



Intellectual  
Property  
Office

# Registered Designs Act 1949

An unofficial consolidated version of The Registered Designs Act 1949  
produced by the Trade Marks and Designs Directorate.

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## **Note to users**

This is an unofficial consolidation of the Registered Designs Act 1949, based on the previous consolidated text, and amended by:

**The Registered Designs Act 1949 and Patents Act 1977** (Electronic Communications) Order 2006. SI 2006/1229

**The Intellectual Property Act 2014** (IPA)

**The Intellectual Property Act 2014** (Amendment) Regulations 2014 s. 3(1), SI 2014/2329

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<sup>1</sup> Inserted by IPA s. 11(3)

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# The Registered Designs Act 1949

## unofficial consolidated version

### Registrable designs and proceedings for registration

#### 1 Registration of designs

- (1) A design may, subject to the following provisions of this Act, be registered under this Act on the making of an application for registration.
- (2) In this Act “design” means the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture or materials of the product or its ornamentation.
- (3) In this Act—

“complex product” means a product which is composed of at least two replaceable component parts permitting disassembly and reassembly of the product; and

“product” means any industrial or handicraft item other than a computer program; and, in particular, includes packaging, get-up, graphic symbols, typographic type- faces and parts intended to be assembled into a complex product.

#### 1A [repealed]

#### 1B Requirement of novelty and individual character

- (1) A design shall be protected by a right in a registered design to the extent that the design is new and has individual character.
- (2) For the purposes of subsection (1) above, a design is new if no identical design or no design whose features differ only in immaterial details has been made available to the public before the relevant date.
- (3) For the purposes of subsection (1) above, a design has individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design which has been made available to the public before the relevant date.
- (4) In determining the extent to which a design has individual character, the degree of freedom of the author in creating the design shall be taken into consideration.
- (5) For the purposes of this section, a design has been made available to the public before the relevant date if—
  - (a) It has been published (whether following registration or otherwise), exhibited, used in trade or otherwise disclosed before that date; and
  - (b) The disclosure does not fall within subsection (6) below.

- (6) A disclosure falls within this subsection if—
- (a) It could not reasonably have become known before the relevant date in the normal course of business to persons carrying on business in the European Economic Area and specialising in the sector concerned;
  - (b) It was made to a person other than the designer, or any successor in title of his, under conditions of confidentiality (whether express or implied);
  - (c) It was made by the designer, or any successor in title of his, during the period of 12 months immediately preceding the relevant date;
  - (d) It was made by a person other than the designer, or any successor in title of his, during the period of 12 months immediately preceding the relevant date in consequence of information provided or other action taken by the designer or any successor in title of his; or
  - (e) It was made during the period of 12 months immediately preceding the relevant date as a consequence of an abuse in relation to the designer or any successor in title of his.
- (7) In subsections (2), (3), (5) and (6) above “the relevant date” means the date on which the application for the registration of the design was made or is treated by virtue of section 3B(2), (3) or (5) or 14(2) of this Act as having been made.
- (8) For the purposes of this section, a design applied to or incorporated in a product which constitutes a component part of a complex product shall only be considered to be new and to have individual character—
- (a) If the component part, once it has been incorporated into the complex product, remains visible during normal use of the complex product; and
  - (b) To the extent that those visible features of the component part are in themselves new and have individual character.
- (9) In subsection (8) above “normal use” means use by the end user; but does not include any maintenance, servicing or repair work in relation to the product.

## **1C Designs dictated by their technical function**

- (1) A right in a registered design shall not subsist in features of appearance of a product which are solely dictated by the product’s technical function.
- (2) A right in a registered design shall not subsist in features of appearance of a product which must necessarily be reproduced in their exact form and dimensions so as to permit the product in which the design is incorporated or to which it is applied to be mechanically connected to, or placed in, around or against, another product so that either product may perform its function.



- (3) Subsection (2) above does not prevent a right in a registered design subsisting in a design serving the purpose of allowing multiple assembly or connection of mutually interchangeable products within a modular system.

