



Designs Act 2003

No. 147, 2003

An Act relating to designs, and for related purposes

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Designs Act 2003

No. 147, 2003

An Act relating to designs, and for related purposes

[Assented to 17 December 2003]

The Parliament of Australia enacts:

Chapter 1—Introductory

Part 1—Preliminary

1 Short title

This Act may be cited as the *Designs Act 2003*.

2 Commencement

- (1) Each provision of this Act specified in column 1 of the table commences, or is taken to have commenced, on the day or at the time specified in column 2 of the table.

Commencement information		
Column 1	Column 2	Column 3
Provision(s)	Commencement	Date/Details
1. Sections 1 and 2 and anything in this Act not elsewhere covered by this table	The day on which this Act receives the Royal Assent	17 December 2003
2. Sections 3 to 161	A single day to be fixed by Proclamation, subject to subsection (3)	17 June 2004

Note: This table relates only to the provisions of this Act as originally passed by the Parliament and assented to. It will not be expanded to deal with provisions inserted in this Act after assent.

- (2) Column 3 of the table is for additional information that is not part of this Act. This information may be included in any published version of this Act.
- (3) If a provision covered by item 2 of the table does not commence within the period of 6 months beginning on the day on which this Act receives the Royal Assent, it commences on the first day after the end of that period.

3 Crown to be bound

- (1) This Act binds the Crown in right of the Commonwealth, of each of the States, of the Australian Capital Territory, of the Northern Territory and of Norfolk Island.
- (2) Nothing in this Act makes the Crown liable to be prosecuted for an offence.

4 Application of the Act

This Act extends to:

- (a) each external Territory; and
- (b) the continental shelf; and
- (c) the waters above the continental shelf; and
- (d) the airspace above Australia, each external Territory and the continental shelf.

Part 2—Interpretation

5 Definitions

In this Act, unless the contrary intention appears:

Agency has the same meaning as in the *Public Service Act 1999*.

artistic work has the same meaning as in the *Copyright Act 1968*.

Australia includes each external Territory.

authority, in relation to the Commonwealth, a State or a Territory, means a body established for a public purpose by or under a law of the Commonwealth, State or Territory.

certificate of examination means a certificate of examination of a registered design issued under Chapter 5.

Commonwealth includes a Commonwealth authority.

complex product means a product comprising at least 2 replaceable component parts permitting disassembly and re-assembly of the product.

continental shelf means the continental shelf of Australia as defined in the *Seas and Submerged Lands Act 1973*.

Convention country means a country declared by the regulations to be a Convention country for the purposes of this Act.

corresponding design, in relation to an artistic work, has the same meaning as in Division 8 of Part III of the *Copyright Act 1968*.

Deputy Registrar means a Deputy Registrar appointed under section 123.

design, in relation to a product, means the overall appearance of the product resulting from one or more visual features of the product.

Note: See also section 8.

design application means an application filed under section 21.

Designs Office means the Designs Office established by section 125.

employee means a person, other than the Registrar or a Deputy Registrar, who:

- (a) is a person engaged under the *Public Service Act 1999* and is employed in the Designs Office; or
- (b) is not such a person but performs services, in the Designs Office, for or on behalf of the Commonwealth.

entitled person, in relation to a design, means a person entitled under section 13 to be entered in the Register as the registered owner of the design.

examination, in relation to a design, means examination of the design under section 65.

file means file with the Designs Office.

Note: Section 144 deals with filing.

filing date has the meaning given by section 26.

head, in relation to the Designs Office of a Convention country, means the official chief (however described) of that Office.

infringement proceedings means an action or proceedings for the infringement of a registered design.

initial application has the meaning given by section 23.

legal personal representative, in relation to a deceased person, means a person to whom:

- (a) probate of the will of the deceased person; or
- (b) letters of administration of the estate of the deceased person; or
- (c) other like grant;

has been granted, whether in Australia or elsewhere.

legal practitioner means a barrister or solicitor of the High Court of Australia or of the Supreme Court of a State or Territory.

Locarno Agreement means the Agreement establishing an International Classification for Industrial Design, signed at Locarno on 8 October 1968.

minimum filing requirements has the meaning given by section 21.

prescribed court means the following:

- (a) the Federal Court of Australia;
- (b) the Supreme Court of a State;
- (c) the Supreme Court of the Australian Capital Territory;
- (d) the Supreme Court of the Northern Territory;
- (e) the Supreme Court of Norfolk Island.

prior art base has the meaning given by section 15.

priority date, in relation to a design, means the priority date of the design under section 27.

product has the meaning given by section 6.

Register means the Register of Designs mentioned in section 111.

registered means registered under this Act.

registered design, at a particular time, means a design that is registered at that time.

registered owner has the meaning given by section 14.

registered patent attorney has the same meaning as in the *Patents Act 1990*.

registered trade marks attorney has the same meaning as in the *Trade Marks Act 1995*.

registrable design has the meaning given by section 15.

Registrar means the Registrar of Designs holding office under this Act.

relevant parties, in relation to the examination of a design under Chapter 5, means:

- (a) the registered owner of the design; and
- (b) the person who requested the examination; and
- (c) each person who is entered on the Register as having an interest in the design.

relevant proceedings, in relation to a registered design, means court proceedings:

- (a) for infringement of the registered design; or
- (b) for revocation of the registration of the design; or
- (c) in which the validity of the registration of the design is in dispute.

representation means a drawing, tracing or specimen of a product embodying a design or a photograph of such a drawing, tracing or specimen.

State includes a State authority.

term of registration has the meaning given by section 46.

Territory includes a Territory authority.

visual feature has the meaning given by section 7.

6 Definition of product

- (1) For the purposes of this Act, a thing that is manufactured or hand made is a product (but see subsections (2), (3) and (4)).
- (2) A component part of a complex product may be a product for the purposes of this Act, if it is made separately from the product.
- (3) A thing that has one or more indefinite dimensions is only a product for the purposes of this Act if any one or more of the following applies to the thing:
 - (a) a cross-section taken across any indefinite dimension is fixed or varies according to a regular pattern;
 - (b) all the dimensions remain in proportion;
 - (c) the cross-sectional shape remains the same throughout, whether or not the dimensions of that shape vary according to a ratio or series of ratios;
 - (d) it has a pattern or ornamentation that repeats itself.
- (4) A kit which, when assembled, is a particular product is taken to be that product.

7 Definition of visual feature

- (1) In this Act:

visual feature, in relation to a product, includes the shape, configuration, pattern and ornamentation of the product.
- (2) A visual feature may, but need not, serve a functional purpose.
- (3) The following are not visual features of a product:
 - (a) the feel of the product;
 - (b) the materials used in the product;
 - (c) in the case of a product that has one or more indefinite dimensions:
 - (i) the indefinite dimension; and

- (ii) if the product also has a pattern that repeats itself—more than one repeat of the pattern.

8 References in this Act to a design

In this Act, a reference to a design is a reference to a design in relation to a product

Chapter 2—Design rights, ownership and registrable designs

Part 1—Simplified outline of Chapter 2

9 Simplified outline

The following is a simplified outline of this Chapter:

This Chapter sets out matters relating to design rights.

Part 2 specifies the exclusive rights of the registered owners of a registered design.

Part 3 specifies:

- (a) who is entitled to be registered as the owner of an unregistered design; and
- (b) who is the registered owner of a registered design.

Part 4 defines the key concepts of *registrable design*, *newness*, *distinctiveness* and *substantial similarity*. These concepts are important because:

- (a) in examining a design under Chapter 5, the Registrar must decide whether it is new and distinctive when compared to the prior art base; and
- (b) in deciding whether a person has infringed a registered design under Chapter 6, a court must consider whether the allegedly infringing design is substantially similar in overall impression to the registered design.

Part 2—Design rights

10 Exclusive rights of registered owners

- (1) The registered owner of a registered design has the exclusive right, during the term of registration of the design:
 - (a) to make or offer to make a product, in relation to which the design is registered, which embodies the design; and
 - (b) to import such a product into Australia for sale, or for use for the purposes of any trade or business; and
 - (c) to sell, hire or otherwise dispose of, or offer to sell, hire or otherwise dispose of, such a product; and
 - (d) to use such a product in any way for the purposes of any trade or business; and
 - (e) to keep such a product for the purpose of doing any of the things mentioned in paragraph (c) or (d); and

- (f) to authorise another person to do any of the things mentioned in paragraph (a), (b), (c), (d) or (e).
- (2) The exclusive rights mentioned in subsection (1) are personal property and are capable of assignment and of devolution by will or by operation of law.
- (3) This section is subject to this Act.

11 Assignment of interest in a design

- (1) The registered owner of a registered design may assign all or part of the registered owner's interest in the design by writing.
- (2) An assignment under subsection (1) must be signed by, or on behalf of, the assignor and the assignee.
- (3) An assignment under subsection (1) may be for a particular place.

Note: Section 114 deals with amendments to the Register to record the assignment of an interest in a design.

12 Power of registered owner to deal with registered design

- (1) The registered owner of a registered design may, subject to any rights appearing in the Register to be vested in another person, deal with the registered owner's interest in the design as absolute owner of it, and give good discharges for any consideration for such dealing.
- (2) However, subsection (1) does not protect a person who deals with the registered owner of a registered design otherwise than as a purchaser in good faith for value and without notice of any fraud on the part of the registered owner.
- (3) Equities in relation to a registered design may be enforced against the registered owner, except to the prejudice of a purchaser in good faith for value.

Part 3—Ownership of designs

13 Who is entitled to be registered as the registered owner of a design

- (1) A person mentioned in any of the following paragraphs is entitled to be entered on the Register as the registered owner of a design that has not yet been registered:
 - (a) the person who created the design (the *designer*);
 - (b) if the designer created the design in the course of employment, or under a contract, with another person—the other person, unless the designer and the other person have agreed to the contrary;
 - (c) a person who derives title to the design from a person mentioned in paragraph (a) or (b), or by devolution by will or by operation of law;
 - (d) a person who would, on registration of the design, be entitled to have the exclusive rights in the design assigned to the person;
 - (e) the legal personal representative of a deceased person mentioned in paragraph (a), (b), (c) or (d).
- (2) Despite subsection (1), a person is not entitled to be entered on the Register as the registered owner of a design that has not yet been registered if:
 - (a) the person has assigned all of the person's rights in the design to another person; or

- (b) the person's rights in the design have devolved on another person by operation of law.
- (3) To avoid doubt:
 - (a) more than one person may be entitled to be entered on the Register as the registered owner of a design; and
 - (b) unless the contrary intention appears, a reference to the registered owner of a registered design in this Act is a reference to each of the registered owners of the design.
- (4) No person other than a person mentioned in paragraph (1)(a), (b), (c), (d) or (e) is entitled to be entered on the Register as the registered owner of a design that has not yet been registered.

14 Ownership of registered designs

- (1) The registered owner of a registered design at a particular time is:
 - (a) the person who, at that time, is entered in the Register as the registered owner of the design; or
 - (b) if, at that time, there are 2 or more such persons—each of them.
- (2) If there are 2 or more registered owners of a registered design:
 - (a) each of them is entitled to an equal, undivided share in the exclusive rights in that design; and
 - (b) subject to paragraph (c), each registered owner is entitled to exercise the exclusive rights in the design to the registered owner's own benefit without accounting to the others; and
 - (c) none of them can grant a licence to exercise the exclusive rights in the design, or assign an interest in the design, without the consent of the others.
- (3) If a product that embodies a registered design is sold by any of 2 or more registered owners of the design, the buyer, and a person claiming through the buyer, may deal with the product as if it had been sold by all the registered owners.
- (4) Subsection (2) is subject to any contrary agreement between the registered owners of a registered design.

Part 4—Registrable designs: Validity

Division 1—Registrable designs

15 Registrable designs

- (1) A design is a *registrable design* if the design is new and distinctive when compared with the prior art base for the design as it existed before the priority date of the design.
- (2) The *prior art base* for a design (the *designated design*) consists of:
 - (a) designs publicly used in Australia; and
 - (b) designs published in a document within or outside Australia; and
 - (c) designs in relation to which each of the following criteria is satisfied:
 - (i) the design is disclosed in a design application;
 - (ii) the design has an earlier priority date than the designated design;

- (iii) the first time documents disclosing the design are made available for public inspection under section 60 is on or after the priority date of the designated design.

