

# RECENT AMENDMENTS TO THE DESIGNS ACT 1906 (Cth)

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[In this comment, Ms Walker outlines recent legislative amendments to the Australian law of Design, and highlights some of the problems these have raised, including: the definition of qualifications for registration of a design in Australia, the difficulty of delineating the separate provinces of Design law and Copyright law, and the grounds on which a person may challenge the registration of a design by another. The discussion, which involves a detailed examination of the legislative provisions, demonstrates clearly the confusion and absence of coherence, which have resulted.]

The law relating to designs has recently been the subject of major amendment. The Designs Act 1906 (Cth) ('the Act') has been amended by the Designs Amendment Act 1981 (Cth) ('the Amending Act') which in turn has been amended by Part XI of the Statute Law (Miscellaneous Amendments) Act 1981 (Cth). New Designs Regulations<sup>1</sup> have also been made. The substantive provisions of the Amending Act, as amended by the Statute Law (Miscellaneous Amendments) Act 1981 (Cth), and the new Designs Regulations both came into operation on 1 April 1982.<sup>2</sup> Generally the amendments implement the recommendations of the Designs Law Review Committee ('the Franki Committee')<sup>3</sup> which reported in February 1973.

The object of this comment is to consider certain problems arising in relation to the Act as amended.

## 1 *Qualifications for registration*

The Act delineates the designs that may be registered. One question which may arise is whether a design which has previously been published, that is disclosed to the public, outside Australia, but has not been published in Australia, may be registered under the Act. A person who *merely* imports a design from outside Australia is not entitled to apply for registration of the design in Australia; to make such an application the importer must be the 'owner'<sup>4</sup> of the design. Thus, the problem arises only where the

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<sup>1</sup> Statutory Rules 1982, No. 72.

<sup>2</sup> Designs Amendment Act 1981 (Cth), s. 2 and Australia, *Government Gazette*, 23 March 1983 (No. G 12) 4; Statute Law (Miscellaneous Amendments) Act 1981 (Cth), sub-s. 2(7); Designs Regulations (Statutory Rules 1982, No. 72) reg. 2.

<sup>3</sup> Australia, *Report on the Law Relating to Designs* (1973) P.P. No. 1.

<sup>4</sup> S. 20 of the Act as amended provides that the owner of a design is entitled to apply for registration of the design. A person may be the owner of the design by reason of being the author of the design (sub-s. 19(1)), by reason of an agreement

importer: is the author of the design, has made an agreement for valuable consideration for the making of the design, is the employer of a person who has made the design in the course of his employment, or is the assignee of an interest in the design; and the design has been published outside Australia.

Certain sections of the Act as amended limit the circumstances in which this problem arises. First, section 47 provides that the fact that a design has been published by being exhibited at certain exhibitions shall not prevent its registration. Secondly, the effect of sub-section 49(1) is that, subject to the restrictions set out in that sub-section, publication constituted by an application to register a design in a convention country, as defined by section 48, and any publication of the design after the date of such an application is irrelevant. Thirdly, if the publication outside Australia took place without the knowledge and consent of the owner and the subject of the publication was derived or obtained from him, section 46A may operate to entitle him to register the design. Finally, section 17A provides that subject to the restrictions set out in that section, where copyright under the Copyright Act 1968 (Cth) subsists in an artistic work the corresponding design shall not be treated as having been published by reason only of any previous use of the artistic work.

Thus the problem arises where the design has been published outside Australia in circumstances not protected by sections 47, 49, 46A or 17A.

Prior to its amendment sub-section 17(1) of the Act provided for the registration of any 'new or original design, which has not been published in Australia before the lodging of an application for its registration'.

