

Australian Registered Designs

Introduction

This document gives a brief summary of the design application process. A design registration protects the appearance of an article, for example the shape of a new chair or pen. Designs are also available for new features of pattern or ornamentation.

Other forms of intellectual property (IP) protection may be used to protect ideas and concepts embodied in things, methods and processes (standard patents or innovation patents), a particular expression of an idea or artistic work (copyright) or a brand or trade name (trade marks). Please refer to our patent and trade mark guides for information in these areas.

It is only possible to obtain design registration for a new design. It is crucial that there is no publication, sale or use of the product before a design application is filed. However, in limited circumstances it may be possible to apply for design registration in one country when the design has already been used or published in another country. For example, Europe and the US have a one year "grace period". No account will be taken in those countries of the applicant's own activities before filing but within the grace period. There is no grace period in Australia and a design must be new with regard to any use in Australia or publication anywhere in the world.

Process in Australia

A design application is filed with a set of drawings or images showing the article in detail. Protection is usually sought for the entire article but it is possible to focus protection on one or more specific aspects of the design. Each application establishes a "priority date", after which publication or release of a product will not generally result in loss of design rights.

The cost of preparing and filing a design application in Australia is around \$AU900, assuming that full drawings can be provided. Additional costs will result if we need to assist in preparation of drawings.

Developments of the design may be covered by filing further design applications.

The design application is examined by IP Australia for formalities only. If all objections are overcome, the design is registered and published. Costs incurred during this process are usually about \$AU250 but can be up to \$AU800 in difficult cases.

A design registration cannot be enforced until it undergoes substantive examination (esp. to determine that it is sufficiently novel). Examination is usually only requested prior to enforcement but may be requested early where infringement is considered likely. Defensive publication of a design is also available but this only provides a defence and gives no enforceable right.

Design protection outside of Australia

In order to obtain design protection outside of Australia, design applications must be filed in each country where protection is desired. If these applications are filed within 6 months of the Australia filing, the Applicant is entitled to retain the benefit of that filing date. The cost of filing these applications varies across different countries, as indicated in the attached guide.

Each application is examined in the appropriate national Patent Office before a design is registered in that country. Some countries examine only for formal matters while others conduct a full examination process. Costs similar to the filing cost are generally incurred in each country during examination and registration procedures although these vary greatly from country to country and are likely to be higher in the US.

Note that some (generally minor) countries are “non-convention” countries. Applications in these countries cannot claim the Australian filing date and must be filed independently, ideally at the same time as filing the Australian application. We therefore recommend that you discuss countries of interest with us at an early stage.

Maintaining a design

In most countries, once a design has been registered renewal fees must be paid periodically over life of the registration to keep it in force.

Designs in Australia last for 10 years from the date of filing if renewed after the initial 5 year term. However in other countries the term of protection varies from 10 years up to 25 years (Europe). Once a design registration expires, or is allowed to lapse by non-payment of a renewal fee, others are free to make, use or sell the design.

Copyright / Unregistered Design Rights

Only very limited protection is provided in Australia for three dimensional copyright works. There will generally be no copyright protection after the design has been “industrially applied” (usually from the production of the 50th article although 2 cranes satisfied this requirement).

A few countries, such as New Zealand, do provide useful copyright for three dimensional works (16 years from industrial application). Other countries, such as the UK, have provisions for protection of unregistered designs. More detailed information can be provided on request.

INDICATIVE COSTS FOR
NATIONAL DESIGN FILINGS

<u>Country</u>	<u>\$AU Typical Filing Cost</u>
Australia	900.00
Canada	2,250.00
United States	2,450.00
China	1,500.00
European Community	2,200.00
Hong Kong	1,600.00
India	1,200.00
Japan	2,400.00
Korea (South)	1,500.00
Mexico	2,000.00
Russian Federation	2,300.00
Singapore	1,400.00
South Africa	2,100.00
Israel	1,600.00
Brazil	1,500.00

Please note that these costs are not fixed quotes, but are indicative costs based on previous filings. The actual cost may vary and if accurate estimates are required please let us know. Further costs will be incurred in examination and registration procedures in each country. Renewal fees must also be paid to maintain a design in force.