Note: For *document*, see section 25 of the *Acts Interpretation Act 1901*.

16 Designs that are identical or substantially similar in overall impression

- (1) A design is new unless it is identical to a design that forms part of the prior art base for the design.
- (2) A design is distinctive unless it is substantially similar in overall impression to a design that forms part of the prior art base for the design (see section 19).
- (3) Subject to paragraph 15(2)(c), the newness or distinctiveness of a design is not affected by the mere publication or public use of the design in Australia on or after the priority date of the design, or by the registration of another design with the same or a later priority date.

17 Certain things to be disregarded in deciding whether a design is new and distinctive

- (1) For the purpose of deciding whether a design is new and distinctive, the person making the decision must disregard:
 - (a) any publication or use of the design, with the consent of the registered owner of the design, or the registered owner's predecessor in title, in circumstances prescribed by the regulations; and
 - (b) any publication or use of the design, without the consent of the registered owner of the design, by another person who derived or obtained the design from the registered owner of the design, or from the registered owner's predecessor in title; but only if a design application in respect of the design is made within the prescribed period.
- (2) For the purpose of deciding whether a design is new and distinctive, the person making the decision must disregard:
 - (a) any information given by, or with the consent of, the registered owner of the design, or the registered owner's predecessor in title, to any of the following, but to no other person or organisation:
 - (i) the Commonwealth, a State or a Territory;
 - (ii) a person authorised by the Commonwealth, a State or a Territory to investigate the design; and
 - (b) anything done for the purpose of an investigation mentioned in subparagraph (a)(ii).

18 Certain designs not to be treated as other than new and distinctive

- (1) This section applies if:
 - (a) copyright under the *Copyright Act 1968* subsists in an artistic work; and
 - (b) an application is made by, or with the consent of, the owner of that copyright for registration of a corresponding design.
- (2) The design is not to be treated, for the purposes of this Act, as being other than new and distinctive, or as having been published, by reason only of any use previously made of the artistic work, unless:

- (a) the previous use consisted of, or included, the sale, letting for hire or exposing for sale or hire of products to which the design had been applied industrially, other than products specified in regulations for the purposes of paragraph 43(1)(a); and
 - (b) the previous use was by, or with the consent of, the owner of the copyright in the artistic work.
- (3) In this section:

applied industrially has the meaning given by regulations under section 77 of the *Copyright Act 1968*.

Division 2—Substantial similarity in overall impression

19 Factors to be considered in assessing substantial similarity in overall impression

- (1) If a person is required by this Act to decide whether a design is substantially similar in overall impression to another design, the person making the decision is to give more weight to similarities between the designs than to differences between them.
- (2) The person must also:
 - (a) have regard to the state of development of the prior art base for the design; and
 - (b) if the design application in which the design was disclosed included a statement (a *statement of newness and distinctiveness*) identifying particular visual features of the design as new and distinctive:
 - (i) have particular regard to those features; and
 - (ii) if those features relate to only part of the design—have particular regard to that part of the design, but in the context of the design as a whole; and
 - (c) if only part of the design is substantially similar to another design, have regard to the amount, quality and importance of that part in the context of the design as a whole; and
 - (d) have regard to the freedom of the creator of the design to innovate.
- (3) If the design application in which the design was disclosed did not include a statement of newness and distinctiveness in respect of particular visual features of the design, the person must have regard to the appearance of the design as a whole.
- (4) In applying subsections (1), (2) and (3), the person must apply the standard of a person who is familiar with the product to which the design relates, or products similar to the product to which the design relates (the *standard of the informed user*).
- (5) In this section, a reference to a person includes a reference to a court.

Chapter 3—Design applications

Part 1—Simplified outline of Chapter 3

20 Simplified outline

The following is a simplified outline of this Chapter:

This Chapter sets out the rules relating to design applications.

Part 2 provides that a person may file a design application in relation to one or more designs.

If the design application meets the minimum filing requirements, the design application is allocated a filing date, and each design disclosed in it obtains a *priority date*.

Under Chapter 4, a person who has filed a design application may, within the prescribed period, request registration or publication of all or any of the designs disclosed in the application.

Part 3 deals with amendment and withdrawal of design applications.

Part 4 deals with the lapsing of design applications.

Part 2—Design applications

Division 1—Applications

21 Person may file a design application

- (1) A person may file an application (a *design application*) in respect of a design.
- (2) A design application must comply with:
 - (a) any requirements prescribed by the regulations in relation to representations of designs disclosed in the application; and
 - (b) any other requirements prescribed by the regulations.
 These are the *minimum filing requirements*.
- (3) A design application may be made by more than one person.
- (4) A design application must specify the entitled person or persons in relation to the designs disclosed in the design application.

22 A design application may be in respect of more than one design

- (1) A single design application may be in respect of:
 - (a) one design in relation to one product; or
 - (b) one design that is a common design in relation to more than one product; or
 - (c) more than one design in relation to one product; or
 - (d) more than one design in relation to more than one product, if each product belongs to the same Locarno Agreement class.

- (2) If more than one design is disclosed in a design application, the entitled person or persons must be the same in relation to each design.

Note: This means that a separate application must be made in respect of designs with a different entitled person or persons.

- (3) To avoid doubt, a design that is a common design in relation to more than one product is a design in relation to each product.

23 Design applications covering excluded designs

- (1) If:
- (a) one or more designs are disclosed in a design application (the *initial application*); and
 - (b) after the initial application is filed, it is amended under section 28 to exclude one or more of those designs (the *excluded designs*); and
 - (c) the initial application has not lapsed or been withdrawn; and
 - (d) none of the designs in the initial application has been registered, or published under section 57;

the applicant may file a design application under section 21 in respect of one or more of the excluded designs.

- (2) An application in respect of one or more excluded designs must be filed within the period prescribed by the regulations.
- (3) To avoid doubt, an application in respect of one or more excluded designs must not include a design that has been withdrawn under subsection 32(2) from the initial application or refused registration or publication.

Division 2—How Registrar must deal with a design application

24 Design applications that meet the minimum filing requirements

- (1) If a design application meets the minimum filing requirements mentioned in subsection 21(2), the Registrar must give a written notice to the applicant stating:
- (a) that the design application meets the minimum filing requirements; and
 - (b) the filing date of the application; and
 - (c) if the design application was not accompanied by a request for registration or publication of each design disclosed in the application—that such a request may be made under section 35.
- (2) If a purported design application does not meet the minimum filing requirements, the Registrar must give a written notice to that effect to the applicant.
- (3) A notice under subsection (1) or (2) must be given in accordance with the regulations.

25 Publication of receipt of application

The Registrar must publish, in the manner prescribed by the regulations, the details prescribed by the regulations in relation to each design application that meets the minimum filing requirements.

Division 3—Filing date and priority date

26 Filing date

A design application has the filing date determined in accordance with the regulations.

27 Priority date

- (1) The priority date of a design disclosed in a design application that meets the minimum filing requirements is:
 - (a) the filing date of the design application; or
 - (b) if, before the design application was filed, an application for protection in respect of the design had been made in a Convention country in accordance with the regulations—the date prescribed by the regulations; or
 - (c) if the regulations provide for a different date as the priority date—the date prescribed by the regulations.
- (2) If more than one design is disclosed in a design application, the designs may have different priority dates.

Part 3—Amendment or withdrawal of design applications

28 Amendment of design applications

- (1) The Registrar may amend a design application if requested to do so by the applicant.
- (2) A request under subsection (1) must be made in the manner prescribed by the regulations.
- (3) Despite subsection (1), the Registrar must not amend:
 - (a) any representations included in the design application; or
 - (b) any other documents accompanying the design application;
 in so far as they define a design disclosed in the design application, in such a way as to alter the scope of the application by the inclusion of matter which was not in substance disclosed in the original design application, representations or other documents.
- (4) In this section:

amend, in relation to a representation of a design disclosed in a design application, includes the substitution of one representation for another representation.
- (5) An appeal lies to the Federal Court against a decision of the Registrar under this section.

29 Disputes between applicants

- (1) This section applies if a dispute arises between 2 or more persons in relation to whether, or in what manner, a design application should proceed.
- (2) The Registrar may, on a request made in accordance with the regulations by any of the persons, make any determinations the Registrar thinks fit for either or both of the following purposes:
 - (a) enabling the application to specify which of those persons is an entitled person in relation to a design disclosed in the application;
 - (b) regulating the manner in which the application is to proceed.

- (3) A person mentioned in subsection (1) or (2) must be:
 - (a) the applicant; or
 - (b) a person who asserts that the person is an entitled person in relation to a design disclosed in the application.

30 Persons may ask for design application to proceed in the person's name

- (1) A person may ask the Registrar to direct that a design application specify the person as:
 - (a) an applicant; or
 - (b) an entitled person in relation to a design disclosed in the application.
- (2) The Registrar may give the direction if the person would, if the design were registered, be entitled under an assignment or agreement, or by operation of law, to:
 - (a) the registered design or an interest in it; or
 - (b) an undivided share in the registered design or in such an interest.
- (3) If the Registrar gives the direction:
 - (a) the person is taken to be an applicant or an entitled person in relation to the design, as the case requires; and
 - (b) the application is taken to be amended accordingly.
- (4) A request under subsection (1) must be in accordance with the regulations.

31 Publication of certain details of amended application

The Registrar must publish the details prescribed by the regulations in relation to a design application amended by the Registrar under this Part.

32 Withdrawal of designs and design applications

- (1) A person who has filed a design application may withdraw the application by written notice filed within the period prescribed by the regulations.
- (2) A person who has filed a design application in respect of more than one design may withdraw one or more of those designs from the application by written notice filed within the period prescribed by the regulations.
- (3) If the design application was filed by more than one person, the notice is not effective unless each of them consented to the giving of the notice.
- (4) If a design is withdrawn from a design application, the person or persons who withdrew the design may not subsequently request registration or publication of the design under Part 2 of Chapter 4 unless the person makes another application in respect of the design under section 21.

Part 4—Lapsing of design applications

33 Lapsing of design applications

- (1) A design application lapses if:
 - (a) a request to register or publish each design disclosed in the application has not been made, in accordance with Part 2 of Chapter 4, within the period prescribed by the regulations; or

- (b) the Registrar has given the applicant a notice under section 41 or 57 in respect of the application, and the applicant has not, within the period prescribed by the regulations:
 - (i) requested that the application be amended; or
 - (ii) responded in writing to the notice as mentioned in subparagraph 41(c)(ii) or 57(3)(c)(ii), as the case requires;
 in such a way that the Registrar is satisfied that the application meets the applicable requirements of Chapter 4.
- (2) If the Registrar has, under section 137, extended a period within which a thing mentioned in subsection (1) is to be done, a reference in subsection (1) to a period is a reference to the extended period.
- (3) For the purposes of paragraph (1)(a), *each design disclosed in the application* does not include the following:
 - (a) a design excluded from the application by an amendment under section 28;
 - (b) a design withdrawn from the application under subsection 32(2).
- (4) The Registrar must publish a notice stating that a design application has lapsed under subsection (1). The notice must be in the form prescribed by the regulations.

Chapter 4—Registration or publication of designs

Part 1—Simplified outline of Chapter 4

34 Simplified outline

The following is a simplified outline of this Chapter:

Part 2 permits an applicant to request registration or publication of all or any of the designs disclosed in a design application.

The Registrar must register or publish the designs under Part 3 or 4 if specified requirements are satisfied.

The Registrar must refuse to register certain designs (see section 43).

Registration of a design is for a maximum of 10 years (see Division 3 of Part 3).

The registration of a design may be revoked on grounds relating to entitled persons (see Division 4 of Part 3).

Registered designs and associated documents are open for public inspection (see Part 5).

Part 2—Requests for registration or publication

35 Request for registration or publication

- (1) An applicant may request registration or publication of one or more designs disclosed in a design application.
- (2) The request must be:
 - (a) included in the design application; or

- (b) made within the period prescribed by the regulations (but see sections 37 and 38).
- (3) The request must be in accordance with any requirements prescribed by the regulations.

