

Design infringement – an overview

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Introduction

A design registration provides protection for aspects of the appearance of an article, such as its shape, configuration, pattern or ornamentation. Unlike patents, a design registration does not protect purely functional aspects of an article unless they also contribute to its appearance. As most manufactured articles involve an element of designer choice, design protection is generally available.

Design infringement generally

A design registration is infringed by the unauthorised manufacture or importation for sale (or commercial use) or the unauthorised sale or hire (or offering to sell or hire) of articles incorporating or embodying the registered design in New Zealand.

Legal action can only be taken against an infringer once the Certificate of Registration has issued. Court proceedings are initiated in the High Court. Appeals are possible to the Court of Appeal. The case is heard and decided by a Judge alone, with no jury involvement.

The test for infringement

For an article to infringe a registered design the registered design, or a design not substantially different from the registered design, must have been applied to it. Putting it another way, the

article must have substantially the same appearance as the registered design.

The question of infringement is a question for which the eye must be the judge. Courts may apply either a side-by-side test and/or an imperfect recollection test, and will also consider actual usage of the design in question.

The degree of novelty of the registered design in light of the prior art (i.e. any material in the public domain as at the application date of the registered design) must also be considered. In one case it was said:

“If there is substantial novelty or originality small variations in the article alleged to infringe will be unlikely to save the defendant. On the other hand if the features of novelty or originality are but little removed from prior art small differences may avoid an infringement.”

The side by side test

The side-by-side test involves comparing the alleged infringing design with the registered design in a side-by-side comparison in order to determine whether one is an obvious imitation of the other.

In a leading New Zealand case one judge described the test as follows:

“The test is whether the article alleged to be an infringement has substantially the same appearance as the registered design. This involves a comparison between the article

complained of and the representations of the article contained in the application for registration.

It is not always easy to compare a two-dimensional design with a three-dimensional object. That difficulty and the fact that a design means features of shape etc applied to an article by industrial process makes it evident, and it has been so held, that articles manufactured by the plaintiff which embody the design may be compared with the artefact said to infringe."

The imperfect recollection test

Products to which the registered design and the alleged infringing design have been applied will not always be sold or viewed side by side. The Court may therefore also compare designs as if they had been viewed at different times. This is known as the "imperfect recollection" test.

Generally speaking the designs will be considered from the view point of a hypothetical customer interested in the design of the particular type of article being purchased, instead of one who is content to purchase any such article without regard to its design.

The actual usage test

Actual usage of the registered design may be considered by the Courts to determine whether the alleged infringing design and the registered design look similar when the articles carrying the design are in use. For example, if a Court were considering a design to be applied to a clothing item, the Court may take into consideration the eye appeal of the garment while being worn.

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