

Designing applications: Tips for filing design applications in Australia

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DESIGNING APPLICATIONS

On average 6000 design applications are filed each year in Australia, with over 90% of these applications proceeding to registration. With the optional post-registration examination of the current system, less than 20% of all registrations are examined and certified as being valid¹. This can be contrasted with the regime under the Designs Act 1906 (Cth) (repealed) (Old Act) where all registrations were thoroughly scrutinised during examination.

This new process means that despite an increase in design application filings since the commencement of the Designs Act 2003 (Cth) (Designs Act), practitioners experience less design prosecution. When this is combined with the relative youth of the Designs Act and the resulting scarcity of Designs Office and Court decisions, practitioners have little guidance from which to develop strong filing practices. Practitioners are therefore still finding their way through some aspects the Designs Act and Regulations by application of theory, collaboration with the Designs Office and dead reckoning. To make matters worse, given the current review by ACIP², as discussed in the August edition³, by the time relevant case law is available, the law may change again.

This article discusses some points to consider when preparing an application and tips for filing design applications.

TABLE OF CONTENTS

| | |
|--|----|
| Top Tips | 2 |
| Has there been prior disclosure? | 2 |
| Will you receive a Formalities Notice? | 3 |
| What is your ability to amend? | 3 |
| What is the product? | 3 |
| Is there more than one design or product? | 5 |
| Are the representations appropriate? | 6 |
| Should a statement of newness and distinctiveness be included? | 9 |
| Take home | 10 |
| Endnotes | 11 |

Top tips

- The representations are the key element that defines the scope of protection. If available, view a sample or computer rendering of the product to ascertain whether the representations for the design application are an appropriate reflection of the design.
- Select a product title that is appropriately broad, sufficiently descriptive and a suitable reflection of the desired rights.
- The ability to amend is practically non-existent after registration and therefore consideration of the below elements should be made when filing an application.

Has there been prior disclosure?

When the Designs Act came into force, it was not appreciated how often applicants might wish to file an application for a product that has already been publicly disclosed in one form or another. Under the Old Act many such applications would never have been filed, and fewer still would have been registered since they would be weeded out during examination.

One can speculate that such filings may be sought due to several circumstances:

- Confusion brought about by the introduction of a grace period for patent applications that excuses an inventor's own disclosure of an invention up to 12 months prior to filing a patent application.
- The existence of general purpose grace periods for designs in the US and Europe.

But, it is also possible that applicants are simply taking advantage of the "optional examination" process that means the disclosure would never be detected if examination was not requested, and the deterrent value of the registration would remain intact for 10 years.

This raises the question as to which prior disclosures of a design are excusable and which invalidate a subsequently filed and registered design. The Designs Act does not provide a "grace period" for prior self-disclosure, as is available under The Patents Act 1990 (Cth)⁴. However, Section 18 does provide that certain prior publications will be disregarded. The Section 18 exclusion applies to use of "Artistic works" in which copyright subsists and therefore may refer to a photograph, rendering or, in some special cases, a prototype, if it is considered a work of artistic craftsmanship. This applies unless:

- The design has been "Applied industrially". This has the meaning given by Regulation 17(1) of the Copyright Regulations 1969 (Cth), which deems 50 or more articles as constituting industrial application. However, this is not a hard and fast rule; fewer articles could still be considered as industrially applied depending on the product. In *Burge v Swarbrick*⁵, 32 yachts were considered to be industrial application. Analysis needs to be conducted on a product by product basis; AND
- The products are sold or let for hire, or exposed for those purposes.

So, if the disclosure was posting a photograph of a prototype on a website (maybe as part of a Kickstarter campaign) but the product is not yet in production, then there is still some prospect of a valid registration. If a product is for sale and in commercial production prior to filing, then there is little prospect of saving a design registration from invalidity.

Will you receive a Formalities Notice?

Although there is no examination, all applications must pass through formalities checking prior to registration⁶ to assess whether the application includes sufficient information to enter it on the Register.