36 Request for registration or publication—applications in respect of more than one design

- (1) If more than one design is disclosed in a design application, a request under section 35:
 - (a) may be in respect of one or more of those designs; and
 - (b) may be for registration of some of the designs and publication of others.
- (2) However, if an applicant makes a request in respect of only some of the designs disclosed in the design application, the following rules apply:
 - (a) the applicant may not subsequently make a request for registration of the designs in respect of which no request for registration was made, unless the Registrar determines, in accordance with the regulations, that the applicant may make such a request;
 - (b) the applicant may subsequently make a request for publication of the designs in respect of which no request was made.

37 Request in respect of designs excluded from an application in respect of more than one design

A design application in respect of designs excluded from an initial application must include a request for registration or publication of all the designs disclosed in the application.

38 Replacement of request for registration with request for publication

- (1) If an applicant has requested registration of a design under section 35, the applicant may replace the request for registration with a request for publication of the design by giving written notice to the Registrar.
- (2) The request is to be made within the period prescribed by the regulations.
- (3) However, an applicant may not replace a request for publication of a design with a request for registration of the design.

Part 3—Registration

Division 1—Formalities check

39 Formalities check—applications in respect of one design only

- (1) This section applies to a design disclosed in a design application if:
 - (a) the design is the only design disclosed in the application; and
 - (b) the applicant has requested that the design be registered.
- (2) The Registrar must register the design if the Registrar is satisfied that:
 - (a) the design application satisfies the formalities check specified in the regulations; and
 - (b) if the design is purportedly a common design in relation to more than one product—that the design is a common design in relation to each product; and
 - (c) the Registrar is not required to refuse to register the design under subsection 43(1).

40 Formalities check—applications in respect of more than one design

- (1) This section applies if:
 - (a) more than one design is disclosed in a design application; and
 - (b) the applicant has requested registration of one or more of those designs.
- (2) The Registrar must register a design requested to be registered if the Registrar is satisfied of the following:
 - (a) that each product to which the design relates belongs to the same Locarno Agreement class;
 - (b) if the design requested to be registered is purportedly a common design in relation to more than one product—that the design is a common design in relation to each product;
 - (c) that the design application satisfies the formalities check specified in the regulations;
 - (d) that the Registrar is not required to refuse to register the design under subsection 43(1).

41 Registrar must give applicants an opportunity to correct deficiencies

If the Registrar is not satisfied as mentioned in section 39 or 40 in relation to a design application, the Registrar must give a written notice to the applicant stating:

- (a) the matters in relation to which the Registrar is not satisfied; and
- (b) that the applicant may request that the Registrar amend the application under section 28; and
- (c) that the application will lapse at the end of the period prescribed by the regulations for the purposes of paragraph 33(1)(b) unless, during that period:
 - (i) the application is amended; or
 - (ii) the applicant responds in writing to the notice stating why the applicant considers that the application does not need to be amended;
 and as a result of the amendment or response, the Registrar is satisfied as mentioned in section 39 or 40, as the case requires.

42 What happens after Registrar gives notice under section 41

- (1) This section applies if the Registrar has given a written notice to an applicant under section 41.
- (2) If the applicant requests that the Registrar amend the application, the Registrar must consider the request under section 28.
- (3) If the applicant responds in writing to the notice as mentioned in subparagraph 41(c)(ii), the Registrar must consider the response.
- (4) If, after considering the request or response, the Registrar is satisfied as mentioned in section 39 or 40 in relation to the design application, the Registrar must register the design or designs disclosed in the application under whichever of those sections applies.
- (5) If, after considering the request or response, the Registrar is not satisfied as mentioned in section 39 or 40 in relation to the design application, the Registrar may either:
 - (a) refuse to register the design or designs under section 43; or
 - (b) give a further notice to the applicant under section 41.

43 Registrar must refuse to register certain designs

- (1) The Registrar must refuse to register a design if:
 - (a) the design is a design, or belongs to a class of designs, prescribed by the regulations for the purposes of this paragraph; or
 - (b) the Registrar must not register the design because of section 18 of the *Olympic Insignia Protection Act 1987*; or
 - (c) the design is in relation to a product that is:
 - (i) an integrated circuit within the meaning of the *Circuit Layouts Act 1989*; or
 - (ii) part of such an integrated circuit; or
 - (iii) a mask used to make such an integrated circuit; or
 - (d) the design is subject to an order under section 108.
- (2) Subject to section 42, the Registrar must refuse to register a design disclosed in a design application in respect of which the Registrar has given a notice under section 41, if the applicant has not:
 - (a) amended the application; or
 - (b) responded in writing to the notice stating why the applicant considers that the application does not need to be amended;
 in such a way that the Registrar is satisfied as mentioned in section 39 or 40 in relation to the design application.
- (3) The Registrar must notify the applicant in writing of a refusal under subsection (1) or (2). The notice must set out the reasons for the refusal.

44 Registrar must register certain designs after refusal

Despite paragraph 43(1)(d), if:

- (a) the Registrar refuses to register a design because the design is subject to an order under section 108; and
 - (b) the order is later revoked; and
 - (c) at the date of the revocation of the order, the design would, but for the operation of section 108, have been registered;
- the Registrar must register the design within the period prescribed by the regulations.

Division 2—Registration procedures

45 Registrar must notify applicant of registration and give public notice

- (1) This section applies if the Registrar is required to register a design under this Act.
- (2) The Registrar must enter in the Register the particulars mentioned in section 111, to the extent that they are applicable.
- (3) The Registrar must issue a certificate of registration to the applicant. The certificate must be in the form prescribed by the regulations.
- (4) The Registrar must publish a notice stating that the design has been registered. The notice must be in the form prescribed by the regulations.

Division 3—Term of registration

46 Term of registration

- (1) The term of registration of a design is:
 - (a) 5 years from the filing date of the design application in which the design was first disclosed; or
 - (b) if the registration of the design is renewed under section 47—10 years from the filing date of the design application in which the design was first disclosed.
- (2) If a design has been excluded from an initial application (see section 23), the design application in which the design was first disclosed is taken, for the purposes of subsection (1), to be the initial application.

47 Renewal of registration

- (1) The registered owner of a registered design may apply for renewal of the registration of the design.
- (2) The application must be made within the prescribed period after the filing date of the design application in which the design was first disclosed.
- (3) The Registrar must renew the registration of the design if the application is in the form prescribed by the regulations.

48 Ceasing of registration

- (1) The registration of a design ceases if an examination of the design has been requested and:
 - (a) within the period prescribed for the purposes of paragraph 65(3)(b), the Registrar is not satisfied as mentioned in paragraph 67(1)(a) or 68(1)(a); or
 - (b) the registered owner of the design has not paid the prescribed fee for the examination by the end of the period prescribed for payment.
- (2) The registration of a design also ceases at the end of the period mentioned in paragraph 46(1)(a) or (b), as the case requires.
- (3) If:
 - (a) a registered design was, at the time of registration, a corresponding design in relation to an artistic work in which copyright subsisted under the *Copyright Act 1968*; and
 - (b) the design would not have been registered under this Act apart from section 18; and
 - (c) the copyright in the artistic work under the *Copyright Act 1968* expires before the date on which registration of the design would (apart from this subsection) cease to be in force;
 the registration of the design ceases at the same time as the expiry of the copyright in the artistic work, and must not be extended after that time.
- (4) If the registration of a design ceases under subsection (1), any certificate of examination that was in force in respect of the design at the time the registration ceased is taken to be revoked at that time.

49 Surrender of registration

- (1) The registered owner of a registered design may offer to surrender the registration of the design.
- (2) If there is more than one registered owner of the design, an offer under subsection (1) must be made by all the registered owners.
- (3) An offer under subsection (1):
 - (a) may be made at any time; and
 - (b) must be in writing and filed; and
 - (c) must be made in a form prescribed by the regulations.

50 Revocation of registration on surrender

- (1) This section applies if the Registrar receives an offer to surrender the registration of a design under subsection 49(1).
- (2) The Registrar must:
 - (a) notify the persons prescribed by the regulations of the offer; and
 - (b) give such persons an opportunity to make submissions in the manner, and within the period, prescribed by the regulations.
- (3) The Registrar may accept the offer, revoke the registration of the design and make an entry in the Register under section 115 after doing the things mentioned in subsection (2).
- (4) If proceedings in a court have been brought and not completed in relation to the design, the Registrar must not accept the offer to surrender the registration of the design unless:
 - (a) the court consents; or
 - (b) all the parties to the proceedings consent.
- (5) If a compulsory licence is in force in relation to the design, the Registrar must not accept the offer to surrender the registration of the design.
- (6) An appeal lies to the Federal Court against a decision of the Registrar under this section.

Division 4—Revocation on grounds relating to entitled persons

51 Revocation of registration on grounds relating to entitled persons

- (1) A person may apply to the Registrar for revocation under section 52 of the registration of a design.
- (2) An application under subsection (1) must:
 - (a) contain the information prescribed by the regulations; and
 - (b) be made in the manner prescribed by the regulations.

52 Procedures in relation to application

- (1) This section applies if a person makes an application under section 51 for revocation of the registration of a design.
- (2) If the Registrar is satisfied that:
 - (a) a person or persons were entitled persons at the time the design was first registered, and one or more of the original registered owners of the design was not an entitled person at that time; or
 - (b) each original registered owner of the design was an entitled person at the time when the design was first registered, but another person or persons were also entitled persons at that time;

the Registrar may make a written declaration specifying that a person whom the Registrar is satisfied was an entitled person at the time the design was first registered is an entitled person under this subsection.
- (3) If the Registrar makes a declaration under subsection (2), the Registrar must:
 - (a) give the relevant parties a notice stating that the registration of the design is revoked; and
 - (b) make an entry in the Register under section 115.
- (4) The Registrar must also publish a notice, in the form prescribed by the regulations, stating that the registration of the design has been revoked and that the design is taken never to have been registered.
- (5) The Registrar must not revoke the registration of a design under this section unless the Registrar has given each original registered owner a reasonable opportunity to be heard.
- (6) The Registrar must not revoke the registration of a design under this section while relevant proceedings in relation to that design are pending.
- (7) An appeal lies to the Federal Court against a decision of the Registrar under this section.

53 Applications by persons declared to be entitled persons in court proceedings

- (1) This section applies if, in any proceedings in a court in relation to a design, the court is satisfied either:
 - (a) that a person or persons were entitled persons at the time the design was first registered, and one or more of the original registered owners of the design was not an entitled person at that time; or
 - (b) that each original registered owner of the design was an entitled person at the time the design was first registered, but that another person or persons were also entitled persons at that time.
- (2) In addition to any other order it may make in the proceedings, the court may declare that a person whom the court is satisfied was an entitled person at the time the design was first registered is an entitled person under this subsection.
- (3) The court may not make an order under subsection (2) unless the registration of the design has been revoked.

54 Applications by entitled persons after revocation following surrender of registration

- (1) This section applies if:
 - (a) the Registrar revokes the registration of a design under section 50; and
 - (b) the Registrar is satisfied on application by one or more persons in accordance with the regulations:
 - (i) that one or more of the original registered owners was not an entitled person at the time the design was first registered, and another person or persons were entitled persons at that time; or
 - (ii) that each original registered owner of the design was an entitled person at the time the design was first registered, but another person or persons were entitled persons at that time.
- (2) The Registrar may make a written declaration specifying that a person whom the Registrar is satisfied was an entitled person at the time the design was first registered is an entitled person under this subsection.
- (3) The Registrar must not make a declaration under subsection (2) without first giving each original registered owner a reasonable opportunity to be heard.
- (4) An appeal lies to the Federal Court against a decision of the Registrar to make, or refuse to make, a declaration under subsection (2).

55 Priority date of design if an application filed by a person declared to be an entitled person

One or more persons declared to be entitled persons in relation to a design under section 52, 53 or 54 may file an application in respect of the design under section 21, and if they do so, the design has the same priority date as it had in the application in which it was first disclosed.

56 Meaning of *original registered owner*

In this Division:

original registered owner, in relation to a design, means each person entered in the Register as the registered owner at the time the design was first registered.

