

Designs Regulations 2004 2004 No. 117

EXPLANATORY STATEMENT

STATUTORY RULES 2004 NO. 117

Issued by the Authority of the Minister for Industry, Tourism and Resources

Designs Act 2003

Designs Regulations 2004

The *Designs Act 2003* (the Act) replaces the *Designs Act 1906* and introduces a new designs registration system. Key features of the new system include a more streamlined registration system, better enforcement and dispute resolution procedures, stricter eligibility and infringement tests and clearer definitions. Subsection 149(1) of the Act provides that the Governor-General may make regulations prescribing matters required or permitted to be prescribed and necessary or convenient to be prescribed for carrying out or giving effect to the Act or for the conduct of any business relating to the Designs Office.

Under the new designs system, applicants are able to select whether to register or to publish designs. Only registered designs can be examined and subsequently enforced in the courts. Applications for designs are only subjected to a formalities check before they are registered. Substantive examination of a design will only occur after the design has been registered, and only if the registered owner or a third party requests examination, or if the Registrar of Designs decides to examine the design. This means that registered owners will not have to undergo the costly and time-consuming examination process except for commercial reasons, for example, in order to commence infringement action.

The Act also introduces a new fee payment system, which enables this administrative function to be handled more flexibly by the Designs Office.

The Regulations give effect to the Act by implementing procedures and processes associated with the new designs system. In particular, the Regulations:

- provide for the minimum filing requirements for a design application;
- prescribe the details for the formalities check, registration, publication and examination processes;
- prescribe the details for the amendment, withdrawal and lapsing of design applications; and
- provide the processes for the new fee payment system.

The Regulations also prescribe other details required by the Act to be provided for in the regulations, including details relating to extensions of time, hearings and the administration of the Designs Office.

Details of the amendments are in the Attachment.

The Regulations commence on the date of commencement of sections 3 to 161 of the Act, which is 17 June 2004.

ATTACHMENT

Designs Regulations 2004

Details of the Regulations are as follows:

Chapter 1 - Introductory

Regulation 1.01 - Name of Regulations

Regulation 1.01 identifies the Regulations as the *Designs Regulations 2004*.

Regulation 1.02 - Commencement

Regulation 1.02 provides that the Regulations are to commence on the commencement of sections 3 to 161 of the *Designs Act 2003* ("the Act"). The Act will commence on 17 June 2004.

Regulation 1.03 - Designs Regulations 1982 - repeal

Regulation 1.03 provides that the *Designs Regulations 1982* and all the Statutory Rules that amended those regulations are to be repealed.

Regulation 1.04 - Interpretation

Subregulation 1.04(1) defines the terms 'Act', 'approved form', 'basic application', 'designer', 'excluded design', 'further design', 'initial application' and '*Official Journal*' for the purposes of the Regulations. Subregulation 1.04(2) clarifies that a document is to be taken to be in the approved form if it contains all the information that the form requires - in other words, the format of the document will not be a basis for rejecting it. Subregulation 1.04(3) provides that a reference in the Regulations to the giving of a notice or other document or the making of a request or application to the Registrar of Designs ("the Registrar") will include a reference to the filing of the notice, document, request or application.

Regulation 1.05 - Convention countries

Regulation 1.05 provides that each country listed in Schedule 1 to the Regulations is to be declared to be a Convention country for the purposes of the Act. The definition of Convention country is contained in section 5 of the Act.

Chapter 2 - Design rights, ownership and registrable designs

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

Regulation 2.01 provides the circumstances under paragraph 17(1)(a) of the Act under which publication or use of a design is to be disregarded for the purposes of deciding whether the design is new and distinctive. This regulation is designed to provide an exemption to the requirement that designs are not be used or published prior to being disclosed in a design application in order to be registrable. Under subregulation 2.01(1), the prescribed circumstances are to be publication or use of the design at an official or officially recognised international exhibition within the meaning of the specified treaties, or an international exhibition recognised by the Registrar. Subregulation 2.01(2) provides that for the exemption to apply, both a notice stating that the design has been exhibited and a document issued by the exhibiting authority giving details of the exhibition are to be filed before or at the time a design application is made.

Subregulation 2.01(3) further provides that the design application must be made within a prescribed period of six months from the date on which the design was first published or used.

