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**INTRODUCTION**

14.1 This chapter of the manual assists the examiner in knowing the role of an examiner and the purpose of examination. It also sets out a well regulated set of procedures to help the examiner develop methodical, efficient work practices throughout all facets of examination and includes:-

- The role of the examiner,
- The purpose of examination,
- Guidelines for searching and indexing,
- Acceptable first and further reports,
- An examination check list,
- Expedited examination,
- S.27B, Extensions of time
- Third party submissions,
- Ad-hoc correspondence,
- Under payment of fees,
- Dealing with the clearance of correspondence,
- Signing off and
- Ownership that has been assigned.

**ROLE OF AN EXAMINER**

14.2 It is the role of the examiner to assist applicants to gain the best registration/protection for their designs within the meaning of the Designs Act. The examiner should therefore be helpful rather than obstructionist.

It is also the responsibility of the examiner to clearly show that a design is not new or original before registration can be refused. It is not the responsibility of the applicant to prove novelty or originality.

**PURPOSE OF EXAMINATION**

14.3. The purpose of examination is to act as a "coarse sieve" to separate clearly unregistrable applications from those that are registrable.

Registrability does not guarantee certainty.

An exhaustive search is not possible within the time and resources available to the Designs Office. The Designs Office does however, search through publications or relevant trade brochures and records of design registrations and applications. The office will never have all possible search material available in any one art-field. In addition the examiner will not know every manufactured or hand made article and, therefore, cannot search/prove prior use of such articles unless very obvious.

For further information refer to Chapter 15 for "Searching" and Chapter 13 for "New or Original" in this manual.

**INDEXING**

- 14.4. One of the first tasks an examiner will be required to perform is "indexing" or "classifying" of applications.

Detailed information is given in section 16 of this manual.

**STEP 1****COMMENCING EXAMINATION**

- 14.5 The same steps apply to applications that have been expedited. (see paragraph 14.14)

**BRINGING-UP CASES FOR EXAMINATION**

- 14.5.1 Before commencing examination the examiner will need to obtain applications due for examination. The term used is "Bringing up cases".

Applications should be examined in strict numerical order so it is with this in mind that all the examiners should only take as many cases as can be reasonably handled in one week ie. about 20 case files.

**PROCEDURES**

- 14.5.2 To "bring-up" a batch of cases for examination, the examiner must first refer to the bring-up screen on DESADMIN, this will show the next lot of numbers to be selected.

Take the relevant range of cases from file. When reaching the last number check to see the name of the applicant and the name of the article. If the following applications have been made by the same applicant, the examiner should examine those as well for consistency in the reports.

(Where possible applications lodged on the same day by the same applicant, should be examined by the same examiner as it is much easier for the applicant or his/her agent to deal with the one examiner.)

If the following applications are different they should not be brought up. If they are from the same applicant, take them all. This is why you cannot always strictly take a batch of 20 applications at a time. The number may vary for different reasons. Suffice it to say, you should not take large batches of say 40, 50 or 60 cases because it could conceivably take much too long to examine so many cases and they would then lose their place in the order of examination.

The examiner should only select those numbers that have been taken by them. Those cases that are missing from the bundle, should not be selected on the screen. The cases that are missing may have already been examined.

Isolated numbers before the main batch of consecutive numbers may be back in file, if they are then they should be taken to make up a batch for examination.

Record selected applications on DESADMIN by typing an "s" in front of the relevant number. Then press 'ENTER' and the cases will automatically be assigned to the examiner.

The examiner should then initial the front of the case file.

It is then the responsibility of the examining officer to consider all aspects relating to examination up until the application can be cleared. However only supervising examiners have the delegation to clear an application for registration.

## **STEP 2**

### **CHECKING CORRESPONDENCE AND STARTING AMENDMENT SHEET.**

14.6 All correspondence pertaining to the application should be fastened to a grey card marked "Correspondence".

Read the correspondence to see if there are matters that will need to be addressed in your report. One such important example is what is known as a "third party submission". This is dealt with in more detail in paragraph 14.15 in this chapter of the manual.