The meaning of the alternatives 'new' or 'original' is uncertain. Russell-Clarke<sup>5</sup> suggests that it is possible that 'new' refers to cases where the shape or pattern is completely new, whilst 'original' refers to cases where the shape or pattern is old in itself but new in its application to the article in question. In *Malleys Ltd v. J.W. Tomlin Pty Ltd*<sup>6</sup> the High Court held that whether or not the design in question in that case was original it was new because the design for every other article previously in existence to which evidence was directed was substantially different. Nevertheless it is clear that prior publication is relevant when determining novelty or originality. In *In re Wolanski's Registered Design*<sup>7</sup> Kitto J. stated that when it is argued that a design is not new or original and this argument is supported by proof of prior publication, the issue is whether there is such a difference between

for valuable consideration for the making of the design (sub-s. 19(2)), by reason of his employment of the designer who made the design (sub-s. 19(3)), or by reason of the assignment of the design to him (sub-s. 19(4)).

<sup>5</sup> Fysh M., *Russell-Clarke on Copyright in Industrial Designs* (5th ed. 1974) 36.

<sup>6</sup> (1961) 35 A.L.J.R. 352, 353.

<sup>7</sup> (1953) 88 C.L.R. 278, 280. In a more recent decision — *British Franco Electric Pty Ltd and Another v. Dowling Plastics Pty Ltd and Others* [1981] 1 N.S.W.L.R. 448, 459-60 — consideration was given to the principles for determining whether a design is new or original in relation to a previously published design.

the conception of shape *etc.* previously published and the design in question as satisfies the requirement of novelty or originality in the latter. More recently in *Aluminium Specialties Pty Ltd and Another v. Ibis Building Products Pty Ltd and Others*<sup>8</sup> Waddell J. compared the registered designs in question with certain designs published before the applications to register the designs and held that as there was, to the eye, no substantial difference, it could not be said that the registered designs were new or original.<sup>9</sup>

Accordingly, if sub-section 17(1) had provided only that the design must be new or original, it could have been argued that a design which had been published outside Australia could not be registered in Australia. However the additional words, 'which has not been published in Australia' implied that publication of an identical design outside Australia would not preclude the design from being registered in Australia. For this reason, the cases referred to above as examples of the relevance of prior publication when determining novelty or originality, all concerned prior publication in Australia.

The Amending Act has substituted a new sub-section 17(1) which provides —

Subject to this Act, a design shall not be registered unless it is a new or original design and, in particular, shall not be registered in respect of an article if the design —

- (a) differs only in immaterial details or in features commonly used in the relevant trade from a design that, before the priority date in respect of the application for registration, was registered, published or used in Australia in respect of the same article; or
- (b) is an obvious adaptation of a design that, before the priority date in respect of the application for registration, was registered, published or used in Australia in respect of any other article.

There are two differences between this sub-section and the sub-section that it replaces. The differences may be used to support an argument that now a design which has been published outside Australia may not be registered despite the fact that it has not been published in Australia. The first difference arises from the addition of the words 'in particular'; these words indicate that prior publication is assimilated with lack of novelty or originality.<sup>10</sup> However, the sub-section does not require only that the design must be new or original in Australia; it requires absolute novelty or originality. Because prior publication is relevant when determining novelty or originality, this absolute requirement is incompatible with prior publication outside Australia.

The second difference is that the sub-section no longer requires that an

<sup>8</sup> Unreported judgment of Waddell J. in the Supreme Court of New South Wales Equity Division, 7 July 1982.

<sup>9</sup> *Ibid.* 10.

<sup>10</sup> It should be noted that s. 17A of the Act as amended retains the distinction between these concepts and that s. 28 still refers to publication as a separate concept.

identical design has not been published in Australia. Thus, the implication that publication of such a design outside Australia will not preclude registration has been deleted.

