

**AUSTRALIA**

**Designs Regulations 2004**

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## **Chapter 1 Introductory**

### **1.01 Name of Regulations**

These Regulations are the *Designs Regulations 2004*.

### **1.02 Commencement**

These Regulations commence on the commencement of sections 3 to 161 of the Designs Act 2003.

### **1.03 *Designs Regulations 1982* -- repeal**

The following Statutory Rules are repealed:

1982 No. 72  
1984 No. 256  
1986 No. 263  
1988 No. 103  
1989 Nos. 95 and 313  
1990 Nos. 29, 239 and 240  
1991 Nos. 65 and 455  
1992 Nos. 149, 445 and 452  
1993 Nos. 114 and 342  
1994 Nos. 180 and 315  
1995 Nos. 19 and 426  
1996 No. 270  
1997 No. 344  
1998 Nos. 259, 344 and 347  
1999 No. 348  
2001 No. 97  
2002 No. 316  
2004 No. 22.

### **1.04 Interpretation**

(1) In these Regulations:

**Act** means the *Designs Act 2003*.

**approved form**, for a provision in which the expression appears, means a form approved by the Registrar for that provision.

**basic application** has the meaning given by subregulation 3.06(1).

**designer** has the same meaning as in paragraph 13(1)(a) of the Act.

**excluded design** has the same meaning as in section 23 of the Act.

**further design** means a design that is disclosed in a design application, but that has not been identified, by the applicant, as being a separate design disclosed in the application.

**initial application** has the same meaning as in section 23 of the Act.  
**Official Journal** means the *Official Journal of Designs* periodically published by the Registrar.

**old Act** means the *Designs Act 1906*.

**old Regulations** means the *Designs Regulations 1982*.

**transitional application** has the meaning given by subregulation 12.03(6).

(2) For these Regulations, a document is taken to be in the approved form if it contains all the information that the form requires.

(3) A reference in these Regulations to:

(a) the giving of a notice or other document to the Registrar; or

(b) the making of a request or an application to the Registrar;

includes a reference to the filing of the notice, document, request or application.

#### **1.05 Convention countries**

For the definition of **Convention country** in section 5 of the Act, each country mentioned in Schedule 1 is declared to be a Convention country for the purposes of the Act.

## Chapter 2 Design rights, ownership and registrable designs

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

(1) For paragraph 17(1)(a) of the Act, a prescribed circumstance is the publication or use of the design at:

(a) an official or officially recognised international exhibition within the meaning of:

(i) Article 11 of the Paris Convention for the Protection of Industrial Property done at Paris on 20 March 1883, as in force for Australia on the commencement of this subregulation; or

(ii) Article 1 of the Convention relating to International Exhibitions done at Paris on 22 November 1928, as in force for Australia on the commencement of this subregulation; or

(b) an international exhibition recognised by the Registrar by notice published in the *Official Journal* before the exhibition begins.

(2) The circumstance mentioned in subregulation (1) is a prescribed circumstance only if, at the time a design application is made in respect of the design:

(a) a notice, stating that the design has been exhibited, has been filed; and

(b) a document, issued by the authority responsible for the exhibition, that:

(i) identifies the design and the exhibition; and

(ii) states the date of opening of the exhibition; and

(iii) if the first publication or use of the design did not take place on that date -- states the date on which the first publication or use took place;

has been filed.

(3) For subsection 17(1) of the Act, the prescribed period is 6 months from the date on which the first publication or use of the design took place.

## **Chapter 3 Design applications**

### **Part 3.2 Applications**

#### **3.01 Minimum filing requirements**

For subsection 21(2) of the Act, each of the following requirements is prescribed:

- (a) the application must include information that indicates that what is filed is intended to be a design application;
- (b) the application must include information that:
  - (i) allows the identity of the applicant to be established; and
  - (ii) allows the applicant to be contacted;
- (c) the application must include a representation, or information that appears to be a representation, of each design.

#### **3.02 Applications covering excluded designs**

For subsection 23(2) of the Act, the prescribed period:

- (a) begins immediately after the Registrar has received the request to amend the initial application under section 28 of the Act to exclude the excluded design or designs; and
- (b) ends immediately before the earlier of:
  - (i) the lapse or withdrawal of the initial application; and
  - (ii) the registration, or publication under section 57 of the Act, of a design disclosed in the initial application.

#### **3.03 Notice -- minimum filing requirements**

(1) For subsection 24(3) of the Act, a notice under subsection 24(1) or (2) of the Act must be sent to:

- (a) if the applicant has given to the Registrar an address for service -- that address; or
- (b) in any other case -- any other contact address given by, or obtained from, the applicant.

(2) A notice under subsection 24(2) of the Act must:

- (a) identify each minimum filing requirement that has not been met; and
- (b) include a direction that the applicant file, within 2 months from the date of the notice, the additional information required.

(3) If the minimum filing requirements are not met within the period mentioned in paragraph (2)(b), the application is taken never to have been filed.

### **3.04 Publication of receipt of application**

(1) For section 25 of the Act, the details prescribed in relation to each design application that meets the minimum filing requirements are the following details for each design disclosed in the application:

- (a) the design number;
- (b) the name of the applicant or the entitled person;
- (c) the filing date of the application;
- (d) if applicable:
  - (i) details about any basic application made in respect of the design;
- and
  - (ii) the design number that was allocated to the excluded design in the initial application;
- (e) if stated in the application -- the product or products to which the design relates.

[Note: For a design application in respect of a design excluded from certain transitional applications, see also regulation 12.03.]

(2) The Registrar must publish the details in the *Official Journal*.

### **3.05 Filing date**

For section 26 of the Act, the filing date of a design application is the day when the application meets the minimum filing requirements.

[Note: For the filing date of a converted application, see section 160 of the Act.]

### **3.06 Priority date -- designs disclosed in basic applications**

(1) In this regulation:

**basic application**, in respect of a design, means an application for protection of the design, being an application that is made in a Convention country in accordance with these Regulations.

(2) For paragraph 27(1)(b) of the Act, if the design application is filed, within 6 months after the date on which the basic application was made, by:

- (a) the applicant in the basic application; or
- (b) the applicant's assignee; or
- (c) the legal personal representative of the applicant or of the applicant's assignee;

the prescribed date is the day when the basic application was made.

(3) If a copy of the basic application is not filed within 2 months after the Registrar has made a request (if any) for a copy, subregulation (2) is taken not to apply to the design.

[Note: Under regulation 11.18, a document that is not in English must be accompanied by a verified translation.]

(4) For paragraph 27(1)(b) of the Act, if subregulation (2) does not apply to the design, the prescribed date is the filing date of the design application.

(5) If 2 or more basic applications have been made in 1 or more Convention countries, a reference to the basic application in subregulation (2) is taken to be a reference to the earlier or earliest of those applications.

[Note: Certain applications are to be disregarded for the purpose of this regulation -- see regulation 3.07.]

(6) For subregulation (1), an application for protection in respect of a design is made in a Convention country:

(a) if:

(i) an application for protection in respect of the design has been made under the Hague Agreement Concerning the International Deposit of Industrial Designs, done at The Hague on 6 November 1925; and

(ii) the application sought protection in the Convention country; or

(b) if:

(i) an application for protection in respect of the design has been made under the Benelux Designs Convention, done at Brussels on 25 October 1966 (the **Benelux Convention**); and

(ii) the Convention country is a State (however described) that has consented to be bound by the Benelux Convention and for which the Benelux Convention is in force; or

(c) if:

(i) an application for protection in respect of the design has been made under the terms of the Treaty Establishing the European Community, done at Rome on 25 March 1957; and

(ii) the Convention country is a State (however described) that has consented to be bound by the Treaty and for which the Treaty is in force.

[Note: For the priority date of a converted application, see section 160 of the Act.]

### **3.07 Certain basic applications to be disregarded**

(1) This regulation applies if:

- (a) an application for protection in respect of a design has been made in a Convention country in accordance with these Regulations; and
- (b) the application has been withdrawn, abandoned or refused without becoming open to public inspection; and
- (c) the application has not been used as the basis for claiming a right of priority in a Convention country under the law of that country corresponding to regulation 3.06; and
- (d) a later application for protection in respect of the design has been made by the same applicant in the Convention country in which the earlier application was made.