## **1D Designs contrary to public policy or morality**

A right in a registered design shall not subsist in a design which is contrary to public policy or to accepted principles of morality.

## **2 Proprietorship of designs**

- (4) The author of a design shall be treated for the purposes of this Act as the original proprietor of the design, subject to the following provisions.
- (1A) [Repealed]<sup>2</sup>
- (1B) Where, ...<sup>3</sup> a design is created by an employee in the course of his employment, his employer shall be treated as the original proprietor of the design.
- (2) Where a design becomes vested, whether by assignment, transmission or operation of law, in any person other than the original proprietor, either alone or jointly with the original proprietor, that other person, or as the case may be the original proprietor and that other person, shall be treated for the purposes of this Act as the proprietor of the design.
- (3) In this Act the “author” of a design means the person who creates it.
- (4) In the case of a design generated by computer in such that there is no human author, the person by whom the arrangements necessary for the creation of the design are made shall be taken to be the author.

## **3 Applications for registration**

- (1) An application for the registration of a design or designs ...<sup>4</sup> shall be filed at the Patent Office in the prescribed manner.
- (2) [Repealed]<sup>5</sup>
- (3) An application for the registration of a design or designs in which national unregistered design right subsists shall be made by the person claiming to be the design right owner.
- (4) [repealed]
- (5) An application for the registration of a design which, owing to any default or neglect on the part of the applicant, has not been completed so as to enable registration to be effected within such time as may be prescribed shall be deemed to be abandoned.

<sup>2</sup> Deleted by Intellectual Property Act 2014 (IPA) s.6(1)(a).

<sup>3</sup> Deleted by IPA s. 6(1)(b).

<sup>4</sup> Inserted by IPA s. 12(2). For transitional arrangements see IPA s. 12(5). See also IPA s. 12(7).

<sup>5</sup> Deleted by s. 6(2). For transitional arrangements see The Intellectual Property Act 2014 (Commencement No. 3 and Transitional Provisions) Order 2014, s. 4. SI 2014/2330

### **3A Determination of applications for registration**

- (1) Subject as follows, the registrar shall not refuse to register a design included in an application under this Act.
- (2) If it appears to the registrar that an application for the registration of a design or designs has not been made in accordance with any rules made under this Act, he may refuse to register any design included in it.
- (3) If it appears to the registrar that the applicant is not under section 3(2) or (3) or 14 entitled to apply for the registration of a design included in the application, he shall refuse to register that design.
- (4) If it appears to the registrar that the application for registration includes—
  - (a) Something which does not fulfil the requirements of section 1(2) of this Act;
  - (b) A design that does not fulfil the requirements of section 1C or 1D of this Act; or
  - (c) A design to which a ground of refusal mentioned in Schedule A1 to this Act applies

he shall refuse to register that thing or that design.

### **3B Modification of applications for registration**

- (1) The registrar may, at any time before an application for the registration of a design or designs is determined, permit the applicant to make such modifications of the application as the registrar thinks fit.
- (2) Where an application for the registration of a design or designs has been modified before it has been determined in such a way that any design included in the application has been altered significantly, the registrar may, for the purpose of deciding whether and to what extent the design is new or has individual character, direct that the application so far as relating to that design shall be treated as having been made on the date on which it was so modified.
- (3) Where—
  - (a) An application for the registration of more than one design has been modified before it has been determined to exclude one or more designs from the application; and
  - (b) A subsequent application for the registration of a design so excluded has, within such period (if any) as has been prescribed for such applications, been made by the person who made the earlier application or his successor in title,

The registrar may, for the purpose of deciding whether and to what extent the design is new or has individual character, direct that the subsequent application shall be treated as having been made on the date on which the earlier application was, or is treated as having been, made.

- (4) Where the registration of a design has been refused on any ground mentioned in section 3A(4)(b) or (c) of this Act, the application for the design may be modified by the applicant if it appears to the registrar that—
  - (a) The identity of the design is retained; and
  - (b) The modifications have been made in accordance with any rules made under this Act.
- (5) An application modified under subsection (4) above shall be treated as the original application and, in particular, as made on the date on which the original application was made or is treated as having been made.
- (6) Any modification under this section may, in particular, be effected by making a partial disclaimer in relation to the application.