Reference should be made to paragraphs 17(1)(a) and (b). These prohibit, *inter alia*, the registration of a design which differs only in immaterial details or features commonly used in the relevant trade from, or is an obvious adaptation of, a design that has previously been published in Australia. Although these paragraphs refer only to prior publication in Australia, the implication which may be drawn from them is limited. They operate to exclude designs which might otherwise have been registrable, that is designs which either differ only in immaterial details or features commonly used in the relevant trade from, or are obvious adaptations of, designs published in Australia. The implication which may be drawn from these paragraphs is that these limited categories of designs may be published outside Australia without precluding registration in Australia. No strong implication can be drawn from these paragraphs in relation to identical designs, particularly in view of the requirement of absolute novelty or originality.

Sub-section 17(1) should be contrasted with the equivalent provision in the Registered Designs Act 1949 (U.K.). Section 1(2) of that Act provides —

Subject to the provisions of this Act, a design shall not be registered thereunder unless it is new or original and in particular shall not be so registered in respect of any article if it is the same as a design which before the date of the application for registration has been registered or published in the United Kingdom in respect of the same or any other article or differs from such a design only in immaterial details or in features which are variants commonly used in the trade.

Although this section assimilates prior publication with lack of novelty or originality, it specifically provides that a design shall not be registered if it is the same as a design which has been published in the United Kingdom. Thus it clearly implies that publication outside the United Kingdom will not preclude the same design from being registered in the United Kingdom.

It should be noted that, generally, in amending sub-section 17(1) the Amending Act follows the recommendations of the Franki Committee; the exception to this generalization is that the Committee recommended that sub-section 17(1) should preclude the registration of a design 'if it is the same as a design which . . . has been . . . published in Australia in respect of the same article . . .'.<sup>11</sup> If these words had been included the sub-section would have implied that a design which, although previously published outside Australia, has not been published in Australia, is registrable. For the reasons indicated above it is suggested that in the absence of these words it is arguable that such a design is not registrable.

<sup>11</sup> Australia, *Report on the Law Relating to Designs op. cit.* para. 70.

## 2 Dual protection under the Copyright Act 1968 and designs legislation

Numerous difficulties arise because of the possibility of dual protection under the Copyright Act 1968 (Cth) ('the Copyright Act') and designs legislation.<sup>12</sup> One way of avoiding this possibility is to exclude from registration under designs legislation, designs for articles that are primarily literary or artistic in character. Sub-section 17(2) of the Act as amended provides that regulations may exclude designs for such articles from registration under the Act. Formerly the exclusions were incorporated in regulation 20A of the Designs Regulations.<sup>13</sup> That regulation provided that designs for articles included in certain specified classes were excluded from registration. The classes of articles included:

- 20A(2) . . . (d) articles that are primarily literary or artistic in character and on which there is printing, including —  
(i) bookjackets . . .

Regulation 20A has been replaced by regulation 11 of the Designs Regulations 1982.<sup>14</sup> Regulation 11 provides that —

- . . . the Registrar shall not register . . . any designs for the following articles, being articles that are primarily literary or artistic in character:  
(a) articles on which there is printing, being —  
(i) bookjackets . . .

There are two differences between regulation 11 and the regulation that it replaces. First, regulation 20A set out an inclusive definition of the literary or artistic articles in respect of which designs could not be registered. Thus a design for an article which was not listed but which was primarily literary or artistic in character and on which there was printing would be excluded from registration pursuant to the regulation. Examples of such articles include record covers, games boards and canvas or paper for paintings and drawings. In contrast, regulation 11 sets out an exhaustive list of those literary or artistic articles in respect of which designs may not be registered. Secondly, regulation 20A did not preclude an argument, in a particular case, that although the design was for a listed article, in this case the article was not primarily literary or artistic in character and therefore a design could be registered. Regulation 11 may preclude such an argument because it provides that the listed articles are articles 'being articles that are primarily literary or artistic in character'.

The first difference is of significance in the context of first, section 17A of the Act as amended and secondly, section 77 of the Copyright Act.

Section 17A of the Act as amended operates where the owner of copyright in an artistic work, or a person acting with the copyright owner's consent,

<sup>12</sup> The Franki Committee outlined the manner in which this arises — see Australia, *Report on the Law Relating to Designs op. cit.* paras 245-7.

