innovation in providing expert, commercially oriented designs advice.