

Feedback on options for Designs reform

Have your say!

Have your say on design policy

We want to hear about your experiences and your views on proposed changes to designs protection in Australia.

We particularly welcome your views on:

1. Introduction of a grace period to provide a safety net for designers
2. More protection for parts of products
3. More protection for virtual products (such as screen displays and graphical user interfaces (GUI))
4. How to make terminology clearer

You can answer as many questions below as you would like. All responses will be considered and reviewed as part of the consultation process. More information about these issues and other proposed changes intended to form part of a designs bill can be found [here](#).

To find out more or for further queries please contact Brett Massey on (02) 6285 0721 or emailing brett.massey@ipaaustralia.gov.au.

About You

We ask you to identify yourself as part of this feedback form as it is important that we understand the source of the input, and to seek clarification if needed. Please let us know if you would like your feedback and details to remain confidential.

Name or Organisation:

Shelston IP

A design is what makes a product look the way it does. It includes shape, configuration, pattern and ornamentation. It must also be new and distinctive.

1. Grace Period – a safety net

Have you published your design before seeking legal protection? For example, have you posted a product on Facebook or Instagram before you lodged your design application? Currently, publishing a design before you file your application can prevent you from being eligible for protection. We would like to hear your views on a general safety net known as a 'grace period'. A grace period would give you a period of time to file for a design, even if you've already published it. Other original designers will also have the benefit of a safety net.

a) Have you ever faced a situation where you needed a grace period, and if so, how would your business have benefited from having this safety net?

Comments:

We have had clients who have disclosed their designs inadvertently, and/or based on incorrect assumptions that there is already a grace period for designs. Particularly relevant to clients who also file Australian patent applications and who are aware of the twelve month grace period for filing a complete patent application. Business would have benefited by still being able to get registered design protection. Important for innovations that are only protectable via register designs.

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b) Should there be a general safety net?

- yes
- no
- not sure

c) If we do introduce a safety net, the duration of the safety net should be:

- we should not have one (like in New Zealand and China)
- 6 months (like in South Africa, Singapore and the Philippines)
- 12 months (like in Canada, the EU the United States and Japan)
- greater than 12 months (like in El Salvador and Macao)

Please provide comments explaining your choice:

This is consistent with both Australian patent provisions and with designs provisions in the jurisdictions of our major trading partners.

d) The safety net should apply before:

- the [filing date](#) (the date that the design was filed with IP Australia);
- a design's [priority date](#) (e.g., the date that the design was filed with IP Australia or the date that the design was filed overseas, whichever is earlier). This date filed overseas can be up to six months earlier than the filing date.

Please provide comments explaining your choice:

Twelve months has proven long enough with Australian patent applications, provides consistency with the patent regime and the design regime of major trading partners, and yet not so long that it drags out the period of uncertainty before local and international rights have been applied for. A corresponding prior use infringement exemption should also be provided.

e) The safety net:

- should apply automatically;
- should require the applicant to request that the safety net applies. This would rely on the applicant knowing that a safety net exists.

Please provide comments explaining your choice:

This minimizes administration and again is consistent with Australian patent grace period provisions.

2. Protection for parts of a product

Designs for parts of products (that are not made or sold separately) generally can't be protected in Australia. For example, designs for the heel of a sock or handle of a mug cannot be registered without the sock or mug, even when it is only the heel or handle which is the new and distinctive part of the product. Unlike Australia, these types of designs are protected in other countries such as the United Kingdom, United States, Japan and Singapore.

a) Have you faced any difficulties or suffered any costs, because you were unable to protect a design for part of a product?

For example, if you have experienced difficulties in applying for design protection overseas or were unable to differentiate your product range from a competitor.

Comments:

Many clients have product ranges that have a common theme of features that are important to the brand identification. These same clients often come up with significant design innovations relating to a portion or part of their products. However, the need to register the design in respect of the whole product dilutes the new features and so prevents adequate protection for the significant innovation to the part.

b) What benefits can you see for your business if you were able to protect your design for a part of a product and why?

For example, if you were able to protect the heel of a sock, handle of a mug or other parts of the products you design.

Comments:

For example, if a client were to develop a new handle for a handbag in the shape of a classic curled ear shaped tea cup handle, and was able to register that handle in respect of handbags and similar goods by limiting the prior art base in the same way, such a novel and creative innovation would be rightly protectable within that type of product.