Part 4—Publication

57 Publication of a design

- (1) This section applies to a design disclosed in a design application if the applicant has requested under section 35, 36, 37 or 38 that the design be published.
- (2) The Registrar must publish the design if the Registrar is satisfied that the documents provided with the design application satisfy any requirements in relation to publication that are prescribed by the regulations.
- (3) If the Registrar is not satisfied as mentioned in subsection (2), the Registrar must give a written notice to the applicant stating:
 - (a) the matters in relation to which the Registrar is not satisfied; and
 - (b) that the applicant may amend the design application under section 28; and
 - (c) that the application will lapse at the end of the period prescribed by the regulations for the purposes of paragraph 33(1)(b) unless, during that period:

- (i) the application is amended; or
 - (ii) the applicant responds in writing to the notice stating why the applicant considers that the application does not need to be amended;
- and as a result of the amendment or response, the Registrar is satisfied as mentioned in subsection (2).

58 What happens after Registrar gives notice under section 57

- (1) This section applies if the Registrar has given a written notice to an applicant under subsection 57(3).
- (2) If the applicant requests that the Registrar amend the application, the Registrar must consider the request under section 28.
- (3) If the applicant responds in writing to the notice as mentioned in subparagraph 57(3)(c)(ii), the Registrar must consider the response.
- (4) If, after considering the request or response, the Registrar is satisfied as mentioned in subsection 57(2), the Registrar must publish the design or designs under that subsection.
- (5) If, after considering the request or response, the Registrar is not satisfied as mentioned in subsection 57(2), the Registrar may either:
 - (a) refuse to publish the design under section 59; or
 - (b) give a further notice to the applicant under subsection 57(3).

59 Refusal to publish

- (1) Subject to section 58, the Registrar must refuse to publish a design if:
 - (a) the design is disclosed in a design application in respect of which the Registrar has given notice under subsection 57(3); and
 - (b) the applicant has not responded to the notice or amended the application in such a way that the Registrar is satisfied as mentioned in subsection 57(2).
- (2) The Registrar must notify the applicant in writing of a refusal under subsection (1). The notice must set out the reasons for the refusal.

Part 5—Certain documents to be available for public inspection

60 Design applications for registered designs and associated documents to be open for public inspection

- (1) After a design is registered or published, the Registrar must make the following documents available for public inspection:
 - (a) the design application in which the design was disclosed;
 - (b) any representations that were included in the design application;
 - (c) any statement of newness and distinctiveness in respect of the design that was included in the application;
 - (d) any document filed in relation to the design (whether before or after its registration or publication);
 - (e) any document sent by the Registrar to the applicant or the registered owner in connection with the design (whether before or after its registration or publication);
 - (f) any other document relating to the design application that is in, or comes into, the possession of the Designs Office;

- (g) any other document prescribed by the regulations.
- (2) Despite subsection (1), the following documents are not to be made available for public inspection:
- (a) a document that would be privileged from production in legal proceedings on the ground of legal professional privilege;
 - (b) a document that is subject to an order of a court or tribunal that prohibits disclosure of the document or information in the document;
 - (c) a document required to be produced under paragraph 127(1)(c), if the Registrar is satisfied that the document, or information in the document, should not be open for public inspection;
 - (d) a document that contains information obtained from a document to which any of paragraph (a), (b) or (c) applies.
- (3) If a document mentioned in subsection (1) has been amended, the document before and after amendment is to be made available for public inspection.
- (4) However, if:
- (a) more than one design was disclosed in the design application; and
 - (b) any of the following apply:
 - (i) the application was amended to exclude one or more of the designs;
 - (ii) one or more of the designs was withdrawn from the application;
 - (iii) one or more of the designs was neither registered nor published;
- the designs that were excluded or withdrawn, or that were not registered or published, and any documents, or parts of documents, mentioned under paragraphs 60(1)(b) to (g) relating exclusively to those designs, are not to be made available for public inspection under subsection (1).

61 Certain documents not to be published

- (1) Except as otherwise provided by this Act, documents of the kind mentioned in subsection 60(1), other than documents prescribed by the regulations for the purposes of paragraph 60(1)(g):
- (a) must not be published or be open to public inspection; and
 - (b) are not liable to be inspected or produced before the Registrar or in a legal proceeding unless the Registrar, court, or any person having power to order inspection or production, directs that the inspection or production be allowed.
- (2) Notice of an application for the production in legal proceedings of a document of the kind mentioned in subsection (1) must be given to the Registrar, who is entitled to be heard on the application.
- (3) Subsection (1) does not prevent documents of the kind mentioned in subsection 60(1) from being made available to an applicant for registration or publication of the design to which the documents relate.

Chapter 5—Examination of designs

Part 1—Simplified outline of Chapter 5

62 Simplified outline

The following is a simplified outline of this Chapter:

Chapter 5 deals with the examination of designs by the Registrar.

Designs may be examined after registration on the request of any person or on the Registrar's initiative.

In examining a design, the Registrar must consider whether there are grounds for revoking the registration of the design.

Part 2—Requests for examination

63 Examination of design

- (1) The Registrar must examine a design that has at any time been a registered design if any person requests, or a court orders, that the Registrar examine the design.
- (2) The Registrar may, on the Registrar's initiative and at any time, examine a design that has at any time been a registered design.
- (3) If relevant proceedings in relation to a design are pending in a court, the Registrar must not examine the design unless the court orders that the Registrar examine the design.
- (4) If:
 - (a) the Registrar has started to examine a design; and
 - (b) relevant proceedings in relation to the design are started;
 the Registrar must not continue to examine the design (including considering a request for amendments under section 66) unless a court orders that the Registrar continue to examine the design.
- (5) For the purposes of this section, the expression *a design that has at any time been a registered design*:
 - (a) does not include a design whose registration has ceased because of the operation of subsection 48(1); and
 - (b) does not include a design whose registration has been revoked, unless a declaration of the entitled persons has been made under section 52, 53 or 54 in relation to the design.

64 Requirements for request for examination of design

- (1) A request by a person that the Registrar examine a registered design must satisfy any requirements prescribed by the regulations.
- (2) The request may contain material in relation to the newness and distinctiveness of the design.

- (3) The Registrar must make available for public inspection material contained in a request under this section in relation to the newness and distinctiveness of the design to which the request relates.

Part 3—Examination

65 What Registrar must do in examining a design

- (1) If the Registrar receives a request to examine a registered design, or decides to examine a registered design, the Registrar must consider whether a ground for revocation under subsection (2) exists.
- (2) The following are grounds for revocation of the registration of a design for the purposes of this Part:
 - (a) the design is not a registrable design;
 - (b) any other ground prescribed by the regulations.
- (3) The examination must be:
 - (a) conducted in accordance with the procedures prescribed by the regulations; and
 - (b) completed within the period prescribed by the regulations.

66 Amendment of registration

- (1) This section applies if the Registrar is satisfied, in the course of examining a registered design, that a ground for revocation of the registration of the design has been made out.
- (2) The Registrar must give written notice to that effect to the registered owner of the design.
- (3) The registered owner of the design may request that the Registrar amend the Register in such a way that the ground for revocation is removed.
- (4) A request under subsection (3) must be made in the manner prescribed by the regulations.
- (5) The Registrar must consider and deal with the request in the manner prescribed by the regulations.
- (6) An amendment must not be such as to:
 - (a) increase the scope of the design registration; or
 - (b) alter the scope of the registration by the inclusion of matter that was not in substance disclosed in the original design application, representations or other documents.

67 Certificate of examination where registration valid

- (1) This section applies in relation to a registered design if:
 - (a) the Registrar has examined the design and is satisfied that a ground for revocation of the registration of the design has not been made out, or that any such ground would be removed if the Register were amended as proposed in a request made under section 66; and
 - (b) the registration of the design has not ceased under subsection 48(1).
- (2) The Registrar must give the relevant parties a notice stating:
 - (a) that the design has been examined; and

- (b) if the Registrar is satisfied that a ground of revocation could be removed if the Register were amended as proposed in a request made under section 66—the details of the proposed amendments; and
 - (c) that a certificate of examination is to be issued.
- (3) If the Registrar remains satisfied as mentioned in paragraph (1)(a) after giving the relevant parties a reasonable opportunity to be heard, the Registrar must:
- (a) issue a certificate of examination, in the form prescribed by the regulations, to the registered owner of the design; and
 - (b) record on the Register the issue of that certificate and, if applicable, such amendments proposed in a request made under section 66 that the Registrar is satisfied would remove a ground of revocation; and
 - (c) publish a notice, in the form prescribed by the regulations, stating:
 - (i) that an examination of the design has been completed; and
 - (ii) that infringement proceedings under Chapter 6 may be commenced.
- (4) An appeal lies to the Federal Court against a decision of the Registrar under this section.

68 Revocation of registration after examination

- (1) This section applies in relation to a registered design if:
- (a) the Registrar has examined the design, and is satisfied that a ground for revocation of the registration of the design has been made out and the ground would not be removed if the Register were amended as proposed in a request under section 66; and
 - (b) the registration of the design has not ceased under subsection 48(1).
- (2) The Registrar must:
- (a) give the relevant parties a notice stating that the registration of the design is revoked; and
 - (b) make an entry in the Register under section 115.
- (3) The Registrar must also publish a notice, in the form prescribed by the regulations, stating that the registration of the design has been revoked and that the design is taken never to have been registered.
- (4) The Registrar must not revoke the registration of a design under this section unless:
- (a) the Registrar has given the registered owner a reasonable opportunity to be heard; and
 - (b) if appropriate, the Registrar has given the registered owner a reasonable opportunity to amend the relevant registered design for the purpose of removing a ground for the revocation of the registration of the design and the registered owner has failed to do so.
- (5) The Registrar must not revoke the registration of a design under this section while relevant proceedings in relation to that design are pending.
- (6) An appeal lies to the Federal Court against a decision of the Registrar under this section.

Part 4—Material may be provided to Registrar

69 Certain material may be provided to Registrar

- (1) A person may provide to the Registrar material relating to whether a registered design is new or distinctive within the meaning of Division 1 of Part 4 of Chapter 2. The material may be provided even if the person has not made a request under subsection 63(1) that the design be examined.
- (2) The material is to be provided in accordance with the regulations.
- (3) If a person provides material to the Registrar under subsection (1), the Registrar must:
 - (a) inform the registered owner of the design that the material has been provided; and
 - (b) provide a copy of the material to the registered owner of the design; and
 - (c) retain the material throughout the period prescribed by the regulations.
- (4) Nothing in this section is to be taken to require the Registrar to examine a design under Part 3.
- (5) The Registrar must make a copy of material provided to the Registrar under subsection (1) available for public inspection.

Chapter 6—Infringement

Part 1—Simplified outline of Chapter 6

70 Simplified outline

The following is a simplified outline of this Chapter:

Chapter 6 is about infringement.

Part 2 provides that a person infringes a registered design if, without the appropriate authority, the person deals in certain ways with a product that embodies the design, or a design that is substantially similar to it.

Part 2 also provides that the registered owner of a design may bring infringement proceedings. The defendant may counter-claim for rectification of the Register.

Various remedies are available, including injunction, damages or an account of profits.

Part 3 deals with unjustified threats of infringement proceedings.

Part 2—Infringement of registered design

71 Infringement of design

- (1) A person infringes a registered design if, during the term of registration of the design, and without the licence or authority of the registered owner of the design, the person:
 - (a) makes or offers to make a product, in relation to which the design is registered, which embodies a design that is identical to, or substantially similar in overall impression to, the registered design; or

- (b) imports such a product into Australia for sale, or for use for the purposes of any trade or business; or
 - (c) sells, hires or otherwise disposes of, or offers to sell, hire or otherwise dispose of, such a product; or
 - (d) uses such a product in any way for the purposes of any trade or business; or
 - (e) keeps such a product for the purpose of doing any of the things mentioned in paragraph (c) or (d).
- (2) Despite subsection (1), a person does not infringe a registered design if:
- (a) the person imports a product, in relation to which the design is registered, which embodies a design that is identical to, or substantially similar in overall impression to, the registered design; and
 - (b) the product embodies the design with the licence or authority of the registered owner of the design.
- (3) In determining whether an allegedly infringing design is substantially similar in overall impression to the registered design, a court is to consider the factors specified in section 19.
- (4) Infringement proceedings must be started within 6 years from the day on which the alleged infringement occurred.

