



# Designs Amendment Act 1981

No. 42 of 1981

---

## An Act to amend the *Designs Act 1906*, and for related purposes

[Assented to 13 May 1981]

BE IT ENACTED by the Queen, and the Senate and the House of Representatives of the Commonwealth of Australia, as follows:

### PART I—PRELIMINARY

#### Short title

1. This Act may be cited as the *Designs Amendment Act 1981*.

#### Commencement

2. (1) Sections 1 and 2 shall come into operation on the day on which this Act receives the Royal Assent.  
(2) Section 31, Part IV and sub-section 36 (2) shall come into operation on a date to be fixed by Proclamation.  
(3) The remaining provisions of this Act shall come into operation on a date to be fixed by Proclamation.

### PART II—AMENDMENTS OF THE DESIGNS ACT 1906

#### Principal Act

3. The *Designs Act 1906*<sup>1</sup> is in this Part referred to as the Principal Act.

#### Title

4. The title of the Principal Act is amended by omitting “Copyright in Industrial Designs” and substituting “designs”.

5. Sections 4, 4A, 4B and 5 of the Principal Act are repealed and the following sections substituted:

**Interpretation**

“4. (1) In this Act, unless the contrary intention appears—

‘article’ means any article of manufacture and includes a part of such an article if made separately;

‘artistic work’ has the same meaning as in the *Copyright Act* 1968;

‘Australia’ includes Norfolk Island;

‘Convention country’ means a country in respect of which there is in force for the time being a Proclamation under section 48 declaring that country to be a Convention country for the purposes of this Act;

‘corresponding design’ has the same meaning as in Division 8 of Part III of the *Copyright Act* 1968;

‘Deputy Registrar’ means the Deputy Registrar of Designs holding office under this Act;

‘design’ means features of shape, configuration, pattern or ornamentation applicable to an article, being features that, in the finished article, can be judged by the eye, but does not include a method or principle of construction;

‘monopoly’, in relation to a registered design, means the exclusive right to apply the design to an article in respect of which the design is so registered;

‘*Official Journal*’ means the Official Journal referred to in section 175 of the *Patents Act* 1952;

‘owner’ means—

- (a) in relation to a design that is not a registered design—a person who is the owner of the design in accordance with section 19 or, if there are 2 or more persons who have an interest in the design in accordance with that section, each of those persons; or
- (b) in relation to a registered design—the person who is registered as the owner of the registered design or, if there are 2 or more such persons, each of those persons;

‘prescribed court’ means the Supreme Court of a State, the Supreme Court of the Australian Capital Territory, the Supreme Court of the Northern Territory of Australia or the Supreme Court of Norfolk Island;

‘register’ means the Register of Designs under this Act;

‘registered’ means registered under this Act;

‘registered design’ means a design registered under this Act;

‘Registrar’ means the Registrar of Designs holding office under this Act;

‘representation’, in relation to an article to which a design is applied, means a drawing, tracing or specimen of the article to which the design is applied or a photograph of such a drawing, tracing or specimen;

**‘set of articles’** means a number of articles that are of the same general character and ordinarily on sale, or intended to be used, together, being articles to each of which there is applied a design that is the same as, or that differs only in immaterial details or in features commonly used in the relevant trade from, the design applied to the other articles or to any of them;

**‘State Designs Act’** means any State Act relating to the registration of designs;

**‘statement of monopoly’**, in relation to a design, means a statement relating to the representations of an article to which the design is applied that indicates—

- (a) those features of the representations in respect of which the applicant for registration of the design wishes to claim a monopoly; and
- (b) those features of the representations that are to be disregarded in considering the extent of the monopoly protection;

**‘statement of novelty’**, in relation to a design, means a statement relating to the representations of an article to which the design is applied that indicates those features of the representations in respect of which novelty or originality is claimed.

**“(2) A reference in this Act to an article shall be read as including a reference to—**

- (a) a set of articles;
- (b) each article in a set of articles; or
- (c) both a set of articles and each article in that set,

**as the case requires.**

#### **References to prescribed court**

**“5. A reference in this Act to a prescribed court shall—**

- (a) in relation to the institution of an appeal or other proceeding, be read as a reference to a prescribed court having jurisdiction with respect to matters arising under this Act in respect of which the appeal or other proceeding is instituted; and
- (b) in relation to the exercise of jurisdiction, be read as a reference to a prescribed court exercising jurisdiction in accordance with section 40G.

#### **Crown to be bound**

**“5A. This Act binds the Crown in right of the Commonwealth, of each of the States, of the Northern Territory and of Norfolk Island.**

#### **Application of Act to Norfolk Island**

**“5B. (1) This Act extends to Norfolk Island.**

**“(2) An application for registration of a design is not receivable under a law (other than this Act) in force in Norfolk Island.”.**

**Registrar and other officers**

6. Section 8 of the Principal Act is amended by omitting sub-section (3) and substituting the following sub-sections:

“(3) There shall be a Deputy Registrar of Designs, who shall, subject to the control of the Registrar, have all the powers and functions of the Registrar under this Act, other than the powers of the Registrar under section 8A.

“(4) Until the Governor-General otherwise determines, the Deputy Commissioner of Patents shall be the Deputy Registrar of Designs.

“(5) A power or function conferred or imposed on the Registrar by this Act, when exercised or performed by the Deputy Registrar, shall, for all purposes, be deemed to have been exercised or performed by the Registrar.

“(6) There shall be one or more Assistant Registrars of Designs.”.

7. After section 8 of the Principal Act the following section is inserted:

**Delegation by Registrar**

“8A. (1) The Registrar may, either generally or as otherwise provided by the instrument of delegation, by writing signed by him, delegate to an Assistant Registrar of Designs any of his powers or functions under this Act, other than this power of delegation.

“(2) A power or function so delegated, when exercised or performed by the delegate, shall, for the purposes of this Act, be deemed to have been exercised or performed by the Registrar.

“(3) A delegation under this section does not prevent the exercise of a power or the performance of a function by the Registrar.”.

**Repeal of Part III of Principal Act**

8. Part III of the Principal Act is repealed.

**New or original design may be registered**

9. Section 17 of the Principal Act is amended—

(a) by omitting sub-section (1) and substituting the following sub-sections:

“(1) Subject to this Act, a design shall not be registered unless it is a new or original design and, in particular, shall not be registered in respect of an article if the design—

(a) differs only in immaterial details or in features commonly used in the relevant trade from a design that, before the priority date in respect of the application for registration, was registered, published or used in Australia in respect of the same article; or

(b) is an obvious adaptation of a design that, before the priority date in respect of the application for registration, was registered, published or used in Australia in respect of any other article.

