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APPLICATION
GUIDE

A guide to applying for your design

DESIGNS

Privacy Notice

As explained in our Privacy Policy, IP Australia is authorised to collect information provided in design applications and other requests for service under the *Designs Act 2003* (the Designs Act). The information provided to us (the information), including personal information about any person, will be used for the purposes of the Designs Act including, as appropriate:

- to process your, or another person's, design application,
- to process a request or notice in relation to a design or design application,
- to enable third parties and IP Australia to contact you about your design or design application or about a request or notice that you have filed in relation to a design or design application; or
- to perform other functions under the Designs Act.

The Designs Act requires or authorises the Registrar of Designs to disclose and publish the information provided to us in specified circumstances, as explained in IP Australia's Privacy Policy. The information may be published in Official Journals, Registers and data bases in Australia and elsewhere which may be accessed over the internet and/or as paper copy. Periodically, IP Australia (or a company under contract to us) will use your personal information to contact you to conduct market research about our products and services.

IP Australia is committed to complying with the *Privacy Act 1988*, which contains information on privacy principles that IP Australia must observe when collecting, using and disclosing personal information. The personal information handling practices of IP Australia are detailed in IP Australia's Privacy Policy, which contains information about accessing and amending records held by IP Australia containing personal information.

To make a complaint about IP Australia's collection or handling of your personal information, contact IP Australia's Privacy Contact Officer:

Telephone 1300 65 10 10
Email assist@ipaaustralia.gov.au
Post Privacy Contact Officer
 IP Australia
 PO Box 200
 Woden ACT 2606

To read IP Australia's Privacy Policy visit our website: www.ipaustralia.gov.au

Contents

What is a design?	2
Filing your design application	5
Requesting registration or publication	8
Statement of newness and distinctiveness	9
Maintaining and protecting your design rights	10
Design registration flow chart	12
Some important points to remember	14
Contacting IP Australia	15

What is a design?

A design is the overall appearance of a product. The visual features that form the design include the shape, configuration, pattern and ornamentation of the product.

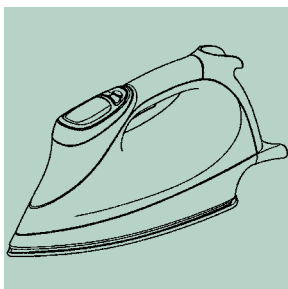
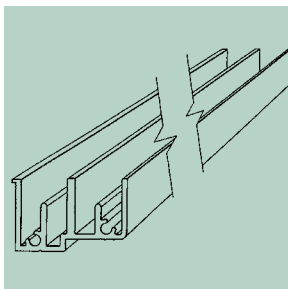
A design does not include the feel of the product, what it is made from or how it works.

To be registrable, a design must be new and distinctive. 'New' means the design has not been publicly used in Australia nor has it been published in a document within or outside Australia.

For example, a design application would not be considered new if it had been 'published' on the internet before the priority date.

A design is distinctive if it is not substantially similar in overall impression to other designs already in the public domain.

EXAMPLES OF REGISTERED DESIGNS INCLUDE:



THE BENEFITS OF REGISTRATION

A registered design can be a valuable commercial asset.

As the registered owner, you:

- have the exclusive right to use the design specified in your registration;
- have the exclusive right to authorise other people to use your design as specified in the registration;
- have a registered design which is ‘personal property’ that can grow in value and can be sold; and
- have a registration which covers the whole of the Commonwealth of Australia.

Many registered design owners will not need protection beyond registration for their design. However, for those who need to enforce protection of their design, ie. to sue for infringement, registration is the first step.

If you own a registered design you have the right to enforce your design once it has been examined and a certificate of examination has been issued (“certified”). If another person uses your registered design without your permission, you can take action to stop them using it after certification (see page 10 for further details about examination).

THE LENGTH OF PROTECTION

Registration initially protects your design for five years from the date the application was filed. The design registration can be renewed for a further five years. If you do not renew your registration it will cease. Once the design has ceased it passes into the public domain and is free for anyone to use.