### **3C Date of registration of designs**

- (1) Subject as follows, a design, when registered, shall be registered as of the date on which the application was made or is treated as having been made.
- (2) Subsection (1) above shall not apply to an application which is treated as having been made on a particular date by section 14(2) of this Act or by virtue of the operation of section 3B(3) or (5) of this Act by reference to section 14(2) of this Act.
- (3) A design, when registered, shall be registered as of—
  - (a) In the case of an application which is treated as having been made on a particular date by section 14(2) of this Act, the date on which the application was made;
  - (b) In the case of an application which is treated as having been made on a particular date by virtue of the operation of section 3B(3) of this Act by reference to section 14(2) of this Act, the date on which the earlier application was made;
  - (c) In the case of an application which is treated as having been made on a particular date by virtue of the operation of section 3B(5) of this Act by reference to section 14(2) of this Act, the date on which the original application was made.

### **3D Appeals in relation to applications for registration**

An appeal lies from any decision of the registrar under section 3A or 3B of this Act.

### **4 [repealed]**

## 5 Provisions for secrecy of certain designs

- (1) Where, either before or after the commencement of this Act, an application for the registration of a design has been made, and it appears to the registrar that the design is one of a class notified to him by the Secretary of State as relevant for defence purposes, he may give directions for prohibiting or restricting the publication of information with respect to the design, or the communication of such information to any person or class of persons specified in the directions.
- (2) The Secretary of State shall by rules make provision for securing that where such directions are given—
  - (a) The representation or specimen of the design,
  - (b) [repealed]shall not be open to public inspection at the Patent Office during the continuance in force of the directions.
- (3) Where the registrar gives any such directions as aforesaid, he shall give notice of the application and of the directions to the Secretary of State, and thereupon the following provisions shall have effect, that is to say:—
  - (a) The Secretary of State shall, upon receipt of such notice, consider whether the publication of the design would be prejudicial to the defence of the realm and unless a notice under paragraph (c) of this subsection has previously been given by that authority to the registrar, shall reconsider that question before the expiration of nine months from the date of filing of the application for registration of the design and at least once in every subsequent year;
  - (b) For the purpose aforesaid, the Secretary of State may, at any time after the design has been registered or, with the consent of the applicant, at any time before the design has been registered, inspect the representation or specimen of the design filed in pursuance of the application;
  - (c) If upon consideration of the design at any time it appears to the Secretary of State that the publication of the design would not, or would no longer, be to the defence of the realm, he shall give notice to the registrar to that effect;
  - (d) On the receipt of any such notice the registrar shall revoke the directions and may, subject to such conditions, if any, as he thinks fit, extend the time for doing anything required or authorised to be done by or under this Act in connection with the application or registration, whether or not that time has previously expired.

- (4) No person resident in the United Kingdom shall, except under the authority of a written permit granted by or on behalf of the registrar, make or cause to be made any application outside the United Kingdom for the registration of a design of any class prescribed for the purposes of this subsection unless—
- (a) An application for registration of the same design has been made in the United Kingdom not less than six weeks before the application outside the United Kingdom; and
  - (b) Either no directions have been given under subsection (1) of this section in relation to the application in the United Kingdom or all such directions have been revoked:
- Provided that this subsection shall not apply in relation to a design for which an application for protection has first been filed in a country outside the United Kingdom by a person resident outside the United Kingdom.
- (5) [repealed]
- (6) [repealed]

## Effect of registration, &c

### 7 Right given by registration

- (1) The registration of a design under this Act gives the registered proprietor the exclusive right to use the design and any design which does not produce on the informed user a different overall impression.
- (2) For the purposes of subsection (1) above and section 7A of this Act any reference to the use of a design includes a reference to—
- (a) The making, offering, putting on the market, importing, exporting or using of a product in which the design is incorporated or to which it is applied; or
  - (b) Stocking such a product for those purposes.
- (3) In determining for the purposes of subsection (1) above whether a design produces a different overall impression on the informed user, the degree of freedom of the author in creating his design shall be taken into consideration.
- (4) The right conferred by subsection (1) above is subject to any limitation attaching to the registration in question (including, in particular, any partial disclaimer or any declaration by the registrar or a court of partial invalidity).

