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**INTRODUCTION**

- 13.1 The intention of all intellectual property legislation is to protect things that would commonly be referred to as "unique", "new" or "original" however these words may be defined. The validity of any such protection hinges on these factors. Consequently Section 17 of the Designs Act requires that, to be registrable, a design must be "new or original". Determining whether a design is "new or original" is therefore fundamental to registration.

"New or original" in the sense used in the Designs Act means that a design must be different to any other design that has been available to the Australian public before the priority date of the application. How much and in what ways the design has to be different will be a matter of judgement in each case and will depend mainly on what type of article the design is to be applied to.

However, designs that have been adapted from an artistic work that is protected by copyright must be treated as if they are new or original in spite of the fact that they have been available to the Australian Public before the priority date of the application.

Chapter 15 - "Searching" is related to novelty and originality.

**CHECK LIST**

- 13.2 What are the similarities? Are the designs identical ?
- What are the differences between the two designs ?
- Are they immaterial ? (Is the art wide or close ?)
  - Are they features commonly used in the trade ?
- Is it an obvious adaptation of a previous design ?
- Is it a combination of old features ?
- What are the priority dates involved ?
- Can the date of publication or use be substantiated ?

**SECTION 17**

13.3 With the significant phrases underlined, Section 17(1) of the Act reads as follows:

17.(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.

Each of the underlined terms will be dealt with in detail in what follows.

**NEW OR ORIGINAL**

13.4 Judicial opinion has been divided as to whether to consider the words "new" and "original" as alternatives or as a combined requirement. (See *Malleys Ltd v. J. W. Tomlin Pty Ltd* 35 ALJR 352 which suggested that they were alternatives and *Aspro-Nicholas Ltd.'s Design Application* [1974] RPC 645 which suggests that they be treated as a combined requirement.) *Malleys v Tomlin* (above) is the prevailing view and is reflected in the requirements of S.17(1) (a) & (b).

While much has been made of the distinction between the words "new" and "original" in the decided case law, the distinctions have little if any practical effect on examination. All considerations of novelty or originality will be directed towards parts (a) and (b) of 17.(1) ie. determining:

- 1) whether the design has already been applied to the same article
- or,
- 2) whether it has already been applied to a similar article

While *Malleys v. Tomlin* used the words "article of analogous character" instead of "similar article" in 2) above the DLRC decided to use the words "obvious adaptation" instead. The intent appears to be the same though the practical implications were probably different.

There are no judicial decisions that actually set out another test for "novelty or originality" apart from what is defined in parts (a) & (b) of s.17(1). (See also *Malleys Case* (1960) 77 W.N. (N.S.W.) 723).

At the very least "original" does not mean "originating from a particular author" as it does in copyright law and "new" does not mean "just purchased" as it would to a consumer. Whatever the terms may have been intended to mean, the basic requirement is that the design should not have been available to the public in Australia before the priority date of the application. (See "priority date" below). The issues involved are treated in detail below.

#### **IMMATERIAL DETAIL & FEATURES COMMONLY USED IN THE RELEVANT TRADE.**

- 13.5 Section 17(1)(a) describes the test that is to be applied when considering the novelty or originality of a design when compared to other designs applied to the same article. That is, to be new or original, the differences between a new design and those already existing must be significant (or material) or be more than would ordinarily be expected in the trade that produced it. These are alternative criteria. A design is not new or original if it fails on either ground. The tests are described in detail below.

The criteria outlined in Section 17(1)(a) are also used in judging the differences between the items in a set (see Chapter 10) and judging whether a design is eligible for registration under Section 25D (see Chapter 19).

#### **IMMATERIAL DETAIL**

- 13.6 It is not sufficient to point to any differences between a design and a previously published one to establish novelty or originality. The differences must be substantial or significant, taking into account the sort of article that is being considered.

When considering the design of dress collars Bagally LJ (in *Le May v Welch* (1885) 28 Ch D 24) commented that a trifling change such as the location of a stud on a collar was not sufficient to make it new or original. Such a difference would be immaterial. By implication there would need to be some more significant difference to justify registration.

In *Le May v Welch* (1885) 28 Ch D 24 Jacobs J in considering the novelty or originality of a chair commented that, in the case of chairs, it was not likely that there would be any dramatic differences between a new design for a chair and what has gone before. To be new or original the differences were likely to be within a small compass. In such a case "small" differences were likely to be material.

When considering differences then, the nature of the article being judged is crucial. Whether a difference is immaterial will be a matter of judgement in each particular case. The examiner may not be familiar with all the prior art involved in every technology and so is not always in a position to insist that a difference is material or immaterial. If the examiner has expertise in a particular field then there is nothing stopping them from using it.

