

The design system

Introduction

This document gives a brief summary of the design application process. The attached chart shows the most common design protection route.

A design registration protects the appearance of an article, for example the shape of a new chair or pen. Designs are also available for new features of pattern or ornamentation.

Other forms of intellectual property (IP) protection may be used to protect ideas and concepts embodied in things, methods and processes (patents), a particular expression of an idea or artistic work (copyright) or a brand or trade name (trade marks). Please refer to our patent and trade mark guides for information in these areas.

It is only possible to obtain design registration for a new design. It is crucial that there is no publication, sale or use of the product before a design application is filed. However, in limited circumstances it may be possible to apply for design registration in one country when the design has already been used or published in another country. For example, Europe and the US have one year and six months “grace periods” respectively. No account will be taken in those countries of the applicant’s own activities before filing but within the grace period.

Design protection in New Zealand

A design application is filed with a set of drawings showing the article in detail. Each application establishes a “priority date”, after which publication or release of a product will not generally result in loss of design rights.

The cost of preparing and filing a design application in New Zealand is around \$800, assuming that full drawings can be provided. Additional costs will result if we need to assist in preparation of drawings.

Developments of the design may be covered by filing further design applications.

The design application is examined by the New Zealand Patent Office. If all objections are overcome, the design is registered and published. Costs incurred during this process are usually about \$250 but can be up to \$1000 in difficult cases.

Design protection outside of New Zealand

In order to obtain design protection outside of New Zealand, design applications must be filed in each country where protection is desired. If these applications are filed within 6 months of the New Zealand filing, the Applicant is entitled to retain the benefit of that filing date. The cost of filing these applications varies across different countries, as indicated in the attached guide.

Each application is examined in the appropriate national Patent Office before a design is registered in that country. Some countries examine only for formal matters while others conduct a full examination process. Costs similar to the filing cost are generally incurred in each country during examination and

registration procedures although these vary greatly from country to country and are likely to be higher in the US.

Note that some (generally minor) countries are “non-convention” countries. Applications in these countries cannot claim the New Zealand filing date and must be filed independently, ideally at the same time as filing the New Zealand application. We therefore recommend that you discuss countries of interest with us at an early stage.

Maintaining a design

In most countries, once a design has been registered renewal fees must be paid periodically over life of the registration to keep it in force.

Designs in New Zealand last for 15 years from the date of filing. However in other countries the term of protection varies from 10 years (Australia) up to 25 years (Europe). Once a design registration expires, or is allowed to lapse by non-payment of a renewal fee, others are free to make, use or sell the design.

Copyright / Unregistered Design Rights

In New Zealand, but not in many other countries, copyright may exist in design drawings and models. Copyright automatically comes into existence when a drawing is created and no registration is necessary. However, good practice is to sign and date all drawings as they are created and to keep them in a safe place. This makes it possible to identify the copyright “work” and its date of creation if necessary.

Only copies can infringe copyright. Someone independently developing a product without copying will not infringe copyright in a similar product. However, it is not necessary to copy a whole copyright work in order to infringe, just a substantial part of that work. There is no clear rule for what constitutes a substantial part – this depends on the nature of the work.