NOT ALL DESIGNS ARE REGISTRABLE

You cannot register a design featuring:

- medals;
- layout for an integrated circuit;
- the Olympic rings symbol, the Olympic motto or the torch and flames design, prescribed under the *Olympic Insignia Protection Act*;
- the word “Anzac”;
- information or graphics which might reasonably be regarded as scandalous;
- coins or notes of a kind prohibited by subsection 19(1) of the *Crimes (Currency) Act 1981*;
- the coat of arms, flags or seal of the Commonwealth or any State of the Commonwealth;
- the coat of arms or emblems of any city or town in the Commonwealth or any State, Territory, public authority or public institution in Australia; or
- armorial bearings, flags, State emblems or signs of any country other than the Commonwealth.

PUBLICATION

An alternate option to registration is publication. Publishing a design does not give you any rights in respect of the design and may be used for strategic purposes. Publication is used to prevent others from obtaining certification for the same design, as the design is no longer considered new.

SEARCHING

Before filing a design application, it is a good idea to conduct a search of existing registered designs. If your registered design is not new and distinctive you may not be able to gain certification. You may also face legal action if you infringe the design rights of the owners of other similar designs.

Our Australian Designs Data Searching (ADDS) system has images of all registered designs from 1985. This is available on our website.

Professional searches can also be conducted by patent attorneys and search firms. Their addresses can be found in your local Yellow Pages Directory.

PROFESSIONAL ASSISTANCE

Patent attorneys and lawyers can provide professional help in applying to register or publish your design or in maintaining your registered design. You can find the names and addresses of patent attorneys in your local Yellow Pages Directory.

Filing your design application

WHO CAN APPLY

Any person can file a design application but the application must specify the person/s entitlement to be the owner/s of the design registration.

The applicant must provide a contact address, phone number or email address.

THE APPLICATION FORM

See the sample of a completed application form on page 7. The application form and an instruction sheet can be found at www.ipaustralia.gov.au or by calling IP Australia's Customer Service Centre on **1300 651 010**.

How many designs can I apply for in one application?

A single design application may be made in respect of:

- a) one design in relation to one product;
- b) one design that is a common design in relation to more than one product;
- c) more than one design in relation to one product; or
- d) more than one design in relation to more than one product, only if each product belongs to the same Locarno Agreement class. Information on the Locarno classes and the classification of different products can be found on the website www.wipo.org/classifications/locarno/en/

Please Note: A single application **MUST NOT** contain designs from more than one of the above categories. If you file a single application for more than one design, **all** the designs must meet the official requirements before any can be registered.

The number of designs in the application should be clearly written in the box on the application form.

Indicate the product/s to which the design relates. The rights you obtain through registration will be for the design in relation to the product/s to which the design is registered.

Where either a single design is to be applied to more than one product or more than one design is to be applied to more than one product, the name of each product or products needs to be clearly stated on the application form.

This is so that each product can be classified in accordance with the Locarno Agreement. Where a design is registered or published it will be displayed on ADDS according to its Locarno class. This makes searching for similar designs much easier.

REPRESENTATIONS

Representations are illustrations of the design. They may be drawings, photographs or digital images. Actual samples may be accepted if the design can be easily mounted on a flat surface and if the sample can be easily stored with other documents.

You should send us five identical copies of each view of each design in the application.

The representations should show an accurate and complete picture of your design.

The representations should be printed or mounted on an A4 quality white paper sheet. Only use one side of the sheet and where possible, show the product in an upright position:

- Each sheet of representations should be numbered in the bottom right hand corner. You will also need to show the total number of sheets lodged. For example sheet 1 of 3, sheet 2 of 3 and so on.
- If the application is for more than one design, a design number or identifier should be written in the top right hand corner of each sheet.
- A single sheet cannot be used to show more than one design.

HOW MUCH DOES IT COST TO FILE AN APPLICATION?

A fee **per design** is payable when filing your design application.

If you have not paid for all the designs in the application at filing you will be issued with an Invitation to Pay (ITP).

A full list of fees can be found on IP Australia's website or by contacting IP Australia's Customer Service Centre on **1300 651 010**. (GST does not apply to these statutory fees under the *GST Act 1999*).

If more designs are found during the formalities check, you will be sent an ITP for all further designs.