<sup>13</sup> Designs Regulations as amended by Statutory Rules 1969, No. 64.

<sup>14</sup> Statutory Rules 1982, No. 72.

applies to register a 'corresponding design'.<sup>15</sup> In these circumstances the section operates so that the design is not treated as other than new or original<sup>16</sup> by reason only of any previous use of the artistic work. Accordingly the applicant is enabled to register the corresponding design in respect of some article that is not primarily literary or artistic in character despite the previous use of the artistic work from which it derives. However section 17A does not operate if the previous use was by or with the consent of the copyright owner and consisted of or included the sale, letting for hire or offering or exposing for sale or hire of articles to which the design had been 'applied industrially'.<sup>17</sup> For the purpose of determining whether the articles so used were articles to which the design had been applied industrially, paragraph 17A(1)(c) of the Act excludes articles specified in regulations made under sub-section 17(2). Thus, the object of section 17A is to ensure that the owner does not lose his right to apply for registration of a corresponding design by reason only of the application of it to articles that are primarily literary or artistic in character.

At this point the first difference between regulation 20A and regulation 11 is of importance. If the corresponding design has been applied to an article that is primarily literary or artistic in character and on which there is printing but that article is not listed, different results follow. Under regulation 20A the design for the article would have been excluded from registration and, accordingly, pursuant to paragraph 17A(1)(c), the article would have been excluded for the purpose of determining whether the design had been applied industrially. Thus the owner, or person acting with his consent, would not have lost his right to apply for registration of the design by reason only of the application of it to articles that are primarily literary or artistic in character. Under regulation 11 the design for such an article would no longer be excluded from registration and, accordingly, the article would not be excluded for the purpose of determining whether the design has been applied industrially. Thus, an application to register a corresponding design may now be rejected because it is not new or original although its previous use was in relation to essentially literary or artistic articles; section 17A will not operate to enable it to be registered if the design was applied industrially to such articles<sup>18</sup> which were sold *etc.*

<sup>15</sup> Sub-s. 4(1) provides that 'corresponding design' has the same meaning as in Division 8 of Part III of the Copyright Act 1968 (Cth). Sub-s. 74(1) of that Act provides that 'corresponding design' means a design that, when applied to an article, results in a 'reproduction' of the artistic work. For the meaning of 'reproduction' see sub-s. 21(3) of the Copyright Act.

<sup>16</sup> It is necessary to establish novelty or originality to register the design — sub-s. 17(1) of the Designs Act, *supra* 91.

<sup>17</sup> Designs Act 1906 (Cth), paras 17A(1)(c) and (d). Sub-s. 17A(2) provides that Regulations in force under the Copyright Act apply to determine whether the design has been 'applied industrially'. Reg. 17(1) of the Copyright Regulations (Statutory Rules 1969, No. 58) provides, *inter alia*, that a design is deemed to be applied industrially if it is applied to more than fifty articles.

<sup>18</sup> Unless the articles are listed in reg. 11.

The difference between regulation 20A and regulation 11 may be overcome by having regard to the fact that section 17A of the Act operates so that a corresponding design is new or original unless the design has been applied industrially to 'articles' which have been sold *etc.* It may be argued first, that an object that is primarily literary or artistic in character is not an article of manufacture and therefore is not an 'article' as defined by sub-section 4(1).<sup>19</sup> Accordingly, the application of the design to such an object is not relevant when determining whether the design has been applied industrially to articles. Secondly, it may be argued that because an object that is primarily literary or artistic in character has no purpose beyond carrying the literary or artistic work the object is so subordinate as to be irrelevant. Accordingly, the application of the design to such an object is not relevant for the purpose of determining whether the design has been applied industrially to articles.<sup>20</sup> Alternatively the difference between the regulations may be overcome by having regard to the fact that section 17A of the Act operates so that a corresponding design is new or original unless the design has been 'applied' industrially to articles which have been sold *etc.* The term 'applied' is not defined in the Act as amended. However regulation 17(3) of the Copyright Regulations 1969<sup>21</sup> provides that, for the purposes of that Regulation a design shall be deemed to be applied if it is applied by a process (whether a process of printing, embossing or otherwise) or it is reproduced on or in the article in the course of its production. This may indicate that a design is not 'applied' unless it is applied by an industrial process or means. When defining the term 'design', section 1(3) of the Registered Designs Act 1949 (U.K.) specifically qualifies the word 'applied' in this manner; the qualification has been used to support a proposition that drawings are not designs capable of registration.<sup>22</sup>