“(1A) For the purposes of sub-section (1), account shall not be taken of any secret use.”; and

(b) by omitting from sub-section (2) “or for articles included in such classes of articles,”.

**Certain designs not to be treated as other than new or original, &c.**

**10. Section 17A of the Principal Act is amended—**

- (a) by omitting from paragraph (1) (c) “, or articles included in a class of articles, specified in regulations made for the purposes of sub-section (2) of the last preceding section” and substituting “specified in regulations made for the purposes of sub-section 17 (2)”; and
- (b) by omitting from sub-section (2) “the last preceding sub-section” and substituting “sub-section (1)”.

**11. Sections 18, 19, 20, 21 and 22 of the Principal Act are repealed and the following sections substituted:**

**Design may include functional features**

“18. An application for registration of a design shall not be refused, and a registered design is not invalid, by reason only that the design consists of, or includes, features of shape or configuration that serve, or serve only, a functional purpose.

**Owner of unregistered design**

“19. (1) Subject to this section, the author of a design is the owner of the design.

“(2) Where, in accordance with an agreement for valuable consideration entered into by a person with another person, the other person or an employee of the other person acting in the course of his employment makes a design for the first-mentioned person, the first-mentioned person is the owner of the design.

“(3) Subject to sub-section (2), where a design is made by a person in the course of his employment with an employer, the employer is the owner of the design.

“(4) The owner of a design or the assignee of any interest in a design may, by instrument in writing signed by him or on his behalf, assign to another person the whole or any part of his interest in the design.

“(5) In this section, ‘design’ does not include a registered design.

**Application for registration**

“20. (1) The owner of a design is entitled to make application for the registration of the design.

“(2) Where 2 or more persons own interests in a design, all of the persons owning such interests, acting jointly, are entitled to make application for the registration of the design.

“(3) An application for registration of a design—

- (a) shall be in accordance with a prescribed form;
- (b) shall be accompanied, as prescribed, by the prescribed number of representations of an article to which the design is applied; and

- (c) shall be lodged by being left at, or delivered by post to, the Designs Office or a sub-office.

“(4) An application under sub-section (3) may be accompanied by a statement of monopoly in respect of the design to which the application relates.

“(5) Upon lodgment of an application under sub-section (3)—

- (a) the Registrar may request the applicant to furnish a statement of novelty in respect of the design to which the application relates; and
- (b) if the application was not accompanied by a statement of monopoly in respect of the design to which the application relates and the Registrar considers it appropriate that such a statement be furnished—the Registrar may request the applicant to furnish such a statement.

### **Priority date**

“21. (1) There shall be a priority date in respect of an application for the registration of a design.

“(2) Subject to this Act, the priority date in respect of an application for registration of a design is the date on which the application was lodged under this Act.

### **Registered design not to be invalid by reason of certain circumstances**

“22. A registered design is not invalid by reason only of—

- (a) the publication or use of the design in Australia on or after the priority date in respect of the application for registration of the design; or
- (b) the registration of another design the application in respect of which has the same or a later priority date.

### **Death of applicant**

“22A. (1) If an applicant for the registration of a design dies before the design is registered, his legal personal representative may be registered as the owner of the design.

“(2) Where, at any time after a design has been registered on an application, the Registrar is satisfied that the applicant had died or, in the case of a body corporate, had ceased to exist, before the design was registered, the Registrar may amend the relevant entry in the register by substituting for the name of the applicant the name of the person who ought to have been registered as the owner of the design.

“(3) Where the Registrar has amended an entry in the register under sub-section (2), the registration has effect, and shall be deemed always to have had effect, accordingly.

### **Amendment of application, &c.**

“22B. (1) The Registrar may, on request made to him in the prescribed manner, amend an application for registration of a design lodged under this Act.

“(2) An appeal lies to a prescribed court from a refusal by the Registrar to amend an application under sub-section (1).

“(3) In this section—

‘amend’, in relation to a representation of an article to which a design is applied, includes the substitution of one representation for another representation;

‘application for registration of a design’ includes the representations of the article to which the design concerned is applied and any statement of monopoly or statement of novelty in respect of the design.

#### **Division of application after amendment**

“22C. (1) Where—

- (a) an amendment of an application for registration of a design has been made under section 22B; and
- (b) the amendment has the effect of excluding a design or designs from the application,

the applicant may, at any time before the registration, or the refusal of the registration, on that application, of a design, make a further application (in this section referred to as a ‘divisional application’) for registration of the design, or each design, so excluded.

“(2) For the purposes of this Act, a divisional application for registration of a design shall be deemed to have been lodged under this Act on the date on which the original application for registration of the design was so lodged and the priority date in respect of such a divisional application is the priority date in respect of the original application.”.

#### **Registrar may register design**

**12. Section 23 of the Principal Act is amended—**

- (a) by omitting “applicant is the owner thereof” and substituting “applicant is, or the applicants are, entitled to make the application”; and
- (b) by adding at the end thereof the following sub-sections:

“(2) For the purpose of deciding whether the design is new or original, the Registrar may cause such searches to be made as he thinks fit.

“(3) The registration of a design shall be a registration in respect of the article specified in the application.”.

**13. Sections 24, 24A and 25 of the Principal Act are repealed and the following sections substituted:**

#### **Registrar may refuse to register design**

“24. (1) Subject to sub-section (2), the Registrar may refuse to register a design, either generally or in respect of the article specified in the application for registration.

“(2) The Registrar shall not refuse to register a design until the applicant, or each of the applicants, has been given an opportunity of being heard.

“(3) An appeal lies to a prescribed court from a refusal by the Registrar to register a design.

### **Monopoly in design**

“25. Subject to section 25A, the owner of a registered design has a monopoly in that design.

### **Co-ownership of registered design**

“25A. (1) Where there are 2 or more owners of a registered design, each of those owners is, unless an agreement to the contrary is in force, entitled to an equal undivided share in the monopoly in that design.

“(2) Subject to this section and to section 25B, where there are 2 or more owners of a registered design, each of those owners is, unless an agreement to the contrary is in force, entitled, by himself or his agents, to make use of the design for his own benefit without accounting to the other or others.

