

CHAPTER 5**MONOPOLY STATEMENTS****INDEX**

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INTRODUCTION

5.1 A statement of monopoly is a statement which defines the extent of the monopoly which the applicant claims. In doing this it defines the design.

A design is registered for one "particular and individual specific appearance" of an article. The statement of monopoly governs how the representations of the article are to be considered.

"Statement of monopoly " is defined in section 4 of the Designs Act. The definition is:

"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 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".

"Monopoly" is also defined in section 4 as:

"in relation to a registered design, means the exclusive right to apply the design to an article in respect of which the design is registered".

Reading these 2 definitions together implies that a statement of monopoly actually defines the design for which registration is sought.

A statement of monopoly is not the same as a patent claim.

EXAMPLES OF STATEMENTS OF MONOPOLY

5.2 Examples of suitable wording for statements of monopoly are as follows:

a statement in accordance with paragraph (a) of the definition is:

"Monopoly is claimed in the (shape/configuration/pattern/ornamentation) of the article as illustrated in the representations" (a claiming or positive statement)

a statement in accordance with paragraph (b) of the definition is:

"No monopoly is claimed in the (shape/configuration/pattern/ornamentation) of the article as illustrated in the representations" (a disclaiming or negative statement)

Examples of accepted statements of monopoly are:

"Monopoly is claimed in the shape and configuration of a light switch flap cover as illustrated in the representations."

"Monopoly is claimed in the features of pattern and ornamentation of a flag as illustrated in the representations."

"Monopoly is claimed in respect of the pattern and/or ornamentation of a set of plates as illustrated in the representations and in considering the extent of the monopoly protection, the shape and/or configuration of the plates is to be disregarded. (This statement contains both a claiming part and a disclaiming part.)"

Examples of unacceptable statements of monopoly are:

"The or each discernible feature of shape pattern ornamentation or configuration shown in the accompanying representations separately or in combination of two or more such features, including each such feature of combination as applied to the article described or any other articles. The words shown in the representations form no part of the design."

"A monopoly is claimed in the shape or configuration comprising the combination of curves and/or bends shown in the accompanying representations. The features to be disregarded in considering the extent of the monopoly protection are the relative lengths of the straight portions which join the curves and/or bends or which form end portions."

HOW DOES THE PRESENCE OF A STATEMENT OF MONOPOLY AFFECT THE INTERPRETATION OF A DESIGN?

- 5.3 If there is no statement of monopoly then the design comprises all the features (shape, configuration, pattern or ornamentation) illustrated in the representations. See . This will apply to T-shirts or articles of clothing and game boards where the design is in the pattern or ornamentation applied to the article of clothing or the game board even though the shape and configuration of the article of clothing or the game board are not new. When the four features are claimed the registration is for the whole design.

A statement of monopoly can define the design as being either everything seen in the representation, or only specific features (e.g. shape or configuration) of the article, or specific features of part of the article.

A statement of monopoly can be used to qualify the representation. A statement of monopoly can claim the features which constitute the design and identify the features which are not significant to the design for the purposes of determining the extent of the monopoly.

A statement of monopoly may also disclaim visual features of the design which are to be disregarded.

Whilst a statement of monopoly may include both a claiming and a disclaiming portion, it need not always include both. However a negative claim cannot be made without a positive claim.

IS A STATEMENT OF MONOPOLY ALWAYS NECESSARY?

- 5.4 A statement of monopoly need not be lodged. Section 20 does not require the applicant to lodge such a statement with the application. Where the applicant has not lodged a statement of monopoly, the Registrar may request that one be lodged, if the Registrar considers it appropriate.

Independent of any request by the Registrar an applicant may supply a statement of monopoly subsequent to the lodgement of an application as an amendment to the application. (See chapter 17).

A statement of monopoly should be requested in the following cases:

- (a) where the article depicts words, letters and numerals and these clearly do not constitute features of pattern or ornamentation
- (b) if indicated elsewhere in the application documents, e.g. on the representations, that the applicant does not want to be restricted to all features.
- (c) where the same representation is used for more than one application. The statement of monopoly required for each application must distinguish the monopoly provided by each registration.

HOW IS A STATEMENT OF MONOPOLY LINKED TO THE REPRESENTATIONS?

- 5.5 The definition of statement of monopoly (in section 4) refers the statement to the representations. Therefore the statement of monopoly must only refer to features that are clearly visible in the representations.

This requirement applies equally to features claimed and/or disclaimed by the statement of monopoly. (See Acme Metal).

The act requires the representations to illustrate the article. The monopoly claim can be limited to a feature or features of only a part or portion of the article.

When the monopoly claim is to be limited to a feature or features of only a part or portion of the article then it is unnecessary to illustrate the remaining features of the rest of the article provided that the nature or general outline of the article is sufficiently disclosed by the representations. In such a case a statement of monopoly of the form "No monopoly is claimed in respect of....." will be necessary. This practice is based on the UK decision, , in which Whitford J. stated:

"In design cases the really important and significant question to my mind is: Does this application adequately show the design features which the applicant desires to protect in such a way that when he has secured his monopoly there will be no difficulty in ascertaining, when you look at the representation, what the design features are?"