In most case though, unless the difference is what a member of the public would regard as an immaterial detail (eg. the length of a table where all other details are the same) or is a difference that has been determined by law to be an immaterial detail then that difference must be treated as material.

**FEATURES COMMONLY USED IN THE RELEVANT TRADE**

- 13.7 A design will not be new or original if the differences it exhibits from previous designs are only what would normally be expected in the trade that produced it eg. putting running spikes on shoes (*Phillips v Harbro Rubber Co* (1920) 37 RPC 233) or "tufting" on a cushion (*J Rapee & Co Pty Ltd v KAS Cushions Pty Ltd* (1989) IPR 577). This is intended to ensure that a tradesperson can exercise their normal skill without fear of infringing a design. It is likely that a trade variant will also be an immaterial detail, but not always. (*J Rapee & Co* above at 591).

As with immaterial detail, determining whether a difference is a trade variant will be a matter of judgement in each particular case. Generally the examiner will not be familiar with the technology involved and so is not always in a position to insist that a difference is a trade variant, though if the examiner has expertise in a particular field then they are entitled to use it.

In most cases though, unless the difference is what a member of the public regards as a trade variant or is a difference that has been determined by law to be a trade variant, then it cannot be considered to be a trade variant.

**COMBINATIONS OF OLD FEATURES**

- 13.8 A design may be composed entirely of old features and still be new or original. In *Australian Building Industries Pty Ltd v Woodman McDonald (Glass) Pty Ltd & Ors* (1986) AIPC 90-302 Kelly ACJ determined that while all the features of a particular gutter had been used before, the combination before him was new and therefore entitled to registration.

**OBVIOUS ADAPTATION**

- 13.9 If a design is taken from one article and applied to any other article the design may be said to have been adapted to the new article. If it would be obvious to do so then it would be an obvious adaptation. For instance, while it has not been tested, it may well be an obvious adaptation to make a model car in the shape of the real car since doing such a thing is quite common and to most people an "obvious" thing to do.

"Obviousness" has been dealt with under Patent law ( ) and has been treated as what:

"a skilled but unimaginative craftsman possessed of the common general knowledge in that area and faced with the task of conceiving a design to apply to that particular article"

would produce in the normal course of their trade. It is suggested, for example, that it would take no imagination for a model car maker to adapt the design of a full sized automobile to a scale replica.

It might be more obvious to transfer a pattern from one article to another than it would be to transfer its shape. For example it might be relatively obvious to take the pattern of a doona cover and apply it to a lampshade or curtain. It might be less obvious however to

take the shape of a bonnet and apply it to a coal scuttle (See *Clarke's Registered Design* (1896) 13 RPC 351 at 359).

Whether a design is an obvious adaptation of another will be a matter of evidence in each case. Unless the examiner is well acquainted with the field or the adaptation has been determined by law to be obvious, or is what a member of the public would consider to be obvious, then the adaptation must be considered as not obvious.

#### **PRIORITY DATE**

- 13.10 The priority date is the date from which the design must be new or original. In the absence of a convention claim or a claim for divisional status, the priority date will be the date of lodgement (S.21(2)).

If there is a convention claim, then the priority date will be the date of lodgement of the basic application in the convention country.

If there is a valid claim for divisional status, the priority date will be that of the parent. In the case where the parent has claimed convention priority, it is not clear from the Designs Act what the priority date will be in every case. Generally, if the design of the divisional child case was shown in the copy of the basic application documents lodged with the parent then the child case would take the lodgement date of the relevant priority document as its priority date. If the design was not disclosed on the copy of the basic application lodged with the parent, then the priority date of the child will be the lodgement date of the parent.

#### **IDENTICAL PRIORITY DATES**

- 13.11 In the case where there are two identical designs with same priority date, the Registrar is obliged to register both designs if they are otherwise suitable (S.22(b)).

#### **REGISTERED, PUBLISHED OR USED IN AUSTRALIA**

- 13.12 The Designs Act only requires novelty or originality of a design in Australia. Any registration, publication or use of the design outside of Australia is not relevant and cannot be taken into account.

If the design was published or used in Australia without the knowledge or consent of the owner, then the design may still be considered new and original once the facts of the case have been established and the owner has wasted no time in applying for registration of the design (Section 46A).