“(3) Subject to section 25B and to any agreement for the time being in force, where there are 2 or more owners of a registered design, one of those owners shall not grant a licence with respect to the use of the design, or assign an interest in the design, except with the consent of the other or others.

“(4) Where an article to which a registered design has been applied is sold by one of 2 or more owners of the design, either by himself or his agents, the purchaser, and a person claiming through him, is entitled to deal with the article in the same manner as if it had been sold by both or all of the owners.

“(5) Nothing in sub-section (1) or (2) affects the rights or obligations of a trustee or of the legal personal representative of a deceased person, or rights or obligations arising out of either of those relationships.

### **Power of Registrar to give directions to co-owners**

“25B. (1) Where there are 2 or more owners of a registered design, one or more of those owners may make application to the Registrar to give such directions as to a dealing with the design or an interest in the design, the grant of licences with respect to the design or the exercise of a right under section 25A in relation to the design, as he thinks fit.

“(2) Upon application made to the Registrar under sub-section (1), the Registrar shall, if he is satisfied that a direction should be given in relation to the matter raised in the application, give such a direction as he thinks appropriate but, if he is not so satisfied, shall refuse to give a direction.

“(3) If an owner, within 14 days after being requested in writing by one of the other owners to execute an instrument or to do some other thing required for the carrying out of a direction given under sub-section (2), fails to execute that instrument or to do that thing, one of those other owners may make



*Designs Amendment No. 42, 1981*

application to the Registrar to give directions empowering a person to execute that instrument or to do that thing in the name and on behalf of the owner in default.

“(4) Upon application made to the Registrar under sub-section (3), the Registrar shall, if he is satisfied that a direction should be given in relation to the matter raised in the application, give such a direction as he thinks appropriate but, if he is not so satisfied, shall refuse to give a direction.

“(5) Before giving a direction under this section, the Registrar shall give an opportunity to be heard—

- (a) in the case of an application under sub-section (1)—to the other owner or owners; or
- (b) in the case of an application under sub-section (3)—to the owner in default.

“(6) A direction shall not be given under this section if it—

- (a) would affect the rights or obligations of a trustee or of the legal personal representative of a deceased person, or rights or obligations arising out of either of those relationships; or
- (b) would be inconsistent with the terms of an agreement between the owners.

**Rights of registered owner to be personal property, &c.**

“25C. (1) The rights of an owner with respect to a registered design are personal property and are capable of assignment and transmission by operation of law.

“(2) Subject to this Act, the laws applicable to ownership and devolution of personal property apply in relation to the monopoly in a registered design as they apply in relation to other choses in action.

“(3) An assignment referred to in sub-section (1) shall be in writing signed by or on behalf of the owner.

**Subsequent registration of design in respect of other articles**

“25D. (1) Where—

- (a) a design (in this section referred to as the ‘original design’) has, whether before or after the commencement of this section, been registered in respect of an article; and
- (b) the person registered as the owner, or all persons registered as owners, of the design makes, or make jointly, an application—
  - (i) for registration of that design, or of another design that is an obvious adaptation of that design, in respect of another article; or

- (ii) for registration, whether in respect of the same article or another article, of a design that differs from the registered design only in immaterial details or in features commonly used in the relevant trade,

the application shall not be refused, and the registration made on that application is not invalid, by reason only of the previous registration, or of any publication or use, after the priority date in respect of the application for the previous registration, of the design registered on that application.

“(2) Where a design is registered by virtue of sub-section (1), the design becomes a design to which this section applies.

“(3) The registration of a design to which this section applies shall be deemed to have come into force on the date on which the application for registration of the design was lodged under this Act and shall remain in force so long as the registration of the original design remains in force, and no longer.

“(4) If under section 28 a prescribed court cancels the registration of the original design in relation to a design to which this section applies, that cancellation does not, unless the prescribed court otherwise orders, affect the registration of the design to which this section applies but, on that cancellation, the design to which this section applies ceases to be a design to which this section applies.

“(5) Where—

- (a) a person makes, or 2 or more persons acting jointly make, an application for the registration of a design in respect of an article;
- (b) that design—
  - (i) is a design that has previously been registered on the application of another person in respect of another article or is an obvious adaptation of such design; or
  - (ii) differs only in immaterial details or in features commonly used in the relevant trade from a design that has previously been registered, whether in respect of the same article or another article; and
- (c) while the application is pending, the applicant, or each of the applicants becomes registered as the owner of the previously registered design,

the preceding provisions of this section apply as if the applicant, or each of the applicants, had been registered as the owner of the previously registered design at the time of the making of the application.”.

### **Certificate of registration of design**

**14.** Section 26 of the Principal Act is amended by omitting sub-sections (2), (2a), (2b) and (2c).

**15. Section 27 of the Principal Act is repealed and the following sections are substituted:**

**Registered designs open to public inspection**

“27. (1) After a design has been registered, the application for registration of the design, the representations of the article to which the design is applied and any statement of monopoly or statement of novelty in respect of the design shall, subject to this Act, be open to public inspection.

“(2) Where a document referred to in sub-section (1) is a document that is open to public inspection and that document has been or is amended, that document as so amended is, subject to this Act, also open to public inspection.

**Period during which registration is in force**

“27A. (1) The registration of a design shall be deemed to have come into force on the date on which the application for registration of the design was lodged under this Act and, subject to this Act, shall cease to be in force on the expiration of a period of 12 months commencing on the date on which the registration was made in the register.

“(2) Application may be made to the Registrar for an extension of the period of registration of a design referred to in sub-section (1).

“(3) An application under sub-section (2)—

- (a) shall be made at least one month before the expiration of the period referred to in sub-section (1); and
- (b) shall be made in the prescribed manner.

“(4) A person may, at any time before the expiration of the period of 11 months commencing on the date on which the registration of a design was made in the register, lodge at the Designs Office a notice, in accordance with a prescribed form, setting out any matter—

- (a) that has been published in a document in Australia before the priority date in respect of the application for registration of the design; and
- (b) that the person considers to be relevant to the question whether the design was not, at the priority date referred to in paragraph (a), a design that was new or original.

“(5) The regulations may provide that a person who lodges a notice under sub-section (4) shall lodge with the notice such number of copies as is prescribed of the document to which the notice relates.

