

Key Changes to the Designs Act

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Australia's design registration system changed in June 2004. The key features of the Act include:

Term

The term a design is now registered for is 10 years. This is in compliance with Australia's minimum obligations under the TRIPS Agreement. Designs that were registered under the old Act could be registered for a period of 16 years and therefore, if your design is registered under the old Act it will continue to enjoy a 16 year term. When designs are now registered they are registered for a five year period and after this term they must be renewed. They can only be renewed for a further five year period.

Application/Registration Process

Under the new Act applications only need to undergo a formalities check to ensure that they contain all the relevant and required information, such as designer details and the name of the applicant, before the applications proceed to registration and publication. This enables design owners to put their rights on public record without having to go through a costly examination process.

Substantive Examination

Instead of substantive examination taking place when a design application is filed, it is now carried out after registration. Any person may request examination after the Registration process, including the Registrar. Under the New Act there is a higher threshold test for the Examination and Certification of designs. Designs must be new and distinctive when examined against the prior art base which has now been significantly expanded. Under the Old Act designs were examined against other designs available in the public domain in Australia. Under the New Act designs are now examined against a much broader prior art base which includes designs published anywhere in the world. If after substantive examination the Registrar is satisfied that the registered design is valid, a Certificate of Examination will be issued. It is not possible to commence legal proceedings, including issuing letters of demand letters on infringers, until substantial examination is carried out. Essentially under the New Act there is a higher threshold test for obtaining registration.

Infringement Test

Under the new Act the test for infringement of a design has changed significantly. For there to be infringement of a design the infringing product must be identical or substantially similar in overall impression to the registered design. The focus is now on the similarities between the designs rather than the differences between the designs. The reasoning behind this change was to make it easier for registered design owners to succeed in infringement actions.

Part/Portion of a design

Under the new Act a product that is not made separately from the product itself cannot be registered as a design.

“Spare Parts” Provision

The new Act has introduced a new spare parts provision. Essentially parts of complex products that are manufactured separately can then be registered separately. However, if these registered parts of complex products are used for repair purposes, that use will not be deemed an infringement of the registered part. It is then up to the design owner if they believe that infringement has occurred (i.e. that the product was not used for repair purposes) to establish that the alleged infringer knew or should have known that the complex/spare part was not used for repair purposes.

When does the new Designs legislation apply?

- If a design was registered before the new Act came into force which was on 17 June 2004, in most circumstances the design will continue to be governed by the old regime.

- If a design was registered immediately before the day it came into force and if a design was registered after the commencing day as a result of a design application to which the old Act continued to apply, the design is taken to be registered and examined under the new Act.

- The old Act will continue to apply for the purposes of determining the validity of the registration of the design.

- If proceedings arising from an application to a court under the old Act were pending immediately before the commencing day, the matter is to be decided as if the old Act had not been repealed. However, any order made by a court in relation to rectification must relate to the Register under the new Act.

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