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## 2016 – Study Question (Designs)

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**Requirements for protection of designs**

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### I. Current law and practice

- 1) Does your Group's current law provide for an intellectual property right (registered or patented) that specifically protects the outward appearance or ornamentation of an object or article of manufacture?

As set out in the Study Guidelines, copyrights and trademarks are not such rights in the context of this Study Question.

yes

Please explain:

- 2) If yes, what is this right called? (e.g. registered design, design patent, industrial design, industrial design patent)

References to design below are to be read as references to this right, irrespective of what it is called in your jurisdiction.

Registered design

- 3) What are the statutory requirements for such right? Please tick any relevant boxes and explain the basis and application of these requirements.

- a) novelty

new or original

b) non-obviousness

c) inventive step

d) individual character

e) originality

new or original

f) aesthetic

g) ornamental

h) other, namely ...

4) Does your Group's current law deny design protection to a design with an appearance that is dictated solely by its function?

yes

Please explain:

5) If yes, what are the relevant factors to determine whether or not a design is deemed unprotectable as being functional? Please tick any relevant boxes and explain as applicable:

a) whether the overall appearance is dictated solely by its technical function

A design can be registered for part of an article as a whole or as a part of an article if that part is made and sold separately. If the overall appearance of that part of the article is dictated solely by its technical function (ie the function that it is to perform) then the design is not registerable.

Just because there are other possible shapes or configurations that the features could take does not mean that they are not dictated solely by the function which they have to perform.

b) whether each portion of the overall appearance is dictated solely by its technical function

c) the availability of alternative appearances that can obtain the same functional result

d) the need to achieve the product's technical function was the only relevant factor when the design in question was selected

e) other, namely ...

6) Does your Group's current law deny design protection to any portions (e.g. a "feature", "element") of the overall design that are deemed functional?

yes

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Please explain:

A design can be registered for part of an article as a whole or as a part of an article if that part is made and sold separately. If the overall appearance of that part of the article is dictated solely by its technical function (ie the function that it is to perform) then the design is not registerable.

Just because there are other possible shapes or configurations that the features could take does not mean that they are not dictated solely by the function which they have to perform.

7) If yes, what are the relevant factors to determine whether or not a portion is deemed functional? Please tick any relevant boxes and explain as applicable:

a) whether the overall appearance is dictated solely by its technical function

b) the availability of alternative appearances for the portion to obtain the same functional result

c) the need to achieve the product's technical function was the only relevant factor when the portion in question was selected

d) other, namely ...

8) What is the effect on the scope of protection of a design with one or more functional portions? Please tick any relevant boxes and explain as applicable:

a) any portions deemed functional will not be taken into account when assessing infringement

Where the registered design differs from an alleged infringement by only one functional feature, there will be no infringement.

b) any portions deemed functional will not be taken into account when assessing validity

Where the registered design differs from what is known by only one functional feature, the registered design will not be valid.

c) any portions deemed functional will not be taken into account separately when assessing infringement, but can play a role in the overall comparison

The test is one of comparing the designs side by side and asking whether they are the same. The doctrine of "imperfect recollection" as been referred to helpful - look at the registered design, go away and come back, and be put in a position of deciding whether some other article (ie the alleged infringement) is the one you originally saw.

d) any portions deemed functional will not be taken into account separately when assessing validity, but may play a role in the overall comparison

e) no effect (e.g. so long as the overall appearance is not dictated solely by its technical function, all

portions of the design are included in the scope of protection, irrespective as to whether any portions may be functional)

f) the Group's current law is unsettled

g) other, namely ...

## II. Policy considerations and possible improvements to your current law

9) How can the following aspects of your Group's current law be improved, if at all?

a) the definition or meaning of a "design"

Allowing a part of an article to be registered without reference to "made and sold separately" would improve understanding of the right provided.

b) the requirements for protection of a design

Removal of the "dictated solely by function" exclusion would would improve understanding of the right provided.

c) the treatment of functionality in the sense described in paragraph 14) of the Study Guidelines or aspects of such functionality

Removal of the "dictated solely by function" exclusion would would improve understanding of the right provided.