All amendments from lodgement and those during examination should be noted on the amendment sheet.

Examples of amendments between lodgement and prior to examination are:-

- (a) Adding a statement in support. The name of the author will need to be entered as an amendment as it would not have been captured on lodgement.
- (b) Representations that may have to be substituted, deleted or added.
- (c) Change of address. If the change is made to the residential address then this amendment along with all the others, except for address for service can wait until the application is cleared.

Address for service should be amended on DESADMIN as soon as the request is received, providing it is an allowable amendment. (For more information see paragraph 17.5 of this manual).

It is good practice to update the amendment sheet with each allowable amendment as and when they are made. This will save time and effort when later making the clear report because the examiner will not have to keep rereading past correspondence.

An amendment sheet is printed on the back of the case file and also on a separate sheet. Either can be used, depending on preference.

Begin by recording the following details on the amendment sheet.

- \* Application number and year.
- \* Name of examiner.
- \* Details of amendment and action to be taken.
- \* Folio number and date of when the amendment request was made.

During examination, if the separate amendment sheet is preferred, it should be stapled to the inside of the front cover so that it can be easily found when clearing the case.

### **STEP 3.**

#### **COMPLETING THE EXAMINERS' REPORT.**

14.7 On the inside front cover of the green application folder there is a printed "Examiners' Report".

(a) Search Directions:

The first part relates to searching details. The main class for searching will be written on the front of the application folder at the time of indexing. However, if the examiner thinks that there are other classes that are relevant to the search they will be marked in this area.

(b) Representation for Card:

This is where any special instructions regarding representations are given to the Operations staff when the application is being indexed. (See indexing procedures in Chapter 16 of this manual.

(c) Similar designs:

This is where any similar designs, related art or s 17 citations found during searching are noted. If nothing was found then an entry of "Nil" should be made.

(d) Comments:

Any comments regarding any of the above should be written here.

(e) Publications Searched:

This is where the examiner indicates any publications, other than the search cards, in which a search has been conducted.

Finish off with your signature and the date on which the search was conducted.

#### **CHECK LIST**

14.7.1 This is for the examiners' use. It is a check list to ensure that all the relevant formalities have been checked. Correct formalities can be ticked. Incorrect formalities can be crossed. Notes can be made as to which objection should be raised. Any other comments the examiner feels necessary or helpful can be noted.

The following is the check list in the order it appears with explanations as to how to deal with each item:

Formalities:

1. Document requirements:

Application documents should consist of:-

- \* 1 x Application form 1 (part 1).
- \* 1 x Statement in Support/Devolution of Title (part 2 of form 1).
- \* 7 sets of representations. (An absolute minimum of five sets of representations may be accepted depending on the circumstances).
- \* Forms 2 are no longer required, but one or more may be lodged.

2. Application Formalities:

The following should appear on every application:

- \* Name of Applicant.(See Chapter 9. Ownership.)

- \* Address of the Applicant should be a place where any legal papers can be served if necessary e.g. Residential/Business address/ Roadside Mailbox (RMB) NOT A P.O. BOX. except in exceptional circumstances.
- \* Date and signatures. All applicants must sign if there are more than one. Original signatures of applicant/s or their agent not photocopies.

Rubber stamp type signatures are acceptable from patent attorneys.

3. Address for service:

Address for service can be:-

- \* The same as the applicant address or otherwise. Can also be a P.O. Box number.

Other formalities.

4. Translations:

This refers to s.49 Convention Documents that are not written in English. See paragraphs 20.12 through to 20.15 of this manual.

5. Convention Documents:

This refers to applications requesting consideration under s.49 of the Designs Act. See paragraphs 20.9 through to 20.11 of this manual.

6. Additional:

Not always included on application form. This only refers to applications making a claim under s.25D of the Design Act. See Chapter 19 of this manual.

7. Divisional:

Not always included on application form. This only refers to applications making a claim under s.22C of the Design Act. See Chapter 18 of this manual.

8. Statement of Monopoly:

This statement is optional and is not always included on the application form. See Chapter 5 of this manual.

