

Designs Amendment Regulations 2004 (No. 2) 2004 No. 325

EXPLANATORY STATEMENT

STATUTORY RULES 2004 NO. 325

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

Designs Act 2003

Designs Amendment Regulations 2004 (No. 2)

Subsection 149(1) of the *Designs Act 2003* (the 2003 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 2003 Act or for the conduct of any business relating to the Designs Office.

The 2003 Act commenced on 17 June 2004. It repealed the *Designs Act 1906* (the 1906 Act) and introduced a new system for the registration of designs. The 2003 Act includes transitional provisions that allow applications filed under the 1906 Act to continue to proceed under the terms of that Act (transitional applications).

Under paragraph 149(2)(l) of the 2003 Act, the Governor-General may make regulations making transitional or consequential provisions as necessary or convenient because of the repeal of the 1906 Act and the enactment of the 2003 Act. Under paragraph 149(2)(m) of the 2003 Act, the regulations may provide for regulations under the 1906 Act to continue to have effect (with any prescribed alterations) for specified purposes of the 2003 Act. Under subsection 149(3) of the 2003 Act, regulations made under paragraph 149(2)(l) of the 2003 Act may provide for the continued operation of specified provisions of the 1906 Act in relation to prescribed persons or matters, or in prescribed circumstances.

Section 130 of the 2003 Act provides that the regulations may prescribe the fees to be paid for the purposes of the 2003 Act or the regulations.

Design applications frequently contain more than one design. However, a design registration must relate to one design only. Therefore design applicants will commonly exclude one or more designs from an initial design application that contains more than one design, and file another design application to protect the designs that were so excluded. Under the *Designs Regulations 2004* (the Principal Regulations), if the initial application was made under the 2003 Act, the excluded designs will retain the priority date (that is, the date at which the validity of the design registration is assessed) that they had in the initial application. This mechanism provides effective protection for the excluded designs.

However, the Principal Regulations do not provide for the situation where the initial application is a transitional application (one made under the 1906 Act) and an application is made under the 2003 Act to protect the excluded designs. Consequently, the excluded designs would not retain the priority date they originally had in the transitional application. This may compromise the protection given to such designs.

The main purpose of the Regulations is to remedy this by amending the Principal Regulations to preserve the priority dates of designs that were excluded from transitional applications.

The Regulations also reinstate certain protection and compensation provisions of the 1906 Act that were repealed by the 2003 Act but not provided for in that Act. These provisions protected third parties in situations where they exploited a design during the period between the design

application or registration lapsing or ceasing, and subsequently being restored, and in certain circumstances where the third party believed the design registration was invalid. The Regulations provide, in accordance with subsection 149(3) of the 2003 Act, that the relevant provisions of the 1906 Act continue to operate as if they had not been repealed.

In addition, the Regulations correct an error in one fee item and introduce a new fee item. These amendments bring the designs fees into line with equivalent provisions in the *Patents Regulations 1991* and the *Trade Marks Regulations 1995*.

Details of the Regulations are in the [Attachment](#).

Regulations 1 to 3 and Schedule 1 commence on the date of their notification in the *Gazette*.

Attachment

Designs Amendment Regulations 2004 (No. 2)

Details of the Regulations are as follows:

Regulation 1 identifies the Regulations as the *Designs Amendment Regulations 2004 (No. 2)*.

Regulation 2 specifies that the Regulations commence on the date of their notification in the *Gazette*.

Regulation 3 specifies that Schedule 1 to the Regulations amends the *Designs Regulations 2004* (the Principal Regulations).

Item 1 of Schedule 1 inserts definitions of the terms 'old Act', 'old Regulations' and 'transitional application' into subregulation 1.04(1), principally for the purposes of new regulations 12.03 and 12.04.

Items 2, 3, 5 and 7 to 10 of Schedule 1 add or amend several notes to refer readers to new regulation 12.03 where relevant.

Item 4 of Schedule 1 amends subregulation 3.14(1) of the Principal Regulations, which provides for the period in which registration or publication of designs must be requested to prevent the design application from lapsing under section 33 of the *Designs Act 2003* (the 2003 Act).