A Formalities Officer will check a number of issues⁷, including that sufficient information has been provided about the applicant, the designers and entitlement. They will assess whether the application identifies the product(s) and whether the product can be classified.

The formalities check can be used to your advantage if you wish to delay registration/publication or maximise the period in which amendments are more freely possible. A check is not conducted until a request for registration has been filed, which must be submitted within 6 months of the priority date⁸. For applications without a priority claim this allows applicants a 6 month delay of publication.

A more strategic approach can be taken by deliberately triggering a formalities notice, e.g. by omitting required elements or submitting multiple designs in one application, without identifying them as separate designs. A formalities notice will issue setting a 2 month deadline to overcome the objections. However, care must be given to meeting this deadline, as the application will lapse if all objections are not overcome by the deadline.

What is your ability to amend?

An application can be amended prior to registration; however amendments cannot alter the scope by the inclusion of matter which was not in substance disclosed in the filed application, representations or other documents⁹. The ability to amend is narrowed after registration, after which time amendments are limited to material contained on the Official Register, and additionally cannot increase the scope of the registration¹⁰.

Thus to maximise the potential for amendment one can consider filing "other documents" to provide additional disclosure, such as copy of the priority document for a convention application.

A statement of newness and distinctiveness (statement) can be amended prior to registration. However, after registration it cannot, because the statement is not included on the Register, just the fact that it exists is noted. This is a point of serious practical consequence. Unlike trade marks and patents, during examination of a design, when prior art is cited by an examiner, the scope of registration cannot be narrowed by amendment to avoid invalidity.

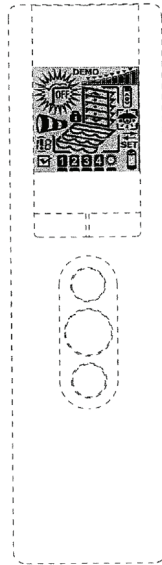
Regulation 9.05 does provide the ability to make amendments to correct a clerical error or obvious mistake.

What is the product?

The design right is expressly limited to products in relation to which the design is registered¹¹. Section 6 defines the meaning of "product". This presents several considerations.

Prior to registration the challenge is meeting the formalities requirement with respect to the product. Regulation 4.04(1)(c) requires that the application identifies the product(s) in relation to which the design is sought to be registered sufficiently well to enable each product to be classified in accordance with the Locarno Agreement¹². Formalities

Officers undertake this task using the product name and representations, and nothing more¹³.



Source: IP Australia¹⁴

Unless the representations are particularly cryptic, or include multiple indefinite dimensions, or the applicant is seeking to register a relatively controversial product, like an image on a computer screen, trade marks, font, etc. this is relatively straightforward. However whilst the application will proceed to registration, additional issues may be raised during examination.



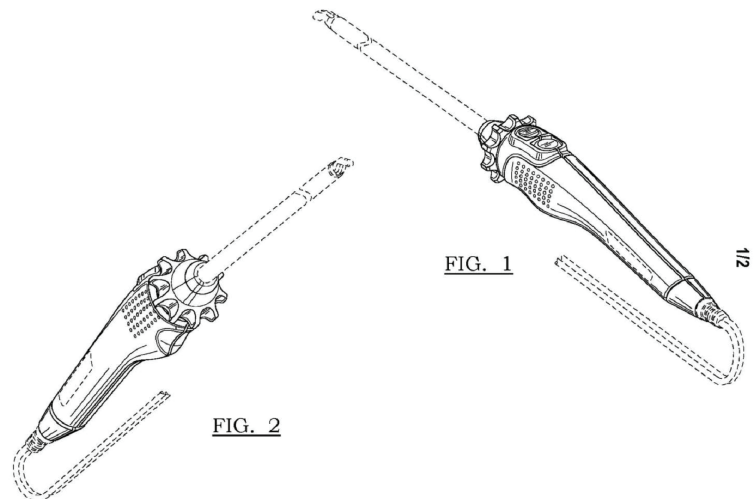
Source: IP Australia¹⁵

In some cases the limited enquiries made during formalities checking can result in unusual outcomes. If the product title is unclear, or uses a trade mark, the Officer may make their own assumptions to classify the product, without referring to the applicant.

