

**CHAPTER 17****AMENDMENTS****INDEX**

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**INTRODUCTION**

17.1 Sec 22B of the act deals with amendments to applications.

Amendments can be made to an application before or during examination. Amendments can be made to the name of the applicant, address of the applicant, name of the article, the representations, details relating to convention, divisional or additional claims, the monopoly statement, novelty statement and address for service. Basically anything that appears on the application form. The Statement In Support cannot be amended see (17.6).

S22B (1A) states that amendments may be refused if the scope of the application is increased by including matter that was not in substance disclosed in the original application.

Requests to amend an application should be in writing and in accordance with Reg.13 and Form 4, although there are some exceptions see (17.8).

There could be any number of reasons why the applicant requests an amendment. eg.

- \* change of ownership in the design,
- \* change in the residential or address for service,
- \* to overcome examiners objections, so that the application can proceed to registration,
- \* an error in the representations,
- \* an error in wording in parts of the application.

Examiners do not deal with amendments to registered designs. Requests to amend registered designs should be processed by operation staff.

**SCOPE OF THE APPLICATION**

17.2 By amending the name of the article, monopoly statement or representations, the scope of monopoly could increase, decrease or change completely. Especially when the amendment introduces new matter that was not shown in the application originally.

Very broad examples are given below. Each amendment should be judged individually in terms of the possible increase to the scope of the application.

Where an amendment could increase the scope of the application,

**a) In the name of the article;**

When the applicant requests that the name be amended to include an article or part of an article that has not been shown in the representations. eg

Original name "container", applicant requests name to read "Container and components thereof".

If the component parts were not shown in the original representations, the amendment should not be accepted, because the scope of the application would be increased.

**b) In the monopoly statement;**

- i) If the article does not show pattern and ornamentation and the applicant requests that the monopoly statement be amended to include it, the request should not be accepted because the scope of the application would increase,
- ii) When a disclaimer is requested, it too can increase or broaden the scope of monopoly protection. eg. "The position, shape and number of slots in the array should be disregarded.

**c) In the substitution of new representations;**

- i) Where the original representations have shown pattern and ornamentation and the new representations did not. The examiner would object to the substitution of the representations on the grounds that the scope of the application would be increased, because new matter would have been included,
- ii) In the case where the original representations are so bad (eg photocopied photographs, or just a dark mass) that the examiner can not determine what the design is, the mere substitution of new representations could increase the scope. The reason being that the original design was indiscernible.

The following two are less important, however they could be useful when making comparisons and decisions.

**Where an amendment decreases the scope of monopoly;**

**a) In the name of the article,**

The examiner should object to the name if the name is too general. eg.

- i) "textile article" implies any article that has been made of textile material. This could be amended to read "a bag" or simply name the article that is shown in the representations.
- ii) "article of clothing" implies any bit of clothing. This could be amended to read "t-shirt".

**b) In the monopoly statement,**

When all four features are shown in the representations and claimed in the monopoly statement, the applicant might request to delete or disclaim, say, pattern and

ornamentation. This would be acceptable, however their scope of monopoly would decrease.

**c) In the substitution of new representations,**

Where an isolated graphic design has been lodged, the examiner should object to the fact that the design has not been applied to an article. The scope of the monopoly would decrease once the design has been applied to, say, a t-shirt.

**Where an amendment changes the scope of monopoly;**

Generally speaking, any amendment changes the application. However, a change in the scope of monopoly could result when representations have been substituted.

**a) In the substitution of new representations,**

When the request to substitute new representations show that the article in the new representations is not at all similar to the original article, an objection should be taken. Even though the scope of monopoly may not be decreased or increased by the substitution, it changes. The request to amend the representations would not be considered as "a genuine amendment reasonable in scope". (see *Chris Ford* below.)

**ALLOWABLE AMENDMENTS**

17.3 In terms of Sec 22B (1A), provided that the new matter disclosed in an application, by way of an amendment, does not increase the scope of the application significantly, the amendment would be an allowable amendment. Examples of allowable amendments are given below.

**In the name of the article,**

The original name read "Container" but a container and lid where shown. The request to amend the name to "container with lid" would be an acceptable /allowable amendment.

**In the monopoly statement,**

Where an applicant claimed features that were inappropriate originally, and requests to amend those features to the appropriate ones, the amendment would be allowable. An example of a monopoly statement before and after an allowable amendment is given below;

**Before :** Monopoly is claimed in the shape and configuration of the textile material as shown in the representations.

**After:** Monopoly is claimed in the pattern and ornamentation of the textile material as shown in the representations.

*Re Application by Bourjois Ltd* (1988) 11 IPR 625 refers in passing to whether an amendment to the statement of monopoly constituted an increase in the scope of the application. A brief summary in terms of the amendment to the monopoly statement of that case is given below:

- The salient feature of the design was the two tone aspect of the lipstick. The tonal consistency was illustrated in the representations by "dot shading", indicating that the contents have the same tone as the outer casing.
- The original features of the shape and configuration of the lipstick were amended to pattern and ornamentation.
- The pattern and ornamentation was derived from the tonal consistency of the outer casing and the lipstick itself.
- The effect of that amendment was that the application, did not include new material.
- The attorney for the applicant said "the limits are found in the actual representations which, for the purposes of the scope of the design, override whatever is said in the statement of monopoly."

