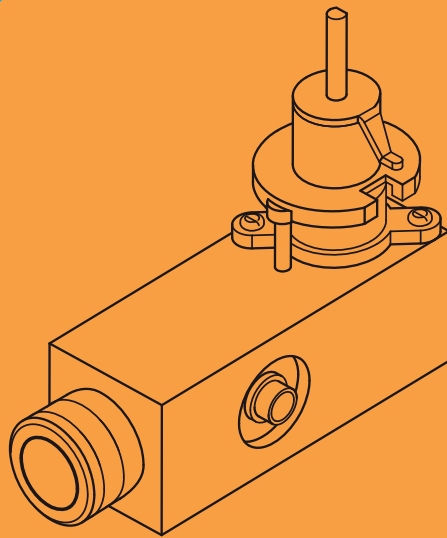


Designs



phillips ormonde fitzpatrick
intellectual property



For the purposes of registration, design means the overall appearance of a product resulting from one or more visual features.

Phillips Ormonde Fitzpatrick has been at the forefront of intellectual property law in Australia since its establishment in 1888. We employ around 150 people in Melbourne, Sydney and Adelaide, and provide IP services all over Australia.

The POF Group offers a range of services through three key organisations – each one specialising in specific areas of IP. Phillips Ormonde Fitzpatrick is a patent and trade mark attorney firm, Phillips Ormonde Fitzpatrick Lawyers is a law firm practising exclusively in IP law, and IP Organisers is a specialist search and investigations company. Together, we are able to provide a comprehensive range of services to assist clients identify, protect, manage, exploit and enforce their IP assets. This includes patents, trade marks, designs, plant breeder's rights and copyright.

What is a design?

For the purposes of registration, design means the overall appearance of a product resulting from one or more visual features of the product. These features may include the shape and configuration (three dimensional features), and the pattern and ornamentation (two dimensional features).

A 'product' is a thing that is manufactured or hand made. A component part of a complex product is considered a product in its own right.

Design registration does not protect how a product is made, what it is made from or how it functions or performs.

Which designs can be registered?

A design may be registered if it is new and distinctive. A design is 'new' if it is not identical to a design publicly used in Australia or published in a document anywhere in the world. However, in certain circumstances where copyright subsists, publication of a design in a document may not prevent a design from being considered new.

A design is 'distinctive' if it is not substantially similar in overall impression to another design publicly used in Australia or published in a document anywhere in the world.

Some designs cannot be registered. These include designs for medals, designs including the word 'ANZAC', designs including the Arms, or a flag or seal of the Commonwealth or of a State or Territory, or designs that are scandalous.

It is important that as soon as a commercially viable design is created, a decision is made on applying for registration. Although confidential disclosure of the design does

not destroy its newness or originality, there is the risk of the disclosure being misused by others. Also, the filing of a design application establishes a priority date for any potential rights in the design. The priority date is important because it is the date on which 'newness' and 'distinctiveness' of the design is assessed.

A design application can be filed containing one design, a single design in relation to many products, or multiple designs for multiple products, provided all the designs fall within the same official class of product.

Why would you want a registered design?

Registration of a design in Australia gives the registered owner a monopoly in the design.


The registration provides a five year (renewable for a further five years) exclusive right to:

- > Make the product in Australia
- > Import the product into Australia
- > Sell, hire or otherwise dispose of the product in Australia
- > Use the product in Australia
- > Keep the product in Australia
- > Authorise others to do any of the above.

This monopoly right is infringed when an unauthorised person makes, or offers to make, a product in relation to which the design is registered, which embodies a design that is identical to or substantially similar in overall impression to the registered design. Infringement also occurs through unauthorised importation, sale or offer for sale, hire or offering for hire, use or keeping in Australia a product which embodies the registered design or one that is substantially similar in overall impression to the registered design.



There are a range of factors to be taken into account in determining whether a product embodies a design that is identical to or substantially similar in overall impression to a registered design. Please contact Phillips Ormonde Fitzpatrick if you would like to discuss these factors and infringement issues generally.