“(6) The Registrar shall give to the owner of a design referred to in sub-section (4) notice, in writing, of any matter to which a notice lodged under that sub-section relates.

“(7) A copy of a document lodged with a notice under sub-section (4) shall, subject to the regulations, be open to public inspection.

“(8) Upon receipt of an application under sub-section (2) for extension of the period of registration of a design, the Registrar shall, subject to this Act,

**extend the period of registration of the design for a period that expires on a date 6 years after the date on which the application for registration of the design was lodged under this Act.**

“(9) The Registrar may, having regard to any matter (including a matter published in a document a copy of which has been lodged with a notice under sub-section (4)) that has come to his notice in connection with a design referred to in sub-section (4), refuse an application under sub-section (2) for extension of the period of registration of a design on the ground that the design was not, at the priority date in respect of the application for registration of the design, a design that was new or original.

“(10) Where the Registrar refuses an application under sub-section (2) for extension of the period of registration of a design, he shall notify the owner of the design accordingly.

“(11) An appeal lies to a prescribed court from a refusal by the Registrar of an application under sub-section (2) for extension of the period of registration of a design.

“(12) Where—

- (a) the period of registration of a design has been extended under sub-section (8); and
- (b) application is made to the Registrar for a further extension of that period of registration,

**the Registrar shall, subject to this Act, extend that period of registration for a further period of 5 years.**

“(13) Where—

- (a) the period of registration of a design has been extended under sub-section (12); and
- (b) application is made to the Registrar for a further extension of that period of registration,

**the Registrar shall, subject to this Act, extend that period of registration for a further period of 5 years.**

“(14) An application under sub-section (12) or (13) shall be made in the manner, and within the period, prescribed for the purposes of that sub section.

“(15) The Registrar shall cause to be published in the *Official Journal* notice of—

- (a) an application under sub-section (2) for extension of the period of registration of a design;
- (b) a refusal under sub-section (9) of such an application; and
- (c) each extension under this section of the period of registration of a design.

“(16) Where—

- (a) a registered design was, at the time when it was registered, a corresponding design in relation to an artistic work in which copyright subsisted under the *Copyright Act 1968*;

- (b) by reason of a previous use of that artistic work, the design would not have been registrable under this Act but for section 17A; and
- (c) the copyright in that artistic work under the *Copyright Act* 1968 expires before the date on which the registration of the design ceases to be in force,

the registration of the design ceases to be in force at the same time as the copyright in the artistic work and shall not be extended after that time.

“(17) Notwithstanding the preceding provisions of this section, where a design has ceased to be a design to which section 25D applies, the period of registration of the design shall not be extended beyond the last date to which the period of registration of the design that was the original design, within the meaning of section 25D, in relation to the design that has so ceased could have been extended under this section.

“(18) In this section, ‘design’ does not include a design to which section 25D applies.

#### **Application for restoration of registered design**

“27B. (1) Where—

- (a) the period of registration of a design has been extended under sub-section 27A (8); and
- (b) the registration of the design has subsequently ceased to be in force by reason of—
  - (i) failure to make application to the Registrar, within the period prescribed for the purposes of sub-section 27A (12) or (13), as the case may be, for a further extension of that period of registration; or
  - (ii) failure to pay a prescribed fee within the prescribed period,

then—

- (c) the owner of the design;
- (d) if the owner of the design has died—the legal personal representative of the owner of the design; or
- (e) a person who would, if the registration of the design had not ceased to be in force, have been entitled, by assignment, transmission or other operation of law, to the design,

may, for the purpose of permitting the extension of the period of registration of the design, make application to the Registrar for the restoration of the registration of the design.

“(2) The application shall contain a statement of the circumstances that led to the relevant failure, and the Registrar shall, if he is satisfied that the failure was unintentional and that no undue delay has occurred in the making of the application, advertise the application in the *Official Journal* but, if he is not so satisfied, shall dismiss the application.

“(3) A person interested may, within such period after the advertisement under sub-section (2) of an application as is prescribed, give notice to the Registrar of opposition to the restoration of the registration of the design and shall serve a copy of the notice on the applicant.

**Registrar to deal with application**

“27C. (1) Where the Registrar has advertised in the *Official Journal* an application for the restoration of the registration of a design, he shall, after the expiration of the period referred to in sub-section 27B (3)—

- (a) if a notice referred to in that sub-section has been given to him—  
hear the matter and either restore the registration of the design or dismiss the application concerned; or
- (b) in any other case—restore the registration of the design.

“(2) The Registrar shall not restore the registration of a design under sub-section (1) until—

- (a) an application for extension of the period of registration of the design is made under sub-section 27A (12) or (13), as the case may be; and
- (b) all prescribed fees have been paid.

“(3) For the purpose of making an application referred to in paragraph (2) (a), the fact that a period has been prescribed, under sub-section 27A (14), for the making of that application shall be disregarded.

“(4) Where—

- (a) the Registrar restores the registration of a design under sub-section (1); and
- (b) that design was the original design, within the meaning of section 25D, in relation to another design that was a design to which section 25D applied,

the Registrar shall also restore the registration of the other design and, thereupon—

- (c) the other design again becomes a design to which section 25D applies; and
- (d) the design referred to in paragraph (a) again becomes the original design, within the meaning of section 25D, in relation to the other design.

“(5) The Registrar may, if he thinks fit, as a condition of restoring the registration of a design under sub-section (1), require that an entry be made in the register in respect of a document or instrument in respect of which the provisions of this Act as to entries in the register have not been complied with.

“(6) Where the registration of a design is restored under this section, such provisions as are prescribed have effect for the protection or compensation of persons who availed themselves, or took definite steps by contract or otherwise to avail themselves, of the design after the registration of the design had ceased to be in force and before the date on which the application for restoration of the registration of the design was advertised in the *Official Journal*.

“(7) Actions or proceedings shall not be taken in respect of an infringement of the monopoly in a registered design committed between the date on which the registration of the design ceased to be in force and the date of the restoration of the registration of the design.”.

**Applications to prescribed court**

**16. Section 28 of the Principal Act is amended—**

- (a) by omitting “the Supreme Court” and substituting “a prescribed court”;
- (b) by omitting from paragraph (a) “date of registration” and substituting “priority date in respect of the application for registration of the design”; and
- (c) by omitting “the Court” (wherever occurring) and substituting “the court”.

