



International Investment Protection

A Global Handbook

Consulting Editor **Clive Thorne**

International Design Protection



A Global Handbook

Consulting Editor **Clive Thorne**

Consulting editor
Clive Thorne

Publisher
Sian O'Neill

Commissioning editor
Katherine Cowdrey

Editor
Carolyn Boyle

Marketing manager
Alan Mowat

Production
Natalie Clarke

Publishing directors
Guy Davis, Tony Harriss, Mark Lamb

International Design Protection: A Global Handbook
is published by

Globe Law and Business
Globe Business Publishing Ltd
New Hibernia House
Winchester Walk
London SE1 9AG
United Kingdom
Tel +44 20 7234 0606
Fax +44 20 7234 0808
Web www.globelawandbusiness.com

Printed and bound by CPI Group (UK) Ltd, Croydon, CR0 4YY

ISBN 978-1-905783-75-5

International Design Protection: A Global Handbook
© 2012 Globe Business Publishing Ltd

All rights reserved. No part of this publication may be reproduced in any material form (including photocopying, storing in any medium by electronic means or transmitting) without the written permission of the copyright owner, except in accordance with the provisions of the Copyright, Designs and Patents Act 1988 or under terms of a licence issued by the Copyright Licensing Agency Ltd, 6-10 Kirby Street, London EC1N 8TS, United Kingdom (www.cla.co.uk, email: licence@cla.co.uk). Applications for the copyright owner's written permission to reproduce any part of this publication should be addressed to the publisher.

DISCLAIMER

This publication is intended as a general guide only. The information and opinions which it contains are not intended to be a comprehensive study, nor to provide legal advice, and should not be treated as a substitute for legal advice concerning particular situations. Legal advice should always be sought before taking any action based on the information provided. The publishers bear no responsibility for any errors or omissions contained herein.



International Design Protection

A Global Handbook

Consulting Editor **Clive Thorne**

Consulting editor

Clive Thorne

Publisher

Sian O'Neill

Commissioning editor

Katherine Cowdrey

Editor

Carolyn Boyle

Marketing manager

Alan Mowat

Production

Natalie Clarke

Publishing directors

Guy Davis, Tony Harriss, Mark Lamb

International Design Protection: A Global Handbook**is published by**

Globe Law and Business

Globe Business Publishing Ltd

New Hibernia House

Winchester Walk

London SE1 9AG

United Kingdom

Tel +44 20 7234 0606

Fax +44 20 7234 0808

Web www.globelawandbusiness.com

Printed and bound by CPI Group (UK) Ltd, Croydon, CR0 4YY

ISBN 978-1-905783-75-5

International Design Protection: A Global Handbook

© 2012 Globe Business Publishing Ltd

All rights reserved. No part of this publication may be reproduced in any material form (including photocopying, storing in any medium by electronic means or transmitting) without the written permission of the copyright owner, except in accordance with the provisions of the Copyright, Designs and Patents Act 1988 or under terms of a licence issued by the Copyright Licensing Agency Ltd, 6-10 Kirby Street, London EC1N 8TS, United Kingdom (www.cla.co.uk, email: licence@cla.co.uk). Applications for the copyright owner's written permission to reproduce any part of this publication should be addressed to the publisher.

DISCLAIMER

This publication is intended as a general guide only. The information and opinions which it contains are not intended to be a comprehensive study, nor to provide legal advice, and should not be treated as a substitute for legal advice concerning particular situations. Legal advice should always be sought before taking any action based on the information provided. The publishers bear no responsibility for any errors or omissions contained herein.