PUBLICLY AVAILABLE INFORMATION

When the design/s in your application are registered, the details of the design/s and the representations will be listed in the 'Australian Official Journal of Designs' (AOJD) and the representations will be displayed on ADDS. These are both available on our website **www.ipaustralia.gov.au**

IP Australia will send you a Certificate of Registration and record the details of your design/s in the Register of Designs.

REGISTERING YOUR DESIGN IN OTHER COUNTRIES

You may wish to register your design in other countries. Timing may be critical, and you will need to decide within six months of filing your application in Australia, as to whether you apply in other countries. IP Australia will provide, upon request, a leaflet on applying to register a design in other countries.

The Application Form

The image displays two pages of the 'Design Application' form. The left page is titled 'Customer Information' and contains sections for 'Personal Details of Customer', 'Correspondence Address', and 'Agent Details'. The right page is titled 'Design Details' and contains sections for 'Number of Designs', 'Design Details', 'Product(s)', 'Statement of Newness and Distinctiveness', 'Designer Details', 'Claim for Convention Priority', 'Excluded Design', and 'Request for Registration/Publishing'. Both pages feature a header with the IP Australia logo and a footer with the slogan 'Robust intellectual property rights delivered efficiently'.

Requesting registration or publication

You must request either registration or publication of each design in your application at filing or do so **within six months of the priority date of your application otherwise your application will lapse**.

The **priority date** of your application will generally be the date you file the application, unless you have:

- a claim to priority from an earlier overseas design application; or
- the design was excluded from an earlier design application in Australia*.

If registration is requested, the design application will be subject to a formalities check to make sure the necessary information and representations are present. If the design application passes the formalities check, the design will be registered and advertised in the Australian Official Journal of Designs and is made available for searching in the Designs searching database (ADDS).

The publication option does not give any enforceable design rights but, because the design is published, it prevents others from gaining any rights to the design.

If publication is requested, the application will be checked and the design will be published in the Australian Journal of Designs and on ADDS.

An applicant must request either registration or publication when their application is filed or within six months of the priority date, otherwise the application will lapse.

* Designs that are excluded from an earlier application must request registration or publication at lodgement.

Statement of newness and distinctiveness

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The provision of a statement of newness and distinctiveness is optional, however it can be of benefit because particular regard will be had to the features identified in the statement when assessing the newness and distinctiveness of the design. If you do wish to identify particular features of the design/s as new and distinctive it is best to do that at this stage, or at the latest, before registration, as a statement cannot be added once the design is registered.

Maintaining and protecting your design rights

EXAMINATION

Registered designs are not automatically examined. Before you can enforce your rights to your design, your registered design must be certified following an examination. To request an examination, you must complete a Request for Examination form, and pay the required fee. IP Australia will then check that your registered design meets all relevant requirements of the Designs Act.

You will then receive one of two possible replies to your request:

- an adverse report. If you receive an adverse report, it will give reasons why your registration, in its present form, does not meet the requirements of the *Designs Act*. However, you will have an opportunity to make submissions and/or amend the details in your design registration; or
- a notice that your design registration has been successfully certified, in which case your rights are then enforceable, and certification of your design is advertised in the *Australian Official Journal of Designs*.

EXAMINATION REQUESTS FROM THIRD PARTIES

Other people can request examination of your registered design. They may also provide information relevant to the newness and distinctiveness of your design to be considered by the Registrar in the examination process.

They pay half of the examination fee, and then you must pay the balance of this fee, because if your design is certified, you stand to benefit from this action. Once both parties have paid the appropriate fee, examination will commence. If a third party requests examination and you do not pay the balance, the design registration will cease.

Please Note: If your registered design is found NOT to be new and distinctive during examination, and you are not able to overcome the objection, your design registration will be revoked after you have had an opportunity to be heard in the matter.

INFRINGEMENT

If your registered design is infringed, or you believe it is being infringed, you should consider requesting an examination and/or seek legal advice. If your registered design is examined and certified, you can then take legal action against the competing party. However if it is examined and found invalid, your design registration will be revoked and you will not be able to take any action.

RENEWAL (EXTENSION OF PERIOD OF REGISTRATION)

The initial period of registration for your design lasts for five years from the filing date of your application.

You may choose to renew your design registration for a further five years (to a maximum of ten years). If you do not renew your registration your design will cease.