Chapter 3 - Design Applications

Part 3.2 - Applications

Regulation 3.01 - Minimum filing requirements

Regulation 3.01 prescribes the minimum requirements for filing design applications under subsection 21(2) of the Act. These requirements are to include information indicating that what is filed is intended to be a design application; information allowing the applicant to be identified and contacted; and a representation, or information that appears to be a representation, of each design included in the application.

Regulation 3.02 - Applications covering excluded designs

Regulation 3.02 prescribes the period under subsection 23(2) of the Act within which a design application in respect of an excluded design is to be made. An excluded design is one which was originally contained in an application ("the initial application"), but which was subsequently excluded from the initial application by an amendment made at the request of the applicant under section 28 of the Act. The prescribed period is to begin immediately after the request to amend the initial application is received by the Registrar, and is to end immediately before the earlier of the lapse or withdrawal of the initial application and the registration or publication (under section 57 of the Act) of a design disclosed in the initial application.

Regulation 3.03 - Notice - minimum filing requirements

If an applicant's purported design application meets the minimum filing requirements, the Registrar must notify them in writing of this fact under subsection 24(1) of the Act. Under subsection 24(2) of the Act, the Registrar must also give a written notice to applicants whose purported application does not meet the minimum filing requirements. Regulation 3.03 prescribes the manner in which these two notices are to be provided. Subregulation 3.03(1) provides that both notices are to be sent to the applicant's address for service, if one has been given, or alternatively to any other contact address given. Subregulation 3.03(2) provides that a notice given under subsection 24(2) of the Act is to identify each minimum filing requirement that has not been met, and advise the applicant that they must file the additional information required within two months from the date of the notice. Subregulation 3.03(3) provides that if the minimum filing requirements are not met within this time, the application is to be taken never to have been filed.

Regulation 3.04 - Publication of receipt of application

Regulation 3.04 prescribes the details that are to be published in respect of design applications that meet the minimum filing requirements, and that those details must be published in the *Official Journal*.

Regulation 3.05 - Filing date

Regulation 3.05 prescribes how the filing date of a design application is to be determined. The regulation provides that the filing date is to be the day the design application meets the minimum filing requirements.

Regulation 3.06 - Priority date - designs disclosed in basic applications

Section 27 of the Act provides that if a basic application (an application for protection of a design in a Convention country in accordance with the Regulations) is made before a design application disclosing the design was filed in Australia, and provided the design also meets the minimum filing requirements, the design is to receive as its priority date the date prescribed by the Regulations. Subregulation 3.06(2) prescribes this date. The subregulation provides that if the design application is filed within 6 months after the date on which the basic application was made, then the prescribed date is to be the day the basic application was made. Subregulation 3.06(3) provides that if the Registrar requests a copy of the basic application, it is to be filed within 2 months of the request, or subregulation 3.06(2) will not apply. Subregulation 3.06(4) provides that where subregulation 3.06(2) does not apply, the prescribed date is to be the filing date of the design application. Subregulation 3.06(5) provides that where multiple basic applications have been made in one or more Convention countries, the basic application for the purposes of subregulation 3.06(2) is to be taken to be the earliest of these. Subregulation 3.06(6) details the types of design application that are to be taken to have been made in a Convention country.

Regulation 3.07 - Certain basic applications to be disregarded

Regulation 3.07 prescribes the circumstances in which an applicant may ask the Registrar to disregard an earlier basic application in favour of a later one for the purposes of subregulation 3.06(2). The regulation only applies if a basic application has been withdrawn, abandoned or refused without becoming open to public inspection, and has not been used as the basis for claiming a right of priority in a Convention country. Where the applicant makes such a request, the Registrar must disregard the earlier application. Once an earlier application is disregarded, that earlier application cannot be used by any person for the purposes of subregulation 3.06(2).

Regulation 3.08 - Priority date - excluded designs

Regulation 3.08 provides that for paragraph 27(1)(c) of the Act, the priority date of an excluded design is to be the same priority date the design had under the initial application.

Part 3.3 - Amendment or withdrawal of applications

Regulation 3.09 - Request for amendment of application

Regulation 3.09 sets out the requirements for requesting amendments to design applications under subsection 28(2) of the Act. Requests for amendments are to be made in writing; they are to be clear that an amendment of a design application is being requested; they are to provide details of the proposed amendments; and they are to be accompanied by substitute documents or representations incorporating the proposed amendments or a statement setting out the proposed amendments and the place at which each amendment is proposed to be made.