### 9. Statement of Novelty.

Not always included on application form. See Chapter 6 of this manual.

### 10. Title:

This refers to the name of the article and should always be included on the application form. (See paragraph 1.6. of this manual for more information).

### 11. Devolution of title/Statement in Support:

It is not always included with the application on lodgement but must be lodged before the application can proceed to registration. See Chapter 9 of this manual.

### 12. Representations.

An application cannot be deemed as lodged unless it contains at least one representation. However, if an application file does not contain a representation when you begin examination, a check of the relevant class in the search material should be made. The reason for this is that sometimes a mistake is made and the only representations is used as the search file representation, instead of a photocopy being taken. It should be taken from the search file and photocopy should be placed on the search file.

The original representation lodged must always remain with the application. See Chapter 11 of this manual for guidance on representations.

### 13. Substantive objections:

This refers to objections taken under major sections of the Act. For example. s.17 for newness or originality; s. 22c because the application contains more than one design; s.25D because the design is an obvious adaptation, or differs only in immaterial details, or in features commonly used in the relevant trade to a registered design, already owned by the applicant.

### 14. Classification:

This refers to the classification that has been given to the design. The examiner should check the class and consider whether other classes need to be included or searched. If the classification needs to be changed then it should be written down on the amendment sheet so that DESADMIN can be amended later. The classification will also have to be altered on the front cover. The representation in the search file will need to be refiled in the correct class/es.

If more information is needed before the article can be classified correctly then this should be requested from the applicant in the Reg.14 report. When a reply is received giving you the nature and use of the article it can then be correctly indexed and the appropriate search carried out. A note should be made that the search will be made when this information is received to remind you that this will need doing before the application can be given a clear report.

#### **STEP 4.**

##### **SEARCHING**

- 14.8 The next step in examination will be to conduct a search of the records to establish newness and/or originality of the design.

Guide-lines for searching can be found in Chapter 15 of this manual.

#### **STEP 5.**

##### **WRITING/TYPING THE FIRST REG.14 REPORT**

- 14.9 A major part of an examiners' task is writing/typing reports in accordance with the Designs Act and Regulations.

The actual physical task of writing your reports is accomplished by using a glossary or format specially written for design reports on the word processing package.

A set of instructions on how to use this glossary together with all DEXTR word processing codes is part of an examiner's equipment. The examiner is urged to make themselves familiar with all the codes available as these are most useful.

They also assist in Departmental Occupation Health and Safety policies by ensuring that time spent at the keyboard is kept within recommended Guide-lines.

If a deficiency exists in these codes the examiner is encouraged to write his/her own and, after consultation, submit them for inclusion into the design glossary.

By using these codes wherever possible it

- \* achieves consistency throughout the Exam Section.
- \* saves time and speeds up the report writing process.
- \* ensures use of plain English.
- \* encourages healthy work practices by reducing time spent at the keyboard.

#### **ORDER & NUMBERING OF OBJECTIONS.**

14.9.1 Objections should be written in order of importance and you can use the order in which the objection is written in the list of word processor codes as an approximate guide.

Every objection taken is numbered consecutively throughout the first report so that the examiner in and the applicant can easily identify which objection is being referred to. When writing further reports the numbers should continue on from the last report.

#### **GUIDE-LINES FOR AN ACCEPTABLE REPORT**

14.9.2 To communicate effectively and achieve an appropriate response there are certain elements a good report should contain. They are:

1. All objections should read clearly. Use plain English. Target the report to the applicant. The report must be so clear and comprehensive that the applicant is left in no doubt as to how to amend the application so it may be accepted.
2. All objections should comply with the Designs Act, office practice and case law precedent.
3. Do not mix different grounds of objection, e.g. an objection to entitlement with an objection to statement of monopoly.
4. All serious objections are taken. A serious objection is one that if not taken could invalidate the design registration.
5. No piecemeal examination. If you need to reserve an opinion clearly state that fact. E.g. you cannot make a search; representations are for more than one design and you have only searched one of them.
6. If any objection is based on an assumption then clearly state that assumption. E.g. assuming that something appears to be common to the trade.
7. Citations are correctly identified. The publication date in Australia is given. Copies of the citations are attached or information as to where copies can be obtained is given.