(2) The applicant may request the Registrar to disregard the earlier application for the purpose of identifying the basic application referred to in subregulation 3.06(2).

(3) If the applicant makes a request under subregulation (2):

- (a) the Registrar must disregard the earlier application for that purpose; and
- (b) neither the applicant nor any other person is capable of making use of the earlier application for that purpose.

### **3.08 Priority date -- excluded designs**

For paragraph 27(1)(c) of the Act, the priority date of a design that is an excluded design is the same priority date as it had under the initial application.

[Note: This regulation also applies to a design excluded from certain transitional applications, see regulation 12.03.]

## **Part 3.3 Amendment or withdrawal of applications**

### **3.09 Request for amendment of application**

(1) For subsection 28(2) of the Act, the request must:

- (a) be in writing; and
- (b) be clear that an amendment of a design application is being requested; and

- (c) set out the nature and extent of the proposed amendments; and
- (d) be accompanied by:
  - (i) a substitute document or representation incorporating the proposed amendments; or
  - (ii) a statement setting out the proposed amendments and the place at which each amendment is proposed to be made.

(2) If the request is not accompanied by a substitute document or representation incorporating the proposed amendments, the applicant must, if directed by the Registrar, file a substitute document or representation within the time allowed by the Registrar.

### **3.10 Disputes between applicants -- requests for determinations**

For subsection 29(2) of the Act, a request must:

- (a) be made in the approved form; and
- (b) include a statement of the grounds on which the request is made.

### **3.11 Requests for direction specifying persons as applicants or entitled persons**

For subsection 30(4) of the Act, a request must:

- (a) be made in the approved form; and
- (b) include a statement of the grounds on which the request is made.

### **3.12 Publication of certain details of amended applications**

(1) This regulation applies in relation to a design application if, as a result of the design application having been amended under Part 3 of Chapter 3 of the Act, any of the details published under section 25 of the Act in relation to the application has changed.

(2) For section 31 of the Act, the details prescribed are the following details for each design in relation to which the published details has changed:

- (a) the design number;
- (b) for each detail that has changed -- the detail as amended.

### **3.13 Withdrawal of designs and design applications**

(1) For subsection 32(1) of the Act, the prescribed period:

- (a) begins immediately after the design application is filed; and
- (b) ends immediately before a design disclosed in the design application is registered or published.

(2) For subsection 32(2) of the Act, the prescribed period:  
(a) begins immediately after the design application is filed; and  
(b) ends immediately before the design to be withdrawn is registered or published.

(3) If a design is withdrawn, including a design disclosed in a design application that is withdrawn, the Registrar must publish the design number in the *Official Journal*.

### **Part 3.4 Lapsing of applications**

#### **3.14 Period within which application lapses**

(1) For paragraph 33(1) (a) of the Act, the prescribed period is:  
(a) if the design is an excluded design -- the period:  
(i) starting on the day when the request to exclude the design is filed; and  
(ii) ending on the day when the application is filed; or  
(b) if the design is a design mentioned in section 55 of the Act, and the period of 6 months from the priority date of the design has expired when an application is filed as mentioned in that section -- the day when the application is filed; or  
(c) in any other case -- 6 months from the priority date of the design.

[Note: Paragraph 3.14(1) (a) also applies to a design excluded from certain transitional applications, see regulation 12.03.]

(2) For paragraph 33(1) (b) of the Act, the prescribed period is 2 months from the later of:  
(a) the date of the first notice given by the Registrar under section 41 of the Act in relation to the design or designs in respect of which registration is requested; and  
(b) the date of the first notice given by the Registrar under section 57 of the Act in relation to the design or designs in respect of which publication is requested.

#### **3.15 Form of notice**

For subsection 33(4) of the Act, the notice must:

(a) be in the form of a notice published in the *Official Journal*; and  
(b) include the design number for each design disclosed in the application that has not been registered or published.

## **Chapter 4 Registration or publication of designs**

### **Part 4.2 Requests for registration or publication**

#### **4.01 Requests for registration or publication**

(1) This regulation does not apply to a request mentioned in section 37 or subsection 38(2) of the Act or in subregulation 12.03(2).

(2) For paragraph 35(2)(b) of the Act, the prescribed period is:

(a) 6 months from the priority date of the design; or

(b) if the design is a design mentioned in section 55 of the Act, and the period of 6 months has expired when an application is filed as mentioned in that section -- the day when the application is filed.

(3) For subsection 35(3) of the Act, the request must be made in the approved form.

#### **4.02 Subsequent requests for registration -- applications in respect of more than 1 design**

(1) For paragraph 36(2)(a) of the Act, the Registrar may determine that the applicant may make a request (a **subsequent request**) for registration of a design (an **other design**) in respect of which no request for registration was made in the original request only if:

(a) the applicant can satisfy the Registrar that it was only because of an error or omission by the applicant or the applicant's agent that a request was not made for registration of the other design; and

(b) the subsequent request is made before any design disclosed in the design application is registered or published.

(2) In this regulation:

**original request** means the first request made under section 35 of the Act in relation to the design application in which the other design is disclosed.

#### **4.03 Period within which replacements of request may be made**

For subsection 38(2) of the Act, the prescribed period:

(a) begins immediately after the request for registration of the design is made; and

(b) ends immediately before the design is registered.

## **Part 4.3 Registration**

### **4.04 Formalities check -- applications in respect of 1 design only**

(1) For paragraph 39(2) (a) of the Act, the formalities check is confirmation, by the Registrar, that:

- (a) the design application is in the approved form; and
- (b) the design application meets the requirements of regulation 11.18; and
- (c) the design application identifies the product or products in relation to which the design is sought to be registered sufficiently to enable each product to be classified in accordance with the Locarno Agreement; and
- (d) for a design application mentioned in subsection 23(2) of the Act -- the design application identifies the design number that was allocated to the excluded design in the initial application; and
- (e) if a specimen is filed as a representation of the design -- the specimen is of a kind that:
  - (i) can be readily mounted in a flat position by affixing it to a paper of the size required under paragraph 1(1) (e) of Schedule 2; and
  - (ii) can be stored without damage to other documents; and
  - (iii) when mounted, is presented in a way that allows any number of copies of the specimen to be reproduced directly by photocopying, digital scanning, microfilming and photography; and
- (f) the design application includes 5 copies of each representation of the design; and
- (g) the design application complies substantially with the formal requirements set out in Schedule 2.

[Note: For a design application in respect of a design excluded from certain transitional applications, see also regulation 12.03.]

(2) If the Registrar is not satisfied with the matter mentioned in paragraph (1) (e), the Registrar may, in giving a notice under section 41 of the Act, require the applicant to file another representation that complies with the paragraph.

### **4.05 Formalities check -- applications in respect of more than 1 design**

(1) For paragraph 40(2) (c) of the Act, the formalities check is confirmation, by the Registrar, that:

- (a) the design application is in the approved form; and
- (b) the design application meets the requirements of regulation 11.18;

and

(c) the design application identifies, for each design, the product or products in relation to which the design is sought to be registered sufficiently to enable each product to be classified in accordance with the Locarno Agreement; and

(d) for a design application mentioned in subsection 23(2) of the Act -- the design application identifies the design number that was allocated to the excluded design in the initial application; and

(e) if a specimen is filed as a representation of a design -- the specimen is of a kind that:

(i) can be readily mounted in a flat position by affixing it to a paper of the size required under paragraph 1(1)(e) of Schedule 2; and

(ii) can be stored without damage to other documents; and

(iii) when mounted, is presented in a way that allows any number of copies of the specimen to be reproduced directly by photocopying, digital scanning, microfilming and photography; and

(f) the design application includes 5 copies of each representation of each design disclosed in the application; and

(g) the number of designs disclosed in the design application is the number of designs identified, by the applicant, as being separate designs disclosed in application; and

(h) the design application complies substantially with the formal requirements set out in Schedule 2.

[Note: For a design application in respect of a design excluded from certain transitional applications, see also regulation 12.03.]

(2) If the applicant has requested registration of some, but not all, of the designs disclosed in the design application, the formalities check is confirmation, by the Registrar, that the matters specified in subregulation (1) are satisfied in relation to the part or parts of the application relating to the design or designs covered by the request.

