



Designs Amendment Regulations 2011

Anand Satyanand, Governor-General

Order in Council

At Wellington this 28th day of March 2011

Present:

His Excellency the Governor-General in Council

Pursuant to section 46 of the Designs Act 1953, His Excellency the Governor-General, acting on the advice and with the consent of the Executive Council, makes the following regulations.

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Regulations

- 1 Title**
These regulations are the Designs Amendment Regulations 2011.
- 2 Commencement**
These regulations come into force on 19 April 2011.
- 3 Principal regulations amended**
These regulations amend the Designs Regulations 1954.
- 4 Interpretation**
 - (1) The definitions of **lodged** and **specimen** in regulation 2 are revoked.
 - (2) Regulation 2 is amended by inserting the following definitions in their appropriate alphabetical order:
 - “**Commissioner’s Internet site** means the Internet site operated by, or on behalf of, the Commissioner
 - “**electronic reproduction** means a copy of a paper document that is transmitted or stored by electronic means (for example, an image of a paper document that has been electronically

scanned or a copy of a paper document that is sent by means of a fax machine)

“**paper document** means a form or document that is represented or reproduced in a visible and tangible form and medium (for example, in print)”.

5 New regulation 5 substituted

Regulation 5 is revoked and the following regulation substituted:

“5 Form of payment

“(1) Fees may be paid—

“(a) by electronic means; or

“(b) by other means acceptable to the Commissioner.

“(2) The Commissioner may delay taking an action until the fee that must be paid for that action has been received.”

6 Payments by post

Regulation 6 is amended by omitting “Money” and substituting “Payments”.

7 Regulation 7 revoked

Regulation 7 is revoked.

8 Regulation 8 revoked

Regulation 8 is revoked.

9 New Part 2A inserted

The following Part is inserted after Part 2:

“Part 2A

**“Compliance with regulations by
electronic means**

“7 Definitions used in this Part

In this Part,—

“**give** means issue, furnish, lodge, supply, produce, file, send, or give in any other manner referred to in these regulations

“**information or a document** means any evidence, application, authority, request, representation, form, certificate, state-

ment, notice, paper, or any other type of information or document referred to in these regulations.

“8 Means of communicating with Commissioner

- “(1) This regulation applies to a requirement in these regulations for—
- “(a) information or a document to be lodged; or
 - “(b) information or a document to be given to the Commissioner; or
 - “(c) any type of request, communication, or correspondence to be made with the Commissioner.
- “(2) The requirement is met by providing the information or document, request, communication, or correspondence to the Commissioner—
- “(a) by means of the Commissioner’s Internet site; or
 - “(b) in accordance with section 48(1) of the Act; or
 - “(c) by other means acceptable to the Commissioner.

“8A Signature requirements for communications by electronic means

- “(1) This regulation applies to a requirement in these regulations for information or a document—
- “(a) to be signed; or
 - “(b) to contain or have a signature upon it; or
 - “(c) containing a signature to be lodged or given to the Commissioner.
- “(2) The requirement is met—
- “(a) if the person who is required to sign the information or document provides it (with or without signature) to the Commissioner by means of the Commissioner’s Internet site by logging on to an account on that site that he or she has the authority to use; or
 - “(b) if an electronic reproduction containing the relevant signature is provided to the Commissioner; or
 - “(c) by other means acceptable to the Commissioner.
- “(3) If a person provides an electronic reproduction in accordance with subclause (2)(b), the person must—
- “(a) retain the original copy of the paper document in the person’s possession or control until the time during

which a hearing or an appeal under the Act or these regulations to which the document may be relevant has ended; and

- “(b) make the paper document available to any hearing or appeal under the Act or these regulations or at the Commissioner’s direction.

“8B Commissioner may communicate by electronic means

- “(1) A requirement in these regulations for the Commissioner to give information or a document, or to communicate or correspond in any way (whether in writing or otherwise), is met by providing the information or document, communication, or correspondence—

- “(a) by means of the Commissioner’s Internet site; or
- “(b) in accordance with section 48(1) of the Act; or
- “(c) by other means that are reasonable in the circumstances.