8. Objections to application form and/or statement in support are accompanied by photocopy of the lodged form showing the deficiency or error objected to. If appropriate, blank forms are provided for the applicant to use to overcome an objection.
9. All enclosures are attached.
10. Final date for response is shown.
11. Contact telephone number is given.
12. Explanations are given, in broad terms of how to propose amendments to overcome the objections and what are allowable amendments and an amendment sheet is provided for each private applicant.
13. Non-statutory matters should be presented as a note to the report.

**NOTE:**

The examiner should avoid implying that "This is done because it suits us" in reports, because it sends a second message; "We don't care about you."

**FINAL STEP:**

- 14.9.3 After completing the report all the above "elements" should be checked (except No 10 for a 1st report) and documents to be included attached to the report. One copy of the report, plus photocopies of citations or other relevant documents should then be placed on the grey "Correspondence" card. When passing the application to the supervisor, the applicants copy and enclosures are to appear first, the correspondence card and application documents should then follow, ready for the supervisor to check and sign.

**FURTHER REPORTS.**

- 14.9.4 "Furthers" is the term used for applications that have had an adverse report issued. As these cases may have time limits in which to overcome objections, the examiner should check to see how close they are to the final date.

The applicant has 12 months from the date of the reg. 14 notice in which to overcome any objections raised. After that a Reg. 16 notice is sent and the applicant then has a further three months from the date of that notice to overcome objections. After the expiry date of the reg 16, applications automatically lapse. If the applicant wishes to continue with the application a request for an extension of time under S27B of the Designs Act will have to be lodged. See paragraph 14.13 of this manual.

All the information needed in checking the final date can be found on the DESADMIN enquiry screen.

The examiner should endeavour to process all further reports within the week they are received. Two weeks should be the maximum. However, applications nearing the final date and expedited cases should be processed as soon as possible after receipt.

See paragraph 14.14 of this manual for information on Expedited cases.

#### Allowable amendment & Processing.

See Chapter 17 of this manual which gives full details on allowable amendments and paragraph 17.05 for procedures on how to complete a clear report.

#### WRITING FURTHER REPORTS.

- 14.9.5 These are produced in the same manner as 1st reports. The information the examiner needs to complete the standard parts of the report will be slightly different but should cause no problems. If a further report is raised, the examiner should clearly indicate which objections have been overcome, and those that have not.

The only major difference will be when completing the bottom paragraph regarding the final date.

#### **Further report - within the 12 month time limit for reply.**

The examiner will have to inform the applicant when this time limit expires. The date is taken from the date of the first Reg 14 report. If the date of the first report is 14th June 1993 then the Final date will be 14th June 1994 i.e. 12 months after the issue date of the first Reg 14 notice.

The endings of these reports are slightly different depending on whether you are writing to an attorney or a private applicant:-

- (a) For a private applicant:  
FINAL DATE for a response is 14th June 1994.
- (b) For an attorney:  
FINAL DATE for the purposes of regulation 16 is 14th June 1994.

Further report - when r.16 notice has been sent.

When the twelve month time limit has expired a Reg. 16 notice is sent to the applicant stating that the FINAL DATE will be 3 months from the date of that notice. A check on DESADMIN will show firstly if a Reg 16 notice has been sent and, if so, the final date for reply.

This final date for reply is then the date to be used.

When this date is expired then refer to paragraph 14.16 of this manual on how to proceed further.

Further reports - when an application has lapsed.

Refer to paragraph 14.16 below.

**MISSED OBJECTIONS.**

- 14.9.6 If an objection was missed and not raised in the first Reg.14 report it should be raised in a further Reg.14 report. Suitable apologies for the omission should be made. (DEXTR code OTH2 should suffice).

**STEP 6**

**CLEAR REPORT - FIRST OR FURTHER**

- 14.10 The following procedure can be applied to either a clear first report or a clear further report.

For a first clear report if there are no objections and no citations are found during the search then a clear report can be issued.

