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PO Box 200
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30 November 2021

Via Email: MDB-TechnicalHub@ipaaustralia.gov.au

Re: Design Instruments Consultation

Dear Registrar of Designs:

The Intellectual Property Owners Association (IPO) appreciates the opportunity to provide comments regarding: the draft *Designs (Formal Requirements for Designs Documents) Instrument*; the draft *Designs (Means and Form of Filing Documents) Instrument* (hereinafter “the Instruments”); and other additional items not currently part of the draft *Designs (Formal Requirements for Designs Documents) Instrument* but warranting further consultation and consideration (collectively referred to as “the Instruments”).

IPO is an international trade association representing a “big tent” of diverse companies, law firms, service providers and individuals in all industries and fields of technology that own, or are interested in, intellectual property (IP) rights. IPO membership includes over 125 companies and spans over 30 countries. IPO advocates for effective and affordable IP ownership rights and offers a wide array of services, including supporting member interests relating to legislative and international issues; analyzing current IP issues; providing information and educational services; and disseminating information to the public on the importance of IP rights.

IPO’s mission is to promote high quality and enforceable intellectual property rights and predictable legal systems for all industries and technologies. Our vision is that this will result in the global acceleration of innovation, creativity, and investment necessary to improve lives.

IPO recognizes the importance of the objective of the Instruments to set formal requirements for documents in a design application and to better reflect current Office practice and clarify the application requirements for filers of a design. IPO hopes that our comments below will be helpful during the process of finalizing the Instruments.

I. Designs (Formal Requirements for Designs Documents) Instrument 2022

IPO has the following comments regarding Part 2, Sections 5 and 6 of this document. The relevant portions are reproduced below, prior to the comments pertaining to each.

5 Information that must be included in a design application

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(1) An application filed with the office must include the following information:

...

(c) product name of all products included in the application, enabling classification;

...

(e) an indication of the number of designs in the application;

...

(2) An application for a common design must include an indication that the application is for a common design and a clear and separate product name for each of the products to which the common design relates.

The requirement in paragraph 5(1)(c) that an application include the “product name” of all products in the application could create the mistaken impression that an applicant must include in its application the brand names of the relevant products. This could be particularly confusing since the *Designs Act 2003* does not contain a definition of the term “product name.” IPO suggests that the wording of paragraph 5(1)(c) be amended to read “all products included in the application, enabling classification.”

Paragraph 5(1)(e) requires that an application include an indication of the number of designs in the application. IPO believes that this requirement imposes an unnecessary obligation on an applicant to characterize the nature of its designs. The *Designs Act 2003* permits an applicant to include in a single application: (a) one design in relation to one product; (b) one design that is a common design in relation to more than one product; (c) more than one design in relation to one product; or (d) more than one design in relation to more than one product, if each product belongs to the same Locarno Agreement class. Given this longstanding and flexible approach to the inclusion of more than one design in an application, and because this requirement would not have the effect of simplifying or expediting the registration process, IPO recommends not introducing this new obligation on an applicant.

For the same reasons as discussed with respect to paragraph 5(1)(c), IPO suggests that the wording of subsection 5(2) be amended to replace the words “and a clear and separate product name for each of the products” with “and a list of the products.”

6 Standards for representations

...

(3) At least one of the representations in a design application must include a view of the design showing the product fully assembled without material extraneous to the product.

...

(5) Representations must consist of one common image format, namely:

(a) drawings;

(b) photographs; or

(c) images derived from computer-aided-design.

(6) Representations contained in one application must be consistent in their use of colour across different representations.

(7) Where an application is for a common design, unless the representations showing the design applied to each product would be identical, the

representations must show the design in relation to each product identified in the application on a separate sheet.

With respect to the standards for representations under Section 6, IPO suggests removing requirement (3) calling for at least one representation being a view of the design showing the product fully assembled. IPO submits that Applicants should have the flexibility to illustrate their claimed designs according to their own view selections if the disclosure of the overall appearance of the design is sufficient, which may or may not benefit from a view of the design showing the product fully assembled. IPO believes that the terms of the requirement for a “view of the design showing the product fully assembled without material extraneous to the product” are ambiguous and open to multiple interpretations, and that such a view may or may not be relevant or helpful depending on the design claimed, therefore it should not be a universal requirement. IPO believes that particular view requirements should be discouraged in favor of enabling international filing harmonization and efficiency.

With respect to requirement (5) calling for representations to “consist of one common image format, namely (a) drawings; (b) photographs; or (c) images, derived from computer-aided-design” IPO recommends that it be clarified that representations in the format of photographs or images may include broken lines.

With respect to requirement (6), IPO suggests that this requirement be eliminated, as representations in the form of (a) drawings; (b) photographs; or (c) images, derived from computer-aided-design may purposefully or unavoidably show inconsistent color in different representations. For example, different views could show different shading and photographic images could unavoidably exhibit differing coloration due to lighting and image capture conditions.