## **7A Infringements of rights in registered designs**

- (1) Subject as follows, the right in a registered design is infringed by a person who, without the consent of the registered proprietor, does anything which by virtue of section 7 of this Act is the exclusive right of the registered proprietor.
- (2) The right in a registered design is not infringed by—
  - (a) An act which is done privately and for purposes which are not commercial;
  - (b) An act which is done for experimental purposes;
  - (c) An act of reproduction for teaching purposes or for the purpose of making citations provided that the conditions mentioned in subsection (3) below are satisfied;
  - (d) The use of equipment on ships or aircraft which are registered in another country but which are temporarily in the United Kingdom;
  - (e) The importation into the United Kingdom of spare parts or accessories for the purpose of repairing such ships or aircraft; or
  - (f) The carrying out of repairs on such ships or aircraft.
- (3) The conditions mentioned in this subsection are—
  - (a) The act of reproduction is compatible with fair trade practice and does not unduly prejudice the normal exploitation of the design; and
  - (b) Mention is made of the source.
- (4) The right in a registered design is not infringed by an act which relates to a product in which any design protected by the registration is incorporated or to which it is applied if the product has been put on the market in the European Economic Area by the registered proprietor or with his consent.
- (5) The right in a registered design of a component part which may be used for the purpose of the repair of a complex product so as to restore its original appearance is not infringed by the use for that purpose of any design protected by the registration.
- (6) No proceedings shall be taken in respect of an infringement of the right in a registered design committed before the date on which the certificate of registration of the design under this Act is granted.

## **7B Right of Prior use<sup>6</sup>**

- (1) A person, who, before the application date, used a registered design in good faith or made serious and effective preparations to do so may continue to use the design for the purposes for which, before that date, the person had used it or made the preparations to use it.
- (2) In subsection (1), the “application date”, in relation to a registered design, means –
  - (a) The date on which an application for the registration was made under section 3, or
  - (b) Where an application for the registration was treated as having been made by virtue of section 14(2), the date on which it was treated as having been so made.
- (3) Subsection (1) does not apply if the design which the person used, or made preparations to use, was copied from the design which was subsequently registered.
- (4) The right conferred on a person by subsection (1) does not include a right to licence another person to use the design.
- (5) Nor may the person on whom the right under subsection (1) is conferred assign the right, or transmit it on death (or in the case of a body corporate on its dissolution), unless –
  - (a) The design was used, or the preparations for its use were made, in the course of a business,
  - (c) The right is assigned or transmitted with the part of the business in which the design was used or the preparations for its use were made.

## **8 Duration of right in registered design**

- (1) The right in a registered design subsists in the first instance for a period of five years from the date of the registration of the design.
- (2) The period for which the right subsists may be extended for a second, third, fourth and fifth period of five years, by applying to the registrar for an extension and paying the prescribed renewal fee.
- (3) If the first, second, third or fourth period expires without such application and payment being made, the right shall cease to have effect; the registrar shall, in accordance with rules made by the Secretary of State, notify the proprietor of that fact.

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<sup>6</sup> Inserted by IPA s.7. For transitional arrangements see IPA s. 7(2)

- (4) If during the period of six months immediately following the end of that period an application for extension is made and the prescribed renewal fee and any prescribed additional fee is paid, the right shall be treated as if it had never expired, with the result that—
  - (a) Anything done under or in relation to the right during that further period shall be treated as valid,
  - (b) An act which would have constituted an infringement of the right if it had not expired shall be treated as an infringement, and
  - (c) An act which would have constituted use of the design for the services of the Crown if the right had not expired shall be treated as such use.
- (5) [repealed]
- (6) [repealed]