Table of contents

Preface	5	France	127
Clive Thorne		Stefan Naumann	
Reynolds Porter Chamberlain LLP		Hughes Hubbard & Reed LLP	
Australia	7	Germany	135
Timothy Webb		Moritz Hüsich	
Clayton Utz		Katharina Scheja	
		Heymann & Partner Rechtsanwälte	
Austria	23	Hong Kong	147
Roland Deissenberger		Anna Mae Koo	
Deissenberger Rechtsanwälte		Vivien Chan & Co	
Belgium	35	India	163
Karel Nijs		AL Mary	
Philippe Péters		Archana Shanker	
NautaDutilh Brussels		Anand and Anand	
Brazil	49	Ireland	177
Simone Lahorgue Nunes		Anne Bateman	
Levy & Salomão Advogados		Philip Lee Solicitors	
Canada	63	David Brophy	
Graeme Deuchars		FRKelly	
Stuart C McCormack		Israel	191
Stikeman Elliott LLP		Shlomo Cohen	
China	79	Dr Shlomo Cohen & Co	
John Ng		Italy	199
Vivien Chan & Co		Massimiliano Pappalardo	
Denmark	99	La Scala	
Claus Barrett Christiansen		Japan	209
Bech-Bruun		Takamitsu Shigetomi	
Finland	115	Oh-Ebashi LPC & Partners	
Kukka Tommila			
Juridia Ltd			

Netherlands	219	Turkey	353
Marc de Kemp		Dilek Usten	
Wolter Wefers Bettink		Istanbul Patent & Trademark	
Houthoff Buruma		Consultancy Ltd	
New Zealand	231	United Arab Emirates	365
Paul Sumpter		Stephen Jiew	
Chapman Tripp		Al Tamimi & Company	
Norway	241	United Kingdom	371
Kaia Bugge Fougner		Clive Thorne	
Ida Gjessing		Reynolds Porter Chamberlain LLP	
Grette		United States	391
Poland	251	Jared C Bunker	
Justyna Rasiewicz		Lynda Zadra-Symes	
LDS Łazewski Depo & Partners		Knobbe Martens Olson & Bear LLP	
Russia	265	About the authors	407
David Aylen			
Gowlings Russia/CIS			
Singapore	295		
Alban Kang			
ATMD Bird & Bird LLP			
South Africa	307		
Lodewyk Cilliers			
Owen Dean			
Spoor & Fisher			
Sweden	317		
Michael Plogell			
Erik Ullberg			
Wistrand			
Switzerland	329		
Markus Wang			
Bär & Karrer			
Thailand	341		
Vorarit Karadist			
Deissenberger & Partners Ltd			

Preface

Clive Thorne

Reynolds Porter Chamberlain LLP

Design protection deals with an uneasy territory concerned with the protection of mass-produced articles which lack the necessary inventiveness to attract patent protection, but whose appearance plays a part in the choice of the article. This may be because the article as a whole has an aesthetically pleasing shape or because the shape carries some form of embellishment.

Similar issues relating to the scope of design protection exist worldwide. The extent of available protection in different jurisdictions reflects the inherent problems associated with design protection. These include the following:

- It has an uneasy interaction with copyright protection. For example, what should the interaction of the term of protection for designs be with the term of protection for copyright? In most jurisdictions, for example, copyright protection has a term of 70 years plus life, whereas design protection rarely exceeds 25 years. The reason for this is that design law is intended to protect consumer products which have a relatively short technical life, whereas copyright is generally concerned with the protection of artistic works which have a meritorious degree of creativity.
- In most jurisdictions there is a difficult balance between the extent of protection available for purely functional designs as opposed to aesthetic designs (which have a degree of aestheticism or 'eye appeal' attached to them). In the United Kingdom, for example, prior to the Copyright, Designs and Patents Act 1988 the extent of protection given to functional designs proved highly controversial, particularly when the term of protection for aesthetic designs was generally considerably less.
- Similar issues arise with regard to originality. In many jurisdictions, originality based on the extent of skill and labour put into the copyright work provides the basis for copyright protection. It is arguable that similar skill and labour generally arise in the creation of aesthetic designs, but are absent in the creation of purely functional designs where the appearance of the article is of no real concern.
- There is a conflict between registered designs and the protection of unregistered designs. This is shown acutely in the United Kingdom in terms of the contrast between registered design protection and UK unregistered design rights. It is by no means unusual for there to be a finding of unregistered design right infringement at the same time as a finding of non-infringement in respect of a registered design.

- Spare-parts protection has also caused great difficulty. The essentially economic argument runs that there should be no design protection for spare parts on the basis that such protection would be anti-competitive and restrict the ability of the owner of an article to repair the product other than by using spare parts provided by the design owner.