Subregulation 3.09(2) provides that if an applicant does not file a substitute document or representation the Registrar may direct the applicant to do so within the time allowed by the Registrar.

Regulation 3.10 - Disputes between applicants - requests for determinations

Under section 29 of the Act, where a dispute arises between two or more persons about whether or how a design application should proceed, the Registrar may make certain determinations at the request of any of those persons. Regulation 3.10 prescribes the manner in which these requests for determinations by the Registrar are to be made.

Regulation 3.11 - Requests for direction specifying persons as applicants or entitled persons

Under subsection 30(1) of the Act, a person may ask the Registrar to direct that a design application specify the person as an applicant or an entitled person in relation to a design disclosed in the application. Subsection 30(4) of the Act provides that a request under subsection 30(1) must be in accordance with the Regulations. Regulation 3.11 prescribes the manner in which requests under subsection 30(1) of the Act are to be made.

Regulation 3.12 - Publication of certain details of amended applications

Regulation 3.12 provides that where details of a design application published under section 25 of the Act have changed because the application has been amended under Part 3 of Chapter 3 of the Act, the design number and amended details for each design in relation to which the published details have changed are to be published.

Regulation 3.13 - Withdrawal of designs and design applications

Subregulation 3.13(1) prescribes the period within which a design application may be withdrawn. Subregulation 3.13(2) prescribes the period within which one or more designs contained in a design application consisting of multiple designs may be withdrawn. Subregulation 3.13(3) prescribes the information that is to be published about designs that have been withdrawn (including designs disclosed in design applications that have been withdrawn) by the Registrar in the *Official Journal*.

Part 3.4 - Lapsing of applications

Regulation 3.14 - Period within which application lapses

Subregulation 3.14(1) prescribes the period within which applicants are to make requests to register or publish the designs disclosed in a design application under paragraph 33(1)(a) of the Act to avoid the application lapsing. In most cases this period will be six months from the priority date of the design. However, paragraphs 33(1)(a) and 33(1)(b) alter this for applications covering excluded designs and design applications filed under section 55 of the Act as in most cases these applications will be filed outside the standard six month period. Subregulation 3.14(2) prescribes the period within which applicants must correct any deficiencies in the application notified by the Registrar under section 41 or section 57 of the Act. If the applicant fails to respond within the prescribed period the design application will lapse.

Regulation 3.15 - Form of notice

Regulation 3.15 prescribes the form and content of notices to be published by the Registrar relating to design applications that have lapsed. Such notices must be published in the *Official*

Journal and include the design number of 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

Regulation 4.01 - Requests for registration or publication

Regulation 4.01 prescribes the period within which an applicant may make a request for registration or publication of one or more designs disclosed in a design application, and the form in which the request is to be made. The regulation does not apply to requests in respect of excluded designs under section 37 of the Act, nor to replacement of a request for registration with a request for publication of the design under section 38 of the Act. Regulation 4.03 prescribes the period within which a section 38 request must be made.

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

Subsection 36(1) of the Act permits an applicant to make a request for registration or publication of a design under section 35 in respect of one or more designs in a design application containing multiple designs. However if an applicant makes a request in relation to some of the designs but not others, they may not subsequently make a request for registration of a design for which no request for registration was originally made, unless the Registrar determines that they may make such a request. This determination must be made in accordance with the Regulations. Paragraph 4.02(1)(a) of the Regulations provides that if the applicant can satisfy the Registrar that the applicant's failure to make a request for registration of a design or designs originally was only due to an error or omission by the applicant or their agent they may make a request for registration of those designs. Paragraph 4.02(1)(b) provides that the applicant's subsequent request must be made before any design disclosed in the design application is registered or published.

Regulation 4.03 - Period within which replacements of request may be made

Regulation 4.03 prescribes the period within which, under section 38 of the Act, a request for registration of a design can be replaced with a request for publication of the design. An applicant will be able to make such a request until immediately before the design is registered.

Part 4.3 - Registration

Regulation 4.04 - Formalities check - applications in respect of 1 design only

Subsection 39(2) of the Act provides that the Registrar must register a design if satisfied of a number of things. Paragraph 39(2)(a) of the Act requires that the design application satisfies the formalities check. Regulation 4.04 sets out the formalities that must be met by the design disclosed in the design application for the purposes of paragraph 39(2)(a) of the Act.