An example:

Monopoly is claimed in the shape and/or configuration of the "contoured ankle strap" for a flipper as shown in the accompanying representations. No monopoly is claimed in the shape and configuration of the flipper apart from the "contoured ankle strap" shown in the accompanying representations.

CAN A STATEMENT OF MONOPOLY CONTAIN ALTERNATIVES?

5.6 A statement of monopoly can not include wording that allows a number of possible alternatives. This is because an application can be made for only one design.

The statement of monopoly must therefore be restricted to one design.

Examiners should look carefully at a statement of monopoly which includes the words "or" or "and/or" to see if they lead to a number of designs being defined.

An Example:

The statement of monopoly originally lodged for registered design no. 108873 (for a sledge canopy) disclaimed "shape or location or number". The statement was objected to because it meant there were a number of different designs being claimed.

Where shape and configuration can be regarded as synonymous designations of a particular feature of an article, it is acceptable that they can be claimed in a statement of monopoly as alternatives.

Similarly, in instances where pattern and ornamentation of a particular article can be seen as synonymous, then a claim for those features as alternatives is acceptable.

A monopoly claim is not acceptable for "shape or pattern" because the feature pattern of an article is not synonymous with the feature of shape of that particular article. When considered individually each of these features constitutes a separate design for that article.

Where monopoly is desired to be claimed in the individual feature of shape of an article as well as, or alternatively to, the individual feature of pattern of that article then the monopoly claims should be made the subject of separate design applications each with a statement of monopoly limiting the monopoly claim to the relevant feature which constitutes the design. See also paragraph 18.5 in this manual.

Where features of shape (and/or configuration) and pattern (and/or ornamentation) are claimed together in a statement of monopoly then the monopoly scope is in respect of the whole design constituted by the combination or totality of those features.

CAN A STATEMENT OF MONOPOLY CONTAIN DESCRIPTIVE MATTER, ETC?

5.7 From the definition of statement of monopoly in section 4 of the Act, a statement of monopoly indicates the features for which a monopoly is sought.

A statement of monopoly should not:

- (a) try to explain the design
- (b) include descriptions of the representations
- (c) describe how the article works or the alleged merits of the design
- (d) describe aspects of the article which do not relate to appearance, such as functional details, constructional principles.

In *Beeren's Application* 7 IPR 413 the Hearing Officer said:

".....the word "features" in the expression "features of the representations" in the Section 4 definition of statement of monopoly is not restricted to the features of shape, configuration, pattern and ornamentation and could include various other matters. But when the monopoly claim is to be considered the fact that "features of the representations" may be interpreted broadly is of little consequence because the design which is to be registered, is confined to the specific feature(s) of shape/configuration/pattern/ornamentation applicable to the relevant article. For that reason the Designs Office has taken the view that it is usually unnecessary and can be misleading to refer in statements of monopoly to aspects involving functional details, construction principles, assembly and operating methods and other non-visible attributes of an article which, while still being "features" of the article, are outside the scope of the four statutorily designated features which, and only which, can be the subject of the registration and the resultant monopoly. The Designs Office, in the interests of clarity and efficiency, has preferred and encouraged claims/disclaimers made in statements of monopoly that are relevant, concise and confined to one or more of the four specific design features for which registration can be obtained, avoiding where possible the inclusion of matter which attempts to describe or explain the design."

For some designs it is not always easy to define certain features in words. Therefore it is possible for applicants to refer in a statement of monopoly to parts or regions of the article illustrated in the representations by such things as shading, letters marks, numbers etc. But this type of reference is only acceptable if the design can be clearly determined.

STATEMENTS OF MONOPOLY FOR DESIGNS APPLIED TO ARTICLES OF INDEFINITE DIMENSIONS

5.8 Examples of articles of indefinite dimensions are extruded sections, mesh panels, wall paper, textiles.

Sub-section 18(2) of the Act provides that registration can not be denied an application because the article or part of an article is of indefinite extent in one or 2 dimensions.

In the case of designs applied to textiles or wall papers or mesh materials where the pattern repeats in both directions it is allowable to use a statement of monopoly to disclaim the length and width.

An Example:

If the pattern does not repeat, then the design has to be restricted to a specific article, e.g. sheet, towel, quilt etc.

An Example:

Monopoly is claimed in the pattern and ornamentation of the quilt cover illustrated in the representations.

Where the variable dimensions affect the identity or essence of the design by creating a large number of different designs, then an objection should be raised by the examiner. Refer to *Bondor Pty Ltd v National Panels Pty Ltd (1991) AIPC 90 - 827*.

Where the article is an extrusion the representations can show indefinite length. The statement of monopoly must disclaim the length.

An Example:

Monopoly is claimed in the features of shape and configuration of a structural member of indefinite length as shown in the accompanying representations.

Where the cross-section is constant the statement of monopoly may refer to the shape of the constant cross-section of the extrusion.

An Example:

Monopoly is claimed in the shape and configuration of a fascia of indefinite length and constant cross-section as shown in the accompanying representations.

Where the cross-section is not constant because of other features, e.g. holes, shown in a repeating manner the statement of monopoly is to refer to the repeating pattern and disclaim length.

An Example:

Monopoly is claimed in the shape and configuration of a fence post of indefinite length as shown in the accompanying representations. The same design of apertures may be repeated at regular intervals between the broken lines.