These issues were to the fore when the current UK scheme of design protection was introduced by the Copyright, Designs and Patents Act 1988. In an April 1986 White Paper entitled *Intellectual Property and Innovation*, the UK government stated: "British Industry relies to a great extent on its innovative abilities. It is clear that there are many innovative industrial products which are costly to design but which are not truly inventive and which therefore do not qualify for patent protection. Accordingly, the Government has concluded that some protection should be available to give the manufacturer, who has spent money on design, the opportunity to benefit from its investment, thus providing the incentive to further investment. It is also concluded that the protection should extend to spare parts but it readily accepts that the full protection of copyright law will be excessive." This encapsulates the inherent problems associated with design protection. Similar issues have arisen worldwide.

This is the first attempt to produce an international compendium of design law.

The editor is grateful to all of the contributors for their help, the publishers and, in particular, Katherine Cowdrey and also Maame Djaan, Elena Shemilt and his colleagues at Reynolds Porter Chamberlain.

Clive Thorne is a partner in Reynolds Porter Chamberlain's IP, technology and outsourcing group. He practises all areas of IP law, including patents, designs, copyright, trademarks and trade secrets. He has a particular interest in the arbitration of IP disputes. He has been appointed an International Chamber of Commerce arbitrator on an IT dispute and is on the World Intellectual Property Organisation (WIPO) panel of arbitrators. He is also on the WIPO panel of experts for domain name disputes and has been on the Nominet panel of experts. He has been involved in many of the leading IP disputes in the United Kingdom and overseas. He is particularly experienced in multi-jurisdictional litigation. Mr Thorne is admitted in Hong Kong and Australia. He practised in Hong Kong between 1984 and 1987 and continues to retain practice links in Asia. He has extensive experience in all areas of intellectual property and has authored a number of books, including Users Guide to Design Law, Users Guide to Copyright and Intellectual Property – The New Law.

Australia

Timothy Webb
Clayton Utz

1. Summary of design protection

In Australia, the law of designs is governed by the Designs Act 2003 (Cth) and the Designs Regulations 2004 (Cth), which provide a regime for the grant and protection of exclusive monopoly rights in registered designs within Australia for up to 10 years. The Designs Act came into force on June 17 2004 and replaced the former Designs Act 1906 (Cth) (the 1906 Act). This was the first major reform in designs law in almost 100 years.¹

The Designs Act establishes a registration system under which a national Register of Designs is kept by a Registrar of Designs.² In practice, the register is maintained by IP Australia, the Australian government agency (part of the Department of Innovation, Industry, Science and Research) responsible for granting patent, trademark, industrial design and plant breeder's rights.³ Exclusive rights in designs are only acquired by registration under the Designs Act. They do not automatically exist on creation of the design, as with copyright.

Designs law relates to the overall appearance of products resulting from their visual features, and is separate from the protection of original artistic works under copyright legislation and the protection of the way items function, which can be obtained through patent law.

The designs law regime seeks to encourage innovation in Australian industry and to derive economic benefit from having well-designed products. It aims to balance the incentive to create new designs by providing monopolies for registered designs with the economic effects of granting the monopolies. This balance is achieved under the Designs Act by granting only a limited-term monopoly for 10 years.

2. Registered design rights

2.1 Nature of rights

A rights holder has the exclusive right, during the term of registration of the design:

- (a) to make or offer to make a product, in relation to which the design is registered, which embodies the design;
- (b) to import such a product into Australia for sale, or for use for the purposes of any trade or business;

¹ The old law under the 1906 Act continues to apply to designs registered under that act. This chapter focuses on the Designs Act, but does note some key differences under the 1906 Act.

² Designs Act, Sections 111 and 122.

³ See www.ipaustralia.gov.au/.

- (c) to sell, hire or otherwise dispose of, or offer to sell, hire or otherwise dispose of, such a product;
- (d) to use such a product in any way for the purposes of any trade or business;
- (e) to keep such a product for the purpose of doing any of the things mentioned in paragraph (c) or (d); and
- (f) to authorise another person to do any of the things mentioned above.⁴

These exclusive rights are personal property and may be assigned.⁵ However, an assignment of all or part of the rights holder's interest in the design must be in writing and signed by, or on behalf of, the assignor and the assignee.⁶

2.2 Qualification

Design registration is intended to protect designs that have an industrial application. To qualify for registration, a design must be a 'registrable design' under the Designs Act, which requires that it be 'new' and 'distinctive' when compared with the 'prior art base' for the design as it existed before the 'priority date' of the design.⁷ This is discussed further in section 4 below.