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

Regulation 4.05 sets out the formalities for the purposes of paragraph 40(2)(c) of the Act that must be met for a design application disclosing more than one design. Subregulation 4.05(2) clarifies that where an applicant has requested registration of only some of the designs disclosed in the design application, the formalities check is to apply only to the part or parts of the application relating to the design/s covered by the request. If the representation of the design is a specimen, and the specimen does not meet the requirements set out in paragraph 4.05(1)(e),

subregulation 4.05(3) allows the Registrar to require that the applicant file a replacement representation.

Regulation 4.06 - Registrar must refuse to register certain designs

Regulation 4.06 sets out the classes of designs that the Registrar is to refuse to register under paragraph 43(1)(a) of the Act.

Regulation 4.07 - Period within which Registrar must register certain designs after refusal

Regulation 4.07 prescribes the period under section 44 of the Act within which the Registrar is to register a design which was previously subject to a prohibition order under section 108 of the Act but which is otherwise registrable.

Regulation 4.08 - Certificate of registration and notice of registration

Subregulation 4.08(1) sets out the information that is to be included in a certificate of registration of a design issued under subsection 45(3) of the Act. Subregulation 4.08(2) provides that for the purposes of subsection 45(4) of the Act a notice of the registration of a design will be published in the *Official Journal*. This subregulation also lists the details of the design that are to be included in the notice.

Regulation 4.09 - Renewal of registration

Subregulation 4.09(1) prescribes the period within which a registered owner of a registered design may apply for renewal of the registration of the design under subsection 47(2) of the Act. Subregulation 4.09(2) prescribes the form in which the application for renewal is to be made.

Regulation 4.10 - Surrender of registration

Regulation 4.10 sets out what information must be provided to the Registrar when making an offer to surrender the registration of a design.

Regulation 4.11 - Revocation of registration on surrender

Subregulation 4.11(1) prescribes the persons who are to be notified of an offer to surrender the registration of a design for the purposes of paragraph 50(2)(a) of the Act. Subregulation 4.11(2) prescribes the manner in which and the period within which these persons may make submissions in relation to the offer of surrender. Under subregulation 4.11(3), the Registrar is to publish a notice of the offer of surrender, and if an interested person wishes to be heard in relation to the offer, they are to notify the Registrar within the period prescribed by subregulation 4.11(4). As a preliminary issue, the Registrar may, under subregulation 4.11(5), hear and determine the question whether a person is an interested person. Under subregulation 4.11(6), the Registrar is to give a person who has given notice under subregulation 4.11(4) the opportunity to be heard before exercising their power to accept the offer of surrender, revoke the registration and make an entry in the Register of Designs ("the Register") under subsection 50(3) of the Act.

Regulation 4.12 - Revocation of registration on grounds relating to entitled persons

Regulation 4.12 prescribes the manner in which an application under subsection 51(2) of the Act for revocation of the registration of a design on grounds relating to entitled persons is to be made, and the information that is to be provided with the application. See section 5 of the Act for the definition of "entitled person".

Regulation 4.13 - Notice of revocation of registration

Regulation 4.13 sets out the manner of publication and content of a notice of revocation of the registration of a design on grounds relating to entitled persons required under subsection 52(4) of the Act.

Regulation 4.14 - Applications by entitled persons after revocation following surrender of registration

This regulation prescribes that an application under paragraph 54(1)(b) of the Act, seeking a declaration by the Registrar that the applicant is an entitled person, must be in writing.

Part 4.4 - Publication

Regulation 4.15 - Publication of a design

Subregulation 4.15(1) prescribes the requirements for documents provided with a design application in respect of which a request for publication has been made. Once satisfied that these requirements are met, subsection 57(2) of the Act requires that the Registrar publish the design. Subregulation 4.15(2) clarifies that where the design application contains multiple designs, the requirements under subregulation 4.15(1) are to be satisfied only in relation to the part/s of the application relating to the design/s covered by the request for publication.

Chapter 5 - Examination of designs

Regulation 5.01 - Requirements for request for examination of design

Regulation 5.01 prescribes that a request for examination of a registered design under subsection 64(1) of the Act must be made in the approved form. In addition, the regulation provides that 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.

Regulation 5.02 - Grounds for revocation of registration of design

Regulation 5.02 provides additional grounds for the revocation of the registration of a design for the purposes of paragraph 65(2)(b) of the Act. The regulation provides that a prescribed ground for the revocation of the registration of a design is to be that the design should not have been registered under section 43 of the Act.

