

The Why and How of Protecting your Designs

An overview of the law that affects creative professions with a specific focus on: Designs.

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The Why and How of Protecting your Designs

Learn about the law and registration procedure to protect your business identity and reputation.

The Keeping It Legal Series is a joint initiative between Match+ Professional Development Network and the Legal Advice Clinic.

Introduction

The University of South Australia's Legal Advice Clinic in partnership with Match+ and the School of Art, Architecture and Design have collaborated to present a series of seminars that focus on Arts Law, and specifically the areas of Intellectual Property and Contract Law. These seminars address some of the legal issues facing students, graduates and members of the creative arts professions.

Introduction to Intellectual Property

Intellectual property is a type of ‘invisible asset’ that is the product of creativity and innovation in industries such as the arts. Intellectual property law provides a framework that protects intellectual property rights.

Introduction To Designs

What is a ‘design’ and a ‘registerable design’?

In ordinary language, the term ‘design’ is often associated with a range of creative works such as artwork, 2D drawings and 3D objects including sculptures, plates, chairs, vases, pots, cars etc.

In intellectual property law we refer to the word ‘design’ as being a design in relation to a product.

A design can either be protected under the *Copyright Act (Cth) 1968* or the *Designs Act (Cth) 2003* or in some situations, under both. Some designs are not capable of copyright protection. The focus of this booklet is on registerable designs under the *Designs Act (Cth)* (‘the Act’). The implications of copyright law on designs are not dealt with here.

Under the Act, a design can be registered where:-

- It relates to a product;
- The design in relation to the product is ‘new and distinctive’; and
- The product has industrial or commercial use.

Why apply for Registration of your Design?

The law surrounding designs is quite complicated. Whether you should apply for a design depends on a number of factors that are discussed in this booklet. You cannot apply for registration if you have published or made the design publicly available in Australia before applying for registration. So the first thing you need to do is make sure you keep your design a secret!

Registering a design offers proof of ownership on the official IP register, provides certain exclusive rights and provides the protection given under the Act.

The benefit of registering your Design is that you are given greater protection if someone tries to use your design or a design similar to yours.

What can be registered as a Design?

To register a design, your design must satisfy the following criteria:-

- The design must be in relation to a product;
- The design needs to be ‘new and distinctive’; and
- It needs to be used industrially or commercially.

IP Australia is the organisation that determines whether designs are registrable.

What constitutes a design in relation to a product?

A design in relation to a product is:

The overall appearance of the product resulting from one or more visual features of the product.

For the purpose of registrable designs, it is not necessary to consider how a product operates or functions or its ergonomic qualities.

Registering a design ONLY protects the visual appearance of a product.

Registration of your design only protects how a product looks, not how it works!!!

For example, a kettle can have a specific design. They come in all shapes and sizes, with different patterns and colour schemes. The function of a kettle is that it boils water. Design registration does not protect the function of the kettle boiling water - it only protects what the kettle looks like.

What is a product?

The Act defines a ‘product’ as ‘a thing that is manufactured or handmade’. A product can also include parts of a product (if it is a complex product like a car) such as parts of an assembled kit and a thing which is of indefinite dimension such as a cornice or piping.

Design/Visual Features

The visual features in relation to a product can include one or more of the following:

- Shape;
- Configuration;
- Pattern; and
- Ornamentation.

For instance, the visual features of a kettle could relate to the shape of the body of the kettle, or possibly a pattern on the kettle, or both.

Colour is not specifically included as a ‘visual feature’ in the Act. However, colour is not excluded from the definition either. The use of colour may be relevant in assessing the overall look of a design but this depends on the circumstances and nature of the design.

The colour in and of itself will not make the product unique, but the colour in relation to a pattern can be considered when determining whether the design of the product is registrable.

Even the smallest individual visual aspect might be important in assessing the ‘overall appearance’ of the product.

What about features that are not visible in ordinary use?

The design in relation to a product can also include visual features that might not be immediately apparent in ordinary use. For example:-

- The inside of a jewellery box;
- The inside of a Kinder Surprise chocolate; and
- The inside of a golf ball.

New & Distinctive

To determine whether you have a registrable design, you need to show that the design is ‘new and distinctive’. Specifically, you need to show that the design:-

- Has not been published anywhere in the world or publicly used in Australia before applying to register it;
- Is new -it must not be identical to any design previously disclosed anywhere in the world; and
- Is distinctive - it must not be substantially similar in ‘overall impression’ to any design previously disclosed anywhere in the world.

Determining whether a design is ‘New and Distinctive’

It is NEW unless it is IDENTICAL to a design that forms the prior art base for the design.

It is DISTINCTIVE unless it is substantially similar in overall impression to a design that forms part of the prior art base.

To determine whether your design is distinctive, IP Australia will:-

- Give more weight to similarities between designs than differences;
- Have regard to the state of development of the prior art base;
- Have regard to the freedom of the designer to innovate; and
- Consider the ‘newness and distinctiveness’ statement (which is included in the application), and in particular have regard to:
 - The particular features which are new and distinctive; and
 - If only part of the design is new and distinctive, whether this part affects the distinctiveness of the whole design.