#### **REGISTERED**

- 13.13 "Registered" means registered under the *Designs Act 1906*. Under subsection 27A(1), a design is deemed to be registered as of the date of lodgement of the application. Thus under subsection 17(1) a design will not be new or original if before its priority date, an application for an identical or similar design was lodged and the earlier design is subsequently registered.

**USING UNREGISTERED APPLICATIONS TO ESTABLISH LACK OF NOVELTY OR ORIGINALITY**

- 13.14 Unregistered applications can thus be used as the basis of establishing lack of novelty or originality.(See chapter 15). Thus each search should include a search of pending applications

If an application for a similar design is found which was lodged before the priority date of the application under examination, then the applicant should be advised of the existence of the earlier application by identifying the application number, title and applicant. The applicant should also be advised that an opinion regarding novelty or originality will be reserved pending registration or refusal of the prior application.

In the case of expedited examination, if a prior application is found, then examination of that prior application should be commenced if it has not already been so."

In such cases the applicant would not know precisely what the other design is, and must wait until it is registered or lapsed. This could mean that if the prior application is not resolved quickly, then the second applicant does not really get the full period available (12+ months) to respond to the reg. 14 notice. There are no provisions under the Act or Regulations which allow us to extend this.

To avoid this a letter, rather than a reg. 14 notice, should be issued on the original application, pointing out that there is a prior lodged application and that a reg 14. notice will be issued when that prior application is resolved (ie. is registered or lapsed).

A note should be placed on the prior application to the effect that the original application needs a reg. 14 notice when the prior application is registered or lapsed.

If the prior application is registered then full disclosure of the representations of that design may be made. If the prior application lapses or is refused registration then the objection to lack of novelty or originality on the original application must be withdrawn.

It has not been determined what would happen if the lapsed application is restored at some later stage.

**PUBLISHED**

- 13.15 Ricketson in *The Law of Intellectual Property* (1984) at [18.17] says:

""Publication" refers to the anticipation of a design by some prior documentary description".

Thus any document, be it a trade magazine, a text-book, a dictionary, a pamphlet or an OPI Patent specification or any similar document or printed material may establish publication. (See Chapter 15). The wording of a patent specification may be taken into account, as well as any drawings that might accompany it (*S. Travers Ld's Application* 68 RPC 255 at 259).

**COPYRIGHT AND PROTOTYPES**

- 13.16 It is possible that the disclosure of a design in a document or printed work may only constitute the revelation of a work of art, or a work of artistic craftsmanship according to the *Copyright Act (1968)* and thus cannot be used to establish lack of novelty or originality. Also, it has not been finally determined that a prototype is a work of artistic craftsmanship. (On both matters see Chapter 12).

In the first instance, if the examiner believes that a design has been published or used, the details of the publication or use may be used as the basis of an objection to the novelty or originality of the design. It will then be a matter of evidence as to whether the publication was in fact a genuine anticipation or a disclosure of a work of art or artistic craftsmanship. (See Chapter 12).

**USED**

- 13.17 "Use" occurs when an article embodying the design is revealed to the public or individual members of the public without any obligation on them for confidentiality. The design need only be visible to a member of the public for it to be "used". Thus a photo taken in public and used as a representation in the application may establish prior use.

However if a disclosure is secret or confidential then no prior use can be established. (Section 17 (1A)).

**EXHIBITIONS**

- 13.18 If the article was on display (ie. "used") or disclosed in a document (ie. published) at an official or officially recognised exhibition, "prior use" cannot be established so long as an application for registration of the design is lodged within six months of the opening date of the exhibition (Section 47).

**ESTABLISHING ABSENCE OF NOVELTY OR ORIGINALITY**

- 13.19 In most cases it will be necessary to establish lack of novelty or originality with substantial evidence.

Details to be supplied in each case are:

Registration: -The registration number.

-The priority date.

-A copy of the design.

Publication: -A copy of the alleged disclosure

-The date the publication was available to the public. Eg. the accession date if it is a library book or journal, or the issue date if it is a commonly available magazine.

Use: -A statutory declaration from the parties aware of the use detailing the nature of the alleged use together with evidence that the use referred to the article in question eg. photos, brochures, the article itself. (See 13.21 below.)

Generally only prior registration and prior publication can be supported from the search material available in AIPO. See para. 13.21 below for establishing prior use.

**"MOSAICING" EVIDENCE OF PUBLICATION OR USE.**

13.20 An objection to novelty or originality should not be sustained by showing a number of different designs which each contain an element of the given design. Designs which are a combination of old features may well be new or original (See 13.8). Only a single source of evidence should be used to substantiate lack of novelty or originality.

