

TOPIC 4 – DESIGN LAW

4.1 History

Designs Act 2003 (Cth) - repealed the 1906 act aiming to clarify overlap between copyright and design law.

- S151-161 provides that the previous act will still operate in limited circumstances

While the publication of the design does not give the applicant any rights in the design, publication places the design in the prior art base

- This destroys the novelty of the design, and prevents others registering similar designs

4.2 Registration

A design will only be protected if it has been duly registered.

- There is no substantive examination of the design application during the registration process
 - However, examination may occur on request, as an infringement action can only be brought once a design has been examined

Designer: Only the author of the design (the designer), the employer of the author (in the design is made in employment), the contractor, and the assignor, can apply for registration

- Joint ownership is allowed

A design application must comply with the 'minimum filing requirements' (s21(2)).

- These are that the application included a complete application form, at least one representation of the design (reg 4.04), and the application fee (reg 3.01)
- Representation = a drawing, photograph or specimen of the design (s5)
 - Photographs of the article are also acceptable
 - These representations should show the article as the eye would see it
 - This allows the public to determine the details of the design and scope of the protection
- Registered designs must be reasonably clear and succinct
 - This means that the design must 'appear with reasonable clarity, and without necessity for unreasonable prolonged or complicated series of deductions from the registered representation' (**Keller**)
- S22 allows for a single application to cover a common design that applies to more than one product or multiple designs that apply to a particular product
- A 'statement of newness and distinctiveness' may also be included in the application form (s69)

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- This sets out the visual features of the design that the applicant believes are novel and distinctive
- It is not compulsory, but may assist in determining if the design is new and distinctive compared to prior art

Can apply for either (s35) (requirements s39-40):

1. **Registration** - gives the applicant rights in the design
 - Provisions prohibiting registration s43(1)
2. **Publication** - merely serves to ensure the design is part of the prior art
 - Destroys the novelty and distinctiveness, preventing other parties from registering similar designs
 - No specific rights obtained, merely prevents others registering it
 - However, not necessary as it will already become part of public domain

Must decide either at time of application lodgement or within 6 months of priority date, or application will lapse (s33(1)(a))

Priority Date: date the application was filed (s27(1); reg 3.06)

Duration: 5 years from the filing date, renewable for up to a total of 10 years (s46 and 47)

4.3 Meaning of Designs

4.3.1 Designs

Design (s5 definition): 'the overall appearance of the product resulting from one or more visual features of the product'

- The design must be in the form of a product (s8) (see product below (s6))

A design must be something separate and distinct from the article or product to which it is applied

(Wolanski)

- **Wolanski:** when discussing the design of a 'neck-tie support', Kitto J observed that a design is '*a conception or suggestion as to shape, configuration, pattern or ornament... and accordingly what the proprietor of a design gets by its registration is a monopoly for one thing only, and that is 'one particular individual and specific appearance'*
- Eg. Rejected Microsoft's application of a type font: the need for Microsoft's design to be applied to the article was a telling factor of rejection. The type font was not built into, or to be applied to, anything at all. The design did not specify a tangible thing.

4.3.2 Visual Features

Visual Features (s7(1)): the 'shape, configuration, pattern or ornamentation' of the product

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- This covers its shape and configuration (3D elements), and its pattern and ornamentation (2D elements) (s7(2))
- The feel of the product and the materials used in the creation of a product are excluded from the definition of a visual feature (s7(3))
- The visual feature may, but need not, serve a functional purpose
- A functional design may be validly registered even if it consists of, or includes, features of shape or configuration that serve a functional purpose
 - **Multisteps:** the court took into account the fact that the functional aspects of the plastic punnet containers intended for small tomatoes and strawberries 'limited the freedom of the designer to innovate'
 - While the registered designs were valid, the individual features were held not to 'signify aspects of design innovation'

4.3.3 Product

Product (s6(1)): Something that is manufactured or handmade

- Includes the components if made separately, and a kit when assembled (s6(2))
- Something may still qualify as a product where it is of an indeterminate length
 - Eg. Plastic pipes, corrugated iron, or roof guttering (manufactured at continuous lengths)
 - Eg. Computer screen has been held not to be registerable as a design on the basis that the physical screen or monitor is the product, and that the appearance of the screen was ephemeral (**Apple Inc**)
 - The screen display was not a product as the pattern or ornamentation was a result of the use of software that was separate from the computer screen
- S6(3) - Steps to show that which something has one or more indefinite dimensions is a product:
 - (a) a cross - section taken across any indefinite dimension is fixed or varies according to a regular pattern;
 - (b) all the dimensions remain in proportion;
 - (c) the cross - sectional shape remains the same throughout, whether or not the dimensions of that shape vary according to a ratio or series of ratios;
 - (d) it has a pattern or ornamentation that repeats itself.