**By the substitution of new representations,**

The examiner may have objected to the quality of the representations or the applicant may have requested that the formal representations be substituted prior to or during examination. In any case, if a perspective view, for example, was included in the new representations but not in the originals, as long as it is a perspective of the original article, this is an allowable amendment.

In the case of *Chris Ford Enterprises Pty Ltd v. B. H. & J. R. Badenhop Pty Ltd* (1985) 4 IPR 485 at 498 Smithers J. said:

" The definition of `amend' is in liberal terms. Representations must disclose something not disclosed in the application before amendment. The restriction found in S22B(1A) is not intended to exclude all amendments which introduce some difference in shape and configuration of the article outside that disclosed in the original application. It would seem that it is designed to exclude amendments which extend the scope in some fundamental way and make disclosures clearly beyond those already made. The terms of S22B(1A) are in a sense imprecise and call for the exercise of judgement. Reading the section as a whole it is proper to conclude that parliament intended genuine amendments reasonable in scope should be permissible and that the restrictive provision of S22B(1A) should be interpreted accordingly."

The amendment to the representations was not really the issue in the *Chris Ford* case, but a brief summary in terms of the validity of the amendment may be helpful and is given below:

The original representations showed a mat comprised of twelve interconnected flat sided tubes. The replacement representations were lodged showing a similar mat with round sided tubes, together with modifications to the gluing key.

It was contended that the redesigned mat increased the scope of the application, because new matter had been included that was not originally disclosed.

It was argued that the scope of application was not increased, because there were still twelve tubes made of rubber in a mat, with a differently shaped top half and slightly modified arrangements.

Because there were no additional elements in the amendment and the change in the shape did not, in the relevant sense, disclose a matter not already substantially disclosed, it was decided that the scope of the application did not increase.

What was already disclosed was a twelve tube solar mat with tubes forming the upper portion and a key arrangement in the lower portion.

**Other allowable amendments** are those where the scope of application is not affected. They are;

- The name of the applicant,
- The residential address of the applicant,
- Convention details,
- Divisional details,
- Additional details,
- Novelty statement,
- Address for service,

#### AMENDING THE NAME OF THE APPLICANT

- 17.4 Where an amendment would change the name of the applicant substantially, and the rights in the design were not assigned (see Sec 20B of the designs act), a statutory declaration and any other evidence should be forwarded stating and supporting the reasons why the error was made or why the name should be changed.

Before the amendment can be made, the examiner should be satisfied that the reasons given on the statutory declaration do warrant the amendment being made.

#### AMENDING THE ADDRESS FOR SERVICE

- 17.5 Most requests to amend the address for service are taken on good faith by the office, that it is the applicants wish to have the address amended. And, in most cases that is correct. However, there have been one or two cases where a conflict of interest has arisen. In both cases, two address for service requests had been received for each application. This is

what normally alerts the examiner to the fact that something is not right. The examiner must clarify the situation. A brief description of the two cases is given below:

- 1) The address for service was amended from one attorneys firm to another. However, correspondence was received from the previous attorney. Correspondence from the new attorney was also received. Both were claiming to be the address for service. The office asked the attorneys to sort out who was to be the address for service. It turned out that the original address for service was to remain the address for service for the application and the other address for service was for the assignment that was taking place.
- 2) Correspondence was received requesting that the address for service be amended as per the request. Shortly after another request was received, accompanying the request were copies of a will naming the applicants wife as the beneficiary. Legally the applicants wife is entitled to be the owner and therefore the amendment is allowable. The other request was from the applicants mother. She was not entitled to be the owner or agent.

In any case clarification is necessary.

#### **PART OF AN APPLICATION THAT CANNOT BE AMENDED**

- 17.6 A statement in support cannot be amended, even when a request for amendment says "Throughout the documentation, amend the name of the article to ..... ". For the simple reason that a statement has been made by a person. Therefore nobody can legally or physically "amend" what another has stated. Consequently, if an objection has been taken regarding any details on the statement in support, a fresh statement should be forwarded.