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We have extensive
experience in preparing
applications for design
registration and representing
client interests in obtaining
design registrations

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How to register a design

The Australian Designs Office in Canberra, a division of IP Australia, is the responsible authority for registering designs.

Any person may apply to register a design but there are restrictions as to whom may be ultimately registered as the owner of the design.

The owner may be the designer of the design, their employer, the person who contracted them to make the design, or a person who has been or is entitled to be assigned the design. There may be more than one owner.

An application should be made on the appropriate form and must include drawings or photographs which show all the features of the design.

A statement of newness and distinctiveness may be included in the design application. It is not compulsory to have this statement, but it may be useful in deciding whether the design is new and distinctive when compared to earlier designs. We will assist in the preparation of an appropriate statement.

Registration or publication of the design may be requested when the application is filed. Registration or Publication of the design must be requested within six months of the date of filing or priority date (whichever is the earliest), or the application will lapse. It is important to understand the differences between a request for Publication of the design, and a request for Registration.

Publication

If you request Publication, then your design will only be published by the Designs Office. No enforceable rights will be obtained, but the publication will prevent others from registering the same design.

Registration

If you request Registration, the Designs Office will conduct a formalities check and if all is in order, your design will be registered and details including the representation of your design will be published. Registration establishes rights that can be enforced once a Certificate of Examination is issued.

On payment of the appropriate fees, the design will be registered for five years from the date of filing the application.

Extension of registration

The term of a registered design may be extended for a further five years. The total term of an Australian registered design is 10 years from the date of filing the application.

Examination and enforcement

Registered designs are not examined automatically.

If the owner of a registered design wishes to enforce their design registration, they must request examination and obtain a Certificate of Examination.

Infringement proceedings or threats of infringement cannot be initiated against an alleged infringer until a Certificate of Examination has issued on the registered design.

If infringement threats are made prior to the issue of a Certificate of Examination the person making those threats is making an 'unjustified threat', and a court may issue an injunction against the continuation of the threats and order the recovery of damages sustained by the threatened party.

Upon receiving a request for examination, an examiner from the Designs Office will conduct an examination. If there are any objections, the owner has an opportunity to argue against these or amend the Registration to overcome them.

If objections are overcome or if there are no objections to the registered design then a Certificate of Examination is issued. Once a Certificate of Examination of the registered design has been issued, infringement proceedings may be commenced.

A third party may request examination of a registered design. This action would most likely be taken if a competitor considered there were reasons a registered design would not survive an examination.

Protection in other countries

Registration under the *Australian Designs Act 2003* only protects the design in Australia. If protection is required in other countries, separate applications must be filed. However not all countries provide for design registration, while some design registrations provide protection in more than one country.

Under the International Convention for the Protection of Industrial Property, an applicant in Australia can claim the Australian filing date as the priority date in any 'convention' country. If the applicant wishes to do this, the foreign design applications must be filed within six months of filing of the Australian design application. The six months gives an applicant time to test the commercial viability of the design in those other countries before committing to the expense of filing foreign design applications.

A single registration may be obtained to cover the 28 countries in the European Community.



The total term of an Australian registered design is 10 years from the date of filing the application





It is recommended that products made according to registered designs are marked appropriately

Marking of products

It is recommended that products made according to registered designs are marked appropriately, e.g. 'Australian Registered Design No. xxxx'. Such notices will minimise innocent infringement of the registered design. A court may refuse to award damages, or make an order for an account of profits if it is satisfied that the infringement was innocent.

IP overlap

Copyright and registered designs

Copyright is a form of protection which automatically exists in most original artistic, literary, musical and various other types of works as soon as they are created. The copyright owner (usually the author of the work or the author's employer) is entitled to stop others from unauthorised reproduction, publication, broadcasts and various other acts in relation to the work.

Some registered designs are also protected by copyright. For example, a two-dimensional artistic pattern applied to the front of a T-shirt may be registered as a design or it may be protected by copyright. However, the copyright protection of designs for three-dimensional products may be significantly reduced once those products are commercialised.

When originally created, such designs are usually protected by copyright, but once the design has been 'industrially applied', it is no longer an infringement of copyright for another person to make products incorporating that design.

There are three exceptions to this rule:

- > Buildings
- > Models of buildings
- > Works of artistic craftsmanship.