10) Are there any other policy considerations and/or proposals for improvement to your current law falling within the scope of this Study Question?

no

Please explain:

## III. Proposals for harmonisation

11) Does your Group consider that harmonisation in the three areas in question 9) above is desirable?

If yes to some but not all of those three areas, please state in relation to which of the areas your Group considers harmonisation is desirable.

If yes in relation to any of those areas, please respond to the following questions without regard to your Group's current law.

Even if no in relation to any of those areas, please address the following questions to the extent your Group considers your Group's current law could be improved.

yes

Please explain:

harmonisation of all three areas would be desirable.

12) Should there be harmonisation of the definition of an intellectual property right that specifically protects the outward appearance or ornamentation of an object or article of manufacture?

yes

Please explain:

This would allow designers to understand the scope of rights across borders both from a protections and infringement perspective. This would reduce incorrect expectations of right availability and reduce misunderstandings about what can and cannot lawfully be done.

13) If so, what should that right be called?

No view

14) What should the requirements for such right be? Please tick any relevant boxes and explain the basis and application of these requirements:

a) novelty

b) non-obviousness

c) inventive step

d) individual character

e) originality

f) aesthetic

g) ornamental

h) other, namely ...

15) Should design protection be denied to a design with an appearance that is dictated solely by its function?

no

Please explain:

16) If yes, what should the relevant factors be to determine whether or not a design is deemed unprotectable as being functional? Please tick any relevant boxes and explain as applicable:

a) whether the overall appearance is dictated solely by its technical function

b) whether each portion of the overall appearance is dictated solely by its technical function

c) the availability of alternative appearances that can obtain the same functional result

d) the need to achieve the product's technical function was the only relevant factor when the design in question was selected

e) other, namely ...

17) Should design protection be denied to any portions (e.g. a "feature", "element") of the overall design that are deemed functional?

no

Please explain:

18) If yes, what should the relevant factors be to determine whether a portion of a design is functional? Please tick any relevant boxes and explain as applicable:

a) whether the overall appearance is dictated solely by its technical function

b) the availability of alternative appearances for the portion to obtain the same functional result

c) the need to achieve the product's technical function was the only relevant factor when the portion in question was selected

d) other, namely ...

19) What should the effect be on the scope of protection of a design with one or more functional portions? Please tick any relevant boxes and explain as applicable:

a) any portions deemed functional will not be taken into account when assessing infringement

b) any portions deemed functional will not be taken into account when assessing validity

c) any portions deemed functional will not be taken into account separately when assessing infringement, but can play a role in the overall comparison

d) any portions deemed functional will not be taken into account separately when assessing validity, but may play a role in the overall comparison

e) no effect (e.g. so long as the overall appearance is not dictated solely by its technical function, all portions of the design are included in the scope of protection, irrespective as to whether any portions may be functional)

f) the Group's current law is unsettled

g) other, namely ...

20) If your answer to question 11) is no, is it your Group's view that a (registered or patented) intellectual property right that specifically protects the outward appearance or ornamentation of an object or article of manufacture should not be available at all?

yes

21) If yes, why?

to encourage an promote innovative design.

22) If your answer to question 11) is no in relation to some but not all of the three areas set out in question 9) above, please state why your Group does not consider that harmonisation in that area(s) is desirable.

23) Please comment on any additional issues concerning any aspect of the definition and requirements for protection of designs, or the role of functionality, you consider relevant to this Study Question.

New Zealand has an overlap between copyright and registered design protection. Copyright in three dimensional articles is protectable in a similar manner to the unregistered design right. Any condiereation of chenges to NZ registered design law would need to take this into account.

Please indicate which industry sector views are included in part “**III. Proposals for harmonization**” of this form:

Industrial design generally. Articles of manufacture, ornamentation as applied to articles.

#### Summary

Registered design law in New Zealand has remained the same since the Designs Act 1953 came into force. It is time that this Act was reviewed in view of modern design requirements and application.