

Is my design registerable?

Registered designs are used to protect the outward appearance of a new or original product design. The design can be in relation to a new shape or pattern applied to an article of manufacture.

Requirements for registration

The New Zealand Designs Act specifies the following requirements to obtain a registered design:

- novel or original features of shape and/or pattern;
- applied to an article of manufacture by any industrial process or means;
- including features which are judged by the eye (i.e. have eye appeal);
- which do not amount to a method or principle of construction; and
- all the novel or original features of shape and/or pattern are not dictated solely by the function the article has to perform.

Even where the design is new and original not every article to which the design is applied can be registered. The following provides an overview of the registerability of different types of designs in New Zealand and also identifies those specifically excluded from registration.

What is registerable?

- Articles of manufacture: these are defined as industrially produced products capable of being delivered to an end user. What this means in practice is that the article embodying the design must be a finished article and must also be sold as an article in its own right (i.e. rather than a piece of a larger thing). By way of example, while a prefabricated building was considered an article of manufacture, a building constructed *in situ* was not. Spare parts may be protected as long as they are sold individually;
- Images on electronic screens: such images are considered registerable as, although the design is not generally visible at the time of purchase and is transitory in nature, it becomes visible when the article was used for its intended purpose and is generally continuously applied to the article (a computer screen) during use. For example, a three dimensional representation of a globe for a computer display screen was registered in NZ30475;
- Features of eye appeal: a design must include at least one feature which is judged by the eye of an ordinary consumer of the article to have eye appeal sufficient to influence the consumer to select or buy the article. Colour is not usually necessary in a registerable design unless it is essential

to the design of the article, for example in a football jersey;

- Variations of known designs: to be considered novel a design must be substantially different from known designs applied to any other manufactured article. For this reason an alteration of scale is generally insufficient to make a design novel but a change in proportions might provide novelty if it results in a substantially different appearance.

What isn't registerable?

The following articles are excluded from registration in New Zealand under the Designs Act and Regulations:

- Dictated solely by function: if every feature of the design is dictated solely by the function the article has to perform then the design will **not** be registerable. For example, a drill bit is unlikely to be registerable and a registration for a z-shaped fence post was considered invalid because the z-shape was purely functional;
- Articles of a primarily literary or artistic nature are not registerable (although artistic images applied to an article of manufacture **for the first time** can be registered);
- Sculptures (excluding casts or models produced by an industrial process);
- Wall plaques and medals;
- Printed matter which does not have a purpose other than carrying the printed information. For example, greeting cards, maps, stamps, playing cards, book jackets, calendars, certificates, coupons, dress making patterns, trade forms, trade advertisements, plans,

leaflets or the like cannot be registered but wallpaper and wrapping paper can be;

- Articles which are contrary to law or morality such as certain weapons or sex aids; and
- Materials or substances as found in nature.

Protecting a Registerable Design

If the article is not excluded from those categories above, the first step to determine if you can protect it is to carry out a clearance search. This will determine whether the design is likely to be novel in comparison to those designs already on the Register. If clear, you can then file an application at the Intellectual Property Office of New Zealand (IPONZ). This application must include suitable representations of the design and a statement of where novelty in the design resides. The application will be examined on form and novelty by an examiner. If the application is deemed to comply with the requirements of the Act and Regulations it is registered for an initial period of five years, which is extendable for two further periods of five years on payment of renewal fees.

Disclaimer

It is important to discuss all matters concerning your products with an IP strategist and to integrate such discussions/decisions into your overall business strategy. That way, maximum benefit can be taken from your specialist's knowledge of how to work the intellectual property system to your advantage.