The registered owner of a registered design is the person who is entered in the Register of Designs as the registered owner of the design (which can be one or two or more persons).⁸ Only the following persons are entitled to be entered on the Register of Designs as the registered owner of a design:⁹

- the person(s) who created the design;
- an employer of the creator(s), if the design is made in the course of employment;
- a person who contracted the creator(s) to make the design;
- a person to whom the design has been assigned in writing; or
- a person who derives title to the design by devolution by will or the legal personal representative of a deceased person mentioned above.

If two or more persons fulfil any of these descriptions, they are co-owners of the design. Where there are two or more owners of a registered design, each of those owners is entitled to an equal, undivided share in the exclusive rights in the design.¹⁰ A co-owner is entitled to exercise the exclusive rights in the design for their own benefit without accounting to the other owner or owners. However, a co-owner may not assign or license a design without consent from the other owner(s).

2.3 Registration procedure

The Designs Act provides for a streamlined registration system whereby design applications will only undergo a formalities check before being registered, to ensure

4 Designs Act, Section 10(1).

5 *Ibid.*, Section 10(2).

6 *Ibid.*, Section 11.

7 *Ibid.*, Section 15(1).

8 *Ibid.*, Section 14(1).

9 *Ibid.*, Section 13(1).

10 *Ibid.*, Section 14(2).

that the application contains all relevant information.¹¹ If an application passes this preliminary check, the design is registered and published in the Australian *Official Journal of Designs* and the registered owner receives a certificate of registration.¹²

The Designs Act provides for the process of substantive examination to occur only after registration. Such an examination may occur on the request of any person (which may be the rights holder or a third party), by the registrar on his own initiative or by order of the court.¹³ The registrar is required to consider whether the registration should be revoked and removed from the register on the ground that the design is not a 'registrable design' or any other ground prescribed by the regulations.¹⁴

After examination, if the registrar finds that the design meets all the requirements of the legislation, a certificate of examination will be issued and the design will remain on the register.¹⁵ However, if the registrar finds that the design is not valid, it will be removed from the register.¹⁶

2.4 Term of protection

In Australia, a registered design gives the rights holder a legally enforceable right exclusively to exploit their design for a maximum of 10 years under the Designs Act, unlike copyright which, in Australia, runs for the life of the author plus an additional 70 years.

The Designs Act provides for an initial registration period of five years from the filing date of the design application, with the potential to apply for renewal of the registration for a further five-year period.¹⁷ If the rights holder does not renew the registration, which is subject to renewal fees, it will expire automatically after the five-year period.

The Australian government has reduced the maximum period (it was formerly 16 years under the 1906 Act – an initial period of one year followed by three five-year renewals) to bring Australian law in line with Australia's international obligations under Article 26 of the Agreement on Trade Related Aspects of Intellectual Property (TRIPs Agreement).

2.5 Infringement

It is the responsibility of the person who has registered a design to protect that design. If someone uses it without permission, they may be infringing the registration.

Infringement proceedings can only be started after the design has been examined and a certificate of examination granted. Proceedings must be commenced within six

11 *Ibid*, Sections 39 to 44.

12 *Ibid*, Section 45.

13 *Ibid*, Section 63.

14 *Ibid*, Section 65. Regulation 5.02 of the Designs Regulations states that a prescribed ground is that, under Section 43 of the act, the design should not have been registered. Section 43 provides that the registrar must refuse to register certain designs, including those prescribed by the regulations (Regulation 4.06 prescribes, eg, designs that are scandalous, or might reasonably be taken to be scandalous).

15 Designs Act, Section 67.

16 *Ibid*, Section 68.

17 *Ibid*, Sections 46 and 47.

years of the day on which the alleged infringement occurred.¹⁸ An action may be brought by the rights holder against any person who infringes the monopoly in the registered design. Proceedings cannot be brought by a licensee.

