

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 may 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, the name of the product 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 representations 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.

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.

In Australia, unlike some other jurisdictions, the name of the product, 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. Careful consideration should therefore 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

As mentioned above, a design application proceeds to registration and publication subject to a formalities check. An Applicant has an option of electing whether to request registration upon filing. If registration is requested at filing, the application will proceed to the formalities check, normally within a month or so. If the application complies with formality requirements it will proceed to registration and publication. In some cases, the applicant may wish to defer registration and publication by not requesting registration at the time of filing. In this case, after a six month period, the request for registration will be deemed to have been made and the application will proceed to the formalities check.

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.

Previously such an Internet publication or prior use of a design was fatal to a design registration. However, changes to the Designs Act that will come into effect from 10 March 2022 introduces a grace period for certain publications or use of a design for design registrations having their priority date on or after 10 March 2022. Any publication or use of the design within 12 months of the prior date will not form part of the prior art base for examination. However, please note our important comments below regarding the prior use infringement exemption.

Substantive Examination cont.

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.

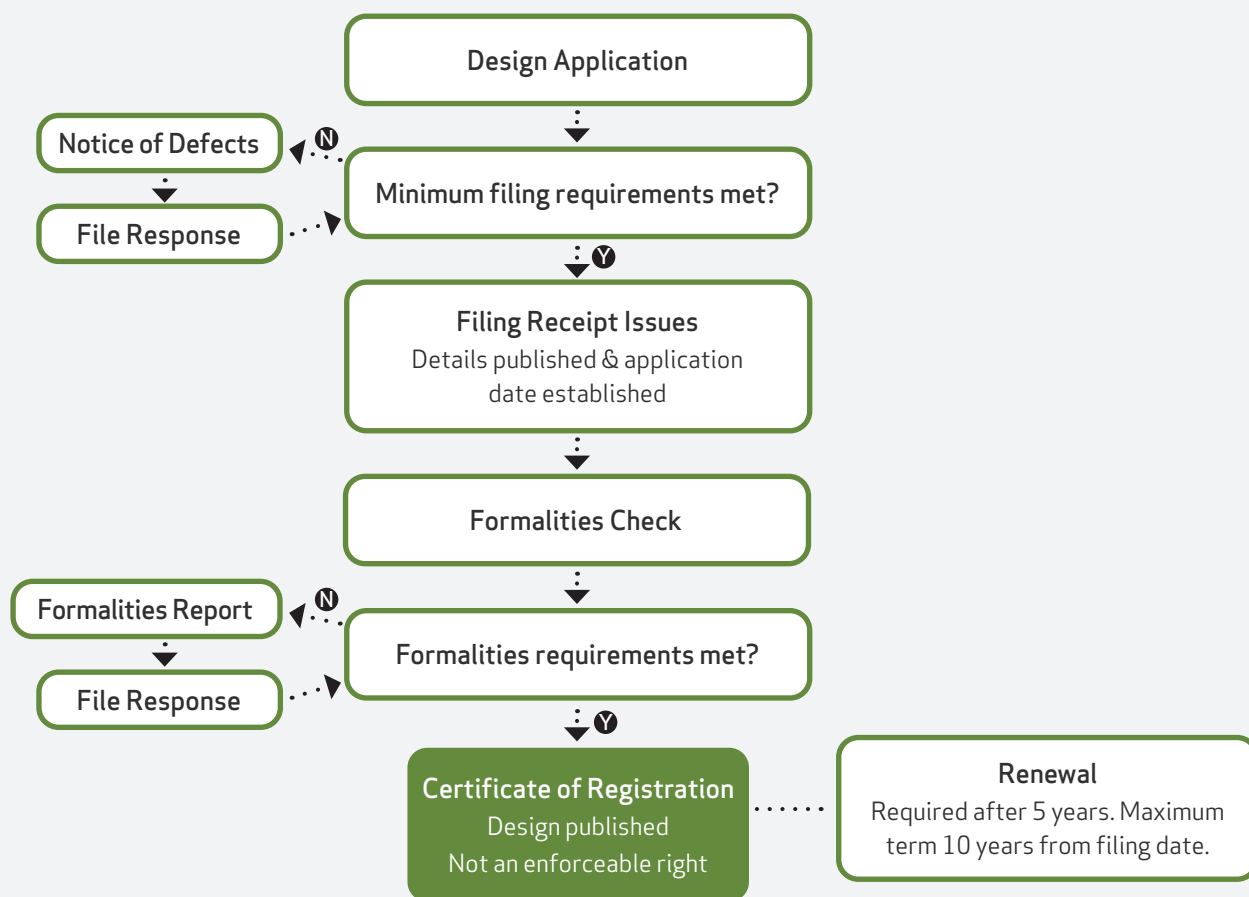
It is important to note that the grace period amendments to the Designs Act also introduce an infringement exemption to protect third parties from infringement where the first use of the design occurred in the grace period between first disclosure of the design by the proprietor and the priority date.

We would be happy to discuss a suitable strategy with you regarding requesting examination and any other issues that may arise if there has been any disclosure or use of a design before the prior date.

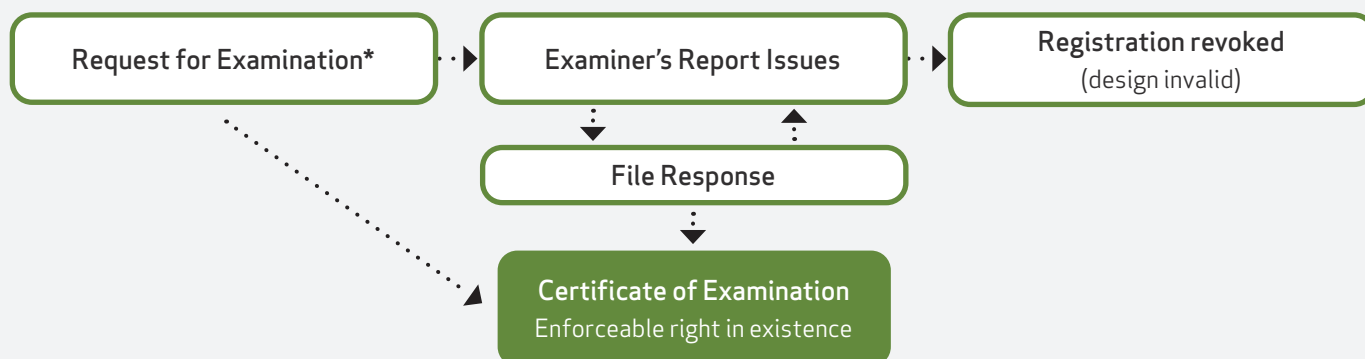
AUSTRALIAN REGISTERED DESIGNS

TYPICAL PROCESSES FOR REGISTRATION AND EXAMINATION

REGISTRATION



EXAMINATION



*Examination request may be filed any time after registration