

New Zealand registered designs FAQs

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What is a registered design? A registered design is a proprietary right in a design. It protects the appearance of a new or original design applied to a product, or any part of a product which is made or sold separately (such as spare parts for a car). The design may be in three dimensions (the shape or configuration of something) or two dimensions (the pattern or ornamentation of something).

What does new or original design mean? New or original means that the same design has not been applied to a manufactured article in New Zealand before the application to register the design is filed. The term often used to refer to 'new and original' is 'novelty'.

Do articles made or sold overseas count?

Articles made or sold overseas are only relevant to whether a design is new or original in New Zealand if they were known (i.e. sold or published) in New Zealand.

When is novelty assessed? Usually at the date when the application to register the design is filed in New Zealand.

Can anything be registered as a design? No.

Designs which are purely functional cannot be protected, and nor can works of sculpture, wall plaques and medals, and printed matter used primarily for literary or artistic purposes (for example greeting cards or playing cards).

What other criteria exists for design

registration? The design must have some element of eye appeal. In addition, a design registration cannot protect a method or

principle of construction or operation – these things are properly protected by patent if they are new and inventive (see "Patent FAQ").

How do I obtain a registered design? An application, accompanied by a Statement of Novelty and representations of the design, must be filed at the Intellectual Property Office of New Zealand (IPONZ). We can prepare and file the documents for you.

Once filed, the application is examined by IPONZ to determine whether the design has the requisite eye appeal. The examiner will also determine if the design is new and original. This is usually done by comparing it to designs already on the Register or disclosed elsewhere. If IPONZ has any concerns about the registrability of the design, it will issue an examination report detailing its objections. We can review the examination report on your behalf and prepare and file submissions arguing against the objections.

If there are no objections (or once they have been overcome), the design will be registered, and details of the design will be published in the Patent Office Journal.

Can I use or publish my design before filing an application? In order for a design to have novelty, it cannot be publicly disclosed in New Zealand before a design application is filed. This generally means that prior to filing a design application a product embodying the design cannot be sold or offered for sale, disclosed (other than in confidence), or published. There are however some exceptions.

Who owns a registered design? Designs are owned by the designer. However, where the design is made under an employment contract or commissioning contract, the employer or commissioning party will own the design.

How long do registered designs last for? A New Zealand registered design is valid for 15 years on payment of renewal fees due on the fifth and tenth anniversaries of the design registration.

Will my design be recognised overseas? As registered designs are territorial, separate applications must be filed in each country in which you want to protect the design. If an application is made overseas within six months of filing the corresponding design application in New Zealand, it can be back dated so that it will have the same priority date as the New Zealand application.

What rights does a registered design give me? The owner of a registered design has the exclusive right to sell, hire (or offer for sale or hire), manufacture and import any article that embodies the design.

How is this right infringed? It is infringed by anyone who does any of those things without the consent of the owner of the registered design.

How close does an infringement have to be? For a product to infringe a registered design, it must embody a design which is the same or not substantially different to that registered. When assessing similarity, if the registered design is quite unique, then large design differences may be necessary to avoid infringement, and vice versa.

What remedies are available against design infringements? If a Court finds that a product infringes a registered design, then it can grant an injunction to prevent further use or sale of the infringing product, and it can order that all infringing products, and possibly the machinery

used to produce those products, are delivered up to you.

A Court can also order that the infringer pay you any profits earned from the sale or hire of infringing products, or compensate you for the losses you have suffered as a consequence of the infringement.

Can I sell or licence my design? Yes. Registered designs can be assigned or licensed to third parties who want to use the design in New Zealand.

Is it possible to challenge the validity of a registered design? Yes. Any interested person may apply to the Intellectual Property Office or the Court for cancellation of a registered design on a number of grounds. The most common ground is that the design was not new or original at the date of filing.

Can copyright also apply to a registered design? Yes. Copyright rests automatically in the design drawings of a registered design. For more information refer to the “**Copyright FAQ**”.

Why is a registered design better than copyright? A registered design is a registered proprietary right which records what the design is, the date of the design and the owner. Each of these things must be proved in a copyright case. The details of a registered design are published and searchable and will act as a deterrent to potential infringers. There is no system of registering copyright, so the deterrent effect is low.

More importantly, to prove copyright infringement in an unregistered design, you have to prove that you have a „copyright work“ in which copyright exists, that you (rather than the designer) own the copyright, and that the infringer actually copied your product. These things, particularly actual copying, can be difficult to prove.

By comparison, if you have a registered design, all you need show is that the look of the infringing product does not differ substantially from your registered design. It does not matter whether the alleged infringer copied or not.

Where can I find out more information on registered designs? You can find out more by reading our *Guide to the protection of innovation and goodwill*, available as a pdf download from the Media/Publications page on our website, or by contacting our Designs Team.

THE ABOVE IS PROVIDED FOR GENERAL INFORMATION PURPOSES ONLY AND DOES NOT TAKE THE PLACE OF SPECIFIC LEGAL ADVICE. FOR MORE SPECIFIC ADVICE ON ALL ASPECTS OF INTELLECTUAL PROPERTY LAW, PLEASE CONTACT US.