**Duty of owner of registered design**

**17. Section 29 of the Principal Act is repealed.**

**Heading to Part V**

**18. The heading to Part V of the Principal Act is amended by omitting “COPYRIGHT” and substituting “MONOPOLY”.**

**Infringement of monopoly in designs**

**19. Section 30 of the Principal Act is amended—**

- (a) by omitting from sub-section (1) “copyright in a registered design if, while the copyright continues, he, without the licence or authority of the owner of the copyright” and substituting “monopoly in a registered design if he, without the licence or authority of the owner of the design”;
- (b) by omitting from paragraph (1) (b) “registered owner of the design” and substituting “owner of the registered design”;
- (c) by inserting in paragraph (1) (c) “or hires, or offers or keeps for hire,” after “sale,”;
- (d) by omitting from sub-paragraph (1) (c) (i) “copyright” and substituting “monopoly”;
- (e) by omitting from sub-paragraph (1) (c) (ii) “registered owner of the design” and substituting “owner of the registered design”; and
- (f) by omitting sub-section (2) and substituting the following sub-section:

“(2) If any person infringes the monopoly in a registered design, the owner of the design may bring an action or proceeding against him for infringement of the monopoly in the design.”.

**20. Sections 31 and 32 of the Principal Act are repealed and the following sections substituted:**

**Infringement actions**

“31. An action or proceeding for the infringement of the monopoly in a registered design may be instituted in a prescribed court, but nothing in this section prevents such an action or proceeding being instituted in a court that is not a prescribed court.

**Defendant may counter-claim for rectification of register**

“32. A defendant in an action or proceeding for the infringement of the monopoly in a registered design may apply, by way of counter-claim in the action or proceeding, for the rectification of the register by the expunging of the entry of the registration of the design from the register.

**Intervention by Registrar in infringement action**

“32A. A prescribed court may grant to the Registrar leave to intervene in an action or proceeding for the infringement of the monopoly in a registered design.

**Remedies for infringement of monopoly in designs**

“32B. (1) The relief that a court may grant in an action or proceeding for the infringement of the monopoly in a registered design includes an injunction (subject to such terms, if any, as the court thinks fit) and, at the option of the plaintiff, either damages or an account of profits.

“(2) A court may refuse to award damages, or to make an order for an account of profits, in respect of an infringement of the monopoly in a registered design if the defendant satisfies the court—

- (a) that, at the time of the infringement, he was not aware that the design was registered; and
- (b) that he had, prior to that time, taken all reasonable steps to ascertain whether a monopoly in the design existed.”.

**Correction of register**

**21. Section 37 of the Principal Act is amended—**

- (a) by omitting from sub-section (1) “registered owner of a design” and substituting “owner of a registered design”; and
- (b) by omitting from paragraphs (1) (a) and (b) “registered” (wherever occurring).

**22. Section 38 of the Principal Act is repealed and the following sections are substituted:**

**Registration of assignments, transmissions, &c.**

“38. Where a person becomes entitled to a registered design by assignment, transmission or other operation of law, he shall apply to the Registrar to register his title, and the Registrar shall, on receipt of the application, and on



proof to the satisfaction of the Registrar of the title of the applicant, cause the name of the applicant to be entered in the register as the owner of the design.

**Registration of mortgages, licences, &c.**

“38A. Where a person becomes entitled as mortgagee, licensee or otherwise to an interest in a registered design, he shall apply to the Registrar to register his title, and the Registrar shall, on receipt of the application, and on proof to the satisfaction of the Registrar of the title of the applicant, cause notice of the interest to be entered in the register, together with particulars of the instrument creating the interest.

**Unregistered instruments not to be admitted in evidence**

“38B. Except in the case of an application under section 39, a document or instrument in respect of which no entry has been made in the register in accordance with the provisions of this Act is not, unless the court otherwise directs, admissible in evidence in a court in proof of title to a design or to an interest in a design.”.

**Rectification of register**

**23. Section 39 of the Principal Act is amended—**

- (a) by omitting from sub-section (1) “the Supreme Court” and substituting “a prescribed court”;
- (b) by inserting in paragraph (1) (b) “or amendment” after “expunging”;
- (c) by omitting sub-section (1A) and substituting the following sub-section:

“(1A) The reference in sub-section (1) to the expunging of an entry wrongly remaining on the register includes a reference to the expunging of an entry effecting the registration of a design where that design ceases to be in force by reason of sub-section 27A (16).”; and

- (d) by adding at the end thereof the following sub-section:

“(3) An office copy of an order under this section shall be served on the Registrar, who shall, upon receipt of the order, take such steps as are necessary to give effect to the order.”.

**24. Section 40 and Part VIA of the Principal Act are repealed and the following Parts substituted:**

**“PART VIA—THE CROWN**

**Interpretation**

“40. (1) In this Part, ‘State’ includes the Northern Territory.

“(2) In this Part, a reference to the Commonwealth shall be read as including a reference to an authority of the Commonwealth and a reference to a State shall be read as including a reference to an authority of a State.

“(3) This Part applies in relation to the Administration of Norfolk Island as if that Administration were a State.

**Use of designs for services of the Commonwealth or a State**

“40A. (1) At any time after an application for registration of a design has been lodged or a design has been registered, the Commonwealth or a State, or a person authorized in writing by the Commonwealth or a State, may make use of the design for the services of the Commonwealth or State.

“(2) An authority under sub-section (1)—

- (a) may be given either before or after the registration of the design;
- (b) may relate to, and authorize retrospectively the doing of, acts done after the lodging of the application for the registration of the design and before the giving of the authority; and
- (c) may be given to a person notwithstanding that he is authorized directly or indirectly by the owner of the design to make use of the design.

“(3) Where a design has been made use of under sub-section (1), the Commonwealth or State, unless it appears to the Commonwealth or State that it would be contrary to the public interest to do so, shall inform the owner as soon as possible of the fact and furnish him with such information as to the use made of the design as he from time to time reasonably requires.

“(4) Where a design is made use of under sub-section (1), the terms for that use of the design are such terms as are, whether before or after that use, agreed upon between the Commonwealth or the State and the owner of the design or, in default of agreement, as are fixed by a prescribed court.

“(5) The prescribed court may, in fixing those terms, take into consideration compensation that a person interested in the design has received, directly or indirectly, from the Commonwealth or State in respect of the design.

