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By email

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Dear Brett Massey

RESPONSE TO PUBLIC CONSULTATION ABOUT THE DESIGNS ACT

This letter outlines AJ Park's response to the public consultation about the Designs Act. We have repeated your questions in bold text and provided our responses below each question.

Scope of designs protection

P1. Do you consider that Australia's approach to partial designs should be reformed? Why or why not?

Yes - Australia's approach to partial designs should be reformed to be more consistent with other jurisdictions. This will benefit Australian applicants because they will be able to achieve better protection both in Australia and overseas. When seeking protection overseas, Australian applicants will be limited to protecting what was filed in Australia. This will also benefit applicants filing into Australia claiming priority from overseas because they will be able to obtain the same protection in Australia that they are given by their priority application.

P2. What is your preferred option, and do you see any additional options for addressing the problem?

Our preferred option is options 2. However, protecting partial designs for the **same** product may be more reasonable than protecting **similar** products. As mentioned below about option 3, protecting 'similar products' could create FTO issues because the scope of each design would be wider.

If the design covered the same product, design registration scope would effectively disregard broken line features but not extend protection beyond the named product - e.g. water jug. The applicant could file for multiple products in one application (one fee) if they want to have the design include similar products. For example, a water jug and a cup.

Our least preferred option is option 3. This option could create FTO issues. The Australian designs register would be hard to search because it would be necessary to search a large number of unrelated products.

P3. Has someone ever copied a part of your design and if so, can you describe your experiences?

N/A.

P4. In relation to partial designs, have you found claiming priority from an overseas application problematic in Australia and if so, can you describe your experiences?

In our experience, this has not been problematic at office level because it is never checked during formalities. It is only checked during examination if there is intervening prior art.

P5. Have you found claiming priority from an Australian application problematic when seeking partial protection overseas and if so, can you share your experiences?

It is currently allowable to show features in broken lines in Australian representations. When filing overseas, the broken lines will have a clear interpretation overseas. However, the title in Australia could limit the options overseas. For example, an application for a cup in Australia that claims novelty in the handle and disclaims novelty in the remainder of the cup would need to be filed as a cup in some jurisdictions to maintain the priority claim. It might not be possible to file an application for a handle and still validly maintain the priority claim.

P6. Are you aware of additional costs and benefits that have not been identified in this paper? If so, please provide further detail

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V1. What is your preferred option, and do you see any additional options for addressing the problem?

Either option 2 or option 3.

Option 2 appears to be a reasonable middle ground, subject to clarification around partial designs (as discussed above). If the protection for partial designs is not clarified, then it will be questionable whether option 2 will give useful protection in many instances where the representations show the product in broken lines. In that case, option 3 may be best.

The references to the outcomes described in relation to each option is not clear. Consideration should be given to whether dynamic GUIs and dynamic icons should be treated consistently with other design registrations. For other designs, it is necessary to file more than one application

V2. Should protection for virtual designs be linked to a physical product? Why or why not?

Yes, they should be linked to a physical product like other types of designs under Australian law.

V3. What types of virtual designs should or shouldn't be protected? e.g. (computer programs and/or other types virtual designs such as fonts, holograms, animations etc)?

Any design that is a visual feature that relates to a product should be protected. However, if a visual feature would not be protectable in another form, eg if it was printed on paper, the expression of the feature on a device should not make it protectable. That is, a font on a computer screen should not be protectable if a font printed on paper would not be protectable.

V4. Do you consider other existing forms of IP protection (such as copyright or trade mark protection) are sufficient for protection of virtual designs in Australia? Why or why not?

In general, all IP rights are not up to date with modern technology.

V5. Would partial design protection need to be provided as well to protect virtual designs effectively? Why or why not?

Yes, if virtual designs are tied to a product, it will be necessary to allow partial design protection. This would allow a design to be protected in relation to a range of different shaped and sized devices. Otherwise, protecting virtual designs would be unnecessarily limited.

V6. Are you aware of additional costs and benefits that have not been identified in this paper? If so, please provide further detail.

In summary, it is our view that virtual designs should be treated consistently with how other designs are treated by IP Australia. Further, their treatment should be based on the legislation and relevant case law and not based on their subject matter. As pointed out in the ACIP report, "there is nothing in the legislation which requires that visual features be observable in the 'resting' state or when unconnected to electricity." Accordingly, we believe virtual designs should be allowable by IP Australia.

C1. Given the concerns raised by the LCA IP Committee, and the preceding discussion, do you see a need to further clarify certain elements of section 19?

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C2. How do you see the suggested changes to the use of the SoND (Options 2 and 3) impacting on the administrative burden of applicants?

We agree with the no change option. We are not aware of confusion caused by the presence of a SoND and are not aware of any administrative burden caused by a SoND.

C3. If protection for partial designs was introduced, how do you see this impacting on the operation of subsection 19(2)? Would the introduction of partial designs cause the SoND to be redundant?

No. The SoND would be used for both partial and complete designs. For either type, the SoND would explain whether 2D, 3D, or a combination of features are being claimed and what features are disclaimed and should be disregarded.

C4. If protection for partial designs was introduced, do you see any problems in retaining the expression 'design as a whole' as it appears in subparagraph 19(2)(b)(ii), paragraph 19(2)(c), and subsection 19(3)?

