

### Registrar of Designs guidance regarding excluded designs

IP Australia has carefully considered the concerns expressed by IPTA and individual practitioners regarding the treatment of excluded designs filed prior to a request to amend an initial application.

We understand that the practice of filing excluded designs prior to an amendment request arose primarily from a desire by professional stakeholders to ensure that excluded designs could be filed prior to the processing of requests to amend the initial application (which led to other designs in the initial application being registered, and the prescribed period for filing excluded designs ending).

Stakeholders are concerned that if excluded designs filed prior to an amendment request are considered non-compliant with the *Designs Act 2003* ('Act') and *Designs Regulations 2004* ('Regulations'), it may result in loss of rights in certain circumstances.

The Registrar's position is outlined in detail below. In summary:

- (i) the Registrar considers that compliance with the Act requires an excluded design application to be filed after, or electronically at the same time as, the request to amend the initial application.
- (ii) with respect to excluded design applications (and subsequent registrations) filed to date, non-compliance with the Act, namely the filing of documents in the wrong order, it is the Registrar's view that this should not result in invalidity of the excluded design. Such a design remains validly registered as an excluded design and able to claim priority from the initial application.
- (iii) out of an abundance of caution, in situations where a current excluded design application can be refiled to ensure compliance, this should be done. The Registrar will write to relevant applicants inviting them to refile applications (and withdraw incorrectly filed applications) and will waive fees, by way of refund, for the earlier application.
- (iv) it would be inappropriate for the Registrar to grant extensions of time under s 137 to file or refile an excluded design application where the initial application has been withdrawn, or any designs in the initial application have been registered. Nevertheless, it is open to applicants to file a request for an extension, which the Registrar would be obligated to consider. Such extensions should be applied for prior to processing of excluded design applications recommencing (see below).
- (v) the Registrar intends to commence processing of excluded design applications from **16 May 2025**.
- (vi) it is the applicant's responsibility to ensure that amendment requests and excluded designs are filed in the correct order. The three day delay on processing amendment requests should provide ample time for excluded design applications to be filed subsequent to filing of the amendment request.

Applicants are encouraged to seek independent advice if they hold concerns with respect to the validity of their excluded designs. The Designs Office does not provide legal advice to customers or the general public.

***Does the order in which an amendment request and an excluded design are filed matter?***

Section 23(1) sets out conditions to be met for an excluded design application to be filed.

Section 23(2) of the Act allows an application for an excluded design to be filed under s 21 within the prescribed period.

Reg 3.02(a) of the Regulations defines the period as beginning immediately after the Registrar has received the request to amend the initial application under s 28 of the Act to exclude the excluded design or designs, and reg 3.02(b) defines the period as ending when either the initial application lapses or is withdrawn, or a design disclosed in the initial application is registered.

The Registrar considers the better view is that:

- the Act intends for applicants to file the amendment request prior to the application for the excluded design, even in cases where both are filed on the same day, and
- the filing of an application for the excluded design at any time prior to the amendment request is not compliant with the Act, and
- similarly, the filing of an excluded design application at any time after the filing of an amendment request during the prescribed period, even on the same day, is compliant with the Act.

With respect to an amendment request and an application for an excluded design that are filed electronically together at the same time, the Registrar treats the amendment request as having been made first in time in order that both be effective.

The Registrar also considers that it is not necessary for the initial application to have actually been amended prior to an application for an excluded design being filed. The Registrar considers it is merely necessary for a request to amend the initial application to have been filed prior to the excluded design application.

***Consequences of non-compliance***

As to whether any non-compliance with the Act affects the validity of the excluded design (including registered excluded designs), in the sense that it is no longer considered a valid excluded design able to claim priority from the initial application, the Registrar's position is that she intends to treat such excluded designs that have been filed prior to the corresponding amendment request on the initial application as valid (and will treat such designs as having the priority date of the initial application) for the following reasons:

- applicants did not derive any illegitimate benefit from making an excluded design application early – applicants merely sought to take advantage of the benefits conferred by the Act and Regulations and avoid having actions occur that may have resulted in the expiry of the prescribed period.
- applicants could very likely have corrected any non-compliance if they had been aware of the issue at the time.
- invalidity could otherwise have the potential to adversely affect design right holders: the Registrar's position is consistent with there being no discernible legislative purpose to invalidate acts that did not comply with the statutory requirements.