(3) If the Registrar is not satisfied with the matter mentioned in paragraph (1)(e), the Registrar may, in giving a notice under section 41 of the Act, require the applicant to file another representation that complies with the paragraph.

#### **4.06 Registrar must refuse to register certain designs**

For paragraph 43(1)(a) of the Act, the following classes of designs are prescribed:

- (a) medals;
- (b) designs of a kind that the Registrar must, under subregulation 2(4) of the Protection of Word 'Anzac' Regulations, refuse to register;
- (c) designs of a kind mentioned in subsection 19(1) of the *Crimes (Currency) Act 1981*;
- (d) designs that are scandalous, or might reasonably be taken to be scandalous;
- (e) the Arms, or a flag or seal, of the Commonwealth or of a State or Territory;
- (f) the Arms or emblems of:
  - (i) a State or Territory; or
  - (ii) a city or town in the Commonwealth; or
  - (iii) a public authority or public institution in Australia;
- (g) the armorial bearings, flags, State emblems or other signs of another country.

#### **4.07 Period within which Registrar must register certain designs after refusal**

For section 44 of the Act, the prescribed period is 1 month from the date on which the Registrar was notified of the revocation of the order.

[Note: A similar arrangement is made in regulation 8.02.]

#### **4.08 Certificate of registration and notice of registration**

(1) For subsection 45(3) of the Act, the certificate must include the following details in relation to the design:

- (a) the registration number;
- (b) the filing date of the design application first disclosing the design;
- (c) the initial term of the registration;
- (d) the name and address of the registered owner;
- (e) the product or products to which the design relates;
- (f) the name of the designer;
- (g) if a statement of newness and distinctiveness has been provided to the Registrar -- that statement;
- (h) if applicable:
  - (i) details about any basic application made in respect of the design; and
  - (ii) the design number that was allocated to the excluded design in the initial application.

[Note 1: A **statement of newness and distinctiveness** is described in

paragraph 19(2)(b) of the Act.]

[Note 2: For a design application in respect of a design excluded from certain transitional applications, see also regulation 12.03.]

(2) For subsection 45(4) of the Act, the notice must:

(a) be in the form of a notice published in the *Official Journal*; and

(b) include the following details in relation to the design:

(i) the design number;

(ii) the registration number;

(iii) the date on which the design was registered;

(iv) the filing date of the design application first disclosing the design;

(v) if applicable:

(A) details about any basic application made in respect of the design;

and

(B) the design number that was allocated to the excluded design in the initial application;

(vi) the product or products to which the design relates;

(vii) the Locarno Agreement classification of the product or each product;

(viii) if a statement of newness and distinctiveness has been provided to the Registrar -- that statement;

(ix) the name and address of the registered owner;

(x) the name of the designer.

[Note: 1 A **statement of newness and distinctiveness** is described in paragraph 19(2)(b) of the Act.]

[Note 2: For a design application in respect of a design excluded from certain transitional applications, see also regulation 12.03.]

#### **4.09 Renewal of registration**

(1) For subsection 47(2) of the Act, the prescribed period is the period of 5 years and 6 months that begins at the start of the term of registration of the design.

[Note: If a renewal fee is paid after 5 years, it will attract the fee set out in paragraph (b) of column 3 of item 5 of Schedule 4.]

(2) For subsection 47(3) of the Act, the application must:

(a) be clear that renewal of the registration of the design is being requested; and

(b) include the registration number of the design; and

(c) be accompanied by the fee set out in item 5 of Schedule 4.

#### **4.10 Surrender of registration**

For paragraph 49(3)(c) of the Act, the offer must include:

- (a) a statement that an offer is made to surrender the registration of the design; and
- (b) the registration number of the design.

[Note: Under subsection 49(2) of the Act, if there is more than 1 registered owner, the offer must be made by all the registered owners.]

#### **4.11 Revocation of registration on surrender**

(1) For paragraph 50(2)(a) of the Act, each other person who is entered on the Register as having an interest in the design is prescribed.

(2) For paragraph 50(2)(b) of the Act, a person mentioned in subregulation (1) may make a submission:

- (a) in writing; and
- (b) within 1 month after the date of the notice under paragraph 50(2)(a) of the Act.

(3) The Registrar must also publish, in the *Official Journal*, a notice of the offer received under section 49 of the Act.

(4) If an interested person wishes to be heard in relation to the offer, he or she must, within 1 month after the date of publication of the notice mentioned in subregulation (3), give notice to the Registrar of his or her wish to be heard.

(5) The Registrar may, as a preliminary issue, hear and determine the question whether a person is an interested person.

(6) If an interested person gives notice to the Registrar under subregulation (4), the Registrar must give the person an opportunity to be heard before exercising his or her powers under subsection 50(3) of the Act.

#### **4.12 Revocation of registration on grounds relating to entitled persons**

For subsection 51(2) of the Act, the application must:

- (a) be made in the approved form; and
- (b) include a statement of the grounds on which the application is made.

#### **4.13 Notice of revocation of registration**

For subsection 52(4) of the Act, the notice must:

- (a) be in the form of a notice published in the *Official Journal*; and
- (b) include the registration number of the design.

#### **4.14 Applications by entitled persons after revocation following surrender of registration**

For paragraph 54(1) (b) of the Act, an application must be in writing.

### **Part 4.4 Publication**

#### **4.15 Publication of a design**

(1) For subsection 57(2) of the Act, the documents:

- (a) must include the applicant's name and the designer's name; and
- (b) must meet the requirements of regulation 11.18; and
- (c) must comply substantially with the formal requirements set out in Schedule 2; and
- (d) must not disclose a design that would have been refused registration under paragraph 43(1) (b), (c) or (d) of the Act; and
- (e) must not disclose a design that is of a class prescribed in paragraph 4.06(b), (c) or (d).

(2) If the design application is in respect of more than 1 design, the requirements specified in subregulation (1) are to be satisfied in relation to the part or parts of the application relating to the design or designs covered by the request.

## **Chapter 5 Examination of designs**

### **5.01 Requirements for request for examination of design**

For subsection 64(1) of the Act, the following requirements are prescribed:

- (a) the request must be made in the approved form;
- (b) if the request is made by a person other than the registered owner, and contains any material in relation to the newness and distinctiveness of the design -- the material must be provided in duplicate.

### **5.02 Grounds for revocation of registration of design**

For paragraph 65(2)(b) of the Act, a prescribed ground is that, under section 43 of the Act, the design should not have been registered.

### **5.03 Examination of design -- procedures**

(1) For paragraph 65(3)(a) of the Act, the procedures set out in this regulation are prescribed for the conduct of an examination of a design.

(2) If, after considering under subsection 65(1) of the Act whether a ground for revocation under subsection 65(2) of the Act exists, the Registrar is satisfied that a ground for revocation has been made out, the Registrar must give notice to the registered owner as required under subsection 66(2) of the Act.

[Note: See section 67 of the Act for what is to happen if the Registrar is satisfied that a ground for revocation has not been made out.]

(3) A registered owner may respond to a notice given under subsection 66(2) of the Act (including a further notice mentioned in subregulation (6)) by:

- (a) contesting, in writing, the ground for revocation; or
- (b) requesting amendment of the Register as provided under subsection 66(3) of the Act.

(4) If the registered owner responds by contesting the ground in writing, the Registrar must reconsider whether a ground for revocation under subsection 65(2) of the Act exists, taking into account the written submissions made by the registered owner.

(5) If the registered owner responds by requesting amendment of the Register, the Registrar must consider whether the ground for revocation would be removed if the Register were amended as proposed in the request.

(6) If:

(a) after the reconsideration mentioned in subregulation (4), the Registrar remains satisfied that a ground for revocation has been made out; or  
(b) after the consideration mentioned in subregulation (5), the Registrar is satisfied that the ground would not be removed if the Register were amended as proposed;

the Registrar must:

(c) give a further notice to the registered owner under subsection 66(2) of the Act; or

(d) give the registered owner a reasonable opportunity to be heard under paragraph 68(4)(a) of the Act.