## **8A Restoration of lapsed right in design**

- (1) Where the right in a registered design has expired by reason of a failure to extend, in accordance with section 8(2) or (4), the period for which the right subsists, an application for the restoration of the right in the design may be made to the registrar within the prescribed period.
- (2) The application may be made by the person who was the registered proprietor of the design or by any other person who would have been entitled to the right in the design if it had not expired; and where the design was held by two or more persons jointly, the application may, with the leave of the registrar, be made by one or more of them without joining the others.
- (3) Notice of the application shall be published by the registrar in the prescribed manner.
- (4) If the registrar is satisfied that the failure of the proprietor—
  - (a) To pay the fee referred to in subsection (2) of section 8 as required by subsection (3) of that section; or
  - (b) To pay the fees referred to in subsection (4) of that section as required by that subsection,

was unintentional, the registrar shall order the restoration of the right in the design on payment of any unpaid renewal fee and any prescribed additional fee.
- (5) The order may be made subject to such conditions as the registrar thinks fit, and if the proprietor of the design does not comply with any condition the registrar may revoke the order and give such consequential directions as he thinks fit.



- (6) Rules altering the period prescribed for the purposes of subsection (1) may contain such transitional provisions and savings as appear to the Secretary of State to be necessary or expedient.

## **8B Effect of order for restoration of right**

- (1) The effect of an order under section 8A for the restoration of the right in a registered design is as follows.
- (2) Anything done under or in relation to the right during the period between expiry and restoration shall be treated as valid.
- (3) Anything done during that period which would have constituted an infringement if the right had not expired shall be treated as an infringement—
- (a) If done at a time when it was possible for an application for extension to be made under section 8(4); or
- (b) If it was a continuation or repetition of an earlier infringing act.
- (4) If, after it was no longer possible for such an application for extension to be made and before publication of notice of the application for restoration, a person—
- (a) Began in good faith to do an act which would have constituted an infringement of the right in the design if it had not expired, or
- (b) Made in good faith effective and serious preparations to do such an act,
- he has the right to continue to do the act or, as the case may be, to do the act, notwithstanding the restoration of the right in the design; but this does not extend to granting a licence to another person to do the act.
- (5) If the act was done, or the preparations were made, in the course of a business, the person entitled to the right conferred by subsection (4)—
- (a) Authorise the doing of that act by any partners of his for the time being in that business, and
- (b) Assign that right, or transmit it on death (or in the case of a body corporate on its dissolution), to any person who acquires that part of the business in the course of which the act was done or the preparations were made.
- (6) Where a product is disposed of to another in exercise of the rights conferred by subsection (4) or subsection (5), that other and any person claiming through him may deal with the product in the same way as if it had been disposed of by the registered proprietor of the design.

- (7) The above provisions apply in relation to the use of a registered design for the services of the Crown as they apply in relation to infringement of the right in the design.
- (8) 9 [repealed]
- (9) 10 [repealed]

## **11 Cancellation of registration**

The registrar may, upon a request made in the prescribed manner by the registered proprietor, cancel the registration of a design.

### **11ZA Grounds for invalidity of registration**

- (1) The registration of a design may be declared invalid —
  - (a) On the ground that it does not fulfil the requirements of section 1(2) of this Act;
  - (b) On the ground that it does not fulfil the requirements of sections 1B to 1D of this Act;
  - (c) Where any ground of refusal mentioned in Schedule A1 to this Act applies.
- (1A) The registration of a design (“the later design”) may be declared invalid if it is not new or does not have individual character when compared to a design which—
  - (a) Has been made available to the public on or after the relevant date; but
  - (b) Is protected as from a date prior to the relevant date—
    - (i) By virtue of registration under this Act or the Community Design Regulation or an application for such registration, or
    - (ii) By virtue of an international registration (within the meaning of Articles 106a to 106f of that Regulation) designating the Community.
- (1B) In subsection (1A) “the relevant date” means the date on which the application for the registration of the later design was made or is treated by virtue of section 3B(2), (3) or (5) or 14(2) of this Act as having been made.
- (2) The registration of a design may be declared invalid on the ground of the registered proprietor not being the proprietor of the design and the proprietor of the design objecting.
- (3) The registration of a design involving the use of an earlier distinctive sign may be declared invalid on the ground of an objection by the holder of rights to the sign which include the right to prohibit in the United Kingdom such use of the sign.