Infringement is discussed in more detail in section 5 below.

2.6 Damages and other relief

In infringement proceedings, a court may grant an injunction and, at the option of the plaintiff, either damages or an account of profits.¹⁹ The court may award such additional damages as it considers appropriate, having regard to the flagrancy of the infringement and all other relevant matters.²⁰

If a successful plaintiff elects for an account of profits rather than an award of damages, the profits that must be accounted for are the infringer's net profits obtained by virtue of the infringing conduct.

A court may refuse to award damages, reduce the damages that would otherwise be awarded or refuse to make an order for an account of profits if the defendant has innocently infringed the registered design. This may occur in the case of 'primary infringement' (ie, the defendant has made or offered to make the product in relation to which the design is registered) if the defendant satisfies the court that, at the time of the infringement, it was not aware that the design was registered and, before that time, took all reasonable steps to ascertain whether the design was registered.²¹ In the case of 'secondary infringement' (ie, all other exclusive rights, such as importing, selling or using for the purposes of trade), the defendant must satisfy the court that, at the time of the infringement, it was not aware, and could not reasonably have been expected to be aware, that the design was registered.²²

2.7 Licensing

The exclusive rights of the rights holder can be licensed just like other forms of intellectual property (IP). The scope of a licence will be governed by the terms of the specific agreement between the licensor and the licensee.

A person does not infringe a registered design if the relevant exclusive act(s) done during the term of registration of the design are done with "the licence or authority of the registered owner of the design".²³ In that context, 'licence' has been held to mean simply 'consent, permission'. It may be express or implied and need not be in writing.²⁴ However, if there are two or more rights holders of a registered design, none of them can grant a licence to exercise the exclusive rights in the design (or assign an interest in the design) without the consent of the others.²⁵ Accordingly, if there are two or more rights holders of a registered design, the licence or authority

18 *Ibid*, Section 71(4).

19 *Ibid*, Section 75(1).

20 *Ibid*, Section 75(3).

21 *Ibid*, Section 75(2)(a).

22 *Ibid*, Section 75(2)(b).

23 *Ibid*, Section 71(1).

24 See *Interstate Parcel Express Co Pty Ltd v Time-Life International (Netherlands) BV* (1977) 138 CLR 534; *Avel Pty Ltd v Multicoin Amusements Pty Ltd* (1990) 171 CLR 88.

25 Designs Act, Section 14(2)(c).

must be sought from each of the co-owners.

Licensing and exploitation are discussed further in section 7 below.

2.8 Compulsory licences

Under the Designs Act, a person may apply to a prescribed court for an order requiring the rights holder of a registered design to grant the person a licence to do anything falling within the rights holder's exclusive rights.²⁶ The application must be made within three years of the date of registration of the design,²⁷ and may not be made unless a certificate of examination has been issued.²⁸

The court may order a compulsory licence if it is satisfied that:²⁹

- products embodying the design have not been made in Australia, to the extent that is reasonable in the circumstances of the case;
- the rights holder has given no satisfactory reason for the failing to exercise the exclusive rights in the registered design; and
- the applicant has tried for a reasonable period, but without success, to obtain from the rights holder an authorisation to do, on reasonable terms and conditions, anything falling within the rights holder's exclusive rights.

A compulsory licence does not give the licensee any exclusive rights in the design, and is assignable only in connection with an enterprise or goodwill in connection with which the licence is used.³⁰ The applicant must pay the rights holder an amount agreed between them or, failing agreement, such amount as is determined by the court to be just and reasonable having regard to the economic value of the licence.³¹

A compulsory licence may be revoked by agreement between the rights holder and licensee, or if a court finds that the circumstances that justified the grant of the licence no longer exist and are unlikely to recur and the legitimate interests of the licensee are not likely to be adversely affected by the revocation.³²

2.9 Validity

As indicated above, a design registration may be revoked by the registrar during the process of examination. In addition, the Designs Act provides two mechanisms for a third party to challenge the validity of a registered design and seek its revocation.

First, a person may apply to the registrar for revocation of the registration of a design on the grounds that a person or persons were entitled persons at the time of the first registration of the design and that one or more of the original rights holders were not so entitled at that time, or that some other person, along with the original rights holders, was also an entitled person at that time.³³

²⁶ *Ibid*, Section 90(1).