(7) A further notice mentioned in subregulation (6) must, in addition to stating that a ground for revocation has been made out, include a statement to the following effect:

(a) if the registered owner has contested the ground in writing -- that the Registrar has taken into account the written submissions made by the registered owner;

(b) if the registered owner has requested amendment of the Register -- that the ground would not be removed if the Register were amended as proposed.

[Note: See section 67 of the Act for what is to happen if the Registrar is satisfied that a ground for revocation has not been made out or that any such ground would be removed if the Register were amended as proposed.]

(8) If the request for examination was made by a person other than the registered owner, the Registrar must send a copy of the notice given under subsection 66(2) of the Act (including a further notice mentioned in subregulation (6)) to the person who requested the examination.

[Note: See section 68 of the Act for what is to happen if the Registrar remains satisfied that a ground for revocation has been made out and the ground would not be removed if the Register were amended as proposed.]

#### **5.04 Period in which examination of a design must be completed**

For paragraph 65(3)(b) of the Act, the prescribed period is worked out as follows:

(a) if a notice is given under subsection 66(2) of the Act in relation to the examination, the prescribed period is 6 months after the date of the first notice;

(b) if:

- (i) a person provides material under section 69 of the Act; and
- (ii) the Registrar gives the registered owner written notice under subsection 66(2) of the Act of a ground of revocation, based on that material; the prescribed period is whichever of the following periods ends later:
  - (iii) 6 months after the date of the first notice under subsection 66(2) of the Act in relation to the examination;
  - (iv) 3 months after the date of the notice under subsection 66(2) of the Act that first raises the ground of revocation;

(c) if:

- (i) the Registrar discontinues the examination of the design in accordance with subsection 63(4) of the Act; or
  - (ii) if a hearing described in section 67 or 68 of the Act is requested; or
  - (iii) if an appeal is made to the Federal Court against a decision of the Registrar under section 67 or 68 of the Act;
- the prescribed period is the period determined by the Registrar to allow the examination to be completed.

#### **5.05 Amendment of registration**

(1) For subsection 66(4) of the Act:

- (a) the request must be in writing; and
- (b) the request must make it clear that an amendment of the Register is being requested; and
- (c) the request must set out the nature and extent of the proposed amendments; and
- (d) the request must be accompanied by:
  - (i) a substitute document or representation incorporating the proposed amendments; or
  - (ii) a statement setting out the proposed amendments and the place at which each amendment is proposed to be made; and
- (e) if:
  - (i) the request is not accompanied by a substitute document or representation incorporating the proposed amendments; and
  - (ii) the Registrar directs the registered owner under paragraph (2) (b) to file a substitute document;the substitute document must have been filed in accordance with the direction.

(2) For subsection 66(5) of the Act:

- (a) the Registrar must notify the registered owner if:

- (i) the request does not meet the requirements mentioned in subregulation (1); or
  - (ii) the proposed amendment is of a kind prohibited under subsection 66(6) of the Act; and
- (b) if the request is not accompanied by a substitute document or representation incorporating the proposed amendments, the Registrar may direct the registered owner to file a substitute document or representation within the time allowed by the Registrar.

#### **5.06 Certificate of examination and notice of examination**

- (1) For paragraph 67(3)(a) of the Act, the certificate must include:
- (a) the registration number of the design; and
  - (b) the date of certification.
- (2) For paragraph 67(3)(c) of the Act, the notice must:
- (a) be in the form of a notice published in the *Official Journal*; and
  - (b) include the following details in relation to the design:
    - (i) the registration number;
    - (ii) the date of certification.
- (3) In this regulation:
- date of certification** means the date on which the Registrar is satisfied that a certificate of examination is to be issued under subsection 67(3) of the Act in respect of the design.

#### **5.07 Revocation of registration after examination**

- For subsection 68(3) of the Act, the notice must:
- (a) be in the form of a notice published in the *Official Journal*; and
  - (b) include the following details in relation to the design:
    - (i) the registration number;
    - (ii) the date on which the design was revoked.

#### **5.08 Material provided to Registrar**

- (1) For subsection 69(2) of the Act, the material must:
- (a) be provided in duplicate; and
  - (b) be accompanied by the approved form; and
  - (c) be accompanied by evidence of the publication of the material.

[Note: Under regulation 11.18, a document that is not in English must be accompanied by a verified translation.]

- (2) For paragraph 69(3)(c) of the Act, the prescribed period:
- (a) begins immediately after the material is provided to the Registrar;
- and
- (b) ends at the end of 6 years after the term of registration of the design.

## **Chapter 7 Jurisdiction and powers of courts**

### **7.01 Application to court for compulsory licence**

For subsection 90(1) of the Act, the prescribed period is 3 years from the date of registration of the design.

### **7.02 Revocation of registration after grant of compulsory licence**

For subsection 92(1) of the Act, the prescribed period is 2 years from the date on which the licence, or the first licence (if more than 1), was granted under section 90 of the Act in relation to the design.

## **Chapter 8 The Crown**

### **8.01 Acquisition of design by the Commonwealth**

For subsection 106(3) of the Act, notice of the acquisition must be published:

- (a) in the *Official Journal*; and
- (b) in the *Gazette*.

[Note: The *Commonwealth of Australia Gazette* is available in hard copy and online.]

### **8.02 Period within which designs must be registered or published after prohibition**

For subsection 108(4) of the Act, the prescribed period is 1 month from the date on which the Registrar was made aware of the revocation of the order.

[Note: A similar arrangement is made in regulation 4.07.]

## **Chapter 9 The Register**

### **9.01 Other particulars to be entered in the Register**

For paragraph 111(2)(e) of the Act, the following particulars are prescribed:

- (a) the address for service of the registered owner;
- (b) the name of each other person who has an interest in the design;
- (c) the designer's name;
- (d) if a statement of newness and distinctiveness was included in the application -- that fact.

### **9.02 Inspection of Register**

For subsection 113(1) of the Act, the prescribed times, in relation to the Designs Office or a sub-office of the Designs office, are from 9 am to 5 pm on Monday to Friday other than a public holiday:

- (a) in the place where the Designs Office or the sub-office is located;  
or
- (b) for the purposes of the Australian Public Service in that place.

### **9.03 Amendments of Register to record changes of ownership**

(1) For subsection 114(3) of the Act, the prescribed period is 1 month from the date of the notice under paragraph 114(3)(a) of the Act.

(2) For subsection 114(4) of the Act, the request must:

- (a) be made in the approved form; and
- (b) be accompanied by satisfactory evidence of:
  - (i) the assignment of the interest in the design; or
  - (ii) the person's interest in the design by devolution by will or by operation of law.

### **9.04 Notice specifying amendments to Register**

For paragraph 116(b) of the Act, the Registrar must publish a notice in the *Official Journal*.

### **9.05 Correction of Register**

(1) The Registrar may, of his or her own motion, amend an entry in the Register to correct a clerical error or an obvious mistake.

(2) The Registrar may, on request made in the approved form, amend an entry in the Register:

- (a) to correct a clerical error or an obvious mistake; or

(b) if a name or an address entered in the Register has been changed -- to change the name or address.

(3) If the Registrar proposes to amend an entry in the Register, the Registrar may give notice of the proposed amendment to a person who is entered in the Register as having an interest in the design.

(4) If a proposed amendment of an entry would materially alter the meaning or scope of the entry, the Registrar must publish, in the *Official Journal*, a notice of the request to amend the entry.

(5) If the Registrar publishes a notice under subregulation (4):

(a) a person may, by giving written notice to the Registrar within 1 month of the publication of the Registrar's notice, oppose the amendment; and

(b) if a person opposes the amendment under paragraph (a), the person must serve a copy of the notice of opposition on the person who requested the amendment; and

(c) the Registrar must amend the entry:

(i) if no person opposes the amendment -- as requested; or

(ii) if notice of opposition is given -- subject to the decision of the Registrar or, if applicable, of a tribunal or a prescribed court in respect of the opposition.

[Note: If a person gives a notice of opposition to the Registrar after the period set out in paragraph (a), the person will need an extension of time under section 137 of the Act.]