“(6) An agreement or licence (whether made or given before or after the commencement of this Part) fixing the terms upon which a person other than the Commonwealth or a State may make use of a design is inoperative with respect to the making use of the design, after the commencement of this Part, under sub-section (1), unless the agreement has been approved by the Minister or by the Attorney-General of the State.

“(7) No action or proceeding for infringement lies in respect of the making use of a design under sub-section (1).

“(8) The right to make use of a design under sub-section (1) includes the right to sell articles to which the design has been applied in exercise of that right and a purchaser of goods so sold, and a person claiming through him, is entitled to deal with the articles as if the Commonwealth or State were the owner of the design.

**Declaration may be sought as to use of registered design**

“40B. (1) An owner of a design who considers that the design has been made use of under sub-section 40A (1) may apply to a prescribed court for a declaration accordingly.

“(2) In a proceeding under sub-section (1)—

- (a) the Commonwealth or the State concerned, as the case may be, shall be the defendant; and
- (b) where the design is a registered design, the Commonwealth or State may, by way of counter-claim in the proceeding, apply for the rectification of the register by the expunging of the entry of the registration of the design from the register.

### **Forfeited articles**

“40C. Nothing in this Part affects the rights of the Commonwealth or of a State, or of a person deriving title directly or indirectly from the Commonwealth or a State, to sell or use an article forfeited under a law of the Commonwealth or the State.

### **Acquisition of designs by the Commonwealth**

“40D. (1) The Governor-General may direct that a design the subject of an application for registration, or a registered design, shall be acquired by the Commonwealth from the owner, and, thereupon, the design or registered design, and all rights in respect of the design or registered design, are, by force of this section, transferred to and vested in the Commonwealth.

“(2) Notice of the acquisition shall be given to the owner and be published in the *Official Journal* and the *Gazette* unless, in the case of the acquisition of a design the subject of an application for registration, an order is in force under section 40F in relation to the application.

“(3) The Commonwealth shall pay to the owner of the design, and, in the case of the acquisition of a registered design, to all other persons appearing in the register as having an interest in the design, such compensation as is agreed upon between the Commonwealth and the owner or other persons, as the case may be, or as, in default of agreement, is determined by a prescribed court in an action for compensation against the Commonwealth.

### **Assignment of design to Commonwealth**

“40E. (1) The owner of a design may assign to the Commonwealth his interest in the design and in the monopoly obtained, or to be obtained, in the design.

“(2) The assignment and all covenants and agreements contained in the assignment are valid and effectual notwithstanding any want of valuable consideration and may be enforced by action or other appropriate proceeding in the name of the Minister.

### **Prohibition of publication of information with respect to designs**

“40F. (1) Subject to any directions of the Minister, the Registrar may, if it appears to him to be necessary or expedient so to do in the interests of the defence of the Commonwealth, by order in writing under his hand, prohibit or restrict the publication of information with respect to the subject-matter of an application for registration of a design, whether generally or to a particular person or to persons included in a class of persons.

“(2) A person shall not, except in accordance with the written consent of the Registrar, publish or communicate information in contravention of an order made under sub-section (1).

Penalty—

- (a) if the offence is prosecuted summarily—a fine not exceeding \$500 or imprisonment for a term not exceeding 6 months, or both; or
- (b) if the offence is prosecuted upon indictment—a fine not exceeding \$10,000 or imprisonment for a term not exceeding 2 years, or both.

“(3) Where an order is in force under this section in relation to an application for registration of a design, the application may be dealt with under this Act but a design shall not be registered on that application.

“(4) Where—

- (a) an order under this section in relation to an application for registration of a design has been revoked; and
- (b) at the date of the revocation of the order, the design would, but for the operation of sub-section (3), have been registered,

the design shall be registered within one month after that date.

“(5) Nothing in this Act prevents the disclosure of information concerning a design to a Department or authority of the Commonwealth for the purpose of obtaining advice as to whether an order under this section should be made, amended or revoked.

## **“PART VI<sub>B</sub>—JURISDICTION AND POWERS OF COURTS**

### **Jurisdiction of prescribed courts**

“40G. (1) Subject to sub-section (2), every prescribed court has jurisdiction with respect to matters arising under this Act in respect of which actions or proceedings may, under this Act, be instituted in a prescribed court.

“(2) The jurisdiction conferred by sub-section (1) on the Supreme Court of a Territory—

- (a) to the extent that it relates to an action or proceeding for the infringement of the monopoly in a registered design or to an application for the rectification of the register made by virtue of section 32—is conferred to the extent that the Constitution permits; and
- (b) in any other case—is conferred only in relation to an action or proceeding instituted by a natural person who is resident in the Territory, or a corporation that has its principal place of business in the Territory, at the time of the institution of the action or proceeding.

“(3) The jurisdiction of a prescribed court under this section shall be exercised by a single Judge.

“(4) The regulations may make provision for and in relation to the practice and procedure of prescribed courts in actions or proceedings under this Act, including provision prescribing the time within which any action or proceeding

may be instituted or any other act or thing may be done, and providing for the extension of any such time.

**Transfer of proceedings**

“40H. (1) A prescribed court in which an action or proceeding has been instituted under this Act may, if the court thinks fit, upon application of a party made at any stage in the action or proceeding, by order, transfer the action or proceeding to another prescribed court having jurisdiction to hear and determine the action or proceeding.

“(2) Where an action or proceeding is transferred from a court in pursuance of this section—

- (a) all documents filed of record in that court shall be transmitted by the Registrar or other proper officer of that court to the Registrar or other proper officer of the court to which the action or proceeding is transferred; and
- (b) the court to which the action or proceeding is transferred shall proceed as if the action or proceeding had been originally instituted in that court and as if the same proceedings had been taken in that court as had been taken in the court from which the action or proceeding was transferred.

**Appeals**

“40I. (1) Subject to sub-section (2), an appeal lies to the Federal Court of Australia from a judgment or order of a prescribed court exercising jurisdiction under this Act or a judgment or order of any other court in an action or proceeding referred to in section 31.

“(2) Where the judgment or order of a prescribed court appealed from was pronounced or made in the exercise of its jurisdiction to hear and determine appeals from decisions of the Registrar, an appeal to the Federal Court of Australia does not lie without leave of that Court.

“(3) An appeal lies to the High Court, with special leave of the High Court, from a judgment or order referred to in sub-section (1).

“(4) Except as provided in the foregoing provisions of this section, no appeal lies from a judgment or order referred to in sub-section (1).