- “(2) The Commissioner must notify the recipient of information or a document, communications, or correspondence provided in accordance with subclause (1)(a) if—

- “(a) there is a time frame within which the recipient must respond to it; or
- “(b) it is reasonable to expect the Commissioner to do so in the circumstances.

“8C Interrelationship of this Part with rest of regulations

- “(1) Nothing in regulation 8A(2)(a) applies to—
 - “(a) an instrument, a document, or an official or certified copy of an instrument or a document that is provided in support of an application that is referred to in Part 10; or
 - “(b) evidence that is required to be filed under these regulations; or
 - “(c) statutory declarations or affidavits that are required by these regulations.
- “(2) Nothing in this Part overrides regulations 13(2), 17, or 18.
- “(3) Except as set out in subclauses (1) and (2), this Part applies despite anything to the contrary in these regulations.”

10 Size, etc., of documents

- (1) Regulation 10 is amended by inserting “as a paper document” after “these regulations”.
- (2) Regulation 10 is amended by adding the following subclause as subclause (2):
“(2) All electronic reproductions lodged or given under the Act or these regulations must be able to be readily printed on one side only of paper of approximately A4 international size, and having on the left hand part of the paper a margin of approximately 5 cm.”

11 Signature of documents by firms and bodies corporate

Regulation 11 is amended by omitting subclause (1) and substituting the following subclause:

- “(1) A document lodged by a firm must be signed by a partner or any other person who satisfies the Commissioner that he or she is authorized to sign the document on behalf of the partnership.”

12 Authorization of agent

- (1) Regulation 13 is amended by omitting “in writing”.
- (2) Regulation 13 is amended by adding the following subclause as subclause (2):
“(2) The authority must be lodged as an electronic reproduction or a paper document.”

13 Regulation 16 revoked

Regulation 16 is revoked.

14 New regulation 20A inserted

The following regulation is inserted after regulation 20:

“20A Applicant may request delay of issue of certificate of registration

- “(1) An applicant for the registration of a design may request the Commissioner to delay issuing a certificate of registration for that application for a period of up to 15 months from the date on which the application was made.
- “(2) The Commissioner may comply with that request.”

15 New regulation 22 substituted

Regulation 22 is revoked and the following regulation substituted:

“22 Separate applications for same design for more than 1 article

“(1) If the same design is to be registered in respect of more than 1 article, a separate application must be made in respect of each article.

“(2) Each application must be treated as a separate and distinct application.”

16 Name of article and novel features of design to be stated

Regulation 23(3) is revoked.

17 New regulations 25 and 26 substituted

Regulations 25 to 28 are revoked and the following regulations substituted:

“25 Representation of design to be furnished

“(1) An application for the registration of a design must be accompanied by a representation of the design.

“(2) If the design is to be applied to a set of articles, the representation must show the design as applied to each different article included in the set.

“(3) The Commissioner may at any time before registration require additional representations.

“26 Means of providing representation of design

“(1) Representations must be given to the Commissioner—

“(a) as 1 or more digital images in an electronic file format acceptable to the Commissioner; or

“(b) in any other format acceptable to the Commissioner.

“(2) Each representation must clearly and unambiguously show the novel design features of the design as applied to the article.

“(3) Each digital image may be in black and white, grey scale, or colour.

“(4) Each digital image must be—

“(a) able to be readily printed on a single-sided A4 international size sheet of paper; and

“(b) clearly labelled stating the view of the article (for example, perspective view, front view, side view, plan, or otherwise).”

18 Words, letters, or numerals

Regulation 29 is amended by omitting “or specimens”.

19 Repeating surface patterns

Regulation 30 is amended by omitting “, and shall not be of less size than 17 cm by 12 cm”.

20 Requirements

Regulation 34(2) is amended by omitting “or specimens”.