### **PROCEDURES**

#### **WHEN A FORMAL PROPOSAL HAS BEEN RECEIVED FROM AN ATTORNEY,**

- 17.7 The examiner should check to see that the following requirements have been adhered to;
- a form 4 should be used. The details of the request for the amendment should be clear, (eg substitute the attached documents or amend application as stated in the statement of proposed amendments),
  - a statement of proposed amendments should accompany the form 4. Details of the amendment and exactly what is to be amended should be set out on this statement. Each consecutive statement of proposed amendments should be numbered accordingly.
  - other forms or documents that could accompany a request for amendment are; a substitute application form, a substitute or original statement in support or substitute representations,

Once the above requirements have been met, the examiner should carry out the following steps;

- 1) consider whether the amendment/s is/are allowable,
- 2) check to see that all objections have been overcome. In the case where they have not, a further notice should be issued. It should state which objections have been overcome and those that have not. Additional reasons for the objection may need to be supplied if they have not already been raised.
- 3) check that covering letters are date stamped by this office, and that new forms or representations are always perforated. This saves confusion especially when more than one lot of representations have been requested to be substituted.

**Note:** It is good practise to update the amendment sheet with each requested and allowable amendment, especially when objections have been overcome in dribs and drabs. This saves rereading the entire correspondence each time an amendment proposal is received.

- 4) When all objections have been overcome and the application can be cleared. The amendment form must be filled out with relevant amendments or folio details, the date/s the amendments were requested and the examining offices signature and date,
- 5) Update the desadmin system according to the amendment sheet or as stated on the statement of proposed amendments. (For more information relating to amendments on desadmin please refer to your LAN Manual.),
- 6) Amend the representations neatly. The view that has been deleted should state "view deleted". Informal representations should be placed in an informal folder.
- 7) Substituted application and statement in support forms should not be placed in the informal folder. They should be attached to the original form. The new form should be marked "substitute".
- 8) It is also good practise to amend the application form. Especially the address for service. This is handy if the examiner relies on information on the form rather than desadmin,
- 9) When the application can be cleared, pass it on to the supervising examiner so they can approve the amendments and clear the application. If the application cannot be cleared, the examiner should sign off the front cover of the file and return the case back to file.

**WHEN A FORMAL REQUEST HAS BEEN RECEIVED FROM A PRIVATE APPLICANT,**

- 17.8 The examiner should be satisfied that the objections in the response have been addressed. This can take the form of a letter. Therefore a form 4 and statement of proposed amendments is not necessary. Because private applicants may not be familiar and are not expected to know the requirements of reg 13, they do not have to strictly comply. However, well and good if they do.

When the examiner is considering the reply and amendments, points 1 to 9 as set out above should be followed.

**INFORMAL REQUESTS. IS THERE SUCH A THING?**

- 17.9 The answer is yes, but they should be avoided. The reason that they may be considered is because in the long run, they help the applicant achieve registration.

Informal requests to amend an application are normally made or discussed on the telephone. Essentially the objection must be raised by the examiner and be in writing.

**Possible scenarios,**

If an attempt has been made by the applicant or attorney, to overcome the objection, and further clarification is required by the examiner, a telephone call may be made to make clear any uncertainty

OR,

Where no attempt has been made to overcome an objection, because it may have been overlooked by the applicant or attorney.

In any case both attorneys and applicants are happy to receive a telephone call and are pleased to discuss matters that have not been settled. Especially when the application is close to the reg 16 expiry date.

A follow up letter should be sent in most/all cases confirming the conversation.

If the applicant or attorney and examiner each record the conversation on their file, the examiner need not follow up with a letter confirming the amendment.

BUT the only way an "informal amendment" can become a "formal amendment" is by the examiner carrying out the following steps;

- 1) The conversation between the examiner and applicant or attorney should be recorded (in writing) and the note should be attached to the file. Regardless of whether a response in writing from the applicant or attorney follows up or not,
- 2) If a response in writing does follow up. This response should then be considered and actioned accordingly,

- 3) Refer to points 1 to 9 above when considering an amendment.

#### **ASSIGNMENT REQUESTS**

- 17.10 If the ownership of the design has been clearly assigned (assignment documents should be enclosed), the case file should be given to operations staff to process the assignment.

All examination procedures should be carried out (when possible) before the case file is given to operations. This avoids unnecessary delays, especially if the reg. 16 date is nearing expiry.

#### **AMENDING THE APPLICATION DOCUMENTS**

- 17.11 All amendments (except for amendments to representations) are recorded on DESADMIN. The application form is marked by means of an amendment stamp to indicate that amendments have been made.

To find out what amendments were made the examiner should look at the Examining Officer's Report Form in the case file.

#### **For statement in support:**

- (i) if original statement is lodged after first notice and is allowable, add statement in support to application documents.
- (ii) if "substitute" statement lodged, mark the original "informal" and leave both forms with the application documents.

#### **Representations**

When acceptable representations lodged, incorporate them into application documents. All representations that are no longer relevant are placed in envelope marked "informal".

#### **Address for Service**

When the address for service is amended the Form 1 should be physically amended to show the new address.

#### **Applicant Name**

The new name should be entered onto Form 1.

#### **Other**

(Address of applicant, name of article, statement of monopoly, convention details, additional details, divisional details and statement of novelty)

The application form should be stamped. No entries are made to the Form 1.