²⁷ Designs Regulations 2004 (Cth), Regulation 7.01.

²⁸ Designs Act, Section 90(2).

²⁹ *Ibid*, Section 90(3).

³⁰ *Ibid*, Section 91(2).

³¹ *Ibid*, Section 92(4).

³² *Ibid*, Section 91(5).

³³ *Ibid*, Sections 51 to 56.

Second, a person may apply to a prescribed court for an order revoking the registration of a design.³⁴ Such an application may be made only after the design has been examined and a certificate of examination has been issued.³⁵ The grounds on which a court may revoke the registration of the design are that:³⁶

- the design is not a registrable design;
- one or more of the original rights holders was not entitled to be a rights holder;
- there were other persons entitled to be rights holders at the time the design was registered;
- the registration of the design was obtained by fraud, false suggestion or misrepresentation; or
- the design is a corresponding design to an artistic work, and copyright in the artistic work has ceased.

If a design was registered under the 1906 Act, the previous law will continue to apply for the purposes of determining the validity of the registration of the design.³⁷

3. **Unregistered design rights**

Copyright protection under the Copyright Act 1968 (Cth) arises automatically on the creation of a work, provided it is original, and there is no registration system for copyright in Australia. The visual features of a product may constitute an artistic work in which copyright subsists under the Copyright Act. 'Artistic work' is defined in the Copyright Act to mean:

- (a) a painting, sculpture, drawing, engraving or photograph, whether the work is of artistic quality or not;
- (b) a building or a model of a building, whether the building or model is of artistic quality or not; or
- (c) a work of artistic craftsmanship whether or not mentioned in paragraph (a) or (b).³⁸

Thus, it is possible that a design might be embodied in a 'product' within the meaning of the Designs Act and be an 'artistic work' within the meaning of the Copyright Act. A painting that is applied as part of wallpaper and a sculpture that is mass-manufactured as a decorative item for the home are clear examples.

This potential overlap between the protection offered under the Designs Act and that offered under the Copyright Act has a long and complex history in Australia. It is presently dealt with in Sections 74 to 77 of the Copyright Act. At the same time as the Designs Act came into force on June 17 2004, a separate piece of legislation relating to designs law came into force altering these 'copyright/design overlap' provisions of the Copyright Act.

In simple terms, this technical area of the Copyright Act is designed to remove

³⁴ *Ibid*, Section 93(1).

³⁵ *Ibid*, Section 93(2).

³⁶ *Ibid*, Section 93(3).

³⁷ *Ibid*, Section 151(3).

³⁸ Copyright Act, Section 10(1).

copyright protection for certain copyright works which are exploited industrially. However, the previous provisions gave rise to differing interpretations and were subject to criticism. The amendments are designed to provide clarity to this area of the law and to close a number of loopholes and anomalies which had developed.

The intention is that these amendments should better reflect the underlying policy that:

- artistic works which are industrially exploited as three-dimensional designs should be denied copyright protection and instead be subject to design protection; and
- artistic works which are exploited as two-dimensional designs should continue to receive copyright protection and be entitled to dual protection by design registration, where available.

Under the regime applying since June 17 2004, where copyright subsists in an artistic work and a corresponding design is or has been registered under the 1906 Act or the Designs Act it is not an infringement of that copyright to reproduce the work by embodying that, or any other, corresponding design in a product.³⁹ A 'corresponding design', in relation to an artistic work, is defined to mean "visual features of shape or configuration which, when embodied in a product, result in a reproduction of that work, whether or not the visual features constitute a design that is capable of being registered under the Designs Act 2003".⁴⁰ Notably, registration of a corresponding design as a design under the Designs Act does not extinguish the copyright in the artistic work, but provides a defence to infringement allegations as a result of reproduction of the artistic work.