72 Certain repairs do not infringe registered design

- (1) Despite subsection 71(1), a person does not infringe a registered design if:
- (a) the person uses, or authorises another person to use, a product:
 - (i) in relation to which the design is registered; and
 - (ii) which embodies a design that is identical to, or substantially similar in overall impression to, the registered design; and
 - (b) the product is a component part of a complex product; and
 - (c) the use or authorisation is for the purpose of the repair of the complex product so as to restore its overall appearance in whole or part.
- (2) If:
- (a) a person uses or authorises another person to use a product:
 - (i) in relation to which a design is registered; and
 - (ii) which embodies a design that is identical to, or substantially similar in overall impression to, the registered design; and
 - (b) the person asserts in infringement proceedings that, because of the operation of subsection (1), the use or authorisation did not infringe the registered design;
- the registered owner of the design bears the burden of proving that the person knew, or ought reasonably to have known, that the use or authorisation was not for the purpose mentioned in paragraph (1)(c).
- (3) For the purposes of subsection (1):
- (a) a repair is taken to be so as to restore the overall appearance of a complex product in whole if the overall appearance of the complex product immediately after the repair is not materially different from its original overall appearance; and
 - (b) a repair is taken to be so as to restore the overall appearance of a complex product in part if any material difference between:
 - (i) the original overall appearance of the complex product; and

(ii) the overall appearance of the complex product immediately after the repair; is solely attributable to the fact that only part of the complex product has been repaired.

(4) In applying subsection (3), a court must apply the standard of the informed user.

(5) In this section:

repair, in relation to a complex product, includes the following:

- (a) restoring a decayed or damaged component part of the complex product to a good or sound condition;
- (b) replacing a decayed or damaged component part of the complex product with a component part in good or sound condition;
- (c) necessarily replacing incidental items when restoring or replacing a decayed or damaged component part of the complex product;
- (d) carrying out maintenance on the complex product.

standard of the informed user, in relation to the overall appearance of a complex product, means the standard of a person who is familiar with the complex product, or with products similar to that product.

use, in relation to a product, means:

- (a) to make or offer to make the product; or
- (b) to import the product into Australia for sale, or for use for the purposes of any trade or business; or
- (c) to sell, hire or otherwise dispose of, or offer to sell, hire or otherwise dispose of, the product; or
- (d) to use the product in any other way for the purposes of any trade or business; or
- (e) to keep the product for the purpose of doing any of the things mentioned in paragraph (c) or (d).

73 Infringement proceedings

- (1) The registered owner of a registered design may bring proceedings against another person alleging that the person has infringed the registered design.
- (2) Infringement proceedings may be brought in a prescribed court or in another court that has jurisdiction in relation to the proceedings.
- (3) However, infringement proceedings may not be brought under subsection (1) until:
 - (a) the design has been examined under Chapter 5; and
 - (b) a certificate of examination has been issued.
- (4) If a person files an application under section 21 for registration of a design as a result of the operation of section 55, the person may only bring infringement proceedings in respect of infringements of the design occurring after the date on which the application was filed under section 21.

74 Counter-claims

A defendant in infringement proceedings in respect of a registered design may apply, by way of counter-claim in the proceedings, for the revocation of the registration of the design under section 93.

75 Remedies for infringement

- (1) Without limiting the relief that a court may grant in infringement proceedings, the relief may include:
 - (a) an injunction subject to such terms as the court thinks fit; and
 - (b) at the option of the plaintiff—damages or an account of profits.
- (2) The court may refuse to award damages, reduce the damages that would otherwise be awarded, or refuse to make an order for an account of profits, if the defendant satisfies the court:
 - (a) in the case of primary infringement:
 - (i) that at the time of the infringement, the defendant was not aware that the design was registered; and
 - (ii) that before that time, the defendant had taken all reasonable steps to ascertain whether the design was registered; or
 - (b) in the case of secondary infringement—that at the time of the infringement, the defendant was not aware, and could not reasonably have been expected to be aware, that the design was registered.
- (3) The court may award such additional damages as it considers appropriate, having regard to the flagrancy of the infringement and all other relevant matters.
- (4) It is prima facie evidence that the defendant was aware that the design was registered if the product embodying the registered design to which the infringement proceedings relate, or the packaging of the product, is marked so as to indicate registration of the design.
- (5) In this section:

primary infringement means infringement of a kind mentioned in paragraph 71(1)(a).

secondary infringement means infringement of a kind mentioned in paragraph 71(1)(b), (c), (d) or (e).

76 Intervention by Registrar

A court may grant the Registrar leave to intervene in infringement proceedings.

Part 3—Relief from unjustified threats

77 Application for relief from unjustified threats

- (1) If a person is threatened by another person (the *respondent*) with infringement proceedings, or other similar proceedings, in respect of a design, an aggrieved person (the *applicant*) may apply to a prescribed court, or to another court that has jurisdiction to hear and determine the application, for:
 - (a) a declaration that the threats are unjustified; and
 - (b) an injunction against the continuation of the threats; and

- (c) the recovery of damages sustained by the applicant as a result of the threats.
- (2) A threat mentioned in subsection (1) may be by means of circulars, advertisements or otherwise.
- (3) If a certificate of examination has not been issued in respect of a design, a threat to bring infringement proceedings, or other similar proceedings, in respect of the design is an unjustified threat for the purposes of this section.

78 Court's power to grant relief

A court may grant the relief sought by an applicant under section 77, unless the respondent satisfies the court that:

- (a) the design concerned is registered, has been examined and a certificate of examination has been issued; and
- (b) the acts about which the threats were made infringe, or would infringe, the registered design.

79 Counter-claim

- (1) The respondent in proceedings under section 77 in respect of a design may apply, by way of counter-claim, for relief to which the respondent would be entitled in separate infringement proceedings against the applicant in respect of the design.
- (2) If the respondent applies under subsection (1) by way of counter-claim, the applicant may, without making a separate application under section 93, apply for revocation of the registration of the design.
- (3) The provisions of this Act relating to infringement proceedings apply, with the necessary modifications, to a counter-claim under subsection (1).
- (4) The provisions of this Act relating to proceedings for the revocation of the registration of a design apply, with the necessary modifications, to an application under subsection (2).

80 Mere notification of registration not a threat

The mere notification of the existence of a registered design does not constitute a threat of infringement proceedings for the purposes of section 77.

81 Legal practitioners, registered patent attorneys and registered trade marks attorneys

A legal practitioner, a registered patent attorney or a registered trade marks attorney is not liable to proceedings under section 77 in respect of an act done in a professional capacity on behalf of a client.

Chapter 7—Jurisdiction and powers of courts

Part 1—Simplified outline of Chapter 7

82 Simplified outline

The following is a simplified outline of this Chapter:

Chapter 7 deals with the jurisdiction of courts.

Under Part 2, the Federal Court is given jurisdiction in relation to matters arising under the Act. Other prescribed courts have jurisdiction if the Act so provides.

Part 3 deals with the capacity of a prescribed court to issue compulsory licences and to revoke the registration of a design in certain circumstances.

Part 4 also deals with the capacity of a prescribed court to revoke the registration of a design in certain other circumstances.

Part 2—Jurisdiction

83 Jurisdiction of Federal Court

- (1) The Federal Court has jurisdiction with respect to matters arising under this Act.
- (2) The jurisdiction of the Federal Court to hear and determine appeals from decisions of the Registrar is exclusive of the jurisdiction of any other court (other than the jurisdiction of the High Court under section 75 of the Constitution).
- (3) A prosecution for an offence against this Act must not be brought in the Federal Court.

84 Jurisdiction of other prescribed courts

- (1) Each prescribed court other than the Federal Court has jurisdiction in respect of matters arising under this Act in relation to which proceedings may be brought in a prescribed court.
- (2) The jurisdiction conferred by subsection (1) on the Supreme Court of a Territory is as follows:
 - (a) the jurisdiction is conferred to the extent that the Constitution permits so far as it relates to:
 - (i) infringement proceedings; or
 - (ii) an application for revocation of registration of a design because of section 74; and
 - (b) in any other case, the jurisdiction is conferred only in relation to proceedings instituted by:
 - (i) a natural person who is resident in the Territory at the time the proceedings are brought; or
 - (ii) a corporation that has its principal place of business in the Territory at the time the proceedings are brought.

85 Exercise of jurisdiction

The jurisdiction of a prescribed court under section 83 or 84 is to be exercised by a single judge.

86 Transfer of proceedings etc.

- (1) A court in which proceedings have been brought under this Act may transfer the proceedings to another prescribed court having jurisdiction to hear and determine the proceedings:
 - (a) if the court thinks fit; and
 - (b) upon application of a party made at any stage in the proceedings.
- (2) If proceedings are transferred from one court to another court under this section:
 - (a) all documents of record relevant to the proceedings are to be sent to the Registrar or other appropriate officer of the other court; and
 - (b) the other court must proceed as if:
 - (i) the proceedings had been started in that court; and
 - (ii) the same steps in the proceedings had been taken in that court as had been taken in the transferring court.

87 Appeals

- (1) An appeal lies to the Federal Court from a judgment or order of:
 - (a) another prescribed court exercising jurisdiction under this Act; or
 - (b) any other court in a proceeding referred to in section 73 or 77.
- (2) An appeal does not lie to the full court of the Federal Court from a judgment or order of a single judge of the Federal Court, in the exercise of its jurisdiction to hear and determine appeals from decisions of the Registrar, other than with the leave of the Federal Court.
- (3) An appeal lies to the High Court, with special leave of the High Court, from a judgment or order referred to in subsection (1).
- (4) No appeal lies from a judgment or order referred to in subsection (1), except as provided by this section.

88 Powers of Federal Court on hearing an appeal

On hearing an appeal against a decision or direction of the Registrar, the Federal Court may do any one or more of the following:

- (a) admit further evidence orally, or on affidavit or otherwise;
- (b) permit the examination and cross-examination of witnesses (including witnesses who gave evidence before the Registrar);
- (c) order an issue of fact to be tried as it directs;
- (d) affirm, reverse or vary the Registrar's decision or direction;
- (e) give any judgment, or make any order, that, in all the circumstances, it thinks fit;
- (f) order a party to pay costs to another party.

89 Registrar may appear in appeals

The Registrar may appear and be heard at the hearing of an appeal to the Federal Court against a decision or direction of the Registrar, even if the Registrar is not a party to the appeal.

Part 3—Compulsory licences and revocation of registration

90 Person may apply to court for compulsory licence

- (1) A person may apply to a prescribed court, after the end of the prescribed period, for an order requiring the registered owner of a registered design to grant the person a licence to do any of the things mentioned in paragraphs 10(1)(a) to (e) in relation to the design.
- (2) An application under subsection (1) may not be made unless a certificate of examination has been issued.
- (3) After hearing the application, the court may make such an order if it is satisfied that:
 - (a) products embodying the design have not been made in Australia, to the extent that is reasonable in the circumstances of the case; and
 - (b) the registered owner of the design has given no satisfactory reason for failing to exercise the exclusive rights in the design; and
 - (c) the applicant has tried for a reasonable period, but without success, to obtain from the registered owner of the design an authorisation to do, on reasonable terms and conditions, any of the things mentioned in paragraphs 10(1)(a) to (e) in relation to the design.

91 Terms of compulsory licence

- (1) This section applies if a court makes an order granting a licence under section 90.
- (2) The order must direct that the licence:
 - (a) does not give the licensee any exclusive rights in the design; and
 - (b) is to be assignable only in connection with an enterprise or goodwill in connection with which the licence is used;
 and may direct that the licence is to be granted on any other terms specified in the order.
- (3) The order operates, without prejudice to any other method of enforcement, as if it were embodied in a deed granting a licence and executed by the registered owner of the design and all other necessary parties.
- (4) The applicant is to pay the registered owner of the design:
 - (a) such amount as is agreed between the applicant and the registered owner of the design; or
 - (b) if paragraph (a) does not apply—such amount as is determined by a prescribed court to be just and reasonable having regard to the economic value of the licence.
- (5) The registered owner of the design or a prescribed court may revoke the licence if:
 - (a) the registered owner of the design and the licensee are agreed, or the court on application made by either party finds, that the circumstances that justified the grant of the licence have ceased to exist and are unlikely to recur; and
 - (b) the legitimate interests of the licensee are not likely to be adversely affected by the revocation.

92 Revocation of registration after grant of compulsory licence

- (1) If a licence is granted under section 90, an interested person may apply to a prescribed court, after the end of the prescribed period, for an order revoking the registration of the design.
- (2) After hearing the application, the court may make the order if it is satisfied that:
 - (a) the reasonable requirements of the public with respect to the design have not been satisfied; and
 - (b) the registered owner of the design has given no satisfactory reason for failing to exercise the exclusive rights in the design.