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c) Can you foresee any difficulties or additional costs (economic or otherwise) for your business if protection for part of a product was allowed?

For example, it could make it harder to find out what designs your competitors have protected.

Comments:

If limited by similar goods, which would be within the same classification, the clearance searching would be the same as is currently the case, and the validity searches would actually be easier as you would not need to search all designs in all classifications. Accordingly, the difficulties and costs would be reduced overall and appropriately significant innovations to parts of particular types of products would be justly protectable. NB in e) below, protection to be limited to similar products, but also prior art base similarly limited as discussed above.

d) Should Partial designs be protected?

- yes
- no
- not sure

e) If we introduce protection for partial designs, how should it apply?

- we shouldn't introduce protection for partial designs (**current approach**)
- protect partial designs for **similar** products only (e.g. handles for household goods)
- protect partial designs for **any** product (e.g. handles for cups, handbags, doors etc.)

3. Protection for virtual designs

Do you have a screen saver, graphical user interface (GUI), icon or font to protect? Currently these types of virtual designs are difficult to protect in Australia. Unlike Australia, these types of designs are protected in other countries such as the United Kingdom, United States, Japan and Singapore. We would like your views on how this issue should be addressed.

a) If virtual designs were protected in Australia, what type of virtual designs should be protected? Please select all that apply.

- screen displays
- graphical user interfaces
- screen icons
- fonts
- holographic designs
- projected images
- animated characters
- virtual 3D designs
- all of the above.
- Other:

b) Have you faced any difficulties or suffered any costs because you were unable to protect a virtual or non-physical design?

For example, have you experienced difficulties determining how to protect or applying for design protection for screen displays, GUIs, fonts, or virtual 3D designs?

Comments:

Yes have faced difficulties as no alternative in Australia that offers the advantages of a registration system.

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c) What benefits can you see for your business if you were able to protect virtual designs and why?

For example, if you were able to protect the screen displays, GUIs, fonts, or virtual 3D designs?

Comments:

In this fast moving digital era, there is massive intellectual capital in virtual designs of this kind, that is not protectable in Australia by other means. Particularly important for local clients who need to ward off competitors and build reputation locally before expanding. OS companies that cannot register in AU are less disadvantaged, as AU is likely one of their smaller markets and reputation has already been established off shore in jurisdictions where they were able to get protection and keep their competitors at bay.

d) Will changing the way virtual design protection works in Australia make it simpler for you to protect your designs outside Australia? Would this make it easier for you to approach the global market?

Comments:

Yes for the reasons set out in c above. Also can use same format representations for design applications. For example in Australia for an icon you need to show the icon plus some representation of the product such as a screen outline etc, whereas in EU only the icon need be shown in the representations. As such the change will make it simpler and less costly.

e) Do you consider that other forms of intellectual property protection (such as copyright or trade marks) are enough to protect your virtual design in Australia?

Comments:

No. Trade marks will not assist if competitor use is not as a trade mark, and copyright is far more difficult and expensive to enforce than registered rights.

f) Should virtual designs be protected?

- yes
- no
- not sure

4. Clearer terminology

Are you confused about the difference between registration and certification of designs? A registered design is not legally enforceable until it is certified. Enforceable means being able to take certain actions to deter potential infringers, such as sending letters of demand or going to court. To get a design certified you need to go through the extra steps of requesting and passing examination. We understand that the term 'registered design' might be confusing some businesses into thinking that uncertified designs are enforceable. We would like your views on how we can make this clearer through changing the terminology.

a) In order of preference, please number the terms below that best describe a design without a certificate of examination. You do not have to number all boxes.

- registered design (current terminology)
- 1 uncertified design
- unexamined registered design
- provisional design
- 2 pre-certification design
- pending certification design
- 3 pending design
- unenforceable design
- other:

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5. Other comments

Please tell us about any other comments or ideas you would like to provide about design policy in the free text field below, and we will consider them as part of our ongoing Designs Review Project.

If you have any input on patents, trade marks or plant breeder's rights policy issues please let us know via our [policy register](#).

Comments:

We also support a system of optional deferred publication of 12 months from the priority date. Options in paper 2 re early flexibility for designers of six months from the priority date is no different from the current situation where the same can be achieved by delaying the request for registration until close to the 6 month deadline.