The amendments clarify the wording of paragraphs 3.14(1)(a) and (b) and remove the reference to section 23 from paragraph 3.14(1)(a). This reference is unnecessary as the definition of the term 'excluded design' in subregulation 1.04(1) of the Principal Regulations already refers to section 23.

Item 6 of Schedule 1 adds a reference to new subregulation 12.03(2) to subregulation 4.01(1) of the Principal Regulations to exclude requests mentioned in subregulation 12.03(2) from the operation of regulation 4.01.

Regulation 4.01 provides for the period in which requests for registration or publication of designs must be filed. However, new subregulation 12.03(2) provides that the request in relation to designs excluded from transitional applications must be included in the design application. This amendment therefore ensures that the period in regulation 4.01 does not apply to such requests.

Item 11 of Schedule 1 adds a reference to the new fee for filing a request for certification of a document (see item 14 of Schedule 1) to subregulation 11.09(1) of the Principal Regulations. This ensures that regulation 11.09, which provides for the consequences of a failure to pay certain fees, applies to the new fee item.

Item 12 of Schedule 1 inserts two new provisions, regulations 12.03 and 12.04.

New regulation 12.03 provides for a new transitional provision in respect of designs that were excluded from a transitional application, i.e. an application that was filed under the 1906 Act and is proceeding under that Act rather than the 2003 Act.

Subregulation 12.03(1) specifies the design applications to which regulation 12.03 applies, namely, applications in respect of excluded transitional designs.

Subregulation 12.03(2) provides that a request for registration or publication of all designs included in such applications has to be included in the application for the excluded design. This provision mirrors section 37 of the 2003 Act, which applies to applications in respect of excluded designs generally.

Under subregulation 12.03(3), the application of the Principal Regulations other than regulations 1.04 and 3.02 would be modified as set out in paragraphs 12.03(3)(a) to (d). In particular, this would affect the interpretation of subregulation 3.04(1), regulation 3.08 and subregulations 3.14(1), 4.04(1), 4.05(1), 4.08(1) and 4.08(2). The main effect of this is that the priority date of an excluded transitional design under regulation 3.08 of the Principal Regulations is the same priority date the design had under the transitional application. This would also modify some of the procedural steps in respect of how the Registrar of Designs must process applications for excluded transitional designs, and ensures that the provisions governing applications in respect of excluded transitional designs substantially mirror those governing applications in respect of excluded designs generally.

Subregulations 12.03(4) and (5) provide for transitional arrangements in relation to the requirements of subregulation 12.03(2). These provisions provide that an application for protection of an excluded transitional design is deemed to have complied with subregulation 12.03(2) if it was filed before the Regulations commenced and the request for registration or publication of the design was filed within the period that applied at that time.

Subregulation 12.03(6) defines the term "transitional application" for the purposes of regulation 12.03.

Regulation 12.04 preserves certain protection and compensation provisions in the 1906 Act that were repealed and not replaced in the 2003 Act.

Subregulation 12.04(1) provides that subsections 18(3) and (4) of the 1906 Act, and the associated regulations, are taken to have effect as if those provisions had not been repealed. Those provisions provided for protection and compensation of third parties who had performed an act that would infringe a design registration because they believed the registration was invalid on the basis of two Federal Court decisions.

Subregulation 12.04(2) provides that subsection 27B(7) of the 1906 Act, and the associated regulations, are taken to have effect as if those provisions had not been repealed. Those provisions provided for protection and compensation of third parties who would be adversely affected by the restoration of a design application or registration because they had exploited the design during the period between the application lapsing, or the registration ceasing, and its restoration.

Item 13 of Schedule 1 amends fee item 12 (the fee for appearing at a hearing) to replace an incorrect reference to fee items '9 or 10' with a reference to fee items '10 or 11'.

Item 14 of Schedule 1 inserts a new fee item 16. This is for filing a request for certification of a document and the amount of the fee is \$25. This is the same as the fee that is charged for the corresponding matter in the *Patents Regulations 1991* and the *Trade Marks Regulations 1995*.