

## Protecting your design in Australia



### What is a registered design?

A registered design is a legal right that protects the way an article looks, but not the way it works. A registered design protects visual features of an article, like:

- shape
- configuration
- pattern
- ornamentation.

Registered design protection can protect both three-dimensional items and two-dimensional designs.

Examples of products that can be protected by registered designs include almost any physical object such as packaging, machinery, furniture, extrusion cross sections, jewellery, clothing, and patterns on wallpaper and textiles.

To qualify for registered design protection, your design must be new and distinctive.

### Copyright, designs or patents?

Patents, copyright, trade marks and registered designs all provide different types of protection for new designs. To protect the way something new works, you could apply for a patent. You could rely on copyright to stop unauthorised copying of literary, artistic, musical and electronically recorded works. Trade marks are used to protect brands. But a registered design specifically protects the appearance of a manufactured article.

Registered designs are particularly important for three-dimensional articles because designs applied to three-dimensional articles generally lose copyright protection in Australia once they are used commercially.

Two-dimensional designs such as patterns have some copyright protection in Australia, even if they are used commercially. However, registered designs have a number of advantages over relying on copyright.

To prove infringement of a valid registered design, the owner of the registered design only has to show enough visual likeness between the infringing design and the registered design. This is usually far more straightforward than proving copyright infringement. To prove copyright infringement, the owner must not only show that there is enough visual likeness, but must also show that they are the owner of the copyright in the original design, and that the alleged infringer has, either directly or indirectly, copied from the original design.

A registered design can give protection against independent creation of the same, or similar, design. Independent creation of a registered design infringes the registered design, but does not infringe copyright.

A registered design only protects an article's appearance, not the way the article works. A patent can provide broader protection for the functional aspects of a product. Often we recommend clients get both patent and registered design protection.

Design registration costs less and is normally much faster than getting a patent.

### Keep your design secret

You should not show, sell, or advertise your design to the public before applying for registration of your design. If someone has seen your design before you file an application, your design may not qualify for legal protection because the design will no longer be considered new.

If you need a third-party to assess or help with the design, make sure they sign a confidentiality agreement before you show them your design.

If you make any significant changes to your design after filing an application, you may need to file other design applications to protect those new features. In that case, it is just as important to keep the changes secret until you have filed the other design applications.

## Check that your design is new and distinctive

A search of published patents and designs before filing your application can help you determine whether your design is new and distinctive, and able to be registered. We can search databases in Australia and in overseas countries for you.

Search results may also signal whether using your design will infringe patents or designs granted in the country where you are searching.

## File a design application

To apply for an Australian registered design, we need to pay a fee and file the following documents at IP Australia.

1. Pictures of your design for a particular article (usually perspective, plan, and elevation drawings, or high quality photographs) clearly showing the design features that you want to protect.
2. A 'statement of newness and distinctiveness', specifying the new and distinctive features of your design.

## How does the registration process work?

After you file a design application, IP Australia will check formalities. If the formalities are satisfied, the design will be registered.

There is no automatic examination of designs for newness and distinctiveness in Australia. However, you cannot enforce your design registration until after it has been examined and certified. You may request examination at any time after your design is registered. Examination may also be requested by a third party or the Registrar for Designs. The examination process normally must be completed within six months.

## How long does your registered design last?

In Australia, your registered design lasts a maximum of 10 years from the date you filed your application. Designs are initially registered for five years and are renewable for an additional five years.

## Protect your design in the countries where you plan to use it

Your Australian registered design is only effective in Australia. You can register your design in other countries of commercial importance.

Each country has different systems and requirements for registered designs. We can tell you about the registration processes and help you file design applications in other countries.

## How do I stop others using my registered design?

As the owner of an Australian registered design for an article, you have the exclusive right to make, import, use and sell that article having that design in Australia.

We recommend marking your product, packaging, or product literature with details of your design registration. Marking is sometimes enough to deter potential copiers.

If you own a registered design, you should enforce your rights. You must have your registered design examined and certified before enforcing it.

If a third party is infringing your design, sometimes a warning letter is enough to make them discontinue the infringement.

But sometimes you have to take court action against the infringer to stop them infringing your rights. The court decides whether an article infringes your design by visually comparing the alleged infringing article and the article shown in your design application.

Talk to AJ Park for the best advice about registering a design in Australia.