No. The design would be the 'partial design'.

C5. If protection for virtual designs was introduced, how would you see this impacting on the definition of 'product' as it currently appears in subsection 19(4)?

The definition of a product shouldn't change.

Simplifying and clarifying the designs system

Question 1: Do you see any unintended consequences with the preferred option?

No. This seems like a sensible approach, especially if it is in line with the approach taken for patents.

Question 2: IP Australia is particularly interested to hear from designers/IP professionals in relation to the following matters:

During the ACIP Designs Review, interested parties advised that the terminology in the Designs Act causes confusion as to the status of a registered design. Is this your experience, either as a designer or IP professional?

Yes, as IP professionals, we are aware of confusion around the status of a registered design. Mostly around the level of examination required to be registered and the uncertainty about whether a registered design is valid. A common misunderstanding is that a design has been substantively examined to be registered.

Do you consider that the registered design terminology should be reformed?

Yes.

Do you see any unintended consequences with the preferred option?

The preferred option does not fully address the issue about whether a registered design has been substantively examined and can be presumed to be valid. But it does clarify that it hasn't been examined.

Do you have an alternative preferred term for a registered design without certification?

No.

Question 3A: Do you consider any of the following issues to be of high priority? Please provide further detail including reasons.

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Question 3B: Does the proposed amendment resolve the present inconsistency between subregulation 3.06(2) and section 13?

We agree that there should be consistency between subregulation 3.06(2) and section 13.

Question 3C: Does the proposed amendment remove the disadvantage to Convention applicants? Are there other disadvantages?

An applicant should at least be able to narrow the scope of the design applied for compared to the design of the priority application. As mentioned in the proposal, this issue would be solved in many situations if partial designs were allowable in Australia.

Question 3D: Is the proposed amendment necessary since courts have an inherent discretion not to act in appropriate circumstances?

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Question 3E: Should the Designs Act be amended to allow a court to revoke a design registration, in appropriate circumstances, at any time after the design is registered?

Yes.

Questions 3F: Is the proposed amendment necessary to clarify subsection 15(2), that is, there is no basis for suggesting that the prior art base does not include designs for 'other products'?

It doesn't appear that an amendment is necessary. In many jurisdictions, other products are considered to be relevant.

Question 3G: Does the proposed amendment resolve the problem, as outlined, completely?

We agree that this should apply to all stages of the design registration process.

Question 3H: What would be the impact on other aspects of the designs system, for example, the use of a SoND, if voluntary amendments were allowed at any stage prior to examination of the design?

We support the ability to make amendments to the SoND, at least to correct errors, or in response to objections raised during formalities or certification examination. It should be allowable to make voluntary amendments to any document filed or part of the application. For example, amend the SoND and/or the representations.

Question 3I: Does the proposed amendment resolve the problem, as outlined, completely?

We support the intention to align with other IP rights.

Question 3J: Does the proposed amendment resolve the problem, as outlined, completely?

We support the intention to align with other IP rights.

Early flexibility for designers

Question 1: If Australia introduces a grace period, do you foresee any issues with implementing the preferred option? IP Australia would be interested to hear from stakeholder as to whether:

the grace period should be six-months or twelve months in duration

Either time period would be fine. 12 months is consistent with other jurisdictions including the US, Canada, and Europe. Six months would be consistent with the priority period – an applicant would not be given more time to file in Australia using the grace period compared to the time they have available relying on a priority date.

the grace period should extend from the filing date or the priority date

The grace period should extend from the filing date. Again, this is consistent with other jurisdictions.

an applicant should be required to declare any disclosures

No. The applicant should not be required to declare any disclosures. This is consistent with the grace period available for patent applications – it is not necessary for a patent applicant to declare any disclosures if they are using the grace period.

any specific conditions should apply to a prior use infringement exemption for designs.

No.

Question 2:

a. Do you support Option 1 of no change?

No. There should be an option of deferred publication.

b. Do you prefer deferred publication through deferred registration under proposal 2.3 or one of the deferred publication options in proposal 2.2?

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c. If proposal 2.2 is preferred: a. should Australia adopt an optional deferred publication or fixed publication regime?

Deferment of publication should be optional. Many applicants do not want publication deferred. Withdrawing a request for deferred publication adds an extra step for the applicant.

How long should the period of deferment last?

Either 12 months (from filing) or 18 months (from the priority date). In New Zealand, the period is up to 15 months from filing. For some applicants, this would not be long enough which may prevent them from using the design system to get protection for certain products if they wish to keep them confidential for longer.

Should the period of deferment be calculated from the priority date or the filing date?

It should be calculated from the filing date. A six-month deferment from priority date is not a deferment at all in most convention cases. That is, convention applications are typically filed at the six month deadline from the priority date. If the deferment period is six months from the priority date, it will expire at the same time the application is filed.

Question 3: Do you foresee any issues with implementing the preferred option?

There are no obvious downsides to removing the publication option, especially since it is rarely used. An alternative might be for registration to be the default option unless the applicant requests publication at time of filing.

Concluding remarks

Please let us know if you need any clarification of any of our answers.

Yours faithfully



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