## Chapter 10 Administration

### 10.01 Delegation by Registrar

For subsection 124(1) of the Act, the prescribed classes of employees are:

(a) for any of the powers or functions of the Registrar under the Act (other than the powers or functions under paragraphs 127(1) (a) and (c) of the Act) -- an employee employed at, or performing duties at, any of the following classifications:

- (i) Executive Level 2;
- (ii) Executive Level 1;
- (iii) APS level 6;
- (iv) APS level 5;
- (v) APS level 4;
- (vi) APS level 3;
- (vii) APS level 2; and

[Note: Under paragraphs 127(1) (a) and (c) of the Act, the Registrar may summon witnesses and require the production of documents or articles.]

(b) for all or any of the powers or functions of the Registrar under the *Olympic Insignia Protection Act 1987* -- an employee employed at, or performing the duties at, any of the following classifications:

- (i) Executive Level 2;
- (ii) Executive Level 1;
- (iii) APS level 6.

[Note: For the meaning of **employee**, see section 5 of the Act.]

### 10.02 Costs (Act s 127)

(1) A party to proceedings before the Registrar may apply to the Registrar, in the approved form, for an award of costs in respect of the proceedings.

(2) The application must be made:

- (a) during the proceedings; or
- (b) within 3 months from:

(i) the day when the Registrar makes a decision that ends the proceedings;  
or

(ii) the date of the Registrar's notice to the party that the proceedings have been discontinued.

(3) The Registrar may award costs only in respect of a matter mentioned in Schedule 3.

(4) Before awarding costs for an amount other than for an amount mentioned in Schedule 3 in respect of the proceedings, the Registrar must give each party to the proceedings a reasonable opportunity to be heard in relation to the award of costs.

(5) If a bill of costs is to be filed in relation to the proceedings, the bill must be filed within 3 months from the day when the costs are awarded.

(6) The amount of costs must be taxed, allowed and certified, in accordance with Schedule 3, by the Registrar.

(7) The Registrar may review the taxation of costs carried out by a delegate of the Registrar or a person authorised to act for the Registrar.

## **Chapter 11 Miscellaneous**

### **Part 11.2 Fees**

#### **11.01 Fees payable**

(1) For subsection 130(1) of the Act, the fee to be paid for a matter mentioned in an item in Schedule 4 is specified in the item.

(2) For subsection 130(3) of the Act, the fee mentioned in an item in Schedule 4 is payable as set out in this regulation.

#### *Who pays*

(3) A fee specified in an item is payable by the person (if any) who is specified in the item as the person by whom the fee is payable.

#### *To whom is it payable*

(4) The fee is payable to the Registrar.

#### *When is it payable*

(5) The fee is payable at the following time:

(a) if it is for filing an application, request or other document -- when the application, request or other document is filed;

(b) if it is for appearing at a hearing:

(i) for the first day -- immediately before the hearing; and

(ii) for each day or part of a day after the first day -- immediately after the completion of the hearing.

#### *How is it paid*

(6) The fee must be paid in the manner that the Registrar reasonably directs.

#### **11.02 Failure to pay -- fee for filing a design application**

(1) This regulation applies if:

(a) the fee mentioned in item 1 in Schedule 4 is not paid on the day when it is payable; and

(b) within 1 month after that day, the Registrar invites the applicant to pay the fee within 2 months after the date of the invitation; and

(c) the fee is not paid within the 2-month period.

(2) The application lapses, or the registration of each design disclosed in the application that has been registered ceases, at the end of the 2-month period.

**11.03 Failure to pay -- fee for filing a request for registration covering a further design**

(1) This regulation applies if:

(a) the fee mentioned in item 2 in Schedule 4 is not paid on the day when it is payable; and

(b) within 1 month after the date of the first notice given under section 41 of the Act in relation to the further design, the Registrar invites the applicant to pay the fee within 2 months after the date of the invitation; and

(c) the fee is not paid in accordance with the 2-month period.

(2) The application lapses, or the registration of each design disclosed in the application that has been registered ceases, at the end of the 2-month period.

**11.04 Failure to pay -- fee payable by the registered owner for filing a request for examination**

(1) This regulation applies if:

(a) the fee mentioned in item 3 in Schedule 4 is not paid on the day when it is payable; and

(b) within 1 month after that day, the Registrar invites the registered owner to pay the fee within 2 months after the date of the invitation; and

(c) the fee is not paid within the 2-month period.

(2) The registration of the design ceases, at the end of the 2-month period.

**11.05 Failure to pay -- fee payable by the registered owner in relation to a request for examination filed by another person**

(1) This regulation applies if:

(a) the fee mentioned in paragraph (b) in column 3 of item 4 in Schedule 4 is not paid on the day when it is payable; and

(b) within 1 month after the fee mentioned in paragraph (a) of item 4 in Schedule 4 is paid, the Registrar invites the registered owner to pay the fee within 2 months after the date of the invitation; and

(c) the fee is not paid within the 2-month period.

(2) The registration of the design ceases at the end of the 2-month period.

**11.06 Failure to pay -- certain other fees for filing**

(1) This regulation applies if:

(a) the fee mentioned in:

(i) paragraph (a) in column 3 of item 4 in Schedule 4; or

(ii) item 7, 8, 9 or 10 in Schedule 4;

is not paid on the day when it is payable; and

(b) within 1 month after the fee is payable, the Registrar invites the person who files the request, application or notice to pay the fee within 2 months after the date of the invitation; and

(c) the fee is not paid within the 2-month period.

(2) The request, application or notice is taken not to have been filed.

**11.07 Failure to pay -- fee for requesting a hearing**

(1) This regulation applies if the fee mentioned in item 11 in Schedule 4 is not paid when it is payable.

(2) No hearing as requested is to be held until the fee has been paid.

(3) If:

(a) within 1 month after the fee is payable, the Registrar invites the person who files the request to pay the fee:

(i) within 2 months after the date of the invitation; or

(ii) if the date of the hearing occurs before the 2 months period -- before the date of the hearing; and

(b) the fee is not paid in accordance with the Registrar's invitation; the request is taken not to have been filed.

**11.08 Failure to pay -- fee for appearing at a hearing**

If the fee mentioned in paragraph (a) in column 3 of item 12 in Schedule 4 is not paid when it is payable, a person cannot appear at the hearing.

**11.09 Failure to pay -- fees for requesting supply of documents by the Registrar**

(1) This regulation applies if the fee mentioned in item 13, 14, 15 or 16 in Schedule 4 is not paid when it is payable.

(2) The Registrar must not process the request until the fee has been paid.

(3) If:

- (a) the Registrar invites the person who files the request to pay the fee within 2 months after the date of the invitation; and
  - (b) the fee is not paid within the 2-month period;
- the request is taken not to have been filed.

#### **11.10 Consequences if Registrar does not invite payment**

- (1) This regulation applies if:
  - (a) the fee mentioned in item 1, 2, 3, 4, 7, 8, 9 or 10 in Schedule 4 is not paid when it is payable; and
  - (b) the Registrar does not give the invitation mentioned in regulation 11.02, 11.03, 11.04, 11.05 or 11.06 within the time mentioned in that regulation for giving the invitation.
- (2) The request, application or notice is to be treated as if the fee had been paid when it was payable.

#### **11.11 Exemption from fees (Act s 149)**

The Registrar may exempt a person from the payment of the whole or any part of a fee, if the Registrar is satisfied on reasonable grounds that the action is justified having regard to all the circumstances.

#### **11.12 Recovery of fees**

A fee payable under these Regulations is recoverable as a debt due to the Commonwealth.

### **Part 11.5 Extensions of time**

#### **11.13 Extensions of time for doing a relevant act**

- (1) For subsection 137(2) of the Act, an application must:
  - (a) be made in the approved form; and
  - (b) be accompanied by a declaration setting out the grounds on which the application is made.
- (2) For subsection 137(4) of the Act, the Registrar must advertise an application in the *Official Journal*.
- (3) For subsection 137(5) of the Act, the person must:
  - (a) file a notice of his or her opposition in the approved form within 1 month after the application was advertised; and
  - (b) serve a copy of the notice on the person who applied for the extension.

(4) If the Registrar grants an extension of time under section 137 of the Act, the Registrar must publish details of the extension in the *Official Journal*.

#### **11.14 Consequence of extension -- notice of restoration**

For paragraph 138(2)(b) of the Act, the Registrar must publish a notice in the *Official Journal*.