IP Australia sends out courtesy renewal reminder notices to the address for service on the Designs database two months before the due date of renewal.

Remember: Please inform IP Australia of any change to your address for service.

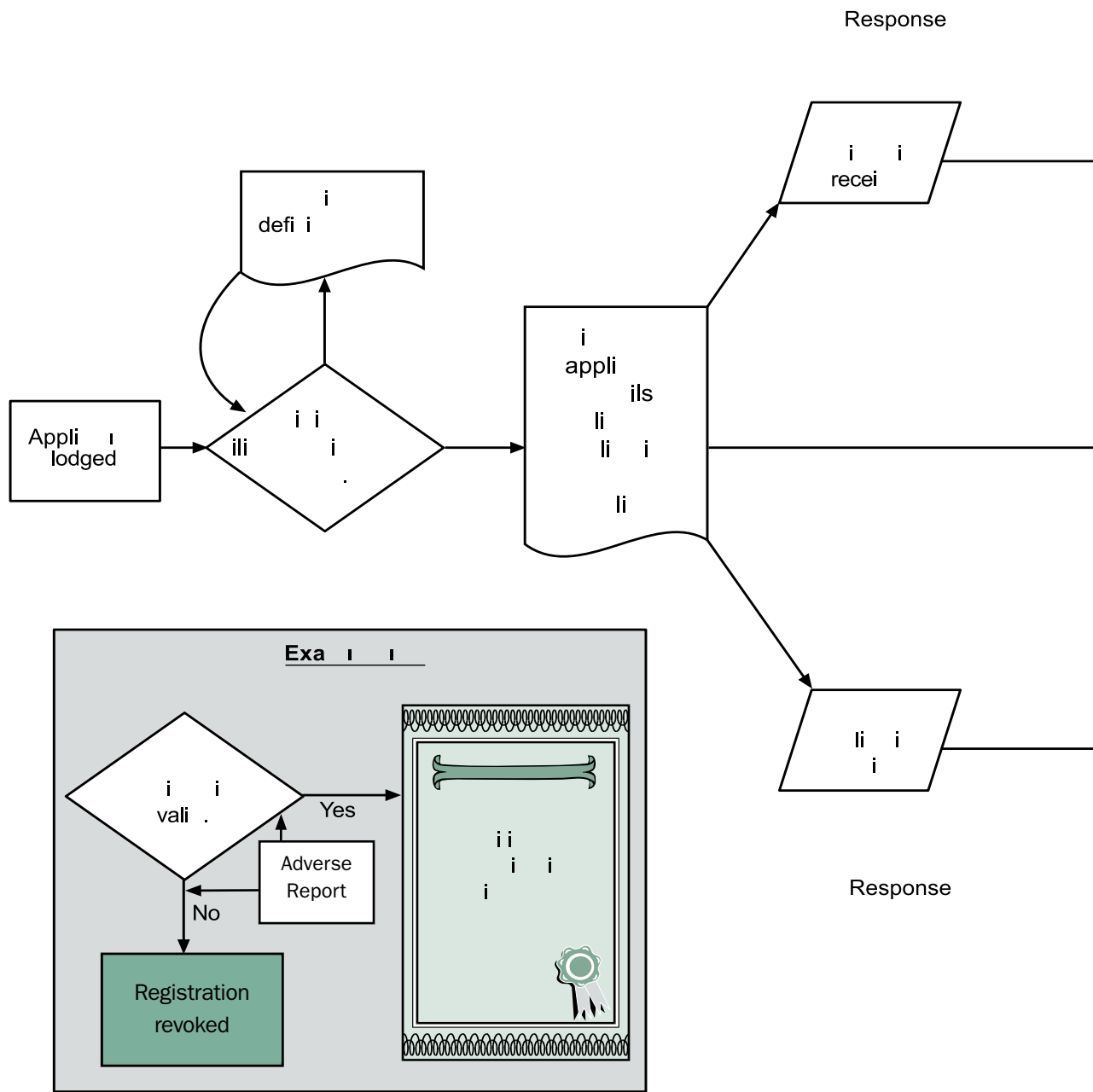
We recommend that you take steps to create your own renewal reminder system, or you may also make arrangements for a patent attorney or other IP professional to keep track of the due dates and forward your payments. This will assist in ensuring your intellectual property rights do not inadvertently cease.