However, reference to various different designs may be useful in showing that a certain element of a design is common and therefore either immaterial or common to the trade. This is rarely necessary though.

**OTHER MEANS OF ESTABLISHING LACK OF NOVELTY OR ORIGINALITY**

13.21 Evidence for lack of novelty or originality may be gained from any legitimate source so long as a date for their disclosure can be well established and a suitable picture or drawing can be provided.

Sources or circumstances other than the documents detailed in Chapter 15 might include:

**Photos in public.** Photos lodged with the application that show the article obviously in clear view of the public may well show that the design was disclosed to the public, ie. used, before the priority date of the application. This may be raised as a valid objection to novelty and originality. (See "use" 13.7 above )

**Use known to the examiner.** If the examiner actually owns an article which they believe would be valid in substantiating lack of novelty or originality and can establish the time from which it has been in his/her possession, and can supply an illustration of the article then a valid claim to novelty or originality may be made. The same applies if they are aware of anyone else who owns the designed article. In the first instance it may only be necessary to state that the examiner or some other person has such an article in their possession. The substantial evidence required to establish "use" would then only be required if the original claim is contested.

**Evidence from vendors/others** Same as above.

**Self revelation.** Occasionally an applicant will state that the design was available to the public well before the priority date of the application. They must be informed that their design was not new or original at the time of lodgement and is therefore not entitled to registration.

**NON-SPECIFIC EVIDENCE FOR LACK OF NOVELTY & ORIGINALITY.**

- 13.22 There will be occasions when the examiner feels, with good reason, that the design before them is not new or original but after extensive search can find no evidence of prior publication or use to back up their impression. While purely speculative claims should be avoided, it is not always necessary to supply substantial evidence.

In *Eise and Mitchells Application* (1967 AOJP 1538) the Deputy Registrar maintained that it was not necessary for the examiner to produce substantial evidence to establish that a branched plumbing fitting lacked novelty or originality. In the case of such common articles, he said, it was not beyond the examiner to know what was common to the trade, and that it was unlikely that such a common feature of plumbing would be illustrated in any publication.

A similar view was taken in *Trusteel (Australia)'s Application* (1978 AOJP 3600) about a connector plate, that consisted of a plain plate with two studs welded to it. The registrar agreed with the examiner when he/she stated that it was unlikely that illustrations of such commonplace features could be found. In support of his decision he referred to *S. Travers Ld's Application* (Op Cit) in which, at 258, Lloyd-Jacobs J. said:

"It is a fundamental point of law of design that the privilege of registration should not be given to trifling variations, of the kind which a craftsman might be expected to introduce in carrying out his ordinary day to day trade."

And at 259 he said:

"...the more common the knowledge as to general features of a design in the trade, the more difficult it may be to secure representations of such design in current literature. So far as I know, there are no public funds available which would justify the Patent Office in procuring physical embodiments of common designs for the purpose of demonstrating to a dissatisfied applicant particular features of common general knowledge, and it is I suppose, not unreasonable to assume, so far as representations are concerned, that it is only if the Office is fortunate in tracing a representation put out by someone who thinks that it might serve his interest - a position which becomes less and less likely the more the design is common to the trade - that examination of catalogues, textbooks and the like will enable the Patent Office to produce a visual indication."

- 13.23 The following should therefore be kept in mind when considering the novelty or originality of a Design for which no prior publication or prior use can be established:

1. *A search can only be conducted within the resources available.*
2. *The office will never have all the possible search material available in any one art-field. The resources required to conduct an exhaustive search would be prohibitive, even if it were possible or even desirable to conduct such a search. See chapter 15 regarding guide-lines for*

*searching. Extensive searches should only be conducted where the likelihood of finding something is high.*

3. *It is unlikely that illustrations of commonplace designs will be available.*
5. *As far as it lies within the power of the Registrar of Designs, registration of designs that would hamper normal trade practice should be avoided.*
4. *It is not the responsibility of the applicant to prove novelty or originality. It is the responsibility of the examiner to clearly show that the design is not new or original before registration can be refused. The applicant should always be given the benefit of the doubt.*
5. *Anyone may object to the registration of the design during the first 11 months of registration (S.27A 4.) on the grounds that it was not new or original at the time of lodgement.*
6. *Pointing out a possible lack of novelty or originality to the applicant may warn them of possible future conflict if they proceed with the registration.*
7. *A private applicant may be intimidated by an unsupported claim that their design is not new or original.*
8. *A request for a novelty statement may be made if the examiner can support a case that the design is very similar to a number of existing designs which they would not otherwise use as a claim for lack of novelty or originality (see para 6.4).*