### **Part 11.6 Other**

#### **11.15 Agents (Act s 141)**

(1) This regulation applies if a person (an **agent**) acts on behalf of another person (the **principal**).

(2) If the agent signs a document on behalf of the principal, the agent must note that fact (including the principal's name) on the document.

(3) If the agent is not a legal practitioner, he or she must not do the following on behalf of the principal:

- (a) prepare any document that is to be filed in, or issued from, a court;
- (b) transact business, or conduct proceedings, in a court.

#### **11.16 Right of lien of registered patent attorneys (Act s 142)**

A registered patent 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.

#### **11.18 Documents to be in English**

(1) An approved form being filed must be in English.

(2) Any other document being filed must:

- (a) be in English; or
- (b) if it is not in English -- be accompanied by a translation of the document into English that has with it a certificate of verification.

(3) However, subregulation (2) does not apply to text that forms part of a design.

(4) In this regulation:

**certificate of verification**, in relation to a translation, means a statement, dated and signed by a person, to the effect that the translation

is, to the best of the knowledge of the person, a true and complete translation of the accompanying document.

#### **11.19 Service of documents**

(1) If provision is made in an approved form to state an address for service, the person completing the form must state an address for service in Australia at which a document under the Act or these Regulations may be given to him or her personally or to the person specified in the form as his or her representative.

(2) A person may file a notice of change of his or her address for service.

(3) If a notice of opposition is filed, a party to the opposition proceedings who has filed a notice under subregulation (2) must serve a copy of the notice on each other party to the proceedings.

(4) If a person serves a document on a person other than the Registrar, he or she must, as soon as practicable after serving the document on the other person, file:

- (a) a notice of the service in the approved form; and
- (b) a copy of the document served.

#### **11.20 Address for correspondence**

(1) If provision is made in an approved form to state an address for correspondence, the person completing the form may state an address to which all correspondence from the Registrar can be sent.

(2) A person may file a notice of change of his or her address for correspondence.

(3) The address for correspondence need not be in Australia.

#### **11.21 Death of applicant or registered owner (Act s 146, s 147)**

(1) This regulation applies to:

- (a) a legal representative who wishes to proceed with the application in accordance with section 146 of the Act; or
- (b) a person who wishes to have the Register amended in accordance with section 147 of the Act.

(2) The legal representative or the person must file:

- (a) a request in the approved form; and

(b) any other document that the Registrar reasonably considers to be necessary to support the request.

#### **11.22 Exercise of discretionary powers by Registrar (Act s 148)**

(1) The Registrar must not exercise a discretionary power under these Regulations adversely to a person without giving that person an opportunity to be heard.

[Note: Section 148 of the Act provides similarly for the exercise of discretionary power under the Act.]

(2) For section 148 of the Act and subregulation (1), the Registrar must give notice of the date, time and place of the hearing to the person as required under subregulation 11.23(2).

(3) The Registrar may exercise the discretionary power if the person:

- (a) gives notice to the Registrar that he or she does not wish to be heard;
- or
- (b) does not attend the hearing; or
- (c) being an applicant or a registered owner -- requests the Registrar to exercise the power without the applicant or registered owner appearing at a hearing.

(4) A request under paragraph (3)(c):

- (a) must be in the approved form; and
- (b) may be accompanied by written submissions.

(5) The Registrar must, in exercising the discretionary power, have regard to any written submission given to him or her under paragraph (4)(b).

(6) The Registrar must notify a person who has given notice under paragraph (3)(a) of his or her decision in relation to the exercise of the discretionary power.

[Note: A person who wishes to be heard will be notified under regulation 11.23.]

#### **11.23 Hearings**

(1) If, under the Act or these Regulations, a person must be given a reasonable opportunity to be heard in respect of a matter, the Registrar must, before proceeding to make a determination on the matter, advise

the person, in writing that:

- (a) the person has the opportunity to be heard; and
- (b) the person must notify the Registrar whether or not the person wishes to be heard within a reasonable period, specified in the notice; and
- (c) if the person does not notify the Registrar, the Registrar may determine the matter without hearing the person.

(2) The Registrar must give notice of the date, time and place of the hearing to each party to the hearing at least 10 days before the day when the hearing is to begin.

(3) The Registrar may adjourn the hearing from time to time and from place to place by notifying the parties to the hearing accordingly.

(4) The Registrar may hold a hearing:

- (a) at which the parties appear before him or her in person; or
- (b) in which a party participates by telephone or other means of telecommunications that the Registrar reasonably allows.

(5) If a party to a hearing does not intend to appear at the hearing, the party may give a written submission to the Registrar before the hearing begins.

(6) The Registrar must, in deciding the matter being heard, have regard to any written submission given to him or her under subregulation (5) as if:

- (a) the party were present or otherwise participating in the hearing; and
- (b) the matter of the submission were presented by the party in the Registrar's presence.

(7) The Registrar must notify each party to the hearing of his or her decision on the matter heard.

#### **11.24 Practice and procedure in relation to applications, oppositions and other matters**

(1) This regulation applies in relation to:

- (a) applications, oppositions and matters that the Registrar is authorised, under the Act or these Regulations, to hear and decide; and
- (b) matters being decided on the motion of the Registrar.

(2) Subject to these Regulations, the practice and procedure to be followed for the purposes of enabling the application or matter to be decided is to be determined by the Registrar.

(3) A person to be heard at a hearing may apply to the Registrar in respect of the practice and procedure relating to the hearing to be determined by the Registrar.

#### **11.25 Evidence**

(1) If evidence is given in writing to the Registrar for the purposes of the Act or these Regulations, the evidence must be in the form of a declaration.

(2) The Registrar may:

- (a) require a person who has made a declaration to appear before him or her to give evidence orally on oath or affirmation in substitution for, or addition to, the evidence contained in the declaration; and
- (b) allow the person to be cross-examined on the declaration.

#### **11.26 Declarations**

(1) A declaration required by the Act or these Regulations to be given to the Registrar must:

- (a) be headed with the title of the matter in respect of which the declaration is made; and
- (b) be expressed in the first person; and
- (c) state the name and address of the person making the declaration; and
- (d) state the name and title of the person before whom the declaration is made; and
- (e) state the date on which, and the place at which, the declaration is made; and
- (f) be divided into paragraphs, each of which must be:
  - (i) numbered consecutively; and
  - (ii) as far as practicable, confined to 1 subject.

(1A) If the declaration is made on behalf of another person, it must also state the other person's name and address.

(1B) If the declaration is made for the purposes of a business whose details are set out in the declaration, it must also state:

- (a) the office or position held in the business by the person who makes the declaration; and

(b) the address of the place at which the business is conducted or principally conducted.

(2) A declaration must be made before:

(a) a magistrate; or

(b) a justice of the peace; or

(c) a commissioner for affidavits; or

(d) a commissioner for declarations; or

(e) a notary public; or

(f) a person before whom a statutory declaration may be made under the *Statutory Declarations Act 1959* or the law of the State, Territory or foreign country where the declaration is made; or

(g) a diplomatic or consular officer.

(3) In this regulation:

*diplomatic or consular officer* means a person who holds any of the following offices of the Commonwealth in a country other than Australia:

(a) ambassador;

(b) high commissioner;

(c) minister;

(d) chargé d'affaires;

(e) counsellor or second or third secretary at an embassy, high commission or other post;

(f) consul general;

(g) consul;

(h) vice consul.

### **11.27 Non compliance in relation to documents other than design applications**

(1) This regulation applies in relation to a document other than a design application.

(2) A document filed at the Designs Office must substantially comply with Schedule 2.

(3) If a document does not substantially comply with Schedule 2, or is not in accordance with any applicable approved form, the Registrar must, depending on the nature and deficiency of the document:

(a) return the document to the person from whom the document was received, with a statement indicating in what way the document does not comply, or is not in accordance; or

(b) direct that person to do the things specified in the direction to ensure that the document will comply, or will be in accordance.

(4) If the Registrar returns a document under paragraph (3) (a), the document is taken not to have been filed.

(5) If the Registrar gives a direction under paragraph (3) (b), the document is taken to have been filed unless the person to whom the direction was given does not comply with the direction within 2 months from the day when it was given.