Where any of these exceptions do not apply, it is important to seek design registration for three-dimensional products to protect their appearance.

Design registration for a two-dimensional pattern may be of less importance because copyright protection is usually available.

If you have any questions concerning the overlap between copyright and registered design protection, then please get in contact.

Patents and designs registration

A design registration protects the appearance of a product. If protection is required for the manner in which the product works, or the way in which a product is constructed, or particular ways in which a product is used, then patent protection should be considered. Some products are suitable for protection by way of both patent and design registration.

How can Phillips Ormonde Fitzpatrick assist you?

Our professionals have extensive experience in preparing applications for design registration, as well as representing client interests in prosecuting design applications.


In addition to providing design services, our attorneys can also provide assistance in obtaining, maintaining and enforcing trade marks and patents (see page 7 for a brief explanation).

We also provide advice in relation to other aspects of intellectual property. This includes managing your IP portfolio, online tracking of international applications and IP portfolio audits.

Our associated law firm, Phillips Ormonde Fitzpatrick Lawyers, can assist you with various intellectual property legal services including licensing agreements and design assignments. Our lawyers enforce your registered design through litigation, or defending an allegation of infringement.

Phillips Ormonde Fitzpatrick provides the following design services to clients:

- > Advice on the registrability of a design
- > Preparation, lodgement and prosecution of design applications in Australia
- > Preparation of drawings
- > Searches for existing registered designs
- > Design application lodgement and prosecution in other countries
- > Infringement searches
- > Investigation and advice on the validity of existing registered designs
- > Defence to allegations of infringement
- > Enforcement of design owner's rights
- > Negotiation and settlement of disputes
- > Continuous monitoring of competitors, their designs and IP activities
- > Drafting of various agreements related to designs.



If the owner of a registered design wishes to enforce their design registration, they must request examination and obtain a Certificate of Examination.

Types of intellectual property

Type	What is protected?	Is registration required for protection?
Patent	The structural and/or functional concept of an invention.	Yes
Design registration	The visual appearance of an article. For example, shape, configuration, pattern, and/or ornamentation.	Yes
Trade mark registration	A 'sign' used to distinguish goods or services in the course of trade. This may include letters, words, names, signatures, numerals, logos, brands, aspects of packaging, shapes, colours, sounds or scents.	Protection may be acquired through use of an unregistered trade mark, but registration provides broader and more certain protection.
Copyright	Creative, intellectual, or artistic works.	No
Trade secret/confidential information	Information not publicly disclosed that can be kept secret. This is of limited value if the secret can be revealed by reverse-engineering.	No
Plant breeder's rights (PBR)	Plant varieties.	Yes
Circuit layouts	Layout designs for integrated circuits and computer chips.	No

The Phillips Ormonde Fitzpatrick Group offers services through three key organisations – each one specialising in specific areas of IP. Together, we provide the full range of IP services from conception to enforcement.

Phillips Ormonde Fitzpatrick (POF) is a leading patent and trade mark attorney firm specialising in obtaining and maintaining patents, trade marks, registered designs and plant breeders' rights. We have some of the most diversely qualified and experienced attorneys in Australia, which allows us to match your IP requirements to an attorney with the appropriate expertise.

We provide a tailored approach to meet individual objectives with a focus on achieving cost-effective, commercial outcomes. Our client base includes individual inventors, start-ups, universities, leading research institutes and multinational corporations.

Phillips Ormonde Fitzpatrick Lawyers (POFL) has a strong reputation in IP litigation, as well as advising on and drafting agreements relating to IP. All patent litigation is supervised by a partner who is a lawyer and an experienced patent attorney. This expertise gives us the advantage of understanding the key technical issues in patent litigation.

POFL is a limited liability partnership by a scheme approved under Professional Standards Legislation.

IP Organisers (IPO) is a specialist information services company providing intellectual property research and searching services including patent, design and trade mark searching and watching. The team is also able to assist with IP portfolio audits, IP management and reporting services.

IP Organisers is a registered investigation agency with a team of in-house Private Investigators who gather evidence on violations of IP rights and conduct background checks.



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