

**Professional Standards Board
For Patent and Trade Marks Attorneys**

2001 Examination

Topic Group I

Designs

(Time Allowed: 3 hours 30 minutes)

Instructions to Candidates

- 1 Standard required to pass: 50%
- 2 Reading time: 10 minutes
- 3 Candidates should attempt ALL questions
- 4 The maximum mark attainable for each question is indicated beside the question number.
- 5 Unless otherwise stated, questions relate to the Designs Act 1906 and the Copyright Act 1968.
- 6 All candidates may take into the examination an unannotated copy of the Designs Act 1906 and Regulations pertaining to that Act, and the Copyright Act 1968.

Question 1 (15 marks)

Discuss how Australian courts have dealt with the following issues:

- (a) The distinction between the terms “new” and “original”. (3 marks)
- (b) “Applied industrially” as defined in the Copyright Regulations. (4 marks)
- (c) “Trade variant” as used in section 17(1) of the Designs Act. (4 marks)
- (d) “Prior publication”. (4 marks)

Question 2 (20 marks)

Your firm is approached for advice by Barry Corporation Limited, a United States company which has the world wide marketing rights to merchandise based on a fictional character, Barry Otter, created by author J K Bowlings. Bowlings has written a series of illustrated books featuring a pesky little furry swimming animal which resembles an otter, and those books are widely and avidly read around the world, including Australia. The company asks whether it needs to file any applications for design or copyright protection in Australia to protect its intellectual property prior to launching the products in Australia. It advises that it intends to market a series of toys

based on Barry including pool toys, furry soft toys, plastic miniatures, and motorised squeak toys. In addition the company wishes to market a series of clothes featuring Barry, as well as bed linen, wall paper, pens, paper, and cups and plates. The company may wish to expand into other product lines at some later date. Some Barry merchandise has been sold in USA, but none has yet been sold in Australia. They mention that last year, during a book launch in Australia, they gave away free Barry “dolls” and those have become collector items cherished by young Barry fans in this country. The company advises that it is important to be able to take action quickly in the event of counterfeit goods entering the country, and the protection they are looking for should be such that would allow them to act without delay. Write a letter of advice.

Question 3 (25 marks)

Mining and excavation through hard rock typically requires the use of explosives to break up the rock body. The process of excavation involves drilling a matrix of holes in the rock face, and filling each of the holes with an explosive charge. The explosive charges are then linked together by some form of detonation initiator, which may be in the form of fuse cord, or an electronic detonation harness.

Your client, Alpha Corp, has developed a new form of explosive charge. A standard explosive charge is in the form of a cylindrical rod which has a diameter slightly less than the diameter of the drilled hole. Your client’s product is somewhat different. It is also of elongate shape but whilst each end region is of standard diameter, it has a central region of reduced diameter. There is a tapered portion connecting each end region to the central region.

Alpha Corp has conducted tests with the new explosive charges and found them to be about 20% more efficient than the standard charge. This would allow a saving of 20% to be made in the cost of explosives for a typical mining operation.

The technical director of Alpha Corp was so excited by the test results that he arranged for an underground demonstration of the product. Engineers from ten of Alpha’s main customers were invited to the demonstration. The demonstration involved showing the engineers a predrilled rock face, dividing the face into two halves, inserting the new explosives into one half, and standard explosives into the other half, and connecting the explosives with a detonation harness. The new explosives were not off a production line but were in fact hand wrapped, although it would have been difficult to distinguish the test explosives from machine made product. About 100 of the new charges were used in the test. The engineers then retired above ground, the face was blasted, and they returned below ground to compare the results. The results were indeed impressive.

Alpha Corp now realises that this new explosive charge could be an extremely profitable product line for them. They ask your firm to advise on whether they would be able to obtain valid design protection for their new product in Australia. The partner in charge of the matter asks you to prepare a memorandum of advice, referring to decided cases as appropriate, and giving full reasons, so that he can prepare a letter

for the client. Write that memorandum of advice. It is not necessary to advise on possible patent protection. **(15 marks)**

Alpha Corp advises that it also wishes to obtain design protection for the new product in USA, Japan, and Germany. For those countries advise:

- i) Is this type of product registrable as a design?
- ii) How long would design protection last?
- iii) Would the underground demonstration have destroyed the novelty of the design?
- iv) Is there a grace period within which to file a design?

(10 marks)

Question 4 (20 marks)

Discuss the registrability of the following, assuming, unless otherwise stated, that the specific subject matter referred to has not previously been published or used. Refer to decided cases to support your view:

- (a) A bus shelter.
- (b) A transparent surfboard wherein the novelty lies solely in the feature of transparency.
- (c) A straw having a concertina-like region to allow bending at a variety of angles.
- (d) A gun-barrel internally “rifled” with a novel system of grooves.
- (e) A group of six differently shaped plastic pieces which can be assembled to form a solid “Sydney Opera House”.

Question 5 (20 marks)

A manufacturer of glass products shows you his latest wine glass design which not only has a particularly novel shape designed by the manufacturer himself but is also embellished with a motif, designed by an artist friend, etched into the surface of the glass. An etching on which the motif is based has been displayed in a local art gallery for several months. The manufacturer is concerned his new glass design may be copied.

- (a) Write a letter advising the manufacturer what action should be taken to fully protect his design and making any further suggestions or recommendations which may assist your client. **(14 marks)**

(b) In the light of your answer to part (a), what action could be taken in the event that a third party applied the motif to:

- (i) a vase having a well-known shape.
- (ii) a dinner plate.
- (iii) a transfer with instructions for the application thereof to glass and ceramic ware.

(6 marks)