

FAQ's

What is a design registration?

A registered design is a design that has been officially registered at the Intellectual Property Office of NZ (or equivalent overseas office). It is allocated a registration number which can be displayed on the product or article to place others on notice that there is a design registration in place. Details of the registration can be accessed on the Intellectual Property database so third parties can be made aware of the registration and elect not to pursue activities that will infringe your registration.

A registered design provides a proprietary right in a design. The owner of the design is provided with an exclusive right in New Zealand to make, sell, import or use any article that the design is applied to. An “article” is essentially a product or part of a product if it is manufactured and sold independently.

The “designs” themselves are all about the visual appearance of the article. They are directed at features of shape, configuration, pattern or ornamentation applied to the article. The article can be three dimensional such as industrial or domestic goods or two dimensional such as wallpaper, textiles and packaging.

Why should I obtain protection?

Officially registering your design means that you are in a stronger position if a third party starts making or otherwise trading in a design that is similar to your own. If you resort to relying on copyright you must prove that you are entitled to copyright in the design and prove that the other party actually copied from your work. This can be hard to do. In contrast, if you have a registered design all you have to show is that the look of the infringing product does not differ substantially from your registered design.

Registered designs can be used to stop parallel importation, whereas copyright will not.

Registering your rights can also add value to your business.

Design registration is generally less expensive and less complicated than patent registration.

Do I need to keep my design confidential?

Yes you do. You must file an application for registered design before you sell or offer for sale or disclose your design to others in a non-confidential manner. Once the application is filed you may disclose your design as your rights are officially (and in most cases internationally) recognized from the date you filed it.

If it is necessary for you to disclose your design to others before filing an application for registered design, ensure that you have the other party sign a confidentiality agreement

prior to disclosing the design to them. By completing this agreement it is easier to prove that it was disclosed in confidence and you have the ability to sue for breach of contract if the recipient of the confidential information you supplied uses or tells others about that information.

If you do not get a confidentiality agreement completed then you should make it very clear, preferably in writing, that the disclosure is made in confidence.

If you make a non-confidential disclosure to others before filing a registered design application, then your disclosure may render your registration invalid.

Is my design suitable for registration?

Registered designs protect the novel appearance of the article. They are directed at features of shape, configuration, pattern or ornamentation applied to the article. A design will not be registered if the features of shape or configuration are dictated purely by function. You also cannot protect literary or artistic works.

To determine whether your design is novel, the same design or a substantially similar design must not have been known by anyone in New Zealand before an application for registration was filed.

We recommend that you contact us to assess whether your design is suitable for registration. We can perform searches to provide an indication on whether the design is novel.

When should I apply for a design?

You should apply for a registered design as soon as possible after finalizing the design and certainly before you disclose the design to others. We recommend that you file drawings of your article that are as close as possible to the actual articles that you will be selling, i.e. not drawings of your initial prototypes.

Your rights in the design are recognized from the date the application is filed so the sooner you file the better the position you will be in if your competitors have created something similar.

However, you should have finalized the design itself as there is little scope for amending the drawings after the application is filed.

Do I need to file overseas?

Registered designs are achieved on a country-by-country basis which means that a separate application must be filed in each country you wish to pursue protection in. Determining which countries to file in can only be answered with reference to your

budget and what you want to achieve. We can recommend a strategy for you that will fit within your budget.

New Zealand is a member of the Paris Convention which means that you can claim your NZ filing date in any overseas applications provided you file your overseas applications within six months of your NZ application (the first application). This only applies to other countries that are also a member of the Paris Convention or where a bi-lateral arrangement is in place between NZ and the country in question. The significance of this is that you need only file an application in NZ to begin with which keeps your initial costs down and allows you to disclose the invention here without it affecting your ability to obtain a valid registration overseas where the novelty requirements are often stricter.

How long is the term of a design?

In New Zealand: Fifteen years provided the renewal fees are paid on the fifth and tenth anniversaries of the design registration. Australian Registered designs have a maximum life of ten years, while European Registered Designs can be kept alive for up to twenty five years.

Do I need an attorney?

It is recommended that you use an attorney to make sure you get the right scope of protection from the design registration.

What information would I need to supply my attorney?

You will need to supply suitable drawings or representations depicting the design and provide information on what the design is to be applied to. We can prepare representations on your behalf if you do not have any or if we do not think that your drawings are suitable. We would also need to know details on the author and the owner of the design.

What is the procedure for design registration?

An application is filed at the Intellectual Property Office of New Zealand (IPONZ). Accompanying the application will be a Statement of Novelty and drawings representing the design.

The application is then examined to determine whether it is eligible for registration. The examiner will perform a search to assess whether the design is new and original and to see if it meets the requisite eye appeal for designs.

The examination results are provided to you in an examination report which is sent to the owner or their attorney if an attorney has been authorized to act on behalf of the owner. The examination reports sets out any objections that the examiner may have to your

application, for example objections concerning the novelty of your design or objections to the quality or clarity of your drawings.

If there are no objections or the objections are withdrawn after the owner (or their attorney) responds to the report, then the application will be accepted and published. The application will subsequently be registered provided no one opposes it. The owner of the design registration can mark their goods with the application number or the registration number to deter potential competitors.

Can my registration be challenged?

Your design registration can be challenged. An interested party can challenge your registration by applying to the Intellectual Property Office of the Court for cancellation of the design. There are number of grounds available to challenge a design such as the design was not new or original at the date of filing.

Can I sell or license my design?

Yes you can. If you sell your design you will need to assign your rights to the new owner and record this transfer at the Intellectual Property Office. If you license your rights in the design to others you should complete a license agreement recording the details of this arrangement. We can prepare these documents for you.

What should I do if my registration is infringed?

The first step is to obtain as much information as you can on the activities of the potential infringer. Do not contact them directly or threaten them in anyway until you have contacted your attorney.

Your attorney will assess your case and contact the other party on your behalf. Infringement cases are generally settled early on in the process by way of a settlement agreement. You might negotiate an undertaking from the other party to cease their activities and delivery up of their goods. You can also pursue an account of their profits or be compensated for any loss you have suffered if it can be quantified.

If the matter proceeds all the way to the Courts and you are successful then similar results might be obtained but the cost in getting them will be significantly higher. You can of course pursue legal costs against the other party to help pay for your attorney costs which will lessen the expense.

In determining whether a design registration is infringed, the product in question must be the same or not be substantially different from the registered design.

The level of similarity required to infringe the registration can vary depending on the uniqueness of the design. The more unique the design is, the broader the scope of protection will be under the registration.