Where there is conflict between the product identification given on the application form, and the representations, the product will be identified on the basis of the representations – with an assumption that the textual product identification is in error¹⁶. This could result in the design being incorrectly classified. In this case there may be potential for an infringer to argue that they are “innocent infringers” because the design was incorrectly classified - as a result it did not appear in a search of the Register that was conducted prior to undertaking the allegedly infringing conduct¹⁷.

Many foreign countries, such as the US, permit registration of partial designs. In some cases, the title used in the foreign application may refer to a portion of a product, e.g. a handle of a surgical instrument. In such

applications it is customary to illustrate the rest of the product in broken lines. In the US, the portions shown in broken lines would be effectively disregarded when considering the scope of the design right. In Australia, such partial products are not products within the definition of Section 6, unless the product is a “component part” of a complex product that is made separately to the product. Moreover, the use of broken lines does not fully exclude those parts shown in broken lines from the design as in other jurisdictions.



Source: IP Australia¹⁸

Where an application is made, claiming convention priority to a foreign design that relates to only a portion of a product, it is worthwhile questioning the applicant’s understanding of what protection they will be given. They may assume their protection covers the design of the designated portion, irrespective of the appearance of the remainder of the product, whereas in Australian the “overall impression” is considered.

Is there more than one design or product?

The Designs Act introduced the ability to file multiple designs in a single application. Practitioners hoped that this would streamline processing, provide cost savings for applicants and bring us into line with many foreign jurisdictions. However the implementation by the Designs Office and fee structure in the Regulations means that this potential has not been fulfilled. Section 22 defines the circumstances where an application may be filed in respect of more than one design or one design in relation to multiple products.

More than one design?

For applications that fall under Section 22(1)(c) or (d), each of the designs is registered separately and requires a separate fee. As mentioned earlier, there can be a benefit to filing an application in this way, but, there is a risk with bundling a number of designs into a single application. Until they are registered they are treated as a single application. So if, prior to registration, one design is unable to overcome the formalities objections and lapses, all remaining, unregistered designs in that application lapse¹⁹. Once the designs are registered, they are examined and renewed separately.

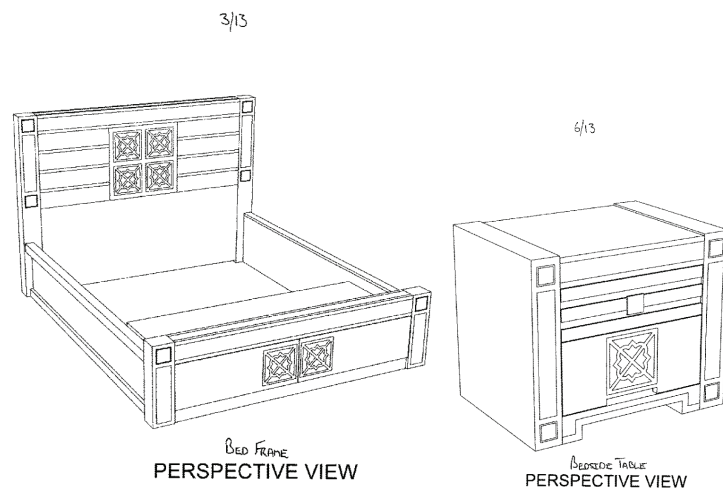
There may be administrative time savings for filing multiple designs in one application, and for straightforward cases, where it is highly unlikely a formalities objection will be raised, there is minimal risk with filing in this way. However, for more complex cases, separate applications should be considered.

A common design?