**Powers of prescribed courts**

“40J. Upon the hearing of an appeal from a decision of the Registrar, the prescribed court may—

- (a) admit further evidence, either orally or upon affidavit or otherwise;
- (b) permit the examination and cross-examination of witnesses, including witnesses who gave evidence orally or upon affidavit or otherwise at the hearing before the Registrar;
- (c) order an issue of fact to be tried in such manner as it directs;
- (d) affirm, reverse or modify the decision appealed from;
- (e) give such judgment, or make such order, as in all the circumstances it thinks fit, or refuse to make an order; and
- (f) order a party to pay costs to another party.

**“PART VIc—APPLICATIONS FOR REVIEW OF CERTAIN  
DECISIONS BY ADMINISTRATIVE APPEALS TRIBUNAL**

**Applications for review**

“40k. Applications may be made to the Administrative Appeals Tribunal for review of—

- (a) a direction by the Registrar given under section 25b or a refusal of the Registrar under that section to give a direction;
- (b) a decision of the Registrar under sub-section 27b (2) dismissing an application for the restoration of the registration of a design; or
- (c) a decision of the Registrar under section 27c.”.

**Governor-General may make regulations**

25. Section 41 of the Principal Act is amended by omitting “the fees to be paid under this Act and”.

26. Section 42 of the Principal Act is repealed and the following sections are substituted:

**Fees**

“42. (1) There are payable to the Registrar such fees as are prescribed in respect of the doing of an act by the Registrar, or the lodging of a document, under this Act.

“(2) Where, in accordance with the regulations, a fee is payable in respect of the doing of an act by the Registrar under this Act, the Registrar shall not do that act until the fee has been paid.

“(3) Where, in accordance with the regulations, a fee is payable in respect of the doing of an act by a person other than the Registrar, the act shall be deemed not to have been done until the fee has been paid.

“(4) Where, in accordance with the regulations, a fee is payable in respect of the lodging of a document under this Act, the document shall be deemed not to have been lodged until the fee has been paid.

**Powers of Registrar**

“42A. The Registrar may, for the purposes of this Act—

- (a) summon witnesses;
- (b) receive evidence on oath, whether orally or otherwise;
- (c) require the production of documents or articles; and
- (d) award costs against a party to proceedings before him.

**Disobedience to summons an offence**

“42B. (1) A person who has been summoned to appear as a witness before the Registrar shall not, without lawful excuse, and after tender of reasonable expenses, fail to appear in obedience to the summons.

“(2) A person who has been required by the Registrar to produce a document or article shall not, without lawful excuse, and after tender of reasonable expenses, fail to produce the document or article.

Penalty: \$100.

**Refusal to give evidence an offence**

“42C. A person who appears before the Registrar as a witness shall not, without lawful excuse, refuse to be sworn or to make an affirmation, or to produce documents or articles, or to answer questions, that he is lawfully required to produce or answer.

Penalty: \$100.

**Recovery of costs**

“42D. Costs awarded by the Registrar may, in default of payment, be recovered in a court of competent jurisdiction as a debt due by the person against whom the costs were awarded to the person in whose favour they were awarded.”

**Registrar may recognize agents**

27. Section 44 of the Principal Act is amended by omitting “industrial”.

**False representation that a design is registered**

28. Section 45 of the Principal Act is amended by omitting from subsection (1) “Forty dollars” and substituting “\$200”.

29. After section 45 of the Principal Act the following sections are inserted:

**Exercise of discretionary power by Registrar**

“46. Where a discretionary power is by this Act given to the Registrar, he shall not exercise that power adversely to a person without giving to that person an opportunity of being heard.

**Objection to validity of design not to be taken in certain circumstances**

“46A. Objection shall not be taken to an application for registration of a design, and a registered design is not invalid, by reason only of the design having been published or used before the priority date in respect of the application for registration of the design, if the Registrar or the prescribed court is satisfied that—

- (a) the publication was made or the user took place without the knowledge and consent of the applicant or owner, as the case may be;
- (b) the subject of the publication or user was derived or obtained from the applicant or owner; and
- (c) if, before the priority date in respect of the application for registration of the design, the applicant or owner became aware of the publication or user, he made application for registration of the design with all reasonable diligence after so becoming aware of the publication or user.

**Notice of appeal to prescribed court to be given to Registrar, &c.**

“46B. (1) Notice of an appeal under this Act to a prescribed court from a decision of the Registrar shall be given to the Registrar.

“(2) The Registrar is entitled to appear and be heard upon the hearing of the appeal and shall appear if so directed by the prescribed court.”.

**Exhibiting of designs at official or international exhibitions**

**30.** Section 47 of the Principal Act is amended by omitting from sub-section (1) “copyright” and substituting “monopoly”.

**31.** Sections 48 and 49 of the Principal Act are repealed and the following sections substituted:

**Convention countries**

“48. (1) The Governor-General may, with a view to the fulfilment of a treaty, convention, arrangement or engagement between the Commonwealth and another country, by Proclamation, declare that a country specified in the Proclamation is a Convention country for the purposes of this Act.

“(2) The Governor-General may, by Proclamation, declare a part of the Queen’s dominions which has made satisfactory provision for the protection in that part of designs to be a Convention country for the purposes of this Act.

“(3) Where the Governor-General, by Proclamation, declares that an application for protection in respect of a design is, in accordance with the terms of a treaty subsisting between 2 or more Convention countries, equivalent to an application made in one of those Convention countries, the first-mentioned application shall, for the purposes of this Act, be deemed to have been made in that Convention country.

“(4) Where the Governor-General, by Proclamation, declares that an application for protection in respect of a design is, in accordance with the law of a Convention country, equivalent to an application made in that Convention country, the first-mentioned application shall, for the purposes of this Act, be deemed to have been made in that Convention country.

**Applications under International Conventions**

“49. (1) Where—

- (a) an application for protection in respect of a design (in this section referred to as the ‘basic application’) has been made in a Convention country; and
- (b) an application for registration of the design is lodged under this Act, within a period of 6 months after the date on which the basic application was made, by a person who is—
  - (i) the applicant in the Convention country;
  - (ii) the assignee of the applicant in the Convention country; or
  - (iii) the legal personal representative of the applicant in the Convention country or of his assignee,



the priority date in respect of the application under this Act is the date of the making of the basic application.

