

CHAPTER 19**S25D ADDITIONAL APPLICATIONS****INDEX**

19.1	Introduction
19.2	Determining S25D Claims
19.3	Same Owner/Applicant
19.4	Parent in force
19.5	Obvious adaptation
19.6	Differing in immaterial detail
19.7	Features commonly used in the relevant trade or trade variant
19.8	Prior art, close art and wide art

INTRODUCTION

- 19.1 Owners of registered or pending designs can apply under this section of the act to register a further design that is a modified or similar version (the child) of an original registered or pending design (the parent).

The registration of the child can only be in force as long as the registration of the parent remains in force. While renewal fees are paid on the parent, the renewal of the child is extended free of charge. The priority date for the child generally is not the same as the parent. The child comes into force on its own date of lodgement. S25D may apply to applications lodged on the same day.

In short, it may be helpful to think of the additional applications (parent and child) as a single design once both are registered. Apart from the Separate lodgement dates of each application, both designs (parent and child) behave as if they were a single design when it comes to renewals and ceasings.

Representations play the most important role when considering a S25D claim.

Details of the claim should appear on the form 1 of the child application and not from correspondence.

DETERMINING S25D CLAIMS

- 19.2 Whether the applicant/owner has made a claim in respect of S25D or the examiner has requested them to do so, the details should eventually appear on the form 1 (Regulation 5, schedule 1). In any case the following four points should be considered;

- 1) the parent, child and/or citation should have the same owner/applicant,
- 2) the parent should be registered or pending and in force,
- 3) the designs should be similar or commonly said to be:
 - a) an obvious adaptation,
 - b) or differing in immaterial detail,
 - c) or features that are commonly used the relevant trade,
- 4) the nature of the article and the extent of prior art should be considered. A search should be conducted to determine these aspects.

All of the above aspects are discussed below:

SAME OWNER/APPLICANT

- 19.3 When a claim in respect of S25D has been made or the examiner has a citation, the owner/applicant should be checked to see that it is the same. The case file, register entry or DESADMIN enquiry screen should be used.

If the owner/applicant is not the same, a S17 objection should be taken rather than a S25D objection. The applicant may have to go through an assignment or change of name procedure to rectify the different owner/applicant name. (If this procedure takes place the S17 objection should be withdrawn).

PARENT IN FORCE

- 19.4 The examiner should always check `DESADMIN` to see that the parent is in force, because it may be lapsed or ceased. The applicant should be made aware that since the parent has ceased/lapsed, the claim under S25D will result in the instant ceasing/lapsing of the child case. S17 may apply in this case.

OBVIOUS ADAPTATION

- 19.5 Is when an owner has a design and then makes an application for registration of the same or similar design, but applies it to a different article. (eg the owner has a design for a toy car, then makes a further application. The difference is that, the design of the toy car has been applied to a telephone)

DIFFERING IN IMMATERIAL DETAIL

- 19.6 If features of the designs are not substantially different then the differences between the designs can only be said to differ in immaterial detail, (eg if two tables have exactly the same design applied to them, but one is longer, the difference then is immaterial)

FEATURES COMMONLY USED IN THE RELEVANT TRADE OR TRADE VARIANT

- 19.7 Is when two designs are very similar yet the only minor difference is something that is commonly used in that particular trade (eg two bottles have the same or similar design applied to them, the minor difference being that one bottle has a screw top, the other has a pull top). The variation of tops is common in the bottling trade, for more information relating to features common in the trade please refer to *J Rapee & Co Pty Ltd V Kas Cushions Pty Ltd And Another* 15 IPR 577.

PRIOR ART, CLOSE ART AND WIDE ART

- 19.8 *Prior art* – can be ascertained from the examiners knowledge, a search of the records, files and from publications. By comparing the designs, the examiner will be able to judge and decide just how substantial any differences are between the designs.

Close art - where there is a close art field any change to a design, regardless of how small, could be considered substantial. (Consequently a S25D objection should not be raised). (eg bottles, it would appear that bottles have almost had every possible conceivable design applied to them).

Wide art - where the art field is wide and changes have been made to a design, S25D may apply. The changes maybe quite substantial and the overall appearance of the article may look quite different. These differences may be attributed to technology or features that are used widely in the relevant trade.

This concept was a key element in the decision of *re Albion Hat & Cap Company Pty Ltd* 21 IPR 558. Illustrations from this decision are shown overleaf. In summary, the hearing officer decided that Registered Design No 106939 (right) was a valid additional application of Registered Design No. 97217 (centre).

On first sight the two designs would be considered to differ quite markedly and not be entitled to such a claim. However, the hearing officer decided that, in the light of the claimed prior art Design Registration No 89789 (left), the child differed less from the parent than the parent did from the prior art and was thus entitled to claim additional status.

In this decision the differences between the prior art design and the parent case establish a wide art field because i) the differences between the two designs are so marked and ii) there are not many of this type of item in existence.