Part 4—Revocation of registration by court in other circumstances

93 Revocation of registration in other circumstances

- (1) A person may apply to a prescribed court for an order revoking the registration of a design.
- (2) An application under subsection (1) may be made only after the design has been examined under Chapter 5 and a certificate of examination has been issued.
- (3) The grounds on which a court may revoke the registration of the design are:
 - (a) that the design is not a registrable design; or
 - (b) that one or more of the original registered owners was not an entitled person in relation to the design when the design was first registered; or
 - (c) that each of the original registered owners was an entitled person in relation to the design when the design was first registered, but another person or persons were entitled persons in relation to the design at that time; or
 - (d) that the registration of the design was obtained by fraud, false suggestion or misrepresentation; or
 - (e) that the design is a corresponding design to an artistic work, and copyright in the artistic work has ceased.
- (4) In this section:

original registered owner, in relation to a design, means each person entered in the Register as the registered owner at the time the design was first registered.

Chapter 8—The Crown

Part 1—Simplified outline of Chapter 8

94 Simplified outline

The following is a simplified outline of this Chapter:

Part 2 permits the use of registered designs by the Commonwealth or a State.

Part 3 permits acquisition of registered designs by the Commonwealth.

Part 4 enables the Registrar to prohibit or restrict the publication of information about a design application, if to do so is necessary or expedient in the interests of the defence of the Commonwealth.

Part 2—Use by the Crown

95 Meaning of terms

- (1) In this Part, a reference to the use of a design, or of a product in relation to which a design is registered, which embodies the design, is a reference to the exercise of the exclusive rights in the design mentioned in paragraphs 10(1)(a) to (e).
- (2) In this Part:

State includes the following:

- (a) the Australian Capital Territory, the Northern Territory and Norfolk Island;
- (b) an authority of the Australian Capital Territory, the Northern Territory or Norfolk Island.

96 Use of design by the Commonwealth or a State

- (1) At any time after a design application disclosing a design has been filed or a design has been registered, the Commonwealth or a State, or a person authorised in writing by the Commonwealth or a State, may use the design for the services of the Commonwealth or State.
- (2) An authority under subsection (1):
 - (a) may be given either before or after the registration of the design; and
 - (b) may relate to, and authorise retrospectively, acts done after the filing of the application and before the giving of the authority; and
 - (c) may be given to a person even if that person is directly or indirectly authorised by the entitled person in relation to the design, or the registered owner of the design, as the case requires, to use the design.
- (3) Subject to section 105, a design is taken for the purposes of this Part to be used for the services of the Commonwealth or a State if the use of the design is necessary for the proper provision of those services within Australia.

97 Applicants, entitled persons and registered owners to be informed of use

- (1) As soon as practicable after the use of a design under section 96, the Commonwealth or a State must inform the following persons of that use:
 - (a) in the case of a design that has not yet been registered—each applicant for registration of the design and each entitled person in relation to the design;
 - (b) in the case of a registered design—the registered owner.
- (2) The Commonwealth or a State must also give to each person mentioned in paragraph (1)(a) or (b) such information about the use of the design as the person from time to time reasonably requires, unless it appears to the Commonwealth or State that it would be contrary to the public interest to do so.

98 Terms of use

- (1) The terms of use of a design:
 - (a) are as agreed on, whether before, during or after that use, between the Commonwealth or State and the entitled person in relation to the design or the registered owner of the design, as the case requires; or
 - (b) in absence of agreement, are as determined by a prescribed court.
- (2) A prescribed court may, in determining the terms of use, take into consideration compensation that a person interested in the design has received, directly or indirectly, from the Commonwealth or State in respect of the design.
- (3) A person may not apply to a prescribed court for a determination under subsection (1) in relation to a design unless a certificate of examination has been issued in relation to the design.

99 Previous agreements inoperative

- (1) This section applies to an agreement or licence (whether made or given before or after the commencement of this section) fixing the terms on which a person other than the Commonwealth or a State may use a design.
- (2) Such an agreement or licence is inoperative with respect to the use, after the commencement of this section, of the design under section 96, unless the agreement or licence has been approved by the Minister or by the Attorney-General of the State.

100 Infringement

Infringement proceedings do not lie in relation to the use of a design under section 96.

101 Declaration by court

- (1) The registered owner of a design who considers that the design has been used under section 96 may apply to a prescribed court for a declaration to that effect.
- (2) An application under subsection (1) may not be made by the registered owner unless a certificate of examination has been issued.
- (3) In a proceeding under subsection (1), the Commonwealth or the State concerned is the defendant and may, by way of counter-claim, apply for the revocation of the registration of the design under section 93.

102 Use of design to cease under court order

- (1) A prescribed court may, on the application of the registered owner, declare that the use of a registered design by the Commonwealth or State is not, or is no longer, necessary for the proper provision of services of the Commonwealth or State.
- (2) The court may make a declaration under subsection (1) if it is satisfied that in all the circumstances of the case, it is fair and reasonable to do so.
- (3) The court may further order that the Commonwealth or the State is to cease to use the design:
 - (a) on and from the day specified in the order; and
 - (b) subject to any conditions specified in the order.
- (4) In making an order under subsection (3), the court is to ensure that the legitimate interests of the Commonwealth or State are not adversely affected by the order.
- (5) A person may not apply to a prescribed court for a declaration under subsection (1) in relation to a design unless a certificate of examination has been issued in relation to the design.

103 Sale of products

If a product that embodies a design is sold during the use of the design under section 96, the buyer, and any person claiming through the buyer, is entitled to deal with the product as if the Commonwealth or the State were the registered owner of the design.

104 Forfeited products

Nothing in this Part affects the right of the Commonwealth or of a State, or of a person deriving title directly or indirectly from the Commonwealth or a State, to sell or use a product forfeited under a law of the Commonwealth or the State.

105 Supply of products by the Commonwealth to foreign countries

- (1) This section applies if:
 - (a) the Commonwealth has made an agreement with a foreign country to supply to the country a product in relation to which a design is registered, which embodies the design; and
 - (b) the product is required for the defence of the country.
- (2) The use of the product by the Commonwealth, or by a person authorised in writing by the Commonwealth, for the purposes of supplying the product is taken, for the purposes of this Part, to be a use of the product by the Commonwealth for the services of the Commonwealth.
- (3) The Commonwealth or the authorised person may:
 - (a) sell the product to the country under the agreement; and
 - (b) sell to any person any of the products that are not required for the purpose for which they were made.

Part 3—Acquisition by and assignments to the Crown

106 Acquisition of design by the Commonwealth

- (1) The Governor-General may direct that a design disclosed in a design application, or a registered design, be acquired by the Commonwealth.
- (2) When a direction is given, all rights in respect of the design are, by force of this section, transferred to and vested in the Commonwealth.
- (3) Notice of the acquisition must be published in the prescribed manner and given to the following:
 - (a) in the case of a design that has not yet been registered—each applicant for registration of the design and each entitled person in relation to the design;
 - (b) in the case of a registered design—the registered owner.
- (4) The Commonwealth must pay:
 - (a) each entitled person in relation to the design or the registered owner of the design, as the case requires; and
 - (b) all other persons appearing in the Register as having an interest in the design; such compensation as is agreed between the Commonwealth and those persons or, in the absence of agreement, as is determined by a prescribed court.
- (5) A person may not apply to a prescribed court for a determination under subsection (4) in relation to a design unless a certificate of examination has been issued in relation to the design.

107 Assignment of design to the Commonwealth

- (1) An entitled person in relation to a design or the registered owner of a design may assign to the Commonwealth the person's interest in the design and in the exclusive rights obtained, or to be obtained, in the design.
- (2) The assignment and all covenants and agreements contained in the assignment are:
 - (a) valid and effectual even if valuable consideration has not been given; and
 - (b) may be enforced by action or other appropriate proceeding in the name of the Minister.

Part 4—Prohibition orders

108 Prohibition of publication of information about designs

- (1) The Registrar may, if it appears to the Registrar to be necessary or expedient to do so in the interests of the defence of the Commonwealth, by written order, prohibit or restrict the publication of information about the subject matter of a design application.
- (2) The Registrar is subject to any directions by the Minister in making an order under subsection (1).
- (3) If an order is in force under subsection (1) in relation to an application, the application may be dealt with under this Act, but a design disclosed in the application must not be registered or published.
- (4) If:

- (a) an order under subsection (1) has been revoked; and
 - (b) at the date of the revocation of the order, the design would, but for the operation of subsection (3), have been registered or published;
- the design must be registered or published within the prescribed period.
- (5) Nothing in this Act prevents disclosing information about a design to an Agency or Commonwealth authority for the purpose of obtaining advice as to whether an order under this section should be made, amended or revoked.

109 Publication of information about designs

- (1) A person commits an offence if:
- (a) the person is subject to an order under subsection 108(1); and
 - (b) the person engages in conduct; and
 - (c) the person's conduct contravenes the order.

Maximum penalty: Imprisonment for 2 years.

- (2) Subsection (1) does not apply if the person has the Registrar's written consent.

Note: A defendant bears an evidentiary burden in relation to the matter in subsection (2) (see subsection 13.3(3) of the *Criminal Code*).

- (3) In this section, *engage in conduct* means:
- (a) to do an act; or
 - (b) omit to do an act.

Chapter 9—The Register

110 Simplified outline

The following is a simplified outline of this Chapter:

Chapter 9 deals with the Register of Designs.

The Chapter requires the Registrar to keep a Register and enter particular matters in it.

The Register is to be available for public inspection.

The Register can be amended in specified circumstances.

111 Registrar must keep Register

- (1) The Registrar must keep at the Designs Office a Register of Designs.
- (2) The following particulars must be entered in the Register in respect of a registered design:
- (a) the product or products in relation to which the design is registered;
 - (b) the name of each person who is entitled to be entered on the Register as the registered owner of the design;
 - (c) representations of the design;
 - (d) whether or not a certificate of examination has been issued in respect of the design;

- (e) any other particulars prescribed by the regulations.
- (3) All documents filed in connection with the registration of particulars mentioned in subsection (2) must be available for inspection at the Designs Office by any person during the hours when it is open for business.

112 Register may be kept by computer

- (1) The Register may be kept wholly or partly by use of a computer.
- (2) If the Register is kept wholly or partly by use of a computer:
 - (a) references in this Act to an entry in the Register include references to a record of particulars kept by use of the computer and comprising the Register or part of the Register; and
 - (b) references in this Act to particulars being registered, or entered in the Register, include references to the keeping of the record of those particulars as part of the Register by use of the computer; and
 - (c) references in this Act to the amendment, alteration or rectification of the Register include references to the amendment, alteration or rectification of the record of particulars kept by use of the computer and comprising the Register or part of the Register.

113 Inspection of Register

- (1) The Register is to be available for inspection at the Designs Office by any person at the times prescribed by the regulations.
- (2) If the Register is kept by use of a computer, subsection (1) is taken to be complied with by giving members of the public access to a computer terminal that they can use to inspect particulars that are kept by the use of a computer.

114 Amendments of Register to record changes of ownership

- (1) The registered owner of a registered design who assigns an interest in the design, or an assignee of an interest in a design, may ask the Registrar to record the assignment of the interest in the design.
- (2) A person who becomes the owner of a registered design by devolution by will or by operation of law may ask the Registrar to record the person's interest in the design.
- (3) If a request is made under subsection (1), the Registrar must:
 - (a) notify each other registered owner of the design of the request; and
 - (b) record the assignment;
 unless any of the other registered owners advises the Registrar, in writing and within the period prescribed by the regulations, that the other registered owner does not consent to the assignment.
- (4) A request under subsection (1) or (2) must be made in accordance with the regulations.

115 Amendments of Register made to give effect to certain decisions

If:

- (a) the Registrar decides to revoke the registration of a design under section 50, 52 or 68; or

(b) a court makes an order revoking the registration of a design;
the Registrar must make an entry in the Register stating that the registration of the design has been revoked and that the design is taken never to have been registered.

