

## **INTA Comments on the Review of Australia's Design System August 2020**

The International Trademark Association (INTA) appreciates and would like to thank IP Australia for the opportunity to contribute to the public consultation regarding certain recommendations from the former Advisory Council on Intellectual Property's (ACIP) Review of the Designs System.

INTA is a global association of brand owners and professionals dedicated to supporting trademarks and related intellectual property (IP) to foster consumer trust, economic growth, and innovation. INTA's membership comprises nearly 6,500 organizations from 185 countries, including 120 in Australia. The organizations represent more than 34,350 professionals, including brand owners from major corporations, small- and medium-sized enterprises, law firms, and nonprofits. INTA's community also includes government agency members, professors, and law students.

INTA has adopted [Model Design Law Guidelines](#) and [Guidelines for Examination of Industrial Designs](#), which contain INTA's basic positions on design law and practice and serve as a baseline standard by which INTA analyzes and comments on national and regional design laws, regulations, and the practices of IP offices. With a basis on those two set of Guidelines, below we provide comments on the Exposure Draft Designs Amendment (Advisory Council on Intellectual Property Response) Bill 2020 and the Exposure Draft Designs Amendment (Advisory Council on Intellectual Property Response) Regulations 2020.

### **Comments on:**

**Exposure Draft Designs Amendment (Advisory Council on Intellectual Property Response) Bill 2020 (the "Bill")**

**Exposure Draft Designs Amendment (Advisory Council on Intellectual Property Response) Regulations 2020 (the "Regulations")**

### **Grace period – Schedule 1 of the Bill and Schedule 1 of the Regulations**

INTA welcomes the proposed changes.

The aim of the proposed changes in the Bill and Regulations is to introduce a 12-month grace period to help protect designers from losing their rights through inadvertent disclosures made prior to filing. In addition, the applicant is not required to file documents to support publication or use within the grace period.

The proposed changes are in line with INTA's position its Model Design Guidelines and INTA's Comments on the Review of Australia's Design System – January 2019. These documents advocate such a 12-month grace period and suggest that the grace period apply automatically, without the applicant being required to declare previous disclosures.

## **Prior use defence – Schedule 2 of the Bill**

INTA welcomes the proposed changes.

The Bill introduces provisions relating to a prior use infringement exemption which ensures fairness between a prior user and a rights holder.

## **Right of exclusive licensee to bring infringement proceedings – Schedule 4 of the Bill**

INTA welcomes the proposed changes.

It is INTA's position that an exclusive licensee should be able to enforce the relevant design if the owner/assignee elects not to do so. Subject to an agreement to the contrary, both the registered owner and the exclusive licensee should have a standing to sue infringers.

The Bill provides the "exclusive licensee" with standing to bring infringement proceedings. The proposed changes are in line with INTA's Model Design Law Guidelines.

INTA stands ready to support IP Australia in its efforts towards reviewing the Designs System. We hope you will find our comments useful. Should you wish to further discuss any of the points we have raised or additional issues, please contact Seth Hays, Chief Representative Officer – Asia-Pacific and China at [shays@inta.org](mailto:shays@inta.org) and Carolina Oliveira, Policy Officer - Europe and Staff Liaison for INTA's Designs Committee at [coliveira@inta.org](mailto:coliveira@inta.org).