The difficulty with the first and second of these arguments is that they are based upon interpreting the term 'article' so as to exclude articles that are primarily literary or artistic in character. This would make both regulation 11 and the regulation-making power in sub-section 17(2) redundant. Further, it would create an internal inconsistency within sub-section 17(2) which refers to the exclusion of designs for 'articles that are primarily literary or artistic in character'.

<sup>19</sup> 'Article of manufacture' is not defined in the Act. Russell-Clarke *op. cit.* 13 cites two cases (*Riego de la Branchardiere v. Elvery* (1849) 18 L.J. Ex. 381 and *Masson Seeley and Co. Ltd v. Embosotype Manufacturing Co.* (1924) 41 R.P.C. 160) to support a proposition that paper and canvas are not 'articles of manufacture', however, neither case specifically supports this proposition.

<sup>20</sup> For an example of the United Kingdom Patents Appeal Tribunal applying this reasoning see *In the Matter of the Application of Littlewoods Pools Ltd to Register a Design* (1949) 66 R.P.C. 309.

<sup>21</sup> Statutory Rules 1969, No. 58. Sub-s. 17A(2) of the Act as amended provides that this regulation has effect for the purpose of s. 17A.

<sup>22</sup> *King Features Syndicate Incorporated and Frank Cecil Betts v. O. and M. Kleeman Ltd* (1941) 58 R.P.C. 207, 222. Lord Romer applied s. 19 of the Patents and Designs Act 1919 (U.K.) which was the equivalent of s. 1(3) of the Registered Designs Act 1949 (U.K.).

The difficulty with all the arguments is that although they would operate to ensure that an application to register a corresponding design will not be rejected by reason only of its application to *certain* articles that are primarily literary or artistic in character, they would not ensure that the application of the corresponding design to *any* article that is primarily literary or artistic in character will be treated in this manner. For example each argument would ensure that the application of the design to canvas or paper would not be relevant in determining whether the design had been applied industrially but none of the arguments would operate in this manner in relation to an application of the design to articles such as record covers or games boards.

A similar problem arises in the context of section 77 of the Copyright Act. Broadly, that section reduces copyright protection where no corresponding design<sup>23</sup> has been registered, if the design has been applied industrially. Regulation 17 of the Copyright Regulations 1969<sup>24</sup> provides, generally, that a design is deemed to be applied industrially if it is applied to more than fifty articles. Accordingly the copyright owner's rights are reduced if he chooses to use his artistic work in a manner more suited to designs protection. Sub-section 77(4) of the Copyright Act makes it clear that, in determining whether the design has been applied industrially, no account is taken of articles in respect of which the corresponding design was excluded from registration under the Designs Act by reason of the operation of regulations made under that Act. The object of this is to ensure that copyright protection is not reduced by reason only of the application of the corresponding design to articles that are primarily literary or artistic in character.

At this point the difference between regulation 20A and regulation 11 is of importance. If the corresponding design has been applied to an article which is primarily literary or artistic in character and on which there is printing but that article is not listed, different results follow. Under regulation 20A the design for the article would have been excluded from registration and the article would not have been taken into account when determining whether the design had been applied industrially. Under regulation 11 the design for the article would not be excluded from registration and arguably the article would be taken into account when determining whether the design has been applied industrially. Thus, copyright protection may now be reduced by reason only of an application of the corresponding design to articles that are primarily literary or artistic in character.