For reasons of clarity and efficiency, IPO also suggests the removal of requirement (7) calling for representations showing a common design applied to each product identified in the application unless the representations showing the design to each product would be identical.

II. Designs (Means and Form of Filing Documents) Instrument 2022

IPO has the following comments regarding Part 2, Section 8, and Part 3, Sections 9 and 10 of this document. The relevant portions are reproduced below, prior to the comments pertaining to each.¹

8 Filing using other means

(1) This section sets out the form in which a document, other than a document that is required to be in an approved form, is to be filed using other means.

(2) The document is to be filed in one or more of the following formats:

(a) hard copy document;

¹ IPO noted that the draft instrument uses the spellings “lodgement” and “lodgment” in different sections. IPO has no view on which spelling should be used.

- (b) electronic file on the following physical media:*
- i. Compact disc (CD).*
 - ii. Digital Versatile Disc (DVD).*

Paragraph 8(2)(b) allows a person who wishes to file a document in electronic form to use one of two specified physical media, namely CD and DVD. IPO recommends that the permissible physical media be broadened to include other commonly-used portable physical media such as flash drives and USB drives. Additionally, given that new types of portable physical storage media may be created from time to time, IPO believes that it would be helpful to have a flexible process for allowing such new types of media under paragraph 8(2)(b).

9 Approved means of filing documents

- (1) A document must be filed with the Designs Office using:*
 - (a) the electronic means mentioned in subsection (2); or*
 - (b) the other means mentioned in subsection (3).*
- (2) For paragraph (1)(a), the electronic means are:*
 - (a) Digital lodgment systems;*
 - (b) an API system;*
 - (c) ALS;*
 - (d) ES, if no other electronic means specified in this instrument is available.*

In paragraph 9(2)(d), it appears that “ES” may have been meant to read “EFS.” If not, then IPO would recommend that a definition of “ES” be added to the instrument.

10 Preferred means of filing documents

- (1) The preferred means for filing a document with the Designs Office are:*
 - (a) digital lodgment systems; or*
 - (b) an API system; or*
 - (a) B2B.*
- (2) If a person is attempting to file a document with the Designs Office by a means specified in subsection (1), and the person is unable to do so due to maintenance, the preferred means of filing a document is by ALS.*
- (3) For the purposes of (2), if ALS is unavailable due to a planned or unplanned outage, the preferred means of filing a document is by EFS.*
- (4) Where subsection (3) applies, the person must also complete and file a Declaration for use of Emergency Fax form.*

Section 10 lists the preferred means of filing documents. As such, IPO understands that the preferred means listed in subsection 10(1) were intended to be a subset of the approved means of filing documents listed in section 9, subsections (1) through (3). It is unclear whether “B2B” (referred to in subsection 10(1)) is included within one of the electronic means listed in subsection 9(2) such as being included within the definition of “ALS.” If not, then IPO would recommend that B2B be expressly added to the list of

permitted electronic means in subsection 9(2), so that there is no doubt that an applicant who files a document using B2B has used an approved means of filing.

Additionally, IPO believes that the section number for “B2B” should read “(c)” rather than “(a).”

IPO is concerned about the inclusion of the phrase “if no other electronic means specified in this instrument is available” in paragraph 9(2)(d). If the reference in this section to “ES” was meant to refer to the Emergency Facsimile Service or “EFS,” IPO appreciates that, by its name, this service is meant to be used only in emergencies. However, IPO is concerned that if an applicant incorrectly determines that no other approved means of electronic filing is available and therefore proceeds to file by EFS, its filing may be deemed by the Designs Office to be a nullity. IPO therefore recommends that these words be deleted from paragraph 9(2)(d).

III. Additional Feedback Sought on Potential Formal Requirements

IPO has the following comments regarding Item 1, which is reproduced below, prior to the comments pertaining to it.

Item 1: A representation must not contain any text which disclaims parts of the design which are clearly present unless the representation is labelled as a reference or environmental view.

It appears Item 1 is directed to preventing an applicant from depicting elements in solid lines and using text to disclaim those elements. For example, this item appears to pertain to a situation in which an applicant submits a representation that was not a reference or environmental view and that includes an umbrella handle in solid lines, but also submits text indicating that “Front view with the solid-line umbrella handle is disclaimed and does not form part of the design.”

IPO suggests that it be clarified what is meant by “clearly present.” For example, an element may be clearly depicted in an image representation, but masked by some form of overlay. In that situation (and in similar situations), IPO believes it should be permissible for an applicant to submit a statement that the masked elements are disclaimed, even though they are clearly present. If “clearly present” refers to elements that are depicted in a manner forming part of the claimed design, then the language should be clarified accordingly.

IPO thanks you for your attention to IPO's comments submitted herein, and welcomes further dialogue and the opportunity to provide additional comments.

Sincerely,

A handwritten signature in blue ink, appearing to read "Daniel Staudt". The signature is fluid and cursive, with a long horizontal stroke extending from the end.

Daniel J. Staudt
President