In arriving at the above position, the Registrar is guided by the High Court decision in *Project Blue Sky Inc v Australian Broadcasting Authority* [1998] HCA 28.

***Status of currently pending applications***

Notwithstanding the above, and considering this issue has not been the subject of judicial consideration, now that applicants are now aware of this issue the Registrar recommends that applicants who have an opportunity to correct any non-compliance for currently pending applications for excluded designs should do so.

Current applicants for excluded designs that have not proceeded to registration can withdraw and refile those applications, where the original excluded design application was filed prior to the amendment request, and where the prescribed period for filing an excluded design remains open (namely, where the initial application has not lapsed or been withdrawn, or designs in that application have not proceeded to registration).

The Registrar will exempt, pursuant to reg 11.11, the fee for the earlier application. A request for refund of the fee for filing the earlier application should be filed via Online Services and can be included in the same request to withdraw the earlier application.

***Future applications for excluded designs***

The Registrar has published updates to the Designs Manual and formalities correspondence, and implemented new messaging on Online Services as of 14 March 2025, to reduce the likelihood of amendment requests and excluded design applications being filed in the incorrect order.

From a practice perspective, examiners will wait a period of 3 business days before actioning amendments requesting designs be excluded from an initial application, to allow additional time for excluded designs to be filed before the processing of requests for amendments and subsequent registration of other design/s in the initial application.

The Registrar emphasises that it is a matter for applicants and their agents to ensure that documents are filed in the correct order in accordance with the requirements of the legislation.

There will also be consideration of changes to Online Services processes for excluded designs as part of ongoing system enhancements. Further information about such changes, if they are feasible, will be provided in due course.

***Changes to the Act and Regulations***

The Registrar does not intend to pursue retrospective amendments to the Act and/or Regulations.

The Registrar is considering whether prospective changes to the Act and/or Regulations are necessary, or whether procedural changes are sufficient to mitigate any risks. This will be discussed further with IP Australia's Policy and Stakeholder Group.

***Extensions of time to file an application for an excluded design***

The Registrar's position regarding extension of time applications under s 137 is outlined below:

- for pending excluded design applications filed prior to an amendment request for which the initial application has not lapsed or been withdrawn, and where designs in that application have not proceeded to registration, the prescribed period has not expired and an extension of

time is not required to be sought. The Registrar recommends that applicants consider refiling an excluded design application and withdrawing the earlier incorrectly filed application.

- where an initial application has lapsed due to failure to respond to a formalities report, an extension of time under s 137 to restore the initial application, and therefore allow an amendment request and an excluded design application to be filed, could be requested and subsequently considered by the Registrar.
- for pending excluded design applications filed prior to an amendment request for which the initial application has been withdrawn, or where designs in that application have proceeded to registration (including the relevant excluded design), the conditions in ss 23(1)(c) and (d) of the Act cannot be satisfied regardless of whether the Registrar granted an extension of time to file such an application under reg 3.02(b). As such, the Registrar is likely to consider it inappropriate to grant an extension of time to re-file such applications.

In regards to the last situation, namely, where we consider it is not possible for the excluded design application to be refiled due to withdrawal of the initial application or registration of any designs in the initial application, we understand that applicants in those cases may still wish to file an application under s 137 for an extension of time to allow them to refile an application for an excluded design. The Registrar would be obligated to consider it.

## Conclusion

The Registrar will, where appropriate, write to applicants for currently identified applications where the excluded design application was filed prior to the request to amend the initial application, providing them the opportunity to refile their application for an excluded design so that it is filed correctly within the prescribed period. The non-compliant application can then be withdrawn.

Processing of existing applications filed in the correct order, refiled applications, and other currently suspended applications (including those where it is no longer possible to refile an excluded design) will recommence from **16 May 2025**.

The Registrar thanks stakeholders for their patience and hopes that this guidance, and the actions outlined above, will alleviate stakeholder concerns.

If you have any questions regarding individual cases, please contact:

Monique Everett (02 6222 3606) or Pamela Prieditis (02 6283 2224) or MDB-QualityPracticeCustomers-Designs@ipaaustralia.gov.au.

If you have any questions regarding the Registrar's position, please do not hesitate to contact Blake Knowles on 02 6283 2301 or by email [Blake.Knowles@ipaaustralia.gov.au](mailto:Blake.Knowles@ipaaustralia.gov.au).

Kelly Sims

Registrar of Designs

General Manager, Trade Marks and Designs Group

IP Australia

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