

# Protecting your design in New Zealand



## What is a registered design?

A registered design is a legal right that protects the way an article looks, but not the way it works.

If you design something new, you can stop others from copying your design in several ways. Patents, copyright, trade marks and registered designs all provide different types of protection for new designs. To protect the way something new works, you could apply for a patent. You could rely on copyright to stop unauthorised copying of literary, artistic, musical and electronically recorded works. Trade marks are used to protect brands. But a registered design specifically protects a manufactured article with visually-apparent design features.

A registered design protects visual features of an article, like

- shape
- configuration
- pattern
- ornamentation

Registered design protection can stop unauthorised copying or reproduction of any three-dimensional manufactured item.

Non-limiting examples of the range of products that can be protected by registered designs are packaging machinery and lathes (industrial products), vacuum cleaners and furniture (whether for domestic or industrial use) and ornamental products like jewellery and clothing.

Registered designs also protect some items made in two dimensions, such as wallpaper, textiles and labels.

To qualify for legal protection, your design must be:

- new and original
- appealing to the eye

- more than just functional.

## Keep your design secret

You should not show, sell or advertise your design to the public before applying for registration of your design. If someone has seen your design before you file an application, your design may not qualify for legal protection because the design will no longer be considered new and original.

If you need a third-party to assess or help with the design, make sure they sign a confidentiality agreement before you show them your design.

If you make any significant changes to your design after filing an application, you may need to file other design applications to protect those new features. In that case, it is just as important to keep the changes secret until you have filed the other design applications.

## Check that your design is new and original

A search of published patents and designs before filing your application can help you determine whether your design is new or original, and able to be registered. We can search databases in New Zealand and in overseas countries for you.

Search results may also signal whether using your design will infringe patents or designs granted in the country where you are searching.

Search results can be indefinite because some material, such as pending design applications, may be unpublished and therefore unable to be searched.

Searching overseas records for a design can be expensive. To get accurate results, we instruct an overseas agent to search patent and design databases in their country.

## File a design application

To apply for a New Zealand registered design, you need to pay a fee and file the following documents at the Intellectual Property Office of New Zealand (IPONZ):

- pictures of your design for a particular article (usually perspective, plan and elevational drawings, or high quality photographs) clearly showing the appearance of the design features that you want to protect
- a 'statement of novelty', specifying the new features of your design.

## How does the registration process work?

After you file a design application, IPONZ examines your application within a few months to make sure it meets official requirements. IPONZ also searches other design registrations to decide whether your design is new and registrable.

If IPONZ raises any objections, you have 12 months (extendible by three months) to reply.

Once any objections have been overcome and your application is acceptable, IPONZ registers your design and issues a certificate of registration. Your design will then be advertised in the IPONZ journal and your design drawings made available publicly on the IPONZ on-line design database.

## How long does your registered design last?

In New Zealand, your registered design lasts 15 years from the date you filed your application – so long as you pay renewal fees by the end of the 5th and 10th years.

## Protect your design in the countries where you plan to use it

Your New Zealand registered design is only effective in New Zealand. You can register your design in other countries where your business uses or sells your design. Each country has different systems and requirements for registered designs.

We can tell you about the registration processes, and help you file your design applications, in foreign countries. You can delay filing design applications in many countries, by up to 6 months after filing your application in New Zealand, without loss of priority rights.

## How do I stop others using my registered design?

As the owner of a registered design for an article, you have the exclusive right, in the country where the design is registered, to make, import, use and sell that article having that design.

If you own a registered design, you should enforce your rights. You can mark your product or product literature with details of your design registration. Marking is sometimes enough to deter potential copiers. Sometimes a warning letter to an infringer of your design is enough to make them discontinue the infringement.

But sometimes you have to take court action against the infringer to stop them infringing your rights. The court decides whether an article infringes your design by visually comparing the alleged infringing article and the article shown in your design application. However, if the same design as yours, appears on a different article to that shown in your registered design, that design may not infringe your registered design.

## Copyright, designs or patents?

In New Zealand, the design of three-dimensional products can be protected by design registration or copyright.

To prove infringement of a valid registered design, the owner of the registered design only has to show enough visual likeness between the infringing design and the registered design. This is usually far more straightforward than proving copyright infringement. To prove copyright infringement, the owner must not only show that there is enough visual likeness, but must also show that they are the owner of the copyright in the original design, and that the alleged infringer has, either directly or indirectly, copied from the original design.

A registered design can give protection against independent creation of the same, or similar, design. Independent creation of a registered design infringes the registered design, but does not infringe copyright.

A registered design only protects an article's appearance, not the way the article works. A patent can provide broader protection for the functional aspects of a product without regard to its appearance. Often we recommend clients get both patent and registered design protection.

Design registration costs less and is normally much faster than getting a patent. A design registration can protect against copying an invention's appearance until a patent is granted for the way the invention works.

Talk to AJ Park for the best advice about registering a design in New Zealand.