The difference between regulation 20A and regulation 11 may be over-

<sup>23</sup> *Supra* n. 15.

<sup>24</sup> Statutory Rules 1969, No. 58.



come in the same manner as outlined above in relation to section 17A of the Designs Act,<sup>25</sup> that is, by having regard to the fact that section 77 operates where the corresponding design has been 'applied' to 'articles'. The argument based on the term 'applied' is supported by regulation 17(3) of the Copyright Regulations<sup>26</sup> which applies to both section 17A of the Designs Act and section 77 of the Copyright Act. So far as the arguments based on the term 'article' are concerned, assuming the term is interpreted in accordance with one of the approaches suggested in the context of the Designs Act, it would be interpreted in the same manner in the context of the Copyright Act. Support for this may be found in *Dorling v. Honnor Marine Ltd*,<sup>27</sup> a Court of Appeal decision in relation to the equivalent provisions of the United Kingdom Copyright Act 1956. It has been suggested that this decision indicates that the operation of section 77 is limited to circumstances in which the corresponding design is registrable under the Designs Act.<sup>28</sup>

The analysis of the significance of the first difference between regulation 11 and its predecessor in the context of section 17A of the Designs Act and in the context of section 77 of the Copyright Act, suggests that designs for all articles that are primarily literary or artistic in character should be treated in the same manner; some should not be excluded from registration by the regulations while others are excluded from registration by reason of the adoption of some artificial interpretation of the term 'article' or the term 'applied'.

The second difference between regulation 20A and regulation 11 is of significance in the context of section 23 of the Act as amended. This section provides that if the Registrar<sup>29</sup> is satisfied that the design is a design which may be registered he may register the design. Formerly, if an article on which there was printing was listed in regulation 20A(2)(d) but, in a particular case, it was not primarily literary or artistic in character, the Registrar could register a design for the article. It is arguable that the Registrar no longer has any such discretion under regulation 11, that is, he is precluded from registering a design for an article on which there is printing if the article is listed in that regulation even in a case where the article is not primarily literary or artistic in character. The rationale for excluding from registration designs for articles that are primarily literary or artistic in character is that it is more appropriate that such articles should be protected under the Copyright Act. However, where an article, in a particular case, is not primarily literary or artistic in character this rationale no longer exists and design registration should be available.

<sup>25</sup> *Supra* 95.

<sup>26</sup> *Ibid.*

<sup>27</sup> [1965] 1 Ch. 1.

<sup>28</sup> Australia, *Report on the Law Relating to Designs op. cit.* para. 277.

<sup>29</sup> See s. 8 of the Act as amended.

### 3 Objections to registration

A person may consider that a particular design should not have been registered under the Act as amended. His objection will generally be based on one of four grounds. First, that the registration is not in respect of a 'design'. 'Design' is defined in sub-section 4(1) as

features of shape, configuration, pattern or ornamentation applicable to an article, being features that, in the finished article, can be judged by the eye, but does not include a method or principle of construction.

Accordingly, in this regard, he may argue that there are no features of shape, configuration, pattern or ornamentation that can be judged by the eye; that the features are not applicable to an 'article';<sup>30</sup> or that the registration is in respect of a method or principle of construction.

Secondly, that the design was not new or original and, accordingly, should not have been registered pursuant to sub-section 17(1).

Thirdly, that the design has been registered in respect of an article specified in regulation 11 as an article in respect of which designs may not be registered.

Fourthly, that the registered proprietor was not the owner of the design and thus was not entitled to make application for registration of the design pursuant to sub-section 20(1).<sup>31</sup>

The following questions arise: which of these grounds may be taken to object to the registration; what standing must the person objecting to the registration establish; to what court or body can an objection be made?