#### **11.28 Directions for actions not otherwise prescribed**

If:

(a) the Registrar reasonably believes that it is necessary, for the proper prosecution or completion of proceedings before the Registrar, for a person to perform an act, file a document or produce evidence; and

(b) that action is not specified elsewhere in the Act or these Regulations; the Registrar may give notice to the person directing the person to perform the act, file the document or produce the evidence.

#### **11.29 Acting for persons unable to act**

(1) If a person is incapable of doing anything required or permitted by the Act or these Regulations to be done because of infancy, mental disability, physical disability or disease, a court may, on the application by a person acting for the incapable person or by any other person interested in the doing of the thing:

(a) do that thing in the name of, and on behalf of, the incapable person; or

(b) appoint a person to do the thing in the name of, and on behalf of, the incapable person.

(2) A thing done in the name of, and on behalf of, an incapable person is taken to have been done by that person as if he or she had not been incapable when the thing was done.

(3) In this regulation:

**mental disability** means a disturbance or defect, to a severely disabling degree, of perceptual interpretation, comprehension, reasoning, learning, judgment, memory, motivation or emotion.

### **11.30 Requirements that cannot be complied with for reasonable causes**

If:

(a) a person is required, under these Regulations, to sign a document, make a declaration, file or give to the Registrar a document or evidence, or to do any other act or thing; and

(b) the Registrar is satisfied that the person cannot reasonably comply with the requirement;

the Registrar may, subject to any condition that he or she reasonably directs, dispense with the requirement.

### **11.31 Review of decisions**

(1) In this regulation:

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

**Tribunal** means the Administrative Appeals Tribunal.

(2) Application may be made to the Tribunal for review of a decision of the Registrar under subparagraph 9.05(5) (c) (ii).

(3) If the Registrar gives a person affected by a decision mentioned in subregulation (2) written notice of the making of the decision, the notice must include a statement to the effect that, subject to the *Administrative Appeals Tribunal Act 1975*, application may be made to the Tribunal for review of that decision by or on behalf of the person whose interests are affected.

(4) Failure to comply with subregulation (3) in relation to a decision does not affect the validity of the decision.

### **11.32 Period for doing certain acts – office not open for business**

For subsection 136A (1) of the Act, the circumstance is that the act is done at:

(a) the Designs Office; or

(b) a sub office of the Designs Office;

that was not open for business.

Note Subsection 136A (1) provides as follows:

'(1) If the last day of a period provided by this Act (except this section) or the regulations for doing an act is a day when the Designs Office, or a sub office of the Designs Office, is not open for business, the act may be done in prescribed circumstances on the next day when the office or sub office is open for business.'

**11.33 Days when office not open for business**

(1) For paragraph 136A (2) (a) of the Act, the days on which the Designs Office, or a sub office of the Designs Office, is not open for business are:

- (a) Saturday; and
- (b) Sunday; and
- (c) Australia Day; and
- (d) Anzac Day.

(2) For paragraph 136A (2) (b) of the Act, the Director General of IP Australia is a prescribed person.

(3) For paragraph 136A (2) (b) of the Act, the prescribed way of publishing a declaration is in the Official Journal of Designs.

**11.34 Period for doing certain acts – acts to which section 136A does not apply**

For subsection 136A (7) of the Act, an act done in relation to proceedings in a court or a tribunal is prescribed.

## Chapter 12 Repeal, transitional and saving provisions

### 12.01 Conversion of transitional applications

(1) For paragraph 159(2) (a) of the Act, the prescribed period:

(a) begins on the commencement of this subregulation; and

(b) ends immediately before:

(i) the design is registered; or

(ii) the application lapses or is withdrawn or refused.

(2) For paragraph 159(2) (c) of the Act, the request must be made in the approved form.

### 12.02 Former Designs Regulations -- transitional

Despite the repeal of the *Designs Regulations 1982*, those Regulations continue to have effect to the extent necessary to give effect to Part 2 of Chapter 12 of the Act.

### 12.03 Designs excluded from transitional applications that are not converted applications

(1) This regulation applies if:

(a) 1 or more designs are disclosed in a transitional application; and

(b) the transitional application is amended under section 22B of the old Act to exclude 1 or more of those designs; and

(c) the transitional application is not a converted application; and

(d) before the registration, or the refusal of the registration, of the design or designs in the transitional application, the applicant files a design application under section 21 of the Act in respect of 1 or more of the designs excluded from the transitional application (the **excluded transitional designs**).

[Note: For a transitional application that is a converted application, see section 160 of the Act.]

(2) A design application in respect of excluded transitional designs must include a request for registration or publication of all the designs disclosed in the application.

(3) In applying these Regulations (other than regulations 1.04 and 3.02) in relation to an excluded transitional design:

(a) a reference to an excluded design is taken to be a reference to the excluded transitional design; and

(b) a reference to an initial application is taken to be a reference to the transitional application; and

(c) a reference to 'the design number that was allocated to the excluded design in the initial application' is taken to be a reference to 'the application number of the transitional application in which the excluded transitional design was disclosed'; and

(d) a reference to 'a design application mentioned in subsection 23(2) of the Act' is taken to be a reference to 'a design application mentioned in paragraph 12.03(1)(d)'.

(4) Subregulation (5) applies in relation to a design application mentioned in paragraph (1)(d) that was filed before this regulation commences.

(5) If a request for registration or publication of each design disclosed in the design application is filed within the period prescribed under these Regulations, as in force immediately before this regulation commences:

(a) the request is taken to have been filed on the day when the design application was filed; and

(b) the design application is taken to have complied with subregulation (2).

(6) In this regulation:

**transitional application** means an application for registration of a design that was made under the old Act before 17 June 2004.

#### **12.04 Protection and compensation provisions -- transitional**

(1) Subsections 18(3) and 18(4) of the old Act, and regulations 29AA, 29A and 29B of, and Schedule 1 to, the old Regulations, are taken to have effect, in relation to an application for a licence under subregulation 29AA(2) of the old Regulations, as if those provisions had not been repealed.

(2) Subsection 27B(7) of the old Act, and regulations 29, 29A and 29B of, and Schedule 1 to, the old Regulations, are taken to have effect, in relation to an application for a licence under subregulation 29(2) of the old Regulations, as if those provisions had not been repealed.

**Schedule 1 Convention countries (omitted)**

(regulation 1.05)

## **Schedule 2 Formal requirements**

(regulations 4.04, 4.05, 4.15 and 11.27)

### **1 Fitness for reproduction**

(1) Each sheet included in a document must:

(a) be presented in a way that allows any number of copies of the sheet to be reproduced directly by photocopying, digital scanning, microfilming and photography; and

(b) not be folded, creased or cracked; and

(c) subject to subclause 5(4), have its content presented in a vertical format; and

(d) be durable, flexible, smooth, strong, white and have a matt finish; and

(e) be of international sheet size A4; and

(f) be printed on 1 side only.

(2) A document must be free from any erasures, alterations, overwriting and interlineations that, in the reasonable opinion of the Registrar, would:

(a) compromise the authenticity of the document; or

(b) reduce the likelihood of clear reproduction of the document.

### **2 Separate sheets**

(1) The sheets included in an application must be connected so that they may:

(a) be readily turned to be read; and

(b) be readily separated for the purposes of reproduction and be readily rejoined.

(2) Representations must be on a separate sheet or separate sheets to any other documents filed in relation to the application.

### **3 Margins**

(1) Each sheet must have a margin of at least 2.5 cm on each side.

(2) A sheet of representations must not contain a frame surrounding the representations.

### **4 Textual matter**

(1) All textual matter must:

- (a) be typewritten; or
  - (b) if it cannot be typewritten -- be in large and legible handwriting.
- (2) The lines of any typewritten text must be 1 1/2 spaced or double spaced
- (3) The text must:
- (a) be presented in letters the capitals of which are at least 0.21 cm high; and
  - (b) be presented in a dark colour; and
  - (c) be indelible.