To do this, the "Examiner's Report" should be completed along with any relevant amendments details (if the application was effected), folio details and the date/s the amendments were requested.

DESADMIN should be amended if necessary. A quick check should also be made to ensure that all the relevant details have been captured correctly on lodgement of the application, mainly author and monopoly statement. Add the examining officer's signature and the date.

The view most suitable for publication (in most cases the perspective view) should be pinned to the inside of the case file. The completed examiners report should be pinned to the outside of the case file, if there is no printed report on the back cover.

## OTHER MATTERS

### EXPEDITED APPLICATIONS

- 14.11 Under Reg. 9(1) and Reg 10 (1) (a) and (b) an applicant can "expedite" the examination of his/her application. This means that an applicant can apply in writing and pay a fee to have his/her application examined earlier, rather than in the usual order of examination, which currently is 6 months from the date of lodgement.

The request and fee to expedite the application is processed by operations. The case file is stamped "Expedite" in red on the front. This is then passed to the examination section and distributed to an examiner. This process usually takes about one week to 10 days from the date of the expedite request to examination.

These cases, as well as the furthers of expedited cases, have top priority and should be examined as soon as possible.

### PROCEDURES

- 14.11.1 Please refer to paragraph 14.5 through to 14.11, step 1 through to step 5 and the final step, for how to begin the process of examining an application.

Do not forget to take out and mark one representation for the search material when indexing an expedited application.

The application can then be examined in the normal manner.

If an expedite request is mistakenly overlooked by operations, and the examiner brings up the application in the normal weekly batch, the expedite fee will have to be refunded.

If there are other objections to be raised in a Reg 14 report, the applicant can be advised that a refund is due to them. This should be mentioned under the heading of 'OTHER'. Operations process and initiate refunds.

When an application is cleared but a refund needs to be processed, the supervising examiner will give the case file to operations who will process the refund.

If an applicant is seeking advice on whether to expedite or not, especially if his/her application is very close to being examined, the 6 month period can be used as a yardstick. It is up to the applicant to consider if it is worth expediting.

### UNDER PAYMENT OF FEES

- 14.12 When an application comes up for examination, a check of the correspondence file (normal examination practice) should be conducted for any notifications regarding lodgement fees. If the fee or part thereof is outstanding, then an objection is to be raised.

If the application can be cleared, a telephone call to the applicant reminding him/her of the under payment should be made. Allow two weeks for a response, if the fees, still, have not been paid, an objection should be raised in a reg. 14 notice.

An application must not be registered if there are any outstanding fees.

#### **SECTION 27B**

14.13 Various sections of the Designs Act and Regulations have prescribed times in which particular actions must be completed or performed. An applicant or owner can apply for an extension of time under s.27B to extend any of these prescribed time limits.

The situations that are likely to arise in examination are:-

- (a) When an applicant has received a Reg. 16 notice and is approaching the final date for a response and still wishes to continue with the application.
- (b) If an application has lapsed because it has passed the Reg. 16 reply date and the applicant wishes to continue with the application.
- (c) If the applicant wishes to extend the date for lodging a divisional application.
- (d) If the applicant wishes to claim convention priority where they have lodged their application more than six months after lodging the convention application.

Generally it will be the applicant or their attorney who will initiate an application for an extension of time to register an application before the application lapses, though the possible need for such an extension may be suggested by the examiner in a notice (if a notice is being sent).

Similarly, applications for extension of time to lodge divisional and convention applications will most often be initiated by the applicant or their attorney. The examiner may advise the applicant that such extensions are available if it is likely that the applicant would not be familiar with such provisions.

Where a formal application for extension has been made (ie. where all relevant documents and fees for the extension have been lodged) the application should be passed to the supervising examiner for approval.

Where the applicant has made a response and obviously wants to continue with the application but the application has lapsed, the following procedure should be followed:

#### **PROCEDURE**

14.13.1 REG.14 NOTICE.

- (a) A Reg.14 notice should be drafted. The first objection raised should be under the heading EXTENSION OF TIME using the DEXTR word processing codes.