An application can be made in respect of one design that is common to more than one product, for example bedside tables, chest of drawers, dressing tables and wardrobes, where the shape of surfaces, handles, edges and legs share a common design.

For a common design the application is treated as a single design and only one fee is payable and a single registration is provided.

There is argument to say that this form of protection is broader than registering each of the individual products separately. According to the Examiner's Manual the features of 'the design' are those features that are in common between the representations of the various products and the features of the products are those features that differ between the representations of the various products. The product to which the design is applied is of secondary importance to the design²⁰. Whilst it has not been interpreted by the Courts yet, this implies that the features of the products that are not part of the common 'design' are given less weight.



Source: IP Australia²¹

Are the representations appropriate?

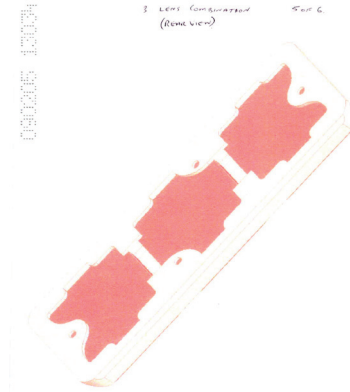
The Designs Act does not include a ground of revocation based on clarity of the representations. As shown in *Keller v LED*²² the Court will go to some lengths to construe the representations and give meaning to the registration, but will representations be construed in the way they were intended?

What views should be included?

There is no requirement for a specific number of views, but there must be sufficient views to fully display the design.

The same design (302360) was considered in two Federal Court decisions, *LED v Roadvision*²³ and *Keller v LED*²⁴. In *Keller v LED* the design was found valid and infringed. In *LED v Roadvision* the design was found valid and not infringed. One reason that *Roadvision* and *Baxters* (second respondent) were found not to infringe was because the lamps they sold had a flat closed back, whereas the registered design had a rear view showing a prominent cut-out pattern on the underside.

The other being the square lenses of the registered design had a wide landing between them while the respondents' had no landing. It would be interesting to see how this case would have turned out if the registered design had not included the rear view, but instead only focussed on the features of the product that were visible in use.



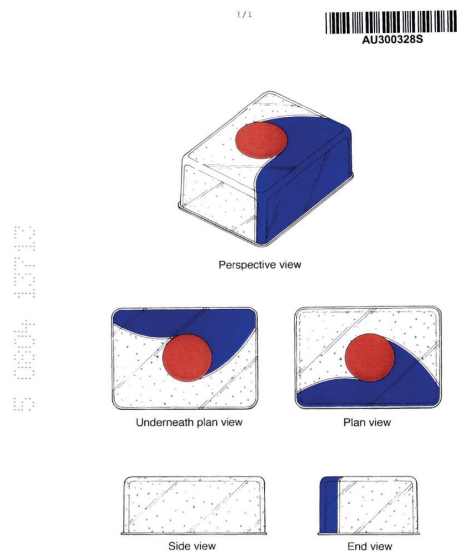
Source: IP Australia²⁵

The Courts have not had a problem with considering prior art publications where a view is omitted. In *World of Technologies v Tempo*²⁶ the prior art was only a front perspective view, whereas the design registration included all views. The design was therefore not considered to be identical to the prior art. However, the perspective view in the prior art was found to give a reasonably good impression of the overall appearance of the product, even though the back and underside were in no way discernable. One could infer that the same can be said when considering the scope of a registered design.

Therefore to optimise scope of protection, one should consider whether a particular view of the product might be omitted.

Should the representations be in colour?

Consider whether the representations should be filed in colour. If the design is registered in colour then colour will be considered when assessing the scope of the design, unless some form of disclaimer is included. Such a disclaimer would typically be provided in the statement.