Further, even where a corresponding design has not been registered under the 1906 Act or the Designs Act, there is a defence to actions for infringement of copyright in an artistic work if the corresponding design of a three-dimensional article is 'applied industrially', whether in Australia or elsewhere, by or with the licence of the owner of the copyright in the place of industrial application.⁴¹ The regulations made under the Copyright Act specify that a design is taken to be applied industrially if it is applied to more than 50 articles or to one or more articles (other than hand-made articles) manufactured in lengths or pieces.⁴² However, this regulation is a deeming provision only, and industrial application will be found if on the facts one or more products embodying the corresponding design have been made under a manufacturing process for the systematic production of articles.⁴³

There are exceptions for artistic works that are buildings, models of buildings or works of artistic craftsmanship.⁴⁴ Even if these artistic works are industrially applied, the copyright owner may bring proceedings for infringement of copyright unheeded

39 *Ibid*, Section 75.

40 *Ibid*, Section 74(1).

41 *Ibid*, Sections 77 and 77A.

42 Copyright Regulations 1969, Regulation 17.

43 See *Safe Sport Pty Ltd v Puma Australia Pty Ltd* (1985) 4 IPR 120 at 126; *Kevlacat Pty Ltd v Trailcraft Marine Pty Ltd* (1987) 11 IPR 77 at 88 to 89; and *Press-Form Pty Ltd v Henderson's Ltd* (1993) 26 IPR 113 at 121, cited in Lahore, James and Warwick Rothnie, *Copyright and Designs* (3rd revised edn, looseleaf) at [64,500].

44 Copyright Act, Section 77(1)(a).

by the defence in Sections 77 and 77A, unless a corresponding design is or has been registered as a design, in which case the Section 75 defence to copyright infringement will apply.

4. Qualification for protection

4.1 What is a 'design'?

In the Designs Act 'design', in relation to a product, means "the overall appearance of the product resulting from one or more visual features of the product".⁴⁵ 'Product' is defined as a thing that is manufactured or hand-made.⁴⁶ The Designs Act provides that "visual feature, in relation to a product, includes the shape, configuration, pattern and ornamentation of the product".⁴⁷

Shape and configuration primarily refer to three-dimensional features of the product, such as the form of a vase or the shape of a light bulb. Pattern and ornamentation generally refer to two-dimensional features, as might appear on wallpaper or a carpet. However, there can be overlap between these visual features, as in the case of diagonal ribbing applied to a rubber hot-water bottle⁴⁸ or decorative plates applied to a coffin.⁴⁹

The feel of the product, its materials and the repeat features of its pattern or shape are not considered visual features under the Designs Act,⁵⁰ nor are features that convey the method or principle of construction.⁵¹

Importantly, the definition of visual features is non-exhaustive, and colour is an example of an additional, potentially relevant visual feature. As stated by Graham J in *Smith Kline & French Laboratories Ltd's Design Application*:⁵² "[c]olour may or may not make a material difference, depending upon the circumstances and nature of the design in question".⁵³ It is true that normally differences in colour are unlikely to be important. Generally, the alteration of a colour in a design would be regarded as being in the nature of a trade variant. However, in other cases colour may be an essential feature of the design.⁵⁴

While a visual feature may serve a functional purpose,⁵⁵ the registration of a design does not protect the function itself. Protection of this nature falls within the domain of patent law.

4.2 What is a 'registrable design'?

To qualify for registration a design must be a 'registrable design' under the Designs

45 Designs Act, Section 5.

46 *Ibid*, Section 6(1).

47 *Ibid*, Section 7(1).

48 See *Cow (PB) & Co Ltd v Cannon Rubber Manufacturers Ltd* [1959] RPC 347.

49 See *Re Rollason's Registered Design* (1898) 15 RPC 441.

50 Designs Act, Section 7(3).

51 See *Firmagroup Australia Pty Ltd v Byrne & Davidson Doors (Vic) Pty Ltd* (1987) 9 IPR 353.

52 [1974] RPC 253 at 261.

53 More recently, see *Review 2 Pty Ltd v Redberry Enterprise Pty Ltd* (2008) 79 IPR 214.

54 For a detailed analysis of the role of colour in registered designs, see Webb, Timothy, 'She Comes in Colours Ev'rywhere: law and practice at the intersection of fashion and registered designs' (2009) 79 *Intellectual Property Forum (Journal of the Intellectual Property Society of Australia and New Zealand)* 11.

55 Designs Act, Section 7(2).