Regulation 5.03 - Examination of design - procedures

Regulation 5.03 sets out the procedures for the examination of a registered design for the purposes of paragraph 65(3)(a) of the Act.

Regulation 5.04 - Period in which examination of a design must be completed

Regulation 5.04 prescribes the period for the purposes of paragraph 65(3)(b) of the Act within which the Registrar is to complete the examination of a design. If examination is not completed within the prescribed period, the registration of the design will cease under paragraph 48(1)(a) of the Act.

Regulation 5.05 - Amendment of registration

Section 66 of the Act allows the registered owner of a registered design to request that the Registrar amend the Register to remove a ground of revocation notified to the owner by the Registrar during an examination of the design. Subregulation 5.05(1) prescribes the form and content of the owner's request under subsection 66(4) of the Act. Subregulation 5.05(2) prescribes the manner in which the Registrar is to consider and deal with the owner's request under subsection 66(5) of the Act.

Regulation 5.06 - Certificate of examination and notice of examination

Subregulation 5.06(1) sets out the details to be included in the certificate of examination issued by the Registrar under paragraph 67(3)(a) of the Act. Subregulation 5.06(2) sets out the form of publication and content of the notice of examination to be published by the Registrar under paragraph 67(3)(c) of the Act.

Regulation 5.07 - Revocation of registration after examination

Regulation 5.07 provides that where the Registrar revokes the registration of a design under section 68 of the Act, the notice of that revocation required to be published under subsection 68(3) is published in the *Official Journal* and includes the details set out in paragraph 5.07(b).

Regulation 5.08 - Material provided to Registrar

Subsection 69(2) of the Act allows a person to provide material to the Registrar relating to whether a registered design is new and distinctive. Subregulation 5.08(1) sets out the requirements for the provision of this material. Subregulation 5.08(2) prescribes the period throughout which the Registrar is to retain the material for the purposes of paragraph 69(3)(c) of the Act.

Chapter 7 - Jurisdiction and powers of courts

Regulation 7.01 - Application to court for compulsory licence

Under subsection 90(1) of the Act, a person may apply to a prescribed court, after the end of a prescribed period, for an order requiring the registered owner of a registered design to grant that person a licence to exercise the rights of a registered owner of the design listed in paragraphs 10(1)(a) to (e) of the Act. This licence is known as a compulsory licence. Regulation 7.01 prescribes the period referred to in subsection 90(1) of the Act. The period is to be three years from the date of registration of the design.

Regulation 7.02 - Revocation of registration after grant of compulsory licence

If a compulsory licence is granted under section 90 of the Act, an interested person may, under subsection 92(1) of the Act, apply to a prescribed court for an order revoking the registration of the design after the end of the prescribed period. Regulation 7.02 prescribes this period as two years from the date on which the licence (or first licence if more than one) is granted under section 90 of the Act.

Chapter 8 -The Crown

Regulation 8.01 - Acquisition of design by the Commonwealth

Regulation 8.01 provides that a notice of the acquisition of a design by the Commonwealth is to be published in the *Official Journal* and the Commonwealth Gazette.

Regulation 8.02 - Period within which designs must be registered or published after prohibition

Subsection 108(4) of the Act provides that if an order under subsection 108(1) prohibiting or restricting the publication of information about the subject matter of a design application is revoked, and at the date of the revocation of the order the design would otherwise have been registered or published, the design must be registered or published within the prescribed period. Regulation 8.02 prescribes this period as one month from the date on which the Registrar was made aware of the revocation of the order.

Chapter 9 - The Register

Regulation 9.01 - Other particulars to be entered in the Register

Regulation 9.01 sets out the other particulars of a registered design that, for the purposes of paragraph 111(2)(e) of the Act, are to be entered in the Register.

Regulation 9.02 - Inspection of Register

Regulation 9.02 provides the times that the Register is to be available for public inspection at the Designs Office for the purposes of subsection 113(1) of the Act.

Regulation 9.03 - Amendments of Register to record changes of ownership

Subsection 114(1) of the Act allows the registered owner of a design to ask the Registrar to record an assignment of their interest in the design and, under subsection 114(3), the Registrar must record the assignment unless another registered owner of the design advises the Registrar within a prescribed period that they do not consent to the assignment. Subregulation 9.03(1) prescribes this period as one month from the date of the Registrar's notice. Subregulation 9.03(2) sets out the requirements for making a request under subsection 114(1) or 114(2) of the Act.

