

From: [Robert Wulff](#)  
To: [MDB-Consultation](#)  
Subject: RE: Design initiatives – Consultation underway [SEC=UNCLASSIFIED]  
Date: Friday, 17 January 2020 5:05:51 PM  
Attachments: [image001.png](#)

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The following are my personal comments (not those of Griffith Hack):

## 1. Examining the scope of design protection

- The protection of partial designs - whether IP protection for only part of a product should be allowed. – ***I support partial designs being generally allowed (Option 3). Reasons include: bringing Australia into line with many o/s countries. It can also avoid the whole ‘disclaimer’ contrivances that attorneys have to adopt. The Office has also, in effect, recognised partial designs in some of its decisions (see e.g. Debrett Lyon’s Colgate toothbrush decisions).***

- The protection of virtual, non-physical and active state designs and considers whether IP protection of new types of designs (including screen displays, screen icons and graphical user interfaces (GUIs)) should be allowed. – ***I support these being generally allowed (Option 3 or at the very least Option 2). This will bring us into line with much of the rest of the world. The world is rapidly moving into digitally-based commerce (consider e.g. AI, Internet 4.0 and the Internet of Things). Virtual, non-physical and active state designs play a big part in the facilitation of services in the digital realm. To deny designers and organisations the opportunity to protect and defend such valuable designs would seem to deny protection in large and emerging fields of economic endeavour.***

- The approach taken in section 19 of the Designs Act, when assessing whether a design is distinctive enough when compared to another design. – ***I personally favour Option 2 – I think Yates J got it right in Multi-Steps. If you limit the standard to actual users, the adducing of evidence can be (and typically is) a nightmare. Yates J focussed on the actual wording of Section 19(4):***

*“...the person must apply the standard of a person who is familiar with the product to which the design relates, or products similar to the product to which the design relates...”*

***Here, there is no reference to a “user” – the reference to “user” only comes with the ‘name’ of this standard. As Yates J correctly (in my view) points out, the person who applies the tests of Section 19 only requires product familiarity. To me, this seems to be a reasonable approach and the correct standard to be applied. It allows for a range of persons to be ‘Informed Users’.***

## 2. Early flexibility for designers

- Introducing a safety net (grace period) to avoid public disclosures made by a designer from prejudicing a later filed application for design protection in Australia. – ***I strongly support a broad, long grace period to align us with Europe and the US (Option 3). Grace periods are especially important to designers, who are often ‘cash-strapped’, especially in AU. It allows designers to try out their new designs without fear of then being able to secure protection (e.g. if reaction to the design seems promising). Also, many designers are ignorant to the consequences of early disclosure.***

- Allowing designers to delay publication of applications for design protection, so that their design can be kept secret for longer (for example, until it is ready to be launched in the market). – ***I favour Option 2 – optional deferred publication. Designs are a particular form of IP protection where an organisation often wishes to delay publication of a design until their associated product is ready to be launched. Many o/s countries offer delayed publication; in AU – we have to adopt a kind of contrivance to achieve this (i.e. provoking a Formalities report to delay publication). Formalising the system would seem to offer the best and easiest resolution. E.g. allow for a 6 month deferment (consistent with the Convention period).***

- Removing the rarely used option for designers to only publish a design application (and

not register it). – *I support Option 2 – get rid of the publication option - it's confusing and rarely (if ever?) used. I'm not aware of anyone in GH or any other firm ever making use of it?*

### **3. Simplifying and clarifying the designs system**

• Several technical proposals seeking to simplify the designs system for users and clarify parts of the system that may be confusing, including possible changes to the terminology used in the Designs Act. – *I haven't looked at ACIP's recommendations in much detail but do agree that the formality requirements could be tidied up.*

- *Updating outdated terminology, such as those referring to paper filing practices, makes a lot of sense.*
- *I'm not as worried as others might be about the need to introduce an 'uncertified design' terminology. Before a design is litigated, practitioners are well aware that they need to check the status of the design to ascertain whether it has been examined ('certified'). What you call such a design has no bearing on the need to check this status.*

*As another example of tidying up Formalities, I note that during Formalities, there is an option for either a 'multiple' design application or an 'excluded' design application (so-called Options 1 and 3 for a design application comprising 2+ designs). Why not allow multiple design applications? Further, why not (like some other jurisdictions) have a reduced filing fee for 2<sup>nd</sup> and further related designs filed at the same time? Surely E-Services now facilitates and simplifies the administration of multiple design applications, allowing for such a reduced fee. Australia is out of kilter with e.g. the US and Europe in not allowing for multiple design applications.*

#### **ACIP Recommendations**

- *I support the proposed amendment to amend Regulation 3.06 to make the identity of Convention applicant consistent with the rules relating to entitlement to designs, as outlined under section 13 of the Designs Act, and to also maintain consistency with Article 4 of the Paris Convention, by ensuring the required identities for applicants claiming a right to priority are retained.*
- *I support the proposed amendment of Section 28 to accommodate instances where the degree of disclosure of the design in the basic application differs between the Convention country and Australia. A flexible system, within reason, is in my view a good system by the prevailing WIPO standards.*
- *I support the proposed amendment to implement the Raising the Bar reforms, namely, to amend Section 93 of the Designs Act to provide courts with a similar discretion to the one specified in subsection 138(4) of the Patents Act "unless the court is satisfied". This would give the courts the power to take into account the specific facts of a case and thereby refuse to revoke a design registration on the basis of the entitlement of the named applicant in appropriate circumstances.*
- *Likewise, I support the proposed amendment of Section 93 to allow a court to revoke a design registration on the basis of entitlement at the time of the revocation proceeding.*
- *I'm not sure that I agree with ACIP's recommendation that the prior art base (against which newness and distinctiveness is considered) should be expanded to include designs for products other than the product the subject of the registered design. In my view, this issue does require closer consideration. I agree that it is not at all clear what the "designated design" is in the definition of the prior art base in Section 15(2). It's also not clear to me whether the 'design' that is generally being referred to in Section 15 is "in relation to a product" as per the Section 5 definition, or whether the reference to 'design' in S15 is independent of a product.*

Feel free to contact me if you would like me to expand on any of the above points.

Best Regards



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