### **5 Additional requirements for representations**

- (1) A single representation must not exceed a single sheet.
- (2) A single sheet may include more than 1 representation.
- (3) Subject to subclause (4), if there are 2 or more representations on a sheet, each representation must be presented in a vertical format and be separated from each other.
- (4) If the representations on a sheet cannot be presented in a vertical format, each representation must be presented in a horizontal format with the top of the representation towards the left of the sheet (when viewed in a vertical format).
- (5) Each sheet of representations must be numbered using a pair of numbers (written in Arabic numerals) separated by '/', the 1st number being the sheet number (beginning with '1') and the 2nd number being the total number of sheets of representations (eg 1/10, 2/10 and 3/10).
- (6) If:
  - (a) the application is for 1 design; and
  - (b) the design is a common design in relation to more than 1 product; the representations must show the design in relation to each product identified in the application
- (7) If the application is for more than 1 design:
  - (a) each design must be separately and clearly indicated; and
  - (b) a single sheet cannot be used to show more than 1 design.
- (8) Originals and copies of drawings must be executed in durable, black,

dense, dark, uniformly thick and well-defined lines and strokes without colouring.

(9) A line in a drawing must generally be drawn with the aid of drafting instruments.

(10) A cross-section must be indicated by oblique hatching that does not impede the clear reading of reference letters, numbers or signs and leading lines.

(11) The scale of a representation and the distinctness of its execution must enable all details to be distinguished without difficulty on a photographic reproduction of the representation with a  $2/3$  linear reduction in size.

(12) Each representation must be shown in proper proportion to each other representation, except when the use of a different proportion is necessary for clarity of the representation.

(13) A letter, number or reference line shown on a representation must be presented simply and be clear.

(14) Brackets, braces, circles or inverted commas must not be used in association with letters or numbers.

(15) A representation must not include descriptive text, other than any word or words necessary for the understanding of the representation.

(16) The height of a letter or a number in a representation must be at least 0.32 cm.

## **6 Photographs and digital images**

(1) Photographs must be original and clear.

(2) Photographs of specimens must be taken against a neutral and contrasting background.

(3) Photographs must be mounted on paper as follows:

(a) the paper and mounting adhesive must be of a nature that will not cause deterioration of the photograph;

(b) the paper and mounting must allow any number of copies of the photograph

to be reproduced directly by photocopying, digital scanning, microfilming and photography;

(c) the photograph and paper must not be folded, creased or cracked;

(d) subject to subclause 5(4), the photograph must be mounted in a vertical format;

(e) the photograph must be mounted:

(i) on paper that is durable, flexible, smooth, strong, white and have a matt finish; and

(ii) on paper that is of international sheet size A4; and

(iii) on 1 side of the paper only.

(4) Representations printed from a digital images must be clear and of high definition.

#### **7 Electronic documents**

A document that is filed in electronic form must be in the approved form.

#### **8 Scandalous matter**

An application must not contain any scandalous matter, or matter that might reasonably be taken to be scandalous.

**Schedule 3 Costs** (regulation 10.02)

**Part 1 Costs**

| Item | Matter  | Amount  |
|------|---|---|
| 1    | Preparing notice of opposition  | \$200   |
| 2    | Receiving and perusing notice of opposition   | \$130   |
| 3    | Preparation of case for hearing   | \$525   |
| 4    | Attendance at hearing by:<br>(a) a registered patent attorney without counsel; or<br>(b) a registered trademarks attorney without counsel;<br>or<br>(c) a solicitor without counsel                 | \$260 an hour,<br>but not more<br>than \$1 170 a<br>day |
| 5    | Attendance at hearing by:<br>(a) a registered patent attorney instructing counsel;<br>or<br>(b) a registered trade marks attorney instructing<br>counsel; or<br>(c) a solicitor instructing counsel | \$200 an hour,<br>but not more<br>than \$900 a<br>day   |
| 6    | Counsel fees for attendance at hearing  | \$300 an hour, but not<br>more than \$1 350 a day       |

**Part 2 Expenses and allowances**

**Division 1 Expenses**

1 A person who has paid a fee prescribed in these Regulations in relation to proceedings before the Registrar may be paid the amount of the fee.

[Note: If the person wishes to be paid, the person must apply for an award of costs in respect of the proceedings: see regulation 10.02.]

2 A person attending proceedings before the Registrar must be paid:  
(a) a reasonable amount for allowances for transport between the person's usual place of residence and the place where he or she attends the proceedings; and  
(b) if the person is required to be absent overnight from his or her usual place of residence -- a reasonable amount for allowances up to a daily maximum of \$700 for meals and accommodation.

**Division 2 Allowances**

3 A person who, because of his or her professional, scientific or other special skill or knowledge, is summoned to appear as a witness before the Registrar must be paid:

(a) if the person is remunerated in his or her occupation by wages, salary or fees -- an amount equal to the amount of wages, salary or fees not paid to the person because of his or her attendance as a witness; or

(b) in any other case -- an amount of not less than \$140, or more than \$700, for each day when he or she so attends.

4 A person summoned to appear as a witness, other than a witness referred to in clause 3, before the Registrar must be paid:

(a) if the person is remunerated in his or her occupation by wages, salary or fees -- an amount equal to the amount of wages, salary or fees not paid to the person because of his or her attendance as a witness; or

(b) in any other case -- an amount of not less than \$80, or more than \$130, for each day when he or she so attends.

**Schedule 4 Fees** (regulation 11.01)

| Item | Matter  | Fee  |
|------|---|--|
| 1    | Filing a design application   | \$200 for each design identified, by the applicant, as being a separate design disclosed in the application  |
| 2    | Filing a request for registration covering a further design   | \$200 for each further design covered by the request   |
| 3    | Filing a request, by the registered owner of a design, for examination of the design                          | \$360  |
| 4    | Filing a request, by a person other than the registered owner of a design, for examination of a design        | (a) payable by the person filing the request -- \$180; and<br>(b) payable by the registered owner -- \$180   |
| 5    | Filing an application for renewal of the registration of a design   | (a) \$275; and<br>(b) if the fee is paid after the expiry of 5 years from the day when the term of registration of the design starts -- \$100 for each month or part of a month after the expiry of the 5 years and before the fee is paid (maximum \$600) |
| 6    | Lodging a request for an extension of the period of registration:   |  |
|      | (a) under subsection 27A(2) of the old Act within the meaning of section 161 of the Act (the first extension) | (a) \$55   |
|      | (b) under subsection 27A(12) of the old Act (the second extension)  | (b) \$90   |
|      | (c) under subsection 27A(13) of the old Act (the third extension)   | (c) \$135  |
| 7    | Filing an application for an extension of time on the ground specified in paragraph 137(2) (a) of the Act     | \$100 for each month or part of a month for which the extension is sought  |
| 8    | Filing an application for an extension of time on the ground specified in paragraph 137(2) (b) of the Act     | \$100  |
| 9    | Filing a notice of opposition   | \$550  |
| 10   | Filing any 1 of the following:  | \$500  |
|      | (a) a request for a determination under section 29 of the Act;  |  |
|      | (b) a request for a direction under section 30 of the Act;  |  |
|      | (c) an application under section 51 of the Act for revocation of the registration of a design;                |  |
|      | (d) a request under paragraph 11.22(3) (c) for the exercise of the Registrar's discretionary powers;          |  |
|      | (e) a request for the exercise of the Registrar's discretionary powers not mentioned in the above paragraphs  |  |
| 11   | Filing a request for a hearing  | \$500  |

|    |   |   |
|----|---|---|
| 12 | Appearing at a hearing  | (a) for the first day -- \$500 less any amount paid under item 10 or 11 in relation to the hearing; and<br>(b) if the hearing runs for more than a day -- \$500 for each day or part of a day after the first day |
| 13 | Filing a request for the supply, by the Registrar, of:<br>(a) a duplicate certificate of registration; or<br>(b) a duplicate certificate of examination | \$250   |
| 14 | Filing a request for the supply, by the Registrar, of a copy of an extract from the Register  | (a) \$50 for the document; or<br>(b) if a search is required for the document -- \$100 for the document   |
| 15 | Filing a request for the supply, by the Registrar, of a copy of a document other than an extract from the Register                                      | (a) \$50 for the document; or<br>(b) if a search is required for the document -- \$100 for the document   |
| 16 | Filing a request for certification of a document  | \$50  |

**Notes to the Designs Regulations 2004 (omitted)**