Regulation 9.04 - Notice specifying amendments to Register

Regulation 9.04 provides that, for the purposes of paragraph 116(b) of the Act, if the Registrar amends the Register, he/she must publish a notice in the *Official Journal*.

Regulation 9.05 - Correction of Register

Regulation 9.05 provides for the amendment of an entry in the Register to correct a clerical error or an obvious mistake or to change a name or address entered in the Register which has changed, and sets out the circumstances in which this can be done and the procedures to be followed.

Chapter 10 - Administration

Regulation 10.01 - Delegation by Registrar

Paragraph 10.01(a) lists the prescribed classes of employees to whom the Registrar may delegate their powers or functions under subsection 124(1) of the Act. Paragraph 10.01(b) lists the classes of employees to whom the Registrar may delegate their powers or functions under the *Olympic Insignia Protection Act 1987*.

Regulation 10.02 - Costs (Act s 127)

This regulation sets out the procedures and time periods for making an application to the Registrar for an award of costs.

Chapter 11 - Miscellaneous

Part 11.2 - Fees

Regulation 11.01 - Fees payable

Subsection 130(1) of the Act provides that the regulations may prescribe the fees to be paid for the purposes of the Act or regulations, and subsection 130(3) of the Act provides that the prescribed fees are payable in accordance with the Regulations. Subregulation 11.01(1) provides that, for subsection 130(1) of the Act, the fees to be paid for a matter mentioned in an item in Schedule 4 to the Regulations are the amounts specified in those items. Subregulation 11.01(3) provides that in the limited circumstances where an item in Schedule 4 to the Regulations specifies who is to pay a fee, it must be paid by the person specified. Under subregulation 11.01(4) fees are to be payable to the Registrar. Subregulation 11.01(5) sets out the time at which a fee is payable. Subregulation 11.01(6) provides that a fee must be paid in the manner that the Registrar reasonably directs.

Regulation 11.02 - Failure to pay - fee for filing a design application

Regulation 11.02 provides the consequences of failing to pay the fee for filing a design application when it is payable. If this fee is not paid within the time allowed under this regulation the design application will lapse, or the registration will cease.

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

Regulation 11.03 provides the consequences of failing to pay the fee for filing a request for registration covering a further design when it is payable. If this fee is not paid within the time allowed under this regulation the design application will lapse, or the registration will cease.

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

Regulation 11.04 provides the consequences of failing to pay the fee payable by the registered owner for filing a request for examination when it is payable. If this fee is not paid within the time allowed under this regulation the design registration will cease.

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

Regulation 11.05 provides the consequences of failing to pay the fee payable by the registered owner in relation to a request for examination filed by another person when it is payable. If this fee is not paid within the time allowed under this regulation the design registration will cease.

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

Regulation 11.06 provides the consequences of failing to pay the fee for:

- a request by a person other than the registered owner of a design for examination of the design;

- an application for an extension of time under paragraph 137(2)(a) of the Act;
- an application for an extension of time under paragraph 137(2)(b) of the Act;
- a notice of opposition; or
- any of the requests listed in item 10 of Schedule 4 to the Regulations.

If these fees are not paid within the time allowed under this regulation, the relevant request, application or notice is taken not to have been filed.

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

Regulation 11.07 provides the consequences of failing to pay the fee for requesting a hearing when it is payable. If this fee is not paid within the time allowed under this regulation, the request is taken not to have been filed.

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

Regulation 11.08 provides that a person cannot appear at a hearing if the fee mentioned in paragraph (a) of item 12 in Schedule 4 to the Regulations has not been paid for the hearing.

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

Regulation 11.09 provides the consequences of failing to pay the fee for requesting the supply of documents by the Registrar. The Registrar must not process the request until the fee is paid. If the fee is not paid within the time allowed under this regulation, the request is taken not to have been filed.

Regulation 11.10 - Consequences if Registrar does not invite payment

Regulation 11.10 provides that if the Registrar fails to give an invitation to pay under regulation 11.02, 11.03, 11.04, 11.05 or 11.06 for a fee mentioned in item 1, 2, 3, 4, 7, 8, 9 or 10 in Schedule 4 to the Regulations within the time allowed in the relevant regulation, the request, application or notice is to be treated as if the fee had been paid.