Any further objections may be made in the same notice.

- (b) At the end of the Reg.14 after "Final date for a response is" the examiner should type "expired".
- (c) Attach an information package to the notice and send it out as usual. The package should consist of
1. an information sheet.
  2. a Form 10 (Application for Extension of Time), and
  3. a Statutory Declaration form.

All these forms are kept in the operations area, but you may wish to make up your own packages ready for use.

The information sheet will need to be filled out with the relevant fees involved. The extension should be for the most likely time-frame.

- (d) Pass the notice to your supervisor. He/she will record the notice on DESADMIN and dispatch the notice.

#### **DEALING WITH THE CLEARANCE OF CORRESPONDENCE**

- 14.14 All examiners take turn of one week each with this duty. Most of the cases will probably be furthered. Others can be expedited cases. Furthered should be given to the examiner whose initial appears on the front of the case file. Otherwise the duty examiner actions the correspondence, and returns the case to file. Common-sense and initiative should be used.

#### **PROCEDURES**

1. Expedite cases.

All examiners including supervisors deal with these cases. They should be distributed fairly throughout the exam section. If there are two or three applications from the same applicant these should be given to the one examiner. However, if there are perhaps 30 cases the same, these could be fairly distributed among the examiners. Common-sense and initiative should be used.

2. "Further" cases.

Further case files are marked with the initials of the examiner responsible for them, they should be distributed accordingly.

### 3. Ad-Hoc letters

This term usually refers to any correspondence pertaining to pre-examination cases which needs action to be taken before the case is due for examination.

The examiner will need to read the letter and initiate whatever action is required. If the matter can be left until the case is examined, the correspondence should be marked "NO FURTHER ACTION". Sign off the front of the case file under "clearing officer" and "date cleared" and return it to file.

Examples:

The type of correspondence needing action could be:-

(a) Change of address for service.

The examiner should check that the amendment is acceptable. Then fill out and amendment sheet and amend DESADMIN in the prescribed manner.

Care will need to be taken:

If the change of address request has been submitted by an Attorney then it can be accepted. However, if the change is requested by a private applicant it should be made by the applicant themselves. If not, then some question may have to be raised on whose authority the request has been made. There could be a conflict of interest. (See paragraph 17.7 for more information).

If there is more than one change of address for service requests then the cases should be shared throughout the examiners.

(b) Pre-examination 3rd party submissions

Occasionally a 3rd party objection to registration can be received before the case is due for examination. These letters must be acknowledged.

It should state that the case has not yet been examined and that the information will be considered when the application is examined.

#### **THIRD PARTY SUBMISSIONS BEFORE OR DURING EXAMINATION**

- 14.15 Third party submissions are when material is lodged in evidence that a design is not new or original before the design application is registered.

If the notice was received prior to examination, the clearance officer should have acknowledged the notice.

Carefully consider the submitted evidence and, if the objection is well founded, use it as the basis of an objection to the registration under s.17 of the Designs Act in a Reg 14 report.

A letter is also written to the informant advising him/her that the evidence is being considered.

If the examiner considers that the evidence will not be used because it is not relevant, state this fact in the letter.

The letter to the informant, should also mention that if the application does proceed to registration, opposition to the extension of the period of registration can be lodged (within the first 11 months of registration) under s.27A(4) of the Designs Act. No additional material should be requested. However, they may be informed as to what sort of evidence would be best.

The informant will need to know that it is his/her responsibility in pursuing the status of the application/registration. The office is not obliged to keep the informant informed of the status of the application. The informant will have to keep checking the official journal for the registration details.

#### **SIGNING OFF**

- 14.16 Throughout the life of the application the details of any action taken should be recorded in the correspondence and on the front of case file which should be initialled and dated before being returned to file or passed to another staff member for further action.

#### **OWNERSHIP OF A DESIGN THAT HAS BEEN ASSIGNED.**

- 14.17 The operations section processes all applications for registration of an assignment on applications and registered designs. Should such an application be received by an examiner it should be given to operations to process. (Refer to paragraphs 17.4 of this manual).