An examination of the Act as amended indicates that although the person objecting has various avenues to pursue, these lack any overall coherent structure. In addition, the grounds which may be taken to object to the registration are not always clear.

First, pursuant to section 39 he may apply to a 'prescribed court'<sup>32</sup> for an order rectifying the register by the expunging of an entry 'wrongly made' in the register. Presumably 'wrongly made' encompasses the four possible grounds outlined above as bases for objection to registration. However, the section requires that the application be made by a 'person aggrieved'; there is thus some threshold standing requirement. It should be noted that the recommendation of the Franki Committee that it should be open to any person, including the Registrar, to apply for rectification, whether or not that person is aggrieved,<sup>33</sup> has not been followed.

Secondly, pursuant to section 28 he may apply to a prescribed court for cancellation of the registration on the ground that the design has been

<sup>30</sup> 'Article' is defined in sub-s. 4(1) of the Act as amended as 'any article of manufacture and includes a part of such an article if made separately'.

<sup>31</sup> S. 19 sets out the rules for determining ownership.

<sup>32</sup> 'Prescribed Court' is defined in sub-s. 4(1) as the Supreme Court of a State, the Supreme Court of the Australian Capital Territory, the Supreme Court of the Northern Territory of Australia or the Supreme Court of Norfolk Island.

<sup>33</sup> Australia, *Report on the Law Relating to Designs op. cit.* para. 159.

published in the Commonwealth prior to the date on which the application for the registration of the design was lodged.<sup>34</sup> It has been held that the registration may be cancelled pursuant to this section only where an identical design has been published prior to the date on which the application was lodged.<sup>35</sup> Accordingly, section 28 is narrower than section 39; section 28 extends only to cancellation of registration on the basis of a narrow aspect of the ground of lack of novelty or originality, that is, prior publication.<sup>36</sup> It is clear however that this ground is encompassed by section 39. Until 15 May 1979 it could be argued that there was some rationale for the existence of section 28 in that it conferred jurisdiction on the High Court to consider the limited ground of objection encompassed by that section, whereas section 39 conferred jurisdiction on the Supreme Court to consider the wider grounds of objection encompassed by that section. However, the Jurisdiction of Courts (Miscellaneous Amendments) Act 1979 (Cth) amended section 28 so that from 15 May 1979 applications pursuant to that section were also made to the Supreme Court. The Act as amended now provides that applications pursuant to both sections are heard by a prescribed court.<sup>37</sup>

The recommendation of the Franki Committee that this part of section 28 should be omitted,<sup>38</sup> has not been followed.

Only a 'person interested' may apply for cancellation of the registration of a design under section 28; the difference, if any, between a 'person aggrieved' and a 'person interested' is unclear and adds to the obtuse nature of the sections.

A person who objects to the registration of a design may take advantage of sub-section 27A(4). Under that sub-section a person may, before the expiration of eleven months after the date of registration, lodge a notice at the Designs Office setting out any matter (a) that has been published in a document in Australia before the date on which the application was lodged *and* (b) that the person considers relevant to the question whether the design was not new or original on the date on which the application was lodged. Sub-section 27A(9) provides that the Registrar may refuse an application under sub-section 27A(2) for an extension of the initial 12 month period of registration of a design on the ground that the design was not new or original; in so doing the Registrar may have regard to any matter

<sup>34</sup> See sub-s. 21(2); see also s. 46A which sets out an exception in relation to prior publication without the knowledge of the applicant or owner and s. 47 which sets out an exception in relation to prior publication at certain exhibitions.

<sup>35</sup> *In re Wolanski's Registered Design* (1953) 88 C.L.R. 278, 280 and *Aluminium Specialties Pty Ltd and Another v. Ibis Building Products Pty Ltd and Others* unreported decision of the Supreme Court of New South Wales (Equity Division), No. 4546 of 1981.

<sup>36</sup> *Supra* 90-1.

<sup>37</sup> *Supra* n. 32.