21 New Part 8A inserted

The following Part is inserted after Part 8:

“Part 8A

“Restoration of design applications

“40A Request for restoration of abandoned design application

A request under section 41G(2) of the Act for the restoration of an application for the registration of a design that is abandoned must be made within 3 months of the date on which the application is deemed to be abandoned under section 7(4) of the Act.

“40B Period for notice of opposition

A notice of opposition under section 41I(1) of the Act must be given to the Commissioner within 2 months of the date on which the request referred to in regulation 40A is published in the *Journal* in accordance with section 41G(5) of the Act.

“40C Protection of persons who avail themselves of design

“(1) Every order under section 41J of the Act must contain or be subject to the provisions prescribed in this regulation.

“(2) No action or other proceeding may be commenced or prosecuted, nor any royalties, damages, or account of profits recovered, in respect of a design that a person referred to in sec-

tion 41J(2) of the Act availed themselves of, or took definite steps to avail themselves of, on the ground that the person has infringed, or infringes, the copyright in the design.

- “(3) However, subclause (2) applies only to the extent that the person—
- “(a) continues to act in a manner that is consistent with, but does not go beyond, the way in which the person availed themselves of the design; or
 - “(b) continues to act in a manner that is consistent with the definitive steps that were taken to avail themselves of the design so as to complete those steps; or
 - “(c) uses the result of the completion of the definitive steps in a manner that is consistent with, but does not go beyond, what was contemplated by those steps in order to avail themselves of the design.
- “(4) To avoid doubt, the protection in subclause (2) applies to activities undertaken at any time after the date of registration of the design.”

22 New regulation 41 substituted

Regulations 41 and 42 are revoked and the following regulation is substituted:

“41 Extension of period of copyright for further 5 years

An application under section 12(2) of the Act for an extension of the period of copyright for a second or a third period of 5 years must be made in form 12.”

23 New Part 9A inserted

The following Part is inserted after Part 9:

“Part 9A

“Restoration of lapsed copyright in registered design

“44A Request for restoration of lapsed copyright in registered design

A request under section 41A(2) of the Act for the restoration of copyright in a registered design that has ended must be made within 12 months of the date on which the copyright ended.

“44B Period for notice of opposition

A notice of opposition under section 41E(1) of the Act must be given to the Commissioner within 2 months of the date on which the request referred to in regulation 44A is published in the *Journal* in accordance with section 41D(2) of the Act.

“44C Protection of persons who avail themselves of design

- “(1) Every order under section 41A of the Act must contain or be subject to the provisions prescribed in this regulation.
- “(2) No action or other proceeding may be commenced or prosecuted, nor any royalties, damages, or account of profits recovered, in respect of a registered design that a person referred to in section 41F(2)(b) of the Act availed themselves of, or took definite steps to avail themselves of, on the ground that the person has infringed, or infringes, the copyright in the design.
- “(3) However, subclause (2) applies only to the extent that the person—
- “(a) continues to act in a manner that is consistent with, but does not go beyond, the way in which the person availed themselves of the design; or
 - “(b) continues to act in a manner that is consistent with the definitive steps that were taken to avail themselves of the design so as to complete those steps; or
 - “(c) uses the result of the completion of the definitive steps in a manner that is consistent with, but does not go beyond, what was contemplated by those steps in order to avail themselves of the design.
- “(4) To avoid doubt, the protection in subclause (2) applies to activities undertaken at any time after the date on which the period of copyright in the registered design ended as set out in section 41A of the Act (including after the date on which the period of copyright is extended).”

24 Schedule 2 amended

- (1) Form 2 of Schedule 2 is amended by omitting “*Four identical representations or specimens*” and substituting “*A representation*”.

- (2) Form 3 of Schedule 2 is amended by omitting “*Four identical representations or specimens*” and substituting “*A representation*”.
- (3) Form 4 of Schedule 2 is amended by omitting “*Four identical representations or specimens*” and substituting “*A representation*”.
- (4) Form 5 of Schedule 2 is amended by omitting “*Four identical representations or specimens*” and substituting “*A representation*”.
- (5) Schedule 2 is amended by revoking forms 12 and 13 and substituting the form set out in the Schedule.