- (4) The registration of a design constituting an unauthorised use of a work protected by the law of copyright in the United Kingdom may be declared invalid on the ground of an objection by the owner of the copyright.
- (5) In this section and sections 11ZB, 11ZC and 11ZE of this Act (other than section 11ZE(1)) references to the registration of a design include references to the former registration of a design; and these sections shall apply, with necessary modifications, in relation to such former registrations.

### **11ZB Applications for declaration of invalidity**

- (1) Any person interested may make an application to the registrar for a declaration of invalidity under section 11ZA(1)(a) or (b) of this Act.
- (2) Any person concerned by the use in question may make an application to the registrar for a declaration of invalidity under section 11ZA(1)(c) of this Act.
- (3) The relevant person may make an application to the registrar for a declaration of invalidity under section 11ZA(1A) of this Act.
- (4) In subsection (3) above “the relevant person” means, in relation to an earlier design protected by virtue of registration under this Act or the Community Design Regulation or an application for such registration, the registered proprietor of the design, the holder of the registered Community design or (as the case may be) the applicant.
- (5) The person able to make an objection under subsection (2), (3) or (4) of section 11ZA of this Act may make an application to the registrar for a declaration of invalidity under that subsection.
- (6) An application may be made under this section in relation to a design at any time after the design has been registered.

### **11ZC Determination of applications for declaration of invalidity**

- (1) This section applies where an application has been made to the registrar for a declaration of invalidity in relation to a registration.
- (2) If it appears to the registrar that the application has not been made in accordance with any rules made under this Act, he may refuse the application.
- (3) If it appears to the registrar that the application has not been made in accordance with section 11ZB of this Act, he shall refuse the application.
- (4) Subject to subsections (2) and (3) above, the registrar shall make a declaration of invalidity if it appears to him that the ground of invalidity specified in the application has been established in relation to the registration.
- (5) Otherwise the registrar shall refuse the application.
- (6) A declaration of invalidity may be a declaration of partial invalidity.

**11ZD Modification of registration**

- (1) Subsections (2) and (3) below apply where the registrar intends to declare the registration of a design invalid under section 11ZA(1)(b) or (c), (1A), (3) or (4) of this Act.
- (2) The registrar shall inform the registered proprietor of that fact.
- (3) The registered proprietor may make an application to the registrar for the registrar to make such modifications to the registration of the design as the registered proprietor specifies in his application.
- (4) Such modifications may, in particular, include the inclusion on the register of a partial disclaimer by the registered proprietor.
- (5) If it appears to the registrar that the application has not been made in accordance with any rules made under this Act, the registrar may refuse the application.
- (6) If it appears to the registrar that the identity of the design is not retained or the modified registration would be invalid by virtue of section 11ZA of this Act, the registrar shall refuse the application.
- (7) Otherwise the registrar shall make the specified modifications.
- (8) A modification of a registration made under this section shall have effect, and be treated always to have had effect, from the grant of registration.

**11ZE Effect of cancellation or invalidation of registration**

- (1) A cancellation of registration under section 11 of this Act takes effect from the date of the registrar's decision or from such other date as the registrar may direct.
- (2) Where the registrar declares the registration of a design invalid to any extent, the registration shall to that extent be treated as having been invalid from the date of registration or from such other date as the registrar may direct.

**11ZF Appeals in relation to cancellation or invalidation**

An appeal lies from any decision of the registrar under section 11 to 11ZE of this Act.

