

30 November 2021

Kelly Sims
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Dear Ms Sims

Draft Designs (Formal Requirements for Designs Documents) Instrument

Thank you for the invitation to provide comments on the draft Designs (Formal Requirements for Designs Documents) Instrument ("draft Instrument"). We greatly appreciated the opportunity to discuss the Draft with Ben Goldsworthy and Craig Finlayson on 19 November 2021 and have taken the opportunity to put some of those discussions in writing here.

The comments provided herein have been prepared by some of the Principals of FPA who advise clients in relation to Australian registered designs. The comments represent personal views that may not necessarily be shared by FPA or QANTM. We provide comments below on those sections where we see potential issues arising from the wording, and have omitted comment on those sections where we do not.

Potentially overly prescriptive requirements

As discussed in a call with Ben and Craig, the term 'must' appears often in the draft Instrument and seems unnecessarily prescriptive, at least in places. If we understood the comments on the call in relation to this issue, it is intended that the mandatory language in the draft Instrument is to be tempered by a requirement in the Designs Regulations 2004 for "substantial" compliance.

The existing requirement for applications to comply with the formalities requirements of Schedule 2 of the Designs Regulations arises from Regulation 4.04(1)(g) and 4.05(1)(h), which both state "the design application complies **substantially** with the formal requirements set out in Schedule 2" (our emphasis). These regulations are authorised by section 39(2)(a) of the Designs Act 2003.

Whilst we agree that a standard of substantial compliance should suffice to enable registration of a design and that a standard of substantial compliance with Schedule 2 is codified by Regulations 4.04(1)(g) or 4.05(1)(h), we are unsure whether there is any provision permitting substantial compliance with the Instrument. It is our understanding that Schedule 2 and Regulations 4.04(1)(g) and 4.05(1)(h) are being repealed.

The draft Instrument is directly authorised by new section 149A of the Designs Act 2003, which refers to new paragraphs 39(2)(aa) and 40(2)(ca). These state:

The Registrar must register the design if the Registrar is satisfied that:

(aa) the design application complies with the formal requirements determined in an Instrument under section 149A;

(ca) that the design application complies with the formal requirements determined in an Instrument under section 149A;

Section 43(2) directs that the Registrar **must** refuse to register a design, if the applicant has not addressed a formalities objection “in such a way that the Registrar is satisfied as mentioned in section 39 or 40 in relation to the design application”.

There is no reference in section 149A, or in paragraphs 39(2)(aa) and 40(2)(ca), to the Registrar being satisfied to a standard of substantial compliance with the formalities requirements as sufficient to enable registration. Therefore, it appears that unless the Registrar is satisfied that the design application **complies** with the requirements of the Instrument, then the Registrar **must** refuse the design.

If the understanding above is correct, it would appear appropriate to include a provision explicitly allowing applicants to substantially comply with the requirements of the Instrument. This would avoid an unfair result where an applicant responds to a formalities notice and substantially complies with the Instrument, but does not comply with one or more particular provisions that do not affect substantially the clarity of the design (i.e. do not substantially affect the clear communication of the design in relation to which exclusive rights are claimed).

In any event, if the understanding above is not correct and there is a provision in the Act or Regulations that permits substantial compliance with the Instrument, it would appear clearer to reflect this in the language of the Instrument, for example by substituting “must” with “should”. Another approach may be to include an overall requirement that the design must be clear, with the other requirements being factors to consider when determining whether the design is clear.

It may also be appropriate to provide the Registrar with a general discretion to register a design despite lack of compliance with some of the requirements of the Instrument. There does not appear to be any policy issues that would require the Registrar’s hands to be tied with respect to the formality requirements of an application. The Registrar would retain the power to not exercise the discretion when it is not in the public interest to do so.

Section 5(1)(c)

Regulation 4.05(1)(c) requires “the design **application** identifies, for each design, the product or products in relation to which the design is sought to be registered sufficiently to enable each product to be classified” (our emphasis). Draft section 5(1)(c) implies that the product name alone must enable classification. We suggest specifying a requirement in the Instrument that an application include a product name of all products, without qualification. Adding to the Instrument a reference to enabling classification seems redundant in light of regulation 4.05(1)(c).

Section 5(1)(g)

Whilst we agree that it is expedient to require applicants to provide details of the priority application(s), specifying who the applicant of the priority application is does not appear to be necessary. Indeed there is no mechanism to provide this information at filing using the current online portal. There is also already a requirement to confirm entitlement has been established. The Examiner has the ability to request information about or a copy of the priority application during examination, particularly if prior art within the convention period is located and entitlement is not obvious.

We also note that for patent convention applications, only the number, country and filing date is required.

Section 6(4)

We suggest that consultation be conducted as to whether the wording used for this section aligns with current drafting practices of industry. For example, we understand that there may be difficulty in meeting these requirements using the current outputs from computer-aided-design packages. It appears that if 6(1) is met and the representations clearly show the visual features of the design, then 6(4) is unnecessary.

Section 6(5)

Whilst we are not opposed to this requirement for a common image format in general, as it is often needed to clearly show the visual features of a design, it may be beneficial to allow

reference or environmental views to be in a different image format, should they support 6(1) in assisting to clearly show the visual features of a design.

Section 6(6)

We understand and agree that colour is part of a design and that different representations should be consistent to avoid a lack of clarity as to what colour has been applied to the product.

We also understand that this restriction is not intended to relate to computer rendered models, where shadows and light are used to represent contours clearly. The shade/colour of grey would differ between views, but the design is clearly shown. It appears that the distinction between inconsistent colours and the use of rendering to illustrate contour may be adequately addressed in guidance to examiners.

Section 6(11)

We understand that the intention of this section is to allow the Registrar to require the removal from an application excess reference or environmental views. We agree that this appears appropriate.

The wording used arguably provides an Examiner with a discretion to require a single reference or environmental view only, but no discretion to require a reduction in the number of reference or environmental views to zero or a number greater than one. We suggest rewording the section to clarify that the Registrar may require removal of reference or environmental views from an application, without limiting that discretion to requiring a single view.

Section 8(2)

Schedule 2 requires "A representation must not include descriptive text, other than any word or words necessary for the understanding of the representation." There are many instances where words are required to understand the representation, for example 'the oblique shade lines indicate transparency or translucency' (vs indicating a reflective surface or a surface pattern). Additional restriction over that set out in Schedule 2 seems to be inappropriate. The examples provided in brackets at the end of 8(2) seem more appropriate to add to the list provided at 8(4) and that the current wording used in Schedule 2 be maintained for 8(2).

Section 8(4)

As mentioned above, we suggest that the list of indicative labels includes those set out in brackets at 8(2).

We welcome the opportunity to discuss our comments further or any revisions to the draft Instrument.

Yours sincerely

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