4.3.4 Spare Parts

- Design protection is available for new or original designs for spare parts
- See: the *right of repair for spare parts* defence below

4.3.5 New and Distinctive

A design must be new AND distinctive (s15; s16)

- Must compare the design with similar designs in the prior art base (PAB) (s15(2)), which includes designs used in Australia, published in a document in Australia or overseas, or disclosed in a published design application.
 - This expands the PAB beyond Australia
 - Only for PAB available before the design's priority date
 - S17 provides that certain things will be disregarded in deciding newness and distinctiveness
1. **New:** a design is new unless it is identical to a design that forms part of the PAB (s16(1))
 2. **Distinctive:** A design is distinctive if it is not substantially similar in overall impression to a design that already exists (s16(2))
 - Substantially Similar: The court will have regard to similarities and differences, but more weight is given to the *similarities* between the designs than the *differences* (s19(1))
 - **Redberry Enterprise:** the inquiry under the DA is more complex and sophisticated than that, particularly where the design field is crowded and due consideration must be given to the state of the development of the prior art
 - 'Hence the relevant comparison cannot be based upon a fleeting or casual inspection of the drawings or object in question or some 'imperfect recollection' or either of them. That is not to deny that the comparison to be undertaken is essentially impression based' (**Hunter Pacific**, applying **Multisteps**)
 - Found infringement as the obvious differences in the design were unable to overcome the significant and eye-catching similarities
 - Distinctiveness is assessed by 'the standard of the informed user' (s19(4))
 - Informed user is flexible enough to incorporate where relevant the views of consumers, experts, specialists and skilled tradespersons. It does not require that the expert or consumer be the test in all cases.
 - The informed user need not have used the product but must have familiarity with the product to which the design relates
 - The examination is whether there is any substantial similarity in the overall impression to any of the prior art, taking into account any statements of newness and distinctiveness and other factors from s19(2)
 - S19(2) - freedom of the designer to innovate, the quality, amount and importance of the part of the design that might be substantially similar

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- (same test for infringement)

4.4 Rights Conferred & Infringement

4.4.1 Ownership and Rights

The owner may assign all or part of their interest in the registered design. Assignment must be in writing and signed (s11). Can also be transferred or devolved by will (s10(2), s11(1)-(3))

The owner has the exclusive right to control the way in which products that embody a design are used in certain circumstances (s10):

SECT 10 - Exclusive rights of registered owners

(1) The registered owner of a registered design has the exclusive right, during the term of registration of the design:

- (a) to make or offer to make a product, in relation to which the design is registered, which embodies the design; and
- (b) to import such a product into Australia for sale, or for use for the purposes of any trade or business; and
- (c) to sell, hire or otherwise dispose of, or offer to sell, hire or otherwise dispose of, such a product; and
- (d) to use such a product in any way for the purposes of any trade or business; and
- (e) to keep such a product for the purpose of doing any of the things mentioned in paragraph (c) or (d); and
- (f) to authorise another person to do any of the things mentioned in paragraph (a), (b), (c), (d) or (e).

4.4.2 Infringement

A registered design must be examined and a cert of examination issued before infringement action (s73(3))

Primary Infringement

1. Infringing Product

- Occurs where someone does a range of activities in relation to a product that embodies a design that is identical or substantially similar in overall impression to the registered design (s71(1); (1a); s19(1))
- Must compare the infringing product and the registered design, not the product embodying the registered design and the infringing product
- Revisit Distinctiveness above.
 - Substantially Similar: The court will have regard to similarities and differences, but more weight is given to the *similarities* between the designs than the *differences* (s19(1))