“(2) For the purposes of sub-section (1), the date on which a basic application was made in a Convention country is such date as the Registrar is satisfied, by certificate of the official chief or head of the Designs Office of the Convention country or otherwise, is the date on which the basic application was made in the Convention country.

“(3) Where 2 or more applications for protection in respect of a design have been made in one or more Convention countries, the period of 6 months referred to in paragraph (1) (b) shall be reckoned from the date on which the earlier or earliest of those applications was made.

“(4) An application to which sub-section (1) applies—

- (a) shall be supported by a copy of the basic application, and of any other related documents filed or deposited by the applicant in the Designs Office of the Convention country in which the basic application was made, certified by the official chief or head of that Office or otherwise verified to the satisfaction of the Registrar; and
- (b) in all other respects, shall be made, lodged and proceeded with in the same manner as an ordinary application under this Act for the registration of a design.

“(5) A copy of a document referred to in paragraph (4) (a) shall be lodged—

- (a) at the same time as the application to which sub-section (1) applies is lodged;
- (b) within 3 months after that time; or
- (c) within such further period after that time as the Registrar allows.

“(6) If a copy of a document referred to in paragraph (4) (a) is in a foreign language, a translation of the document, verified by declaration or otherwise to the satisfaction of the Registrar, shall be annexed to the document.

**Withdrawn application not to be used as basic application in certain circumstances**

“50. Notwithstanding anything contained in section 49, where—

- (a) an application for protection in respect of a design has been made in a Convention country;
- (b) the application has been withdrawn, abandoned or refused without becoming open to public inspection;
- (c) the application has not been used as the basis for claiming a right of priority in a Convention country under the law of that country corresponding to section 49; and
- (d) a later application has been made by the same applicant for protection in respect of that design in the Convention country in which the earlier application was made,

the applicant may request the Registrar to disregard the earlier application for the purposes of section 49 and, if he so requests—

- (e) the earlier application shall be so disregarded; and
- (f) neither the applicant nor any other person is capable of making use of the earlier application as a basic application for the purposes of section 49.”.

### **PART III—AMENDMENTS OF THE COPYRIGHT ACT 1968**

#### **Principal Act**

32. The *Copyright Act 1968*<sup>2</sup> is in this Part referred to as the Principal Act.

#### **Consequential amendments**

33. The Principal Act is amended as set out in the Schedule.

### **PART IV—AMENDMENT OF THE PATENTS, TRADE MARKS, DESIGNS AND COPYRIGHT ACT 1939**

#### **Principal Act**

34. The *Patents, Trade Marks, Designs and Copyright Act 1939*<sup>3</sup> is in this Part referred to as the Principal Act.

#### **International arrangements**

35. Section 15 of the Principal Act is repealed.

### **PART V—TRANSITIONAL**

#### **Transitional provision in relation to applications**

36. (1) The amendments made by Parts II and III (other than the amendment made by section 31), insofar as they apply in relation to applications for registration of designs, apply in relation to such applications made after the date fixed by Proclamation under sub-section 2 (3).

(2) The amendment made by section 31, insofar as it applies in relation to applications for registration of designs, applies in relation to such applications made after the date fixed by Proclamation under sub-section 2 (2).

#### **Transitional provision in relation to designs registered in accordance with section 24A of Principal Act**

37. Where, immediately before the date fixed by Proclamation under sub-section 2 (3), a design registered under the Principal Act was a design registered in accordance with section 24A of that Act, then, on and after that date—

- (a) that design shall be deemed to be a design to which section 25D of the *Designs Act 1906* applies; and
- (b) the design that was the original registered design in relation to that first-mentioned design shall be deemed to be the original design, within the meaning of section 25D of the *Designs Act 1906*, in relation to that first-mentioned design.

**SCHEDULE**

Section 33

**CONSEQUENTIAL AMENDMENTS OF COPYRIGHT ACT 1968**

1. The following provisions of the Principal Act are amended by omitting "copyright" (wherever occurring) and substituting "monopoly":

Paragraphs 75 (a) and (b) and 76 (1) (b).

2. The Principal Act is further amended as set out in the following table:

Provision	Amendment
Sub-section 8 (1) . . . .	Omit "or of the <i>Designs Act 1906-1968</i> "
Heading to Division 8 of Part III	Omit " <i>Industrial</i> "
Sub-section 74 (2) . . . .	Omit, substitute the following sub-section: <div style="margin-left: 40px;">                     "(2) In this Division—                      (a) a reference to the scope of the monopoly in a registered design is a reference to the aggregate of the things that, by virtue of the <i>Designs Act 1906</i>, the person registered as the owner, or all persons registered as owners, of the design has, or have, the exclusive right to do; and                      (b) a reference to the scope of the monopoly in a registered design as extended to all associated designs and articles is a reference to the aggregate of the things that, by virtue of that Act, the person registered as the owner, or all persons registered as owners, of the design would have had the exclusive right to do if—  <div style="margin-left: 40px;">                         (i) when that design was registered, there had at the same time been registered every other related design capable of being registered by virtue of section 25D of that Act, and the person registered as the owner, or all persons registered as owners, of that design had been registered as the owner, or owners, of every such other related design; and                          (ii) that design, and every other related design capable of being registered by virtue of section 25D of that Act, had been registered in respect of all the articles to which it was capable of being applied."                     </div> </div>
Sub-section 77 (2) . . . .	(a) Omit "fifteen", substitute "16" (b) Omit "copyright in the corresponding design", substitute "monopoly in the corresponding design"
Sub-section 77 (3) . . . .	Omit "copyright in that design", substitute "monopoly in that design"

**NOTES**

- No. 4, 1906, as amended. For previous amendments, see No. 19, 1910; No. 14, 1912; Nos. 53 and 70, 1932; No. 36, 1933; Nos. 42 and 45, 1934; No. 80, 1950; No. 93, 1966; No. 108, 1967; No. 64, 1968; No. 216, 1973 (as amended by No. 20, 1974); and No. 19, 1979.
- No. 63, 1968, as amended. For previous amendments, see No. 216, 1973 (as amended by No. 20, 1974); Nos. 37 and 91, 1976; No. 160, 1977; No. 19, 1979; and No. 154, 1980.
- No. 66, 1939, as amended. For previous amendments, see No. 32, 1940; No. 77, 1946; No. 11, 1953; No. 216, 1973 (as amended by No. 20, 1974); and No. 91, 1976.