Regulation 11.11 - Exemption from fees (Act s 149)

Regulation 11.11 allows the Registrar to 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.

Regulation 11.12 - Recovery of fees

This regulation provides that fees payable under the Regulations are to be recoverable as a debt due to the Commonwealth.

Part 11.5 - Extensions of time

Regulation 11.13 - Extensions of time for doing a relevant act

Subsection 137(2) of the Act allows the Registrar, in certain circumstances, on application by a person, to grant to that person an extension of time for doing a relevant act. Subregulation

11.13(1) prescribes the requirements for making such an application. This regulation provides that an application under subsection 137(2) of the Act must be made in the approved form and be accompanied by a declaration setting out the grounds on which the application is made. Under subsection 137(4) of the Act, if the application is for an extension of time of more than three months, the Registrar must advertise the application. This regulation provides that such an application be advertised in the *Official Journal*. The regulation also sets out the requirements for opposing the granting of an application for an extension of time. This regulation also provides that if the Registrar grants an extension of time, they are to publish details of the extension in the *Official Journal*.

Regulation 11.14 - Consequence of extension - notice of restoration

Regulation 11.14 provides that if a design application or registration has been restored under subsection 138(1) of the Act, the Registrar must publish a notice in the *Official Journal*.

Part 11.6 - Other

Regulation 11.15 - Agents (Act s 141)

Regulation 11.15 sets out certain requirements pertaining to agents. Subregulation 11.15(2) provides that an agent who signs a document on behalf of a principal is to note that they are doing so, and the principal's name, on the document. Subregulation 11.15(3) provides that if an agent is not a legal practitioner, he/she is not to prepare any document that is to be filed in or issued from a court, nor transact business or conduct proceedings in a court.

Regulation 11.16 - Right of lien of registered patent attorneys (Act s 142)

Section 142 of the Act allows for the Regulations to provide that a registered patent attorney or a registered trade marks attorney has the same right of lien that a solicitor has in relation to the documents and property of a client. Regulation 11.16 provides that registered patent attorneys are to have this same right of lien.

Regulation 11.17 - Filing of documents

Paragraph 144(b) of the Act allows documents to be filed at a sub-office of the Designs Office either personally or by post or by any other prescribed means. Regulation 11.17 provides that for the purposes of paragraph 144(b), documents can be filed by facsimile transmission.

Regulation 11.18 - Documents to be in English

Subregulation 11.18(1) provides that approved forms being filed are to be in English, and subregulation 11.18(2) provides that any other document being filed is to be either in English or accompanied by a certified translation. However subregulations 11.18(1) and 11.18(2) are not to apply to text that forms part of a design (subregulation 11.18(3)).

Regulation 11.19 - Service of documents

Subregulation 11.19(1) provides that where provision is made in an approved form to state an address for service, the person completing the form must provide an address in Australia where documents under the Act or Regulations can be served on him/her or his/her representative. Subregulation 11.19(2) allows a person to file a notice of change of his/her address for service. Subregulation 11.19(3) provides that if a person who has filed a notice of a change of address for service under subregulation 11.19(2) is a party to opposition proceedings, they are to serve a copy of the notice on each other party to the proceedings. Subregulation 11.19(4) requires that if a person serves a document on a person other than the Registrar, that person must file a

notice of service in the approved form and a copy of any document served as soon as practicable after serving the document on the other person.

Regulation 11.20 - Address for correspondence

Subregulation 11.20(1) provides that where provision is made in an approved form to state an address for correspondence, the person completing the form may provide one. Subregulation 11.20(2) allows a person to file a notice of change of his/her address for correspondence. Subregulation 11.20(3) clarifies that an address for correspondence, in contrast to an address for service, need not be in Australia.

Regulation 11.21 - Death of applicant or registered owner (Act s 146, s 147)

Subregulation 11.21(2) sets out the procedure that a legal representative seeking to proceed with an application for the registration or publication of a design under section 146 of the Act or a person seeking an amendment of the details of who is recorded as the registered owner of a design in the Register under section 147 of the Act is to comply with.