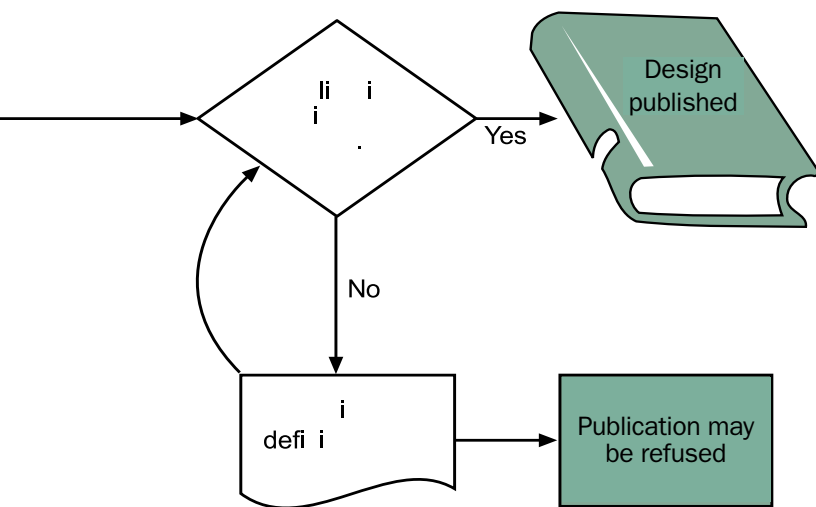
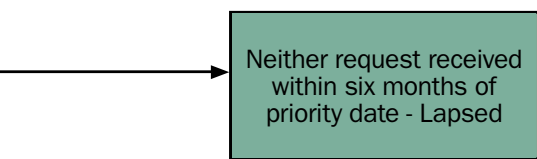
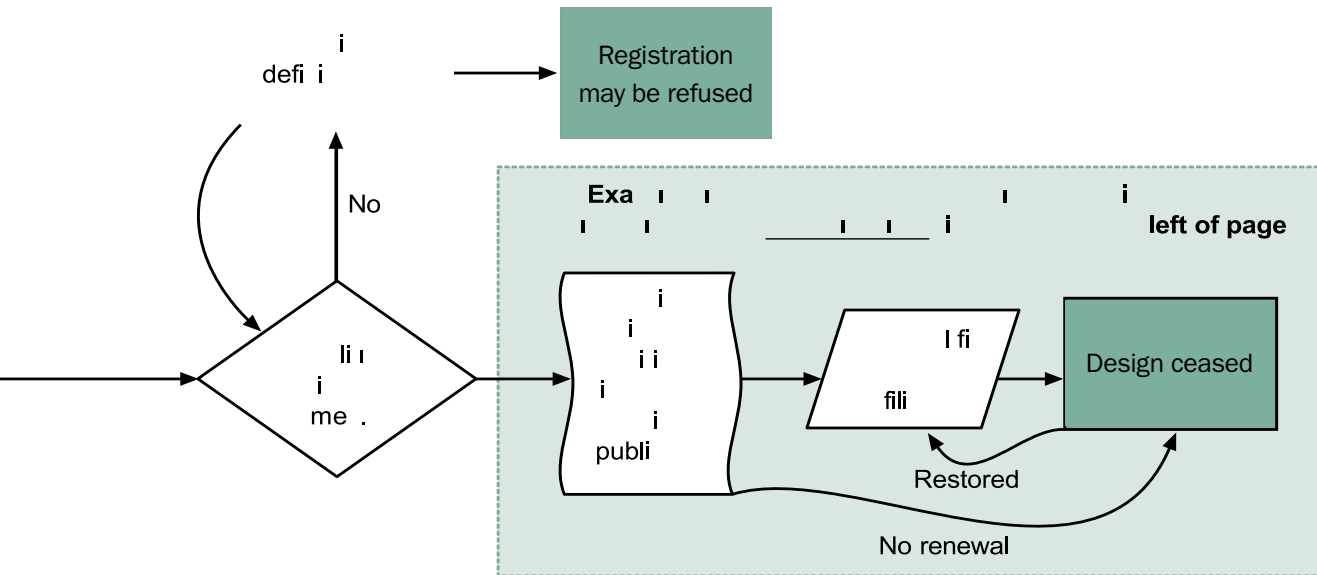
The decision to renew the period of registration is a commercial decision which you are in the best position to make.