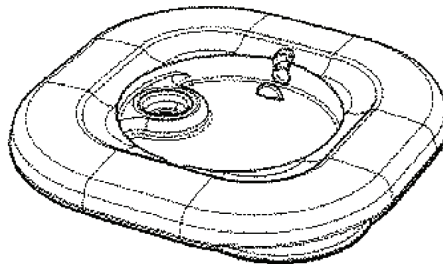


Source: IP Australia²⁷

What drafting elements have been used?

Do the images include broken lines, shading, rendering, stippling? What shows the visual features best? Generally speaking black and white line drawings give the broadest protection, however in cases where the contours are important then different drafting elements may be beneficial; each product must be considered on a case by case basis. When filing convention applications it is common for foreign designs, particularly those coming from the US to include shading lines to indicate contour etc. Consideration should be given as to what effect these lines have on the registration and if there is a need to clarify their intended meaning.

It is also important when receiving drawings to consider whether the images, which may be CAD files, accurately depict the commercial product. The CAD files may include facet lines that are not visible on the actual product; however they create a visual impact in the representations. The radial lines on this lid design are an artefact of the CAD model, and show the line along which the curvatures of the corners of the lid meet the straight sides. These lines are not likely to be visible in the commercial product, but appear as prominent features in the design registration. Compare the representation with a sample or computer rendering.

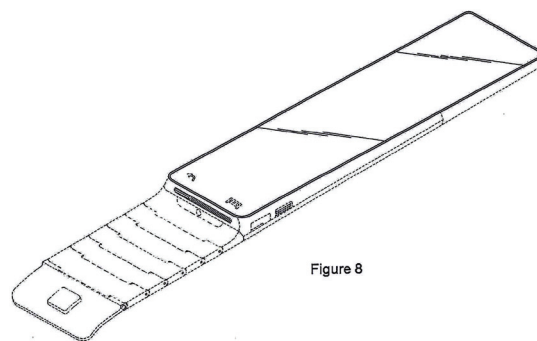


Source: *IP Australia*²⁸

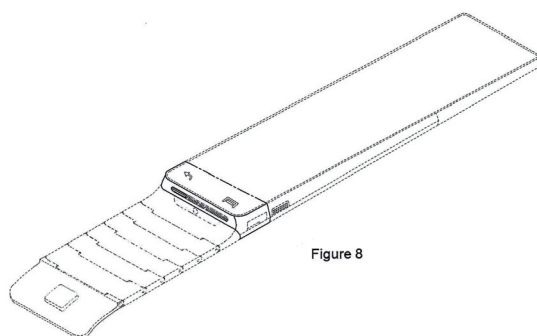
Have broken lines been used?

Broken lines are routinely used to “de-emphasise” elements, which in Australia is not equivalent to disclaiming these elements. Broken lines can be key in differentiating a design over prior art, by drawing attention to features shown in solid lines. Experience shows that two applications can be filed for the same product, with the drawings being identical except that one includes all solid lines and the other includes broken lines. The registration with broken lines sailed through examination, whilst the one without broken lines drew an objection. The use of broken lines does indeed make a difference to the scope.

Another way to “hedge your bets” in terms of the scope is to protect several separate designs, with each depicting a different element of the product in solid lines, with the remainder of the product shown in broken lines. Each registration therefore emphasises different elements of the product.



Source: IP Australia²⁹



Source: IP Australia³⁰

Practical issues

There are many instances of the representations on AU Designs Data Searching (ADDS) being of poor quality. Historically this was a shortcoming of the process employed for scanning a hardcopy design application, but even with implementation of online filing, issues still arise. The new electronic lodgement system is an improvement in this respect but presents some challenges. Using this system, images are uploaded onto IP Australia's central database, which then updates the publicly available ADDS database at registration. The software that the Designs Office currently uses requires all pages to be in portrait layout. When a representation is uploaded in landscape mode, the software automatically manipulates the images to portrait format, which can result in the quality being compromised. Checking the online version when they are published is good practice.

Should a statement of newness and distinctiveness be included?

A statement is used to identify particular visual features of the design as new and distinctive, such that particular regard is given to those features, in the context of the design as a whole, when assessing the substantial similarity in overall impression of the design³¹.