Schedule

r 24(5)

New form 12 substituted

Form Designs No 12
Application for extension of copyright in design
for period of 5 years
Designs Act 1953

To the Commissioner of Designs
Intellectual Property Office of New Zealand
205 Victoria Street
PO Box 9241
Marion Square
Wellington 6141

I/We*, [*insert name and full address to which certificate is to be sent*],
the registered proprietor of design number [*no*], apply for the ex-
tension of the period of copyright in that design for a second/third*
period of 5 years.

* Select one

Signature:

Form Designs No 12—*continued*

[This part of the form to be filled in at the Intellectual Property Office of New Zealand]

Certificate of extension of copyright in design for period of 5 years

This is to certify that [*name*] on [*date*] applied, and paid the prescribed fee, for the extension of copyright in design number [*no*] and that the copyright is extended for a second/third* period of 5 years until [*date*].

* Select one

Commissioner of Designs
Intellectual Property Office of New Zealand
205 Victoria Street
PO Box 9241
Marion Square
Wellington 6141

Rebecca Kitteridge,
Clerk of the Executive Council.

Explanatory note

This note is not part of the regulations, but is intended to indicate their general effect.

These regulations, which come into force on 19 April 2011, amend the Designs Regulations 1954. The amendments fall into 2 main categories. First, those that allow for various matters prescribed in the Designs Regulations 1954 to take place by electronic means (in particular, by means of the Commissioner of Designs' Internet site) and otherwise streamline the application processes. Secondly, amendments that are required in order to implement the Designs Amendment Act 2010, which comes into force on 19 April 2011.

A *new Part 2A* is inserted in the Designs Regulations 1954. *New Part 2A* provides that—

- a requirement in the regulations for information or a document to be given to the Commissioner may be satisfied by providing that information or document by means of the Commissioner's Internet site; and
- a requirement in the regulations for information or a document to be signed may be satisfied by providing that information or document by logging on to an account on the Commissioner's Internet site, or by providing an electronic reproduction of the information or document with a signature on it; and
- a requirement in the regulations for the Commissioner to give information or a document may be satisfied by providing that information or document by means of the Commissioner's Internet site.

A number of consequential amendments are made in order to facilitate the electronic communication established in *new Part 2A*, and also to allow for electronic payment of fees.

The application processes are streamlined through a series of amendments that, amongst other things, remove the need for multiple copies of documents and for specimens to be lodged with applications. A *new regulation 20A* is also inserted to allow an applicant for the registration of a design to request a delay in granting registration for a period of up to 15 months.

New sections 41G to 41J of the Designs Act 1953 (as inserted by the Designs Amendment Act 2010 on 19 April 2011) provide for the restoration of design applications that are deemed to be abandoned. These regulations insert a *new Part 8A* into the Designs Regulations 1954 to provide for various matters required to implement that process, including—

- how the request for restoration of an application must be made and when it must be made by; and
- when a notice of opposition must be made by; and
- the protections that are to apply to a person who has availed themselves of a design while the application for the registration of that design was abandoned.

New sections 41A to 41F of the Designs Act 1953 (as inserted by the Designs Amendment Act 2010 on 19 April 2011) provide for

the restoration of the lapsed copyright in a registered design. These regulations insert a *new Part 9A* into the Designs Regulations 1954 to provide for various matters required to implement that process, including—

- how a request for restoration of copyright must be made and when it must be made by; and
- when a notice of opposition must be made by; and
- the protections that are to apply to a person who has availed themselves of a design while the copyright in the design was lapsed.

Issued under the authority of the Acts and Regulations Publication Act 1989.

Date of notification in *Gazette*: 31 March 2011.

These regulations are administered by the Ministry of Economic Development.
