

PROCEDURES FOR OBTAINING INDUSTRIAL DESIGN PROTECTION IN AUSTRALIA

What is a Registrable Design?

The registration of an Industrial Design allows designers to obtain protection for the appearance of products that they have designed.

Registrable designs must have features of shape, pattern, or ornamentation which are present in the product. These features in the product must be apparent to the eye.

Registrable designs do not include methods or principles of construction which are more appropriately afforded protection through patents.

When is a Design Registrable?

To be registrable, a design must be new and distinctive with respect to other designs that preceded it.

The design must also not have been published, shown or used in public prior to seeking design registration.

Seeking and Obtaining a Design Registration

Applying for a Design Registration

To seek registration for a design it is necessary to lodge a design application with the Australian Design Office. The filing date of the application is called the priority date of the application. The newness of the design will be judged based on the priority date of the design application.

In addition to filing the design application, it is also necessary to request registration. A request for registration can be filed with the design application, but in any event should be filed before the expiry of six months from the earliest priority. For Australian originated designs, the earliest priority date will usually be the filing date of the application filed to seek design registration in Australia.

Examination of the Application

Before a design registration can be enforced, and before any threats can be made to any alleged infringers, it is necessary to have the design registration examined and certified.

Design registrations are examined at the Designs Office, only on lodgement of a request for examination. Such a request for examination can be filed at any time after the design is registered.

If there are grounds for objecting to the design application, an examination report will be issued. To overcome the objections, it is necessary to respond to the examination report. The cost of responding to the examination report will depend on the nature of the objections raised and the number of examination reports that are issued.

If there are no objections, or once all objections have been overcome, the design registration will be certified. At this stage it is possible to enforce the design registration and threats can be made to any alleged infringers.

Protection Term and Renewals

A design is registered for an initial term of five years from the date of filing the application, with a further period of five years available on application, providing a possible maximum term of 10 years.

Patent and Design Protection

It is possible and sometimes advisable to obtain both patent and design protection for the one development. We recommend seeking the advice of a Patent Attorney who can consider and advise on the benefits of following this course.

Foreign Design Registration

In order to seek design registration in jurisdictions other than Australia, it is necessary to file a design application in each of the jurisdictions of your interest.

The procedures for gaining design protection are different in most jurisdictions to the Australian procedures for seeking design registration. Therefore, advice from a Patent Attorney should be sought if design registrations in jurisdictions other than Australia is desired.

In any event, if design registrations in jurisdictions other than Australia are desired, the design applications should be filed in the respective jurisdictions prior to publication, disclosure or use of the design. However, if foreign design registration is desired for a design for which an Australian design application has been filed, any foreign design application must be filed within six months from the filing date of the Australian design application.

Costs

Costs will be incurred in respect of each of the above stages in applying for, obtaining, prosecuting and renewing a Design Registration. We can provide detailed advice on the costs likely to be incurred in respect of any or each of these stages should you require it.

About Wrays

Wrays is a leading IP specialist firm in Australia, bringing together the right combination of experts to protect, grow and defend our client's intellectual property assets locally and globally for more than 100 years.

And when you combine our passion for achieving the best result with our broad capability across the IP spectrum, it's our clients who enjoy the benefits. In day-to-day reality, this means bringing the right people in the room every time and working together across disciplines to deliver what's needed.

It doesn't stop there. Through our extensive local and global networks, we can connect clients with like-minded experts who deliver supporting services, such as private equity, tax advisors, corporate and employment law, as well as IP specialists around the world servicing other jurisdictions.