It was apparent from *Keller v LED*³², that a statement, even if poorly expressed, will be construed. However, it is only used as one element in assessing the distinctiveness of the design. In *Keller v LED* parts of the statement that were descriptive of functional features were ignored and the feature 'no visible screws' was given little regard, as the infringing product had screws the same colour as the base and therefore they did not create a different "visual appeal".

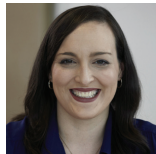
There are a number of different ways that statements can be written, but there are a few standard examples. The first is to draw attention to the shape and configuration of the product. The second is to draw attention to the pattern and ornamentation. Statements also often refer to features shown in solid lines, to de-emphasise those features shown in broken lines. Statements such as these can serve to clarify a design scope by focusing attention on the most distinctive visual features of a design and should be included where possible, but remember these are not claims or a statement of monopoly and are not able to be amended after registration, so care should be taken in their preparation.

There are also “generic” statements, which may be written such as: Newness and distinctiveness resides in the features of the design as shown in the representations. According to the Examiner’s Manual, such statements add nothing to the design over what is shown in the representations and are entirely redundant³³.

Even though the materials used in a product are excluded from the definition of “visual feature” in the Designs Act, and thus cannot form part of a design, a carefully crafted statement that refers to an appearance of a material, e.g. a metallic or wood-grain appearance, may serve to provide protection for such features.

Take home

There is no “one size fits all” approach to design applications and until more Court decisions issue care must be given to assessing the most appropriate way for products to be protected whilst navigating the complexity of the Designs Act and Regulations.



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Endnotes

1. ACIP (Advisory Council on Intellectual Property) Review of the Designs System: Issues Paper September 2013, available at www.acip.gov.au.
2. Above n 1.
3. 2014 Vol 27 No 2 August edition of IP Bulletin, Opening 'Pandora's Box': ACIP's review of the Australian designs system by Victoria Bell, Baker & McKenzie.
4. The Patents Act 1990 (Cth) Section 24(1).
5. *Burge v Swarbrick* [2007] HCA 17.
6. The Designs Act 2003, Part 3, Division 1.
7. Designs Regulations 2004, Reg 4.04, 4.05, 4.06.
8. Above n 7, Reg 4.01.
9. Above n 6, Section 28.
10. Above n 6, Section 66.
11. Above n 6, Section 10(1)(a).
12. Locarno Agreement Establishing an International Classification for Industrial Designs.
13. *Somfy SAS* [2011] ADO 4 (31 May 2011).
14. Design AU335651 – initially titled “A display screen”, subsequently amended to “LCD screen for remote control”; Above n 13.
15. Design AU96223 registered under the Designs Act 1906 (Cth) (repealed).
16. IP Australia Designs Examiners' Manual of Practice and Procedure (2003 Act), D04.3.1.
17. Above n 6, Section 75(2).
18. Design AU356024: “Electrosurgical hand piece”.
19. Above n 6, Section 42(5).
20. Above 16, D04.3.7.
21. Design AU 345275: “A bed frame, bed head, bedside table, tall boy and dresser”.
22. *Keller v LED Technologies Pty Ltd* [2010] FCAFC 55 (9 June 2010).
23. *LED Technologies Pty Ltd v Roadvision Pty Ltd* [2012] FCAFC 3 (10 February 2012).
24. Above n 22.
25. Design AU302360 titled “Rear combination lights”.
26. *World of Technologies (Aust) Pty Ltd v Tempo (Aust) Pty Ltd* [2007] FCA 114.
27. Design AU300328: “Coloured Tablet”.
28. Design AU349373: “Lid for container”.
29. Design AU350984: “Electronic device”.
30. Design AU350982: “Electronic device”.
31. Above n 6, Section 19(2).
32. Above n 22.
33. Above n 16, D04.6.1.4.

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