Please note that a six month grace period for renewal will apply after the first five years of registration. You may renew your registration during the six month grace period however it will incur a fee of \$100 per month from the date renewal is due.



Design registration flow chart





Note: When a notice of deficiency is issued following a request for registration or for publication, the application will lapse if the objections are not overcome within two months.

Some important points to remember

POINTS TO REMEMBER

- Registration gives you the right to use, licence and sell your design.
- A design is not enforceable until it has been registered, examined and certified.
- Take care when filing your application. After it is filed, only very limited amendments are allowed to the representations covered by the application.
- Keep a copy of all the documents (including the representations) you file for reference purposes.
- Give each design a reference number or identifier, so you know which one it is.
- Not all designs are registrable.
- Do not assume that your design is registered when the application is filed. Until you receive the Certificate of Registration, you cannot claim that the design is registered.
- If you do not request registration or publication when filing your application – you must do so within six months from your priority date. You should keep a diary or calendar reminder to ensure you do request registration or publication or your application will LAPSE.
- Note, however, that if your design is registered, the protection given by registration takes effect from the priority date.
- Remember that if you do not renew your registration within the initial five years, your registration will cease.
- Your registered design is personal property and may be licensed, assigned or mortgaged.

For further information or assistance

- Visit our website www.ipaustralia.gov.au and follow the designs links.
- Contact our Customer Service Centre on **1300 651 010**.

Contacting IP Australia

IP Australia staff are happy to help you and answer your queries. However we cannot assist clients on legal matters or provide business advice. You may wish to consult a patent or trade marks attorney, a solicitor experienced in intellectual property matters, or your business advisor.

IP Australia subscribes to the **Telephone Interpreter Service**. If you need help communicating in English, you can phone the interpreter service on **131 450** for the cost of a local call from anywhere in Australia.

All written correspondence regarding designs should be directed to The Registrar of Designs.

Post: **PO Box 200, WODEN ACT 2606**

Phone: **1300 651 010 General Enquiries** — contact our **Customer Service Centre** for general information relating to Patents, Trade Marks, Designs or Plant Breeder's Rights and for assistance with subscriptions, sale of publications and electronic communication.

Fax: **(02) 6283 7999 Business Transactions Fax** — for lodgement, filings and business related correspondence such as financial and confidential material. Faxes received at this secure number are receipted at Australian Eastern Standard/Daylight Saving time.

Email: **assist@ipaaustralia.gov.au** — for general enquiries. Note, filing of documents and payments are not available through this address.

Website: **www.ipaustralia.gov.au** — for information relating to intellectual property and to download forms and other documents.

CUSTOMER SERVICE CHARTER

IP Australia is committed to being a customer focused organisation. To help our customers, IP Australia has a Customer Service Charter outlining the standards of service you can expect from us. To obtain a copy of the charter, simply ring **1300 651 010** or visit our website.

COMMUNICATING ELECTRONICALLY WITH IP AUSTRALIA

The date which you provide information to IP Australia can be critical to the certainty of your intellectual property rights.

IP Australia has implemented a set of business rules which establish that when you communicate with us electronically (eg. email, fax or online) using our preferred contact numbers and methods, the date and time of communication will be Australian Eastern Standard/Daylight Saving time.

Our preferred means of electronic communication are:

- the IP Australia website — **www.ipaustralia.gov.au**;
- our business transactions fax number — **(02) 6283 7999**; or
- email — **assist@ipaustralia.gov.au**

Communications sent to other contact points electronically will be processed in accordance with the date and time at the place of receipt. These communications will not gain the benefits provided by the *Electronic Transactions Act* such as security and certainty of receipt.

The *Electronic Transactions Act* business rules address a range of issues including:

- identifying the appropriate form of electronic communication to use for different types of correspondence;
- choosing electronic payment options;
- receiving notifications; and
- utilising supported electronic formats.

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