Regulation 11.22 - Exercise of discretionary powers by Registrar (Act s 148)

Subregulation 11.22(1) requires that the Registrar not exercise a discretionary power under the Regulations adversely to a person without giving that person an opportunity to be heard. Subregulation 11.22(2) prescribes the information that the Registrar is to provide a person in relation to a hearing for both subregulation 11.22(1) and section 148 of the Act. Subregulation 11.22(3) provides the circumstances in which the Registrar may exercise the discretionary power. Subregulation 11.22(4) prescribes the form for a request under paragraph 11.22(3)(c) that the Registrar exercise his/her discretionary power without the applicant or registered owner appearing at a hearing. Subregulation 11.22(5) requires the Registrar, in exercising his/her discretionary power, to have regard to any written submission provided under paragraph 11.22(4)(b). Subregulation 11.22(6) requires the Registrar to notify a person who has given notice under paragraph 11.22(3)(a) of his/her decision in relation to the exercise of the discretionary power.

Regulation 11.23 - Hearings

This regulation sets out the procedures and time frames for the conduct of hearings under the Act or Regulations.

Regulation 11.24 - Practice and procedure in relation to applications, oppositions and other matters

Regulation 11.24 sets out the practice and procedure to be followed in relation to applications, oppositions and matters that the Registrar is authorised to hear and decide under the Act or Regulations or that are being decided on the Registrar's motion.

Regulation 11.25 - Evidence

Subregulation 11.25(1) prescribes that evidence is to be given to the Registrar in the form of a declaration for the purposes of the Act or Regulations. Paragraph 11.25(2)(a) gives the Registrar the power to require a person who has made a declaration to appear before him/her to give evidence orally on oath or affirmation in substitution for, or in addition to, the evidence contained in the declaration. Paragraph 11.25(2)(b) gives the Registrar the power to allow a person who has made a declaration to be cross-examined on the declaration.

Regulation 11.26 - Declarations

This regulation sets out the requirements for making declarations under the Act or Regulations, including the persons before whom such a declaration can be made (subregulation 11.26(2)).

Regulation 11.27 - Non compliance in relation to documents other than design applications

Regulation 11.27 sets out the requirements with which documents received by the Designs Office (other than design applications) are to comply, and the consequences of not complying with these requirements.

Regulation 11.28 - Directions for actions not otherwise prescribed

This regulation gives the Registrar the power to give notice to a person directing them to perform an act, file a document or produce evidence if the Registrar reasonably believes this is necessary for the proper prosecution or completion of proceedings before the Registrar and the action is not specified elsewhere in the Act or Regulations.

Regulation 11.29 - Acting for persons unable to act

Regulation 11.29 allows a court to act, or appoint a person to act, on behalf of a person who is unable to do something required or permitted under the Act or Regulations because of infancy, mental disability, physical disability or disease.

Regulation 11.30 - Requirements that cannot be complied with for reasonable causes

Regulation 11.30 allows the Registrar to dispense with a requirement under the Regulations if satisfied that a person cannot reasonably comply with the requirement.

Regulation 11.31 - Review of decisions

This regulation provides that a decision of the Registrar under subparagraph 9.05(5)(c)(ii) is appealable to the Administrative Appeals Tribunal.

Chapter 12 - Repeal, transitional and saving provisions

Regulation 12.01 - Conversion of transitional applications

Subsection 159(1) of the Act allows a person who has made a transitional application to request that it be treated as a converted application ("conversion request"). Subregulation 12.01(1) prescribes the period within which a conversion request must be made. Subregulation 12.02(2) provides that such a request be made in the approved form. "Transitional application" and "conversion request" are defined in sections 161 and 159 of the Act respectively.

Regulation 12.02 - Former Designs Regulations - transitional

Regulation 12.02 is a transitional provision which provides that the *Designs Regulations 1982* continue to have effect to the extent necessary to give effect to Part 2 of Chapter 12 of the Act (Transitional and Saving provisions).

Schedule 1

Schedule 1 to the Regulations lists the countries that are to be declared Convention countries for the purposes of the Act and regulation 1.05.

Schedule 2

Schedule 2 to the Regulations lists the formal requirements that are to apply to documents to which regulations 4.04, 4.05, 4.15 or 11.27 apply.

Schedule 3

Schedule 3 to the Regulations lists the matters in respect of which costs may be awarded by the Registrar under regulation 10.02.

Schedule 4

Schedule 4 to the Regulations lists the matters in relation to which fees are to be paid under regulation 11.01 and the amounts of those fees.