

By Email Only

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Mr Ben Goldsworthy
Quality, Practice & Customers
IP Australia
WODEN ACT 2606

Dear Mr Goldsworthy,

Draft Designs (Formal Requirements for Designs Documents) Instrument 2022

We thank IP Australia for the opportunity to comment on this draft.

We think the draft is mostly sound, though have concerns in relation to certain proposed requirements in respect of design representations.

Our comments are set out below.

Subsection 6(3)

This subsection provides that *[a]t least one of the representations in a design application must include a view of the design showing the product fully assembled without material extraneous to the product.*

It is possible that such a view, added to an application after filing to address a formalities objection, may *alter the scope of the application by the inclusion of matter which was not in substance disclosed in the original design application, representations or other documents* and thus be objectionable under paragraph 28(3)(b) of the Designs Act 2003 ("the Act") – even if the view does nothing to inform the scope of the application.

Also, a view showing the product fully assembled and without extraneous material could, where the application claims priority from a basic application, add matter and thus invalidate the priority claim if the basic application includes no such view – again even if the view does not inform scope.

Extraneous material is especially possible in the case of representations deriving from a basic application in a jurisdiction that allows for "partial design registration" (conferring design protection for part of a product/article independent of the remainder thereof), such as the United States. Such a basic application might establish a priority date in respect of more than one product; in particular, it may disclose an assembly which is a product and includes a component that is itself a product, so as to form the basis of a valid priority claim in respect of a product constituted by either the assembly or the component. The provision would, where the Australian application specifies the component as a product, necessitate a view showing the component alone, notwithstanding that often there would be no such view in the basic application.

Also, omission of extraneous material may be impracticable for certain designs, particularly designs produced through creation of the product in question or a model thereof (rather than drawings), including clothing designs. Such designs often cannot

reasonably be shown other than by way of photographs of the product on a mannequin or other “extraneous” support. Removal of extraneous material may require the use of image-editing software, which is not necessarily available to designers, particularly small, local designers.

We thus do not support the inclusion of subsection 6(3).

Subsection 6(7)

The intention behind this subsection seems reasonable to us, though we suggest the following amendment in the interests of clarity:

[w]here an application is for a common design, unless the representations showing the design applied to each product would be identical, the representations must show the design in relation to each product identified in the application—~~on a separate sheet~~, and a single sheet must not be used to show the design applied to more than one of the products identified.

Subsection 6(11)

This subsection provides that *[t]he Registrar may require that only a single reference or environmental view is included where there is uncertainty as to the design for which the applicant has applied.*

It is unclear as to whether this provision empowers the Registrar to require:

- that an application having no reference/environmental view be amended to include such a view;
- that an application having two or more reference/environmental views be amended so as to have only one such view; or
- either of the foregoing.

If the subsection is to be included, we suggest that it be amended to provide clarification in this regard. We also think *uncertainty as to the design* is an appropriate precondition for enlivening the provision, particularly given the potential for addition or removal of views to add matter so as to be objectionable under paragraph 28(3)(b) or to invalidate a priority claim.

Subsection 8(2)

This subsection provides that *[a] representation must not include text which is descriptive, other than any word or words necessary for the labelling and understanding of the nature of the representation (e.g. ‘Perspective View’, ‘Top View’, ‘Left-Side View’ and ‘Right-Side View’ etc.).*

The provision is apparently to replace subclause 5(15) of Schedule 2 once that schedule is repealed, which subclause provides that *[a] representation must not include descriptive text, other than any word or words necessary for the understanding of the representation.* However, we see no replacement for subclause 5(13) of Schedule 2, which subclause provides that *[a] letter, number or reference line shown on a representation must be presented simply and be clear.*

We agree that restrictions around descriptive text in representations are appropriate, though believe it is critical that labelling, including reference lines and lettering, numbering and other indicia, in representations be clearly allowable for the purposes of either pointing out a specified product (shown along with other material) or identifying a part of a design in respect of which newness and distinctiveness is claimed pursuant to paragraph 19(2)(b) of the Act, particularly given that such labelling, especially where the representations comprise photos or shaded drawings, may be all that is practicable to that end.

We also believe that consecutive numbering of representations (e.g. *Fig. 1, Fig. 2, etc.*) and inclusion of a separate sheet setting out a brief description of each should remain allowable in an application.

In conclusion, subsections 6(3), 6(11) and 8(2) could impose burdens on applicants reliant on photographs or sketches to show their designs, especially where such applicants have limited access to technology.

Please let us know if you require any clarification or would like further input from us.

Yours sincerely,

DAVIES COLLISON CAVE PTY LTD

A handwritten signature in blue ink, appearing to read "Robert Finn", is written over the typed name and title.

Robert Finn
Principal

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