<sup>38</sup> Australia, *Report on the Law Relating to Designs op. cit.* para. 165.

that has come to his notice in connection with a design referred to in sub-section 27A(4).

On what grounds may the person lodge such a notice? Sub-section 27A(4) refers only to matters relevant to whether the design was new or original. Thus, this sub-section could not be used to draw to the Registrar's attention matters relevant to any of the other possible grounds of objection to registration.<sup>39</sup> It should be noted that the Franki Committee recommended that this sub-section should enable a person to inform the Registrar of any matter published in a document which affects the validity of the registration 'on any of the grounds on which a registration may be held to be invalid'.<sup>40</sup> In relation to the question of whether a design is new or original, it should be noted that sub-section 17(1) of the Act indicates that 'publication', 'registration' and 'use' are different aspects of novelty or originality. The use of the word 'and' in sub-section 27A(4) indicates that the only ground for lodging a notice under that sub-section is that the design has been previously 'published' in a document in Australia. Thus the person could not submit evidence of prior use; he could not submit evidence of prior publication in something other than documentary form (for example a film). Accordingly the grounds for complaint are limited.

Under sub-section 27A(4) 'any person' may lodge such a notice. Accordingly, there is no standing requirement.

Reference should be made to sub-section 27B(3) which operates where a registered design has ceased to be in force on the expiration of the period of registration<sup>41</sup> or the period of registration as extended under sub-section 27A(8) or (12), and an application is made for the restoration of the registration of the design. In these circumstances 'a person interested' may give notice to the Registrar of opposition to the restoration of the registration of the design. The sub-section does not set out the grounds of opposition which may be relied on. Paragraph 27C(1)(a) provides that the Registrar shall hear the matter and he may restore the design registration or dismiss the application for restoration; it does not set out the grounds upon which he may dismiss the application.

It may be argued that a person may assert that he has taken steps to use the design in reliance upon the fact that the design registration had ceased. However, this argument is unlikely to succeed because regulation 29<sup>42</sup> (made pursuant to sub-section 27C(6)) provides for the protection or compensation of such persons in the form of a licence. The regulations also set out the procedure for applications for such protection or compensation separately from Part IV of the Regulations which deals with the procedure in relation to a sub-section 27B(3) notice of opposition.<sup>43</sup>

<sup>39</sup> *Supra* 98.

<sup>40</sup> Australia, *Report on the Law Relation to Designs op. cit.* para. 121.

<sup>41</sup> Sub-s. 27A(1).

<sup>42</sup> Designs Regulations (Statutory Rules 1982, No. 72).

<sup>43</sup> *Ibid.* reg. 27.

It is suggested that the only grounds of opposition which may be relied upon are either that the failure to apply for an extension was not unintentional or that undue delay occurred in making the application for an extension.<sup>44</sup>

It should be noted that under sub-section 27B(3) only 'a person interested' may give notice of opposition to the restoration.

Finally, a defendant in an action for the infringement of the monopoly in a registered design may counter-claim for the rectification of the register by the expunging of the entry.<sup>45</sup> Presumably like section 39, this encompasses the four possible grounds outlined above as bases for objection to registration.

It can be seen that a person who wishes to object to the registration of a design has a number of possible avenues of appeal. These avenues lack any overall coherence in relation to standing requirements or the grounds on which objection may be taken.

## CONCLUSION

This comment points to certain problems arising from the recent amendment of Australian designs law. These amendments were not implemented until some nine years after the Franki Committee<sup>46</sup> had provided the Commonwealth parliament with an exhaustive, careful report on designs law. Despite this, certain of the amendments bear the mark of hasty and careless drafting. The effects of this may be avoided only by the courts engaging in what will amount to judicial re-drafting of these amendments.

<sup>44</sup> See sub-s. 27B(2).

<sup>45</sup> S. 32.

<sup>46</sup> Australia, *Report on the Law Relating to Designs op. cit.*