116 Reissue of certificates

After amending the Register, the Registrar must:

- (a) issue to the registered owner of the design a new certificate of registration; and
- (b) publish a notice in the manner prescribed by the regulations, specifying the amendments to the Register; and
- (c) if appropriate, publish the design.

117 Trusts not to be entered in Register

Notice of a trust, whether express, implied or constructive, must not be received by the Registrar or entered in the Register.

118 Evidentiary provision

- (1) The Register is prima facie evidence of any particulars entered in it.
- (2) If the Register is wholly or partly kept by use of a computer, a document issued by the Registrar producing in writing all or any of the particulars comprising the Register, or that part of it, as the case may be, is admissible in any proceedings as prima facie evidence of those particulars.
- (3) A signed copy of, or signed extract from, the Register is admissible in any proceedings as if it were the original.
- (4) In this section:

signed means signed by or on behalf of the Registrar.

119 Admissibility of unregistered interests

A document or instrument in respect of which an entry has not been made in the Register is not admissible in evidence in a court as proof of title to a design, or an interest in a design, except as follows:

- (a) in the case of an application under section 120;
- (b) if the court concerned directs that the document or instrument is admissible.

120 Rectification of Register

- (1) A person aggrieved by:
 - (a) the omission of an entry from the Register; or
 - (b) an entry wrongly made in the Register; or
 - (c) an error or defect in an entry in the Register; or
 - (d) an entry wrongly existing in the Register;
 may apply to a prescribed court for an order to rectify the Register.
- (2) On hearing an application under subsection (1), the court may:
 - (a) decide any question that it is necessary or expedient to decide in connection with the rectification of the Register; and

- (b) make an order it thinks fit for the rectification of the Register.
- (3) The Registrar must be given notice of an application made under subsection (1), and is entitled to appear and be heard in proceedings in relation to the application.
- (4) If the court makes an order under this section:
 - (a) the court must give a copy of the order to the Registrar; and
 - (b) the Registrar must give effect to the order.
- (5) A person may not apply to a prescribed court under subsection (1) for rectification of the Register in relation to a design unless a certificate of examination has been issued in relation to the design.

Chapter 10—Administration

121 Simplified outline

The following is a simplified outline of this Chapter:

Chapter 10 contains administrative provisions.

The offices of Registrar and Deputy Registrar of Designs are established by this Chapter.

The Designs Office is also established.

122 Registrar

- (1) There is to be a Registrar of Designs.
- (2) The Registrar has such powers and functions as are conferred by this Act or any other Act.

123 Deputy Registrars

- (1) There is to be at least one Deputy Registrar of Designs.
- (2) Subject to any direction by the Registrar, a Deputy Registrar has all the powers and functions of the Registrar under this Act or any other Act, except the Registrar's powers of delegation under section 124.
- (3) A power or function of the Registrar under this Act or any other Act, when exercised or performed by a Deputy Registrar, is to be taken for the purposes of this Act or any other Act to have been exercised or performed by the Registrar.
- (4) The exercise of a power, or function, of the Registrar under this Act or any other Act by a Deputy Registrar does not prevent the exercise of the power, or the performance of the function, by the Registrar.
- (5) If the exercise of a power or function by the Registrar, or the operation of a provision of this Act or any other Act, depends on the opinion, belief or state of mind of the Registrar in relation to a matter:
 - (a) that power or function may be exercised by a Deputy Registrar upon the opinion, belief or state of mind of the Deputy Registrar in relation to that matter; and

- (b) that provision may operate upon the opinion, belief or state of mind of a Deputy Registrar in relation to that matter.

124 Delegation by Registrar

- (1) The Registrar may, by written instrument signed by the Registrar, delegate all or any of the Registrar's powers or functions under this Act or any other Act to a prescribed employee, or a prescribed class of employees.
- (2) A delegate must, if so required by the instrument of delegation, exercise or perform a delegated power or function under the direction or supervision of the Registrar or an employee specified in the instrument.

125 Designs Office

- (1) There is to be a Designs Office.
- (2) There is to be a sub-office of the Designs Office in every State.

126 Seal of Designs Office

- (1) There is to be a seal of the Designs Office and impressions of the seal must be judicially noticed.
- (2) The seal of the Designs Office may be kept and used in electronic form.

127 Registrar's Powers

- (1) The Registrar may, for the purposes of this Act:
 - (a) summon witnesses; and
 - (b) receive written or oral evidence on oath or affirmation; and
 - (c) require the production of documents or articles; and
 - (d) award costs against a party to proceedings before him or her.
- (2) The Registrar may protect the confidential status of documents or articles produced in confidence under paragraph (1)(c).

128 Recovery of costs

Costs awarded by the Registrar against a party are recoverable as a debt.

Chapter 11—Miscellaneous

Part 1—Simplified outline of Chapter 11

129 Simplified outline

The following is a simplified outline of this Chapter:

Chapter 11 contains miscellaneous matters.

Part 2 deals with fees.

Part 3 contains offence provisions.

Part 4 sets out decisions that are reviewable by the Administrative Appeals Tribunal.

Part 5 gives the Registrar the power to extend the time within which specified things must be done.

Part 6 sets out regulation-making powers and other provisions dealing with miscellaneous matters.

Part 2—Fees

130 Fees

- (1) The regulations may prescribe the fees to be paid for the purposes of this Act or the regulations.
- (2) Without limiting subsection (1), the regulations may prescribe different fees, in respect of the doing of an act or the filing of a document, according to when the act is done or the document is filed.
- (3) The prescribed fees are payable in accordance with the regulations.
- (4) The regulations may provide for the consequences of failing to pay a fee in accordance with the regulations.
- (5) In particular, the regulations may provide that, for the purposes of this Act or the regulations:
 - (a) an act is not to be done, or is taken not to have been done, if the fee for doing the act is not paid in accordance with the regulations; or
 - (b) a document is not filed, or is taken not to have been filed, if the fee for filing the document is not paid in accordance with the regulations; or
 - (c) an application for registration of a design lapses, or is taken to have lapsed, if a fee relating to the application is not paid in accordance with the regulations.
- (6) Subsection (5) does not limit subsection (4).

Part 3—Offences

131 False entries in Register

- (1) A person commits an offence if:
- (a) the person makes an entry, or causes an entry to be made, in the Register; and
 - (b) the person knows, or is reckless as to whether, the entry is false.

Maximum penalty: Imprisonment for 12 months.

- (2) A person commits an offence if:
- (a) the person tenders a document in evidence; and
 - (b) the person knows that, or is reckless as to whether, the document falsely purports to be a copy of or extract from an entry in the Register.

Maximum penalty: Imprisonment for 12 months.

132 False representation that a design is registered

- (1) A person commits an offence if:
- (a) the person represents that a design is registered; and
 - (b) the person knows, or is reckless as to whether, the representation is false.

Maximum penalty: 60 penalty units.

- (2) A person commits an offence if the person:
- (a) represents that the person, or another person, is the registered owner of a registered design; and
 - (b) knows that the design is not registered, or is reckless as to whether the representation is false.

Maximum penalty: 60 penalty units.

- (3) A person commits an offence if:
- (a) the person sells a product which embodies a design; and
 - (b) the product has stamped, engraved, impressed upon or otherwise applied to it the words “registered in Australia”, “design registered in Australia”, or other words, expressing or implying that the design is registered; and
 - (c) the person knows the design is not registered, or is reckless as to whether the design is registered.

Maximum penalty: 60 penalty units.

- (4) Strict liability applies to paragraph (3)(b).

133 False representations about the Designs Office

- (1) A person commits an offence if:
- (a) the person:
 - (i) places, or allows to be placed, words on the building in which the person’s office or business is situated; or
 - (ii) uses words when advertising the person’s office or business; or

- (iii) places words on a document, as a description of the person's office or business; or
- (iv) otherwise uses words in connection with the person's office or business; and
- (b) the words are "Office for registering designs", or other words, that would lead a reasonable person to believe that the office or business is, or is officially connected with, the Designs Office; and
- (c) the person knows or is reckless as to whether the person's office or business is, or is connected with, the Designs Office.

Maximum penalty: 30 penalty units.

- (2) Strict liability applies to paragraph (1)(b).

134 Failure to comply with requirements of Registrar

- (1) A person commits an offence if:
 - (a) the person is subject to a requirement to:
 - (i) appear as a witness before the Registrar, having been offered reasonable expenses to appear; or
 - (ii) answer a question put by the Registrar; or
 - (iii) produce a document or article to the Registrar; or
 - (iv) be sworn or make an affirmation in proceedings before the Registrar; and
 - (b) the person engages in conduct; and
 - (c) the person knows or is reckless as to whether the person's conduct contravenes the requirement.

Maximum penalty: 30 penalty units.

- (2) Subsection (1) does not apply if the person has a lawful excuse.

Note: A defendant bears an evidential burden in relation to the matter in subsection (2) (see subsection 13.3(3) of the *Criminal Code*).

- (3) A person is excused from the requirements of paragraph (1)(a) if those requirements might tend to incriminate the person or expose the person to a penalty.

Note: A defendant bears an evidential burden in relation to the matter in subsection (3) (see subsection 13.3(3) of the *Criminal Code*).

- (4) In this section:

engage in conduct means:

- (a) do an act; or
- (b) omit to do an act.

135 Officers not to traffic etc. in designs

- (1) The Registrar, a Deputy Registrar or an employee commits an offence if he or she sells, acquires or traffics in:
 - (a) a registered design, whether granted in Australia or anywhere else; or
 - (b) a right to, or licence under, a registered design, whether granted in Australia or anywhere else.

Maximum penalty: 60 penalty units.

- (2) A purchase, sale, acquisition, assignment or transfer made or entered into in contravention of this section is void.
- (3) This section does not apply to the registered owner of the design or to an acquisition by devolution by will or by operation of law.

Note: A defendant bears an evidential burden in relation to the matter in subsection (3) (see subsection 13.3(3) of the *Criminal Code*).

Part 4—Review of the Registrar’s decisions

136 Review by Administrative Appeals Tribunal

- (1) A person may apply to the Administrative Appeals Tribunal for review of a decision of the Registrar:
 - (a) to refuse an application that does not meet the minimum filing requirements under subsection 24(2); or
 - (b) to make or refuse to make a determination under section 29; or
 - (c) to refuse an application under section 30 for a design application to proceed in the person’s name; or
 - (d) to refuse to register a design under section 43; or
 - (e) to refuse to publish a design under section 59; or
 - (f) to prohibit or restrict the publication of information about the subject matter of a design application under section 108; or
 - (g) to refuse an application under section 137 for an extension of time.
- (2) If a decision mentioned in subsection (1) is made and a written notice of the decision is given to a person whose interests are affected by the decision, the notice must include a statement to the effect that an application may be made to the Administrative Appeals Tribunal under the *Administrative Appeals Tribunal Act 1975* for review of the decision.
- (3) Failure to comply with subsection (2) in relation to a decision does not affect the validity of the decision.
- (4) In this section:

decision has the same meaning as in the *Administrative Appeals Tribunal Act 1975*.

Part 5—Extensions of time

137 Extensions of time

- (1) The Registrar must extend the time for doing a relevant act that is required to be done within a certain time if the act is not, or cannot be, done within that time because of an error or omission by:
 - (a) the Registrar or a Deputy Registrar; or
 - (b) a person employed in the Designs Office; or
 - (c) a person providing, or proposing to provide, services for the benefit of the Designs Office.
- (2) The Registrar may, on application by a person concerned in accordance with the regulations, extend the time for doing a relevant act if, because of:
 - (a) an error or omission by the person, or by the person’s agent; or
 - (b) circumstances beyond the control of the person;

the relevant act that is required to be done within a certain time is not, or cannot be, done within that time.

- (3) The time for doing a relevant act may be extended, whether before or after that time has expired.
- (4) The Registrar must advertise an application for an extension of time of more than 3 months in the manner prescribed by the regulations.
- (5) Subject to subsection (6), a person may, as prescribed, oppose the granting of the application.
- (6) If the Registrar is satisfied that an application under subsection (2) would not be granted, even in the absence of opposition under subsection (5):
 - (a) the Registrar need not advertise the application in accordance with subsection (4); and
 - (b) the application cannot be opposed; and
 - (c) the Registrar must refuse the application.
- (7) In this section:

relevant act means an action (other than a prescribed action) in relation to:

- (a) a registered design; or
- (b) an application for registration or publication of a design; or
- (c) any proceedings under this Act (other than court proceedings).

