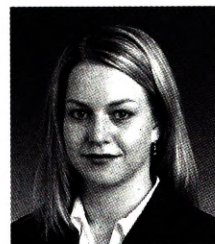
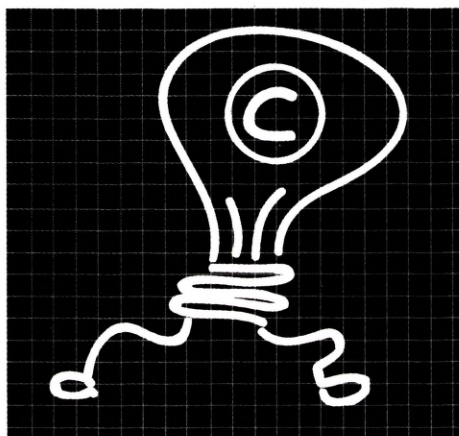


New Australian design laws



By Katrina Brigham, Solicitor, Corrs Chambers Westgarth



Australia will introduce a new registration system for industrial designs after the *Designs Act 2003* (Cth) (Act) received royal assent on 17 December 2003. The new legislation will commence six months after the date of royal assent (i.e. 17 June 2004) and will replace the existing registered design system by repealing the *Designs Act 1906* (Cth).

Specifically, the Act proposes to streamline the design registration system, enhance enforcement, adopt better dispute resolution procedures and clearer definitions, and introduce stricter infringement and eligibility tests.

The current designs registration system has been criticised for providing ineffective protection because registration is too easily obtained but it is difficult to prove that a registration has been infringed.

Key features of the new system are:

- a new definition of "design";
- a new higher threshold test for the registration of designs;

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Expert evidence

Part 15.5 sets out the new Rules in relation to expert evidence. The purpose of Part 15.5 is to restrict evidence to that which is necessary to determine/resolve the case, to save the extra time and money arising from multiple witnesses, and ensure that the witness is more impartial and less like a "hired gun".

There are therefore two types of experts under the new Rules:

- an expert appointed by a party; or

- a shift in the examination of a design's novelty from pre-registration to post registration;
- a broader threshold test for design infringement;
- the introduction of a defence against infringement for "right of repair"; and
- the reduction of the maximum period of design protection from 16 years to 10 years.

Definition of design

The new definition of a "design" under the Act gives greater clarification than the existing legislation. A design, under the Act, means the "overall appearance of the product resulting from one or more visual features of the product". Visual features includes shape, configuration, pattern or ornamentation of the product and may serve as a functional purpose. They do not include the feel of the product, the materials used in the product and the indefinite dimensions of the product.

Registrability of designs

Under the existing legislation, the threshold requirement for the registration of a design is that a design must be either "new or original". The Act introduces a new higher threshold test by requiring the design to be "new and distinctive" when compared with the prior art base for the design. A design will not be new if it is identical to another design. The test of whether a design is distinctive will be one of substantial similarity to overall impression to another design. The prior art base when comparing the newness and distinctiveness of a design has been expanded to incorporate designs published overseas.

Examination

The new legislation shifts the time at which the Registrar examines a design's novelty. Under the existing legislation a design's novelty was examined at the time of application.

- a single expert (agreed by the parties or appointed by the Court).

The "permission rule" prevents a party from calling their own expert witness unless the Court (i.e. the deputy registrar) authorises the use of an additional/adversarial expert.

All instructions to an expert witness must be in writing and questions about a report must also be in writing.

And the good news is . . .

The few areas that I have outlined above are the

The Act takes away this requirement and designs may only be examined after registration on the request of any person or on the registrar's initiative. Under the new system design applications will only be required to satisfy a formalities check prior to being registered and published.

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Infringement

The infringement test under the Act is much broader than under the existing legislation. A person will infringe a registered design if a product is identical to, or substantially similar in overall impression to a registered design.

Right of repair defence

A person will not infringe under the Act if the product is a component part of a complex product and the product is used for the purpose of repairing a complex product to restore the overall appearance in whole or part (such as spare parts). This "right of repair" exemption will allow the registration of component parts of a complex product but use of design registered parts for repair purposes will provide a complete defence against infringement.

Period of protection

The Act reduces the term of the registration of the design from 16 years under the existing legislation to 10 years. ■

"tip of the iceberg" in terms of the changes brought about by the new Rules.

As young lawyers, we've probably all heard the line "there can be no substitute for reading the Rules from cover to cover" on more than one occasion and most of us have probably cringed at the thought.

The good news in all of this is that, because the Rules are a complete rewrite, all practitioners (young or otherwise) will be on a level playing field for a while yet. And, if you need added incentive to read all 554 pages, I'll close with this thought: *you have to know the Rules to know how to break them!* ■