

**CHAPTER 15****SEARCHING****INDEX**

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**INTRODUCTION**

- 15.1 Designs are searched to try and establish that they are new and original. This is one of the most important tasks of designs examination. Only a new or original design may be registered. This is specified by Section 17 of the Designs Act.

**WHAT TO LOOK FOR**

- 15.2 When searching, only designs that are similar should be used to establish that a design is not new or original. "Similar" in this instance is defined by the terms immaterial differences, trade variants, obvious adaptations and copyright. These terms are explained in more detail in Chapter 13 of this manual.

- 15.3 Also if a similar design is found it has to have been registered, published or used in Australia before the priority date of the application the examiner are searching. This is also explained in more detail in Chapter 13 of this manual.

**WHEN TO SEARCH**

- 15.4 As stated, the reason designs are searched is to try and establish that they are new or original. However, if it is reasonably obvious to the examiner, that the design is new or original, a search may not be necessary. To search or not, is a matter of judgement and usually only applies to the more experienced examiners as they are familiar with, and have a good knowledge of, the search material. If there is any reasonable doubt as to the newness and originality of the design a search should be conducted.

**WHAT CLASS TO SEARCH**

- 15.5 Before a search is commenced the examiner will have to check that the application has been correctly indexed. If the indexing is not correct, the examiner should amend the indexing. The search material and Desadmin must also be updated.
- 15.6 Sometimes there is not enough information for a correct classification and more information will be requested from the applicant before a search can be commenced. This is usually in the form of better representations or more information about the article itself. A search cannot be commenced until the examiner has received the better representations or the additional information.
- 15.7 Also, sometimes depending on the nature of the design, it could be appropriate that searches be conducted in a related class or even an unrelated class. This especially applies in articles such as clothing, fabrics etc.

**WHERE AND HOW TO SEARCH**

- 15.8 **Previous registrations and applications.**

This is the main area of searching the examiner will be required to do. All applications (except as mentioned in part 15.4) will have to be searched for previous registrations and applications indexed in the class of the application under examination. There are two ways to do this. They are:

- 15.9 (i) using the search cards. These contain most previous registrations.

**Note:** As some classes, such as computing, are changing rapidly they only go back about twenty years. To go back further in these particular classes the examiner will have to look at the micro-fiche set of search material.

- 15.10 (ii) using the micro-fiche. These contain all previous registered designs. Unlike the cards they have no twenty year cutoff. But, the micro-fiche are only updated every six months with new registrations. So if the examiner uses the micro-fiche they will have to search the recent registrations via the cards.

- 15.11 Current applications must also be searched. These are stored separately from the search cards.

- 15.12 If a previous design is found the examiner will have to firstly establish if it was lodged before the priority date of the application being searched. If it is not, it can be disregarded. If it is, the examiner can use it in a notice. A copy of the representation should be sent with the notice. If the previous design is an application the representation cannot be used as a citation, as an application is not open to public inspection. In this case a letter instead of a notice should be sent to the applicant. The letter should tell the applicant that there is a prior registration and that a reg. 14 notice will issue when the earlier application is resolved. Once the cited application is registered, lapsed or refused a notice can issue. The case file of the earlier application should be annotated to the effect that the second application needs a reg. 14 notice when the first one is resolved.

**OTHER**

- 15.13 Sometimes after the examiner has searched the registrations and applications and not found anything, they still feel that the design is not new and original. The search can be taken further. This does not apply to all searches only as stated above. Options for the examiner are:

- (i) **Other search material in the designs area.** In the designs area there are journals, magazines, suppliers index, books etc which cover many areas. Again if a similar design is found the examiner will have to ascertain if it was public before the priority date of the application under examination.
- (ii) **IP Australia library.** IP Australia, due to the nature of its work has an extensive library. The books, magazines, journals etc cover a wide area in respect of designs.
- (iii) **Patents, Trade Marks And Other.** Patents are indexed and searched using the International Patent Classification. Mechanical type subject matter could usefully be searched in patent specifications. The trade marks search material is useful for searching logo type designs. Before searching these areas an examiner should discuss the search with their supervising examiner.

**RELATED ART**

- 15.14 If the examiner finds some previous designs that are close to the application being searched but not similar enough for a citation they should still be noted. These close designs are considered as related art and are recorded on file and via amendments (see Chapter 17 of this manual).