138 Consequences of extension

- (1) If:
 - (a) a design application lapses, or the registration of a design ceases to be in force because of a failure to do a relevant act (within the meaning of section 137); and
 - (b) the time for doing the act is extended;
 the application or registration must be treated as having been restored on the day on which the extension is granted.
- (2) If an application or registration is restored under subsection (1), the Registrar must:
 - (a) advise the applicant or registered owner that the application or registration has been restored; and
 - (b) publish a notice in the manner prescribed by the regulations that the application or registration has been restored.

139 Protection of third parties

- (1) This section applies if the registration of a design ceases to be in force because of a failure to do a relevant act (within the meaning of section 137) and is subsequently restored under section 138.
- (2) A person who took definite steps to use the design commercially after the registration of the design ceased to be in force but before the registration is restored may:
 - (a) continue to use the design after the registration is restored; or
 - (b) sell the right to use the design to another person.
- (3) However, the person must not grant a licence to another person to use the design.

- (4) A person who purchases a right under paragraph (2)(b) must not sell to another person the right to use the design or grant a licence to another person to use the design.
- (5) A person who continues to use a design because of paragraph (2)(a) or used the design after purchasing it as mentioned in subsection (4) does not infringe the registered design.

140 Infringement proceedings

Infringement proceedings cannot be brought in respect of an infringement committed:

- (a) between the day on which the registration of the design ceases to be in force and the day on which it is restored; or
- (b) between the day on which the design application lapses and the day on which it is restored.

Part 6—Other

141 Powers of agents

An agent may do any act in connection with the registration of designs, on behalf of any other person.

142 Right of lien of registered patent attorney and registered trade marks attorney

The regulations may provide that a registered patent attorney or a registered trade marks attorney has, in relation to documents and property of a client in a matter relating to designs, the same right of lien that a solicitor has in relation to the documents and property of a client.

143 Revocation of registration does not affect court decisions and things done under contracts before revocation

The revocation of the registration of a design does not affect the operation of a court decision made before the revocation, or things done under a contract before the revocation.

144 Filing of documents

A document may be filed:

- (a) by any means determined by the Registrar; or
- (b) by delivering the document to a sub-office of the Designs Office either personally or by post or by any other prescribed means.

145 Service of documents

Where this Act provides for a document to be served on, or given or sent to, a person and the person has given the Registrar an address in Australia for service of documents, the document may be served on, or given or sent to, the person by post to that address.

146 Death of applicant before application determined

If an applicant for registration or publication of a design dies before the application is determined, the person's legal representative may proceed with the application.

147 Death of person after design registered

- (1) This section applies if, at any time after a design is registered, the Registrar is satisfied that the registered owner had died (or, in the case of a body corporate, had ceased to exist) before the design was registered.
- (2) The Registrar may amend the Register by substituting for the name of the registered owner the name of the person who should have been entered in the Register as the registered owner.
- (3) An amendment by the Registrar under this section has effect, and is to be taken always to have had effect, accordingly.

148 Exercise of discretionary power by Registrar

The Registrar must not exercise a discretionary power under this Act adversely to a person without giving that person an opportunity to be heard.

149 Regulations

- (1) The Governor-General may make regulations prescribing matters:
 - (a) required or permitted to be prescribed; and
 - (b) necessary or convenient to be prescribed for carrying out or giving effect to this Act; and
 - (c) necessary or convenient for the conduct of any business relating to the Designs Office.
- (2) Without limiting subsection (1), that subsection includes the power to make regulations:
 - (a) requiring persons to give statutory declarations in relation to applications under the Act or regulations, or in relation to proceedings under the Act (other than court proceedings); and
 - (b) making provision for and in relation to the making of a declaration, or the doing of an act, under this Act on behalf of a person who, because of infancy or physical or mental disability, is unable to make the declaration or do the act; and
 - (c) providing for the refund, in the whole or part of a fee paid under the Act; and
 - (d) providing for the waiver, in whole or part, of a fee that would otherwise be payable under the Act; and
 - (e) making provision for and in relation to the amendment of an entry in the Register to correct a clerical error or an obvious mistake, or for any other purpose; and
 - (f) empowering the Registrar to require a person to inform the Registrar, within the period prescribed by the regulations, whether or not the person wishes to be heard for the purposes of a provision of the Act; and
 - (g) empowering the Registrar to require a person who wishes to be heard for the purposes of a provision of the Act to appear on a day, and at a place and time, specified by the Registrar; and
 - (h) providing for the contents of design applications in which one or more designs are disclosed, including, but not limited to, requirements as to common ownership of the designs; and
 - (i) empowering the Registrar to direct an applicant for registration or publication of a design to do such things as are necessary to ensure that the application is in accordance with the requirements of the regulations for filing and:

- (i) providing for the lapsing of the application if such a direction is not complied with within the period specified in the regulations; and
 - (ii) providing for the restoration of an application that has so lapsed; and
 - (j) providing for appeals against decisions of the Registrar made under the regulations; and
 - (k) making provision for and in relation to the practice and procedure of prescribed courts in proceedings under this Act, including provision prescribing the time within which any proceeding may be started or anything else may be done, and providing for the extension of any such time; and
 - (l) making transitional or consequential provisions as necessary or convenient because of the repeal of the *Designs Act 1906* and the enactment of this Act; and
 - (m) provide for regulations under the *Designs Act 1906* to continue to have effect (with any prescribed alterations) for specified purposes of this Act; and
 - (n) providing for things to be done for the purposes of this Act or the regulations by means of electronic equipment or communication; and
 - (o) empowering the Registrar to prepare, publish and sell such documents relating to designs as the Registrar thinks fit; and
 - (p) making provision for and in relation to the destruction of documents.
- (3) Despite the repeal of the *Designs Act 1906* by this Act, regulations made under paragraph (2)(1) may provide for the continued operation of specified provisions of the *Designs Act 1906* in relation to prescribed persons or matters, or in prescribed circumstances.

Chapter 12—Repeal, transitional and saving provisions

Part 1—Repeal of Designs Act 1906

150 Repeal

The *Designs Act 1906* is repealed.

Part 2—Transitional and saving provisions

151 Application of this Act to certain designs

- (1) This section applies to the following designs:
 - (a) a design registered under the old Act immediately before the commencing day;
 - (b) a design registered after the commencing day as a result of a design application to which the old Act continued to apply because of section 153.
- (2) The design:
 - (a) is taken to be registered under this Act:
 - (i) in the case of a design mentioned in paragraph (1)(a)—on and from the commencing day; and
 - (ii) in the case of a design mentioned in paragraph (1)(b)—on and from the day on which the design was registered; and
 - (b) is taken to have been examined by the Registrar under Part 3 of Chapter 5 and a certificate of examination is taken to have been issued under section 67.
- (3) However, despite subsection (2):

- (a) the old Act continues to apply for the purposes of determining the validity of the registration of the design; and
- (b) this Act does not apply for the purposes of determining the validity of the registration of the design; and
- (c) the design must not be examined under Chapter 5.

152 Term of registration of certain designs

Despite section 151:

- (a) the term of registration of a design to which that section applies ceases to be in force on the day on which it would have ceased to be in force under the old Act if the old Act had not been repealed; and
- (b) section 27A of the old Act continues to apply to the design as if the old Act had not been repealed.

153 Applications made before commencing day

- (1) The old Act continues to apply to an application made under the old Act before the commencing day as if the old Act had not been repealed, unless a conversion request is made under section 159 in respect of the application.
- (2) However, an application for an extension of time in relation to an application mentioned in subsection (1) must be made under section 137 of this Act.
- (3) If, after dealing with an application under the old Act, the Registrar is required to register the design to which the application relates, the Registrar must comply with section 45 of this Act in relation to the registration of the design.

154 Other applications and proceedings

- (1) This Act applies, on and after the commencing day, to any application, request, action or proceeding made or started under the old Act and not finally dealt with under that Act before that day as if the application, request, action or proceeding had been made or started under a corresponding provision of this Act.
- (2) Subsection (1) does not apply to:
 - (a) an application to which the old Act continues to apply under section 153; or
 - (b) a proceeding to which the old Act continues to apply under section 155.

Note: Section 152 deals with the application of section 27A of the old Act.

155 Pending proceedings

- (1) If proceedings arising from an application to a court under the old Act were pending immediately before the commencing day, the matter is to be decided as if the old Act had not been repealed.
- (2) However, any order made by a court in relation to rectification must relate to the Register under this Act.

156 Infringement under old Act

- (1) This section applies to the following designs:
 - (a) a design that was at any time registered under the old Act and had not been expunged from the Register under the old Act (whether or not the design is a design to which section 151 applies); and
 - (b) a design that was registered after the commencing day as a result of an application to which the old Act applied because of section 153.
- (2) If:
 - (a) either of the following applies:
 - (i) a person engages, before the commencing day, in conduct that infringed the monopoly in the design under the old Act;
 - (ii) a person engages, after the commencing day, in conduct that would have infringed the monopoly in the design under the old Act if that Act were still in force; and
 - (b) an action relating to that infringement was not pending immediately before the commencing day;

an action may be brought under this Act for infringement of the design.
- (3) However, in an action under subsection (2):
 - (a) the old Act continues to apply for the purposes of determining whether the person's conduct infringed the monopoly in the design; and
 - (b) this Act does not apply for the purposes of determining whether the person's conduct infringed the monopoly in the design; and
 - (c) a person is not entitled to any injunction or other relief to which the person would not have been entitled under the old Act.
- (4) Subsection (2) is subject to any law with respect to the time period within which an action of a kind mentioned in that subsection may be started.

157 Registrar and Deputy Registrar

A person who held office as the Registrar, or as a Deputy Registrar, under the old Act immediately before the commencing day continues to hold office as the Registrar or Deputy Registrar (as the case requires) under this Act on and after that day.

158 The Register

On and after the commencing day, the Register within the meaning of the old Act is taken to be the Register within the meaning of this Act.

159 Conversion of transitional applications

- (1) A person who has made a transitional application may request that the transitional application be treated as a converted application. This is a *conversion request*.
- (2) A conversion request must be:
 - (a) made before the end of the prescribed period; and
 - (b) in writing and filed; and
 - (c) made in accordance with any requirements prescribed by the regulations.

- (3) If a conversion request is made in respect of a transitional application, nothing that has been done under the old Act in relation to the application before the request was made is taken to constitute an examination under Chapter 5.
- (4) If a conversion request is made in respect of a transitional application, the application is taken to be a converted application from the date of the conversion request.

160 Effect of a converted application

- (1) A converted application is taken to be an application made under this Act, subject to the modifications set out in this section.
- (2) The filing date of a converted application is taken under section 26 of this Act to be the filing date of the transitional application.
- (3) The priority date of a design disclosed in a converted application is taken under section 27 of this Act to be the same priority date as it had under the transitional application.
- (4) A converted application is taken to meet the minimum filing requirements mentioned in subsection 21(2) of this Act.
- (5) A converted application is taken to include a request under section 35 of this Act for registration of each of the designs disclosed in the converted application.
- (6) The term of registration of a design disclosed in a converted application is taken under section 46 of this Act to start from the date of the conversion request under subsection 159(1).
- (7) An amendment requested under section 22B of the old Act in relation to a transitional application to which a converted application relates is taken to be an amendment requested under section 28 of this Act.
- (8) If:
 - (a) a converted application is amended under section 28 of this Act to exclude one or more of the designs disclosed in the converted application; and
 - (b) the applicant files a design application under section 23 of this Act in respect of one or more of the excluded designs;
 the term of registration of the excluded designs starts from the date of the conversion request under subsection 159(1).

160A Approvals under subsection 40A(6) of old Act

An approval that was in force under subsection 40A(6) of the old Act immediately before the commencing day has effect on and after that day as if it were an approval under subsection 99(2) of this Act.

161 Definitions

In this Chapter:

commencing day means the day on which this section commences.

old Act means the *Designs Act 1906*.

transitional application means an application for registration of a design that:

- (a) is made under the old Act before the commencing day; and
- (b) is not a lapsed application; and
- (c) is not in relation to a design that has been registered or refused registration.

[Minister's second reading speech made in—
House of Representatives on 11 December 2002
Senate on 4 December 2003]
(271/03)