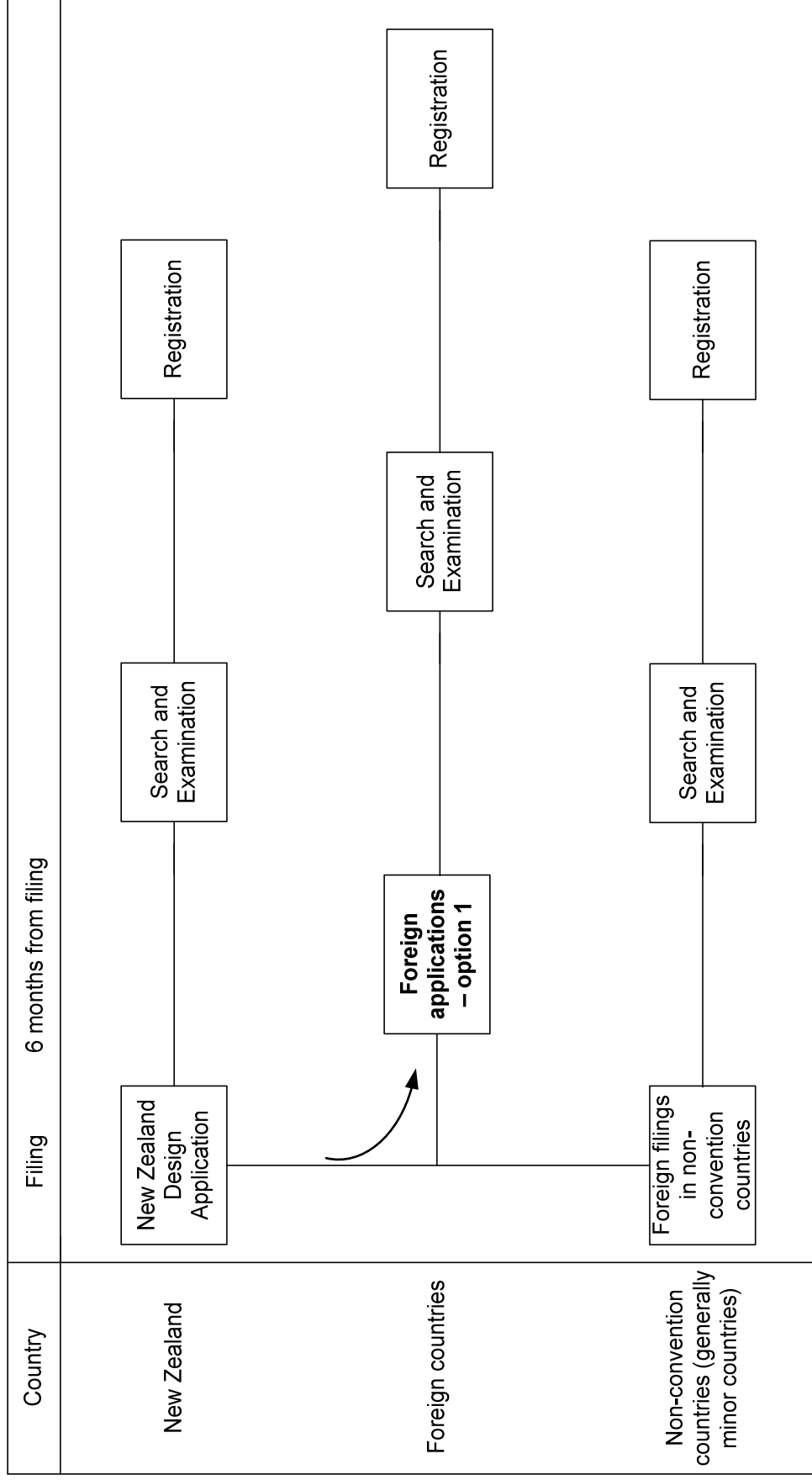
As with other forms of intellectual property it is important to have clear ownership structures in place. If you commission someone to do work for you, they may retain ownership of some copyright in their work unless you agree otherwise.

For industrial designs the term of copyright is usually limited to 16 years from the date of “industrial application”, which is the date when 50 articles have been made for sale or hire or, for products made in lengths, one length has been made for sale or hire.

Note that it is generally not an infringement of copyright to copy directly from the drawings of a lapsed New Zealand patent or design.

Other countries generally do not provide copyright for industrial designs. However some countries provide for short term protection of unregistered design rights. For example, Europe provides a three year term for unregistered design rights.

Design Timeline



INDICATIVE COSTS FOR
NATIONAL DESIGN FILINGS

<u>Country</u>	<u>NZ\$ Typical Filing Cost</u>
Australia	1,200.00
Canada	2,800.00
United States	3,050.00
China	1,900.00
European Community	2,700.00
Hong Kong	1,950.00
India	1,350.00
Japan	2,900.00
Korea (South)	1,900.00
Mexico	2,400.00
Russian Federation	2,850.00
Singapore	1,715.00
South Africa	2,600.00
Israel	1,950.00
Brazil	1,850.00

Please note that these costs are not fixed quotes, but are indicative costs based on previous filings. The actual cost may vary and if accurate estimates are required please let us know. Further costs will be incurred in examination and registration procedures in each country. Renewal fees must also be paid to maintain a design in force.