

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

2000 Examination

Subject “I”

**Designs Law of Australia
And the practice of the Designs Office**

(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 marks attainable for each question are indicated beside the question number.
- 5 Unless otherwise stated, questions relate to the Designs Act 1906 and the Copyright Act 1968.
- 6 All candidates make 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 (25 marks)

In answering the following questions, reference should be made to pertinent decided cases, where appropriate.

- a. Explain the purpose of the “Statement of Monopoly” and “Statement of Novelty” and the circumstances when they may be required. Does a “Statement of Monopoly” have the effect of increasing the scope of protection or decreasing the scope of protection?
(5 marks)
- b. Explain the time limits prescribed for the following actions under the Design Act and any remedial provisions available should these time limits not be complied with:
 - i. Gaining acceptance of an application following an Examiner’s Report.
 - ii. Extending the period of registration beyond its initial one year term.
(5 marks)
- c. What is the maximum period of registration of an Australian design with all possible extensions included. Under what circumstances can the registration expire within this period despite the granting of an extension or extensions.
(3 marks)

- d. Explain how you would deal with the following objections to an application for registration of a design in Australia from an Examiner:
- i. That the design was not new or original because the Examiner cites a document published 55 years ago.
 - ii. That the design is too similar to an earlier 1994 registration by the present applicant. The earlier registration was due for renewal in August 2000 but the renewal fee was not paid on the registered proprietor's instructions.
 - iii. That the design of a telephone handset base is not adequately shown in the representations because there is no view of the underside of the base.
 - iv. That the title of the design application is "a cap" but the representations show the cap on a container.

(12 marks)

Question 2 (15 marks)

- (a) Discuss with reference to decided cases the meaning of the expression "new or original" as used in Section 17 of the Designs Act 1906.
- (b) Your client, a designer has created a set of three desk designs X, Y and Z with a particularly striking artistic shape. The desks have been displayed at the Museum of Contemporary Art and have caused a great deal of interest. An uncle of the designer has made 45 copies of one of the desk designs X and sold them to family friends. A furniture manufacturer B has now commenced manufacture of the desk designs Y and Z. A rival manufacturer C has approached your client and wishes to manufacture all the desk designs. Write a letter of advice to your client explaining his rights and how he can protect them.

(5 marks)

(10 marks)

Question 3 (20 marks)

Your client A is an artist who sketches ancient buildings and ruins. He sketches a "reconstruction" of ancient Spanish Church which was partially destroyed by earthquake in the 7th century. The sketch attracts wide publicity and is published in a Spanish tourist brochure with A's permission. The brochure is displayed in the Australian Office of the Spanish Tourist Bureau.

B Ltd, a Spanish company makes executive desk accessories based on ancient buildings and uses A's sketch as a model for its latest design. B Ltd obtains design registration for the desk accessory in Spain, the accessories go on sale and within three months are on sale in Australia. A is upset by the Spanish company "ripping off" his reconstruction and applies for registration of the desk accessory in Australia and obtains registration shortly thereafter. B Ltd then applies for registration of its design in Australia claiming priority under the International Convention provisions.

A notes that B Ltd's advertising refers to a pending Australian design application and approaches you for advice. He is not particularly concerned about making desk accessories but wants to stop B Ltd using his sketch. Fully advise your client, assuming that he owns the copyright subsisting in his sketch as an "artistic work" by virtue of the Australian Copyright Act 1968.

Question 4 (20 marks)

Your firm is asked for advice by an overseas associate who is acting on behalf of a large Italian motor car manufacturer. The associate advises that its client, L. Co, sells large numbers of its cars around the world. As part of its development and advertising program L. Co engages in rally car racing on the international circuit. Its 2001 GT development car has been raced extensively this year and is doing extremely well, and it is anticipated that this will lead to a significant boost in production car sales to the general public around the world. Indeed, the Australian leg of the circuit was won by the GT 2001, and the driver of the car, one Fangio de la Rossi, was featured on the front page of the Sydney Morning Herald, seated on the bonnet of his car.

As anyone who is interested in top-level rally racing would know, the different works teams keep details of developments and improvements made to the cars secret. Only the mechanics and team officials would generally have access to the cars, and the cars' engines. However, during the staging of the Australian race Fangio suffered a mechanical problem on one of the more spectacular legs of the race which caused him and his co-driver to raise the bonnet of the car to give urgent attention to the fuel injection system. Eager spectators crowded around and photographed the car, the engine, and captured for posterity the general scene. One of those general scene photographs was published in the Herald, alongside the aforementioned Fangio picture.

It now turns out that the disposable air filter mounted on top of the engine of Fangio's 2001 GT is intended for use in the production car version of the 2001 GT. The filter was of course visible when the bonnet was open. As this is a replacement part it is desirable to protect the air filter by way of design protection, for otherwise non-authorized manufacturers will produce copies almost immediately the production cars are sold. As you would know, replacement parts form a significant component of the profit margin made by manufacturers of motor vehicles.

The managing partner of your firm, who you would like to impress, asks you to provide a detailed memorandum of advice, referring to relevant decided cases, on whether it would be possible to protect the design of the air filter in Australia. Prepare that memorandum.

(15 marks)

Would the substance of your advice be different if your associate advised that the air filter had been in full production in Italy but that none of the product had yet been sold or distributed in Australia.

(5 marks)

Question 5 (20 marks)

Your client has manufactured hockey sticks for many years and runs a successful business, supplying some 50% of the quality sticks used in Australia, and has recently expanded her sales into many overseas countries. Hockey sticks have undergone subtle changes over the years, not only in materials of manufacture, but also in shape and flexibility. A threat to your client's business is that new production facilities are springing up around the world and good quality sticks are now being manufactured in a number of countries where hockey is popular.

Your client has recently been working on a new design which, although not a radical departure from prior sticks, is indeed different. The new design involves providing in the rear side of the lower part of the stick, just above the curved head of the stick, a series of three parallel longitudinal grooves, the grooves each being about 10cm long. The grooves provide more flexibility and whip for the stick causing a sweetly struck ball to travel much faster, but with just as much control, as conventional designs.

Just prior to the gold medal game of the Olympics your client suggested to Alyson Annan, one of the stars of the Australian team, that she might like to give the new stick a trial run. Alyson had a few hits and was so impressed that she decided to use the stick in the game against Argentina. It was the stick in question with which she scored the first goal of the game. The stick can indeed be seen, albeit unclearly, in the front page newspaper photographs taken of the team with their gold medals proudly displayed.

All of the other players in the team are now clamouring for one of the new sticks and your client has suddenly realised that she has not yet applied for design protection for her new stick. She feels it will only be a matter of time before the overseas manufacturers copy the design, and because the overseas production costs are lower, she will find it difficult to compete on price.

(a) Advise your client, with reasons, whether it will be possible to obtain valid design protection for the new stick in Australia. (Do not advise on possible patent protection).

(8 marks)

(b) Your client also would like to obtain design protection in Germany, UK, Japan and USA. Advise, for each of those countries, giving brief reasons:

(i) whether a design of that type would be registrable;

(ii) the maximum period of the registration;

(iii) whether the aforementioned set of circumstances would have the effect of destroying the novelty of the design.

(12 marks)