You should always consider the factors mentioned above when determining if a design is registrable.

Industrial or Commercial Use

You can only register a design where you can show that it has commercial or industrial use. That is, you need to show that the product has been industrially applied to that product more than 50 times and that the product is available for sale or hire.

Summary of a Registrable Design

The Design Act governs registrable designs.

A registrable design is a design in relation to a product.

Registration protects the overall appearance of your product not the product's function.

To obtain registration of a design you need to show that the design is 'new and distinctive' and that the product has industrial or commercial use.

Registering A Design

Am I entitled to register?

You are entitled to register if you are the owner of a design. The owner can be the:

- Person who created the design (the designer);
- Employer of the designer;
- Person who contracted the designer to create the design; or
- Person to whom the designer has assigned the design in writing.

Where two or more people own interests in a design, they must apply for registration jointly.

The owner can be:-

- An individual;
- A company;
- An association; or
- A partnership.

What can't you register?

Some designs, even when unique, cannot be legally registered. For example:

- Designs for medals;
- Australian currency; and
- Scandalous designs (i.e. defamatory, child pornography, discriminatory).

Times and Costs

Registering and certifying your design can be a lengthy, complex and costly process. Developing a commercial design may require the assistance of an:-

- Industrial designer;
- Lawyer;

- Marketing consultant;
- Patent attorney; and
- Accountant.

As well as the above costs, there are also fees for obtaining registration and certification.

Pre-Application

Before you apply, you need to do the following:

- DO NOT make the design public. You MUST keep your design a secret.
- Search online and on Australian and international design databases for similar designs.
- If a similar design has already been published, your design may not be ‘new and distinctive’.
- Make drawings & images of the design.
 - Good quality;
 - Accurately show overall features; and
 - Front, side and top views.

The process of searching design databases is quite complex and requires legal skill. If you are considering the registration of a design you should speak to a lawyer or patent attorney who specialises in intellectual property law.

Application

Fill out application form

A design application must specify the ‘entitled person or persons’. An ‘entitled person’ is the designer, the designer’s employer/contractor, a person who has been assigned the design, or the entitled person’s legal representative.

Minimum Filing Requirements

- Indicate that what is filed is a designs application;
- Identify the applicant and their contact details;
- Include a representation of each design; and
- You can include a statement of newness & distinctiveness (recommended).

If your design application meets the minimum filing requirements and formality checks, it will enter the designs register.

After you have filled out the application, you then need to lodge it. You will receive a lodgement number and you will then be asked to pay the application fee. Details of the fees associated with filing an application are available on the IP Australia website. There are different costs associated with filing online or by post.

Examination post application

As mentioned above, once all formalities are checked and the minimum filing requirements have been met, your design enters the Designs Register. Entering the Designs Register does not automatically mean that you have a ‘registerable design’ for the purposes of the Act.

In order to be sure you have a registerable design you need to request that IP Australia undertakes an examination of the design. The examination determines whether your design is ‘new and distinctive’ and whether it is enforceable. Requesting an examination attracts additional fees to the initial application fee.

If an examination is requested, the examiner will determine whether your design is new and distinctive. If it is, the examiner can issue a Certificate of Registration but only after the examiner has filed a public notice of their intention to certify.

An examiner needs to file a public notice of intention to certify so that anyone who thinks your design is not ‘new and distinctive’ can oppose the certification. Any opposition to your design needs to be made within a month of the public notice being issued. If someone opposes, the examiner then needs to consider all the evidence before making a determination on whether your design is registrable or not.

If the examiner considers your design is ‘new and distinctive’, then you need to pay the registration fee and the Certificate is issued.

In summary, there are potentially three lots of payments that need to be made:

- Application fee;
- Examination fee; and
- Certification/Registration fee.

Terms of Registration

Registration lasts for 5 years. It can be renewed for a further 5 years. Renewing registration attracts additional fees to those listed above.

Registration ceases if:

- It is revoked;
- Applicant has not paid fees; or
- Registration is surrendered.

Registration Rights

Once a design is registered, you have the **exclusive right** to:

1. Make, or offer to make, a product with the design on it;
2. Import the product into Australia for sale, or use for trade or business;
3. Sell, hire or otherwise dispose of;
4. Use for trade or business; and
5. Authorise someone else to do any of these acts.

If a third party does any of the acts mentioned above without having the authority to do so, then they are considered to have illegally breached your rights and you can take action against them in court. You can ask for an injunction order (this forces them to stop using your design), of damages (compensation for the loss you have suffered) and on account of profits (if they have made money from using your exclusive rights, you can ask for that money to be paid back to you).

A third party will not be considered to have unlawfully used your rights where they can show the following:-

- That you have authorised them or provided them with a licence to do so;
- That they have needed to repair the product (where it is a complex product such as a car); or
- In certain situations, the Crown (Commonwealth Government) needs to use the product for the defence of the country.

In summary, it is obvious that the law surrounding registrable designs under the Act is quite complex.

We always recommend you seek legal advice about any design you wish to register in relation to a product.

Notes:

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it's legit.