## 11A Powers exercisable for protection of the public interest

- (1) Where a report of the Competition Commission has been laid before Parliament containing conclusions to the effect—
  - (a) [repealed]
  - (b) [repealed]
  - (c) On a competition reference, that a person was engaged in an anti-competitive practice which operated or may be expected to operate against the public interest, or
  - (d) On a reference under section 11 of the Competition Act 1980 (reference of public bodies and certain other persons), that a person is pursuing a course of conduct which operates against the public interest,  
  
the appropriate Minister or Ministers may apply to the registrar to take action under this section.
- (2) Before making an application the appropriate Minister or Ministers shall publish, in such a manner as he or they think appropriate, a notice describing the nature of the proposed application and shall consider any representations which may be made within 30 days of such publication by persons whose interests appear to him or them to be affected.
- (3) If on an application under this section it appears to the registrar that the matters specified in the Commission's report as being those which in the Commission's opinion operate or operated or may be expected to operate against the public interest include—
  - (a) Conditions in licences granted in respect of a registered design by its proprietor restricting the use of the design by the licensee or the right of the proprietor to grant other licences,
  - (b) [repealed]he may by order cancel or modify any such condition.
- (4) [repealed]
- (5) [repealed]
- (6) An appeal lies from any order of the registrar under this section.
- (7) In this section "the appropriate Minister or Ministers" means the Minister or Ministers to whom the report of the Competition Commission was made.

## **11AB Powers exercisable following merger and market investigations**

- (1) Subsection (2) below applies where—
  - (a) Section 41(2), 55(2), 66(6), 75(2), 83(2), 138(2), 147(2) or 160(2) of, or paragraph 5(2) or 10(2) of Schedule 7 to, the Enterprise Act 2002 (powers to take remedial action following merger or market investigations) applies;
  - (b) The Competition Commission or (as the case may be) the Secretary of State considers that it would be appropriate to make an application under this section for the purpose of remedying, mitigating or preventing a matter which cannot be dealt with under the enactment concerned; and
  - (c) The matter concerned involves conditions in licences granted in respect of a registered design by its proprietor restricting the use of the design by the licensee or the right of the proprietor to grant other licences.
- (2) The Competition Commission or (as the case may be) the Secretary of State may apply to the registrar to take action under this section.
- (3) Before making an application the Competition Commission or (as the case may be) the Secretary of State shall publish, in such manner as it or he thinks appropriate, a notice describing the nature of the proposed application and shall consider any representations which may be made within 30 days of such publication by persons whose interests appear to it or him to be affected.
- (4) The registrar may, if it appears to him on an application under this section that the application is made in accordance with this section, by order cancel or modify any condition concerned of the kind mentioned in subsection (1)(c) above.
- (5) An appeal lies from any order of the registrar under this section.
- (6) References in this section to the Competition Commission shall, in cases where section 75(2) of the Enterprise Act 2002 applies, be read as references to the Office of Fair Trading.
- (7) References in section 35, 36, 47, 63, 134 or 141 of the Enterprise Act 2002 (questions to be decided by the Competition Commission in its reports) to taking action under section 41(2), 55, 66, 138 or 147 shall include references to taking action under subsection (2) above.
- (8) An order made by virtue of this section in consequence of action under subsection (2) above where an enactment mentioned in subsection (1)(a) above applies shall be treated, for the purposes of sections 91(3), 92(1)(a), 162(1) and 166(3) of the Enterprise Act 2002 (duties to register and keep under review enforcement orders etc), as if it were made under the relevant power in Part 3 or (as the case may be) 4 of that Act to make an enforcement order (within the meaning of the Part concerned).

**11B** [repealed]

**12 Use for services of Crown**

The provisions of the First Schedule to this Act shall have effect with respect to the use of registered designs for the services of the Crown and the rights of third parties in respect of such use.

**International Arrangements**

**13 Orders in Council as to convention countries**

- (1) His Majesty may, with a view to the fulfilment of a treaty, convention, arrangement or engagement, by Order in Council declare that any country specified in the Order is a convention country for the purposes of this Act:

Provided that a declaration may be made as aforesaid for the purposes either of all or of some only of the provisions of this Act, and a country in the case of which a declaration made for the purposes of some only of the provisions of this Act is in force shall be deemed to be a convention country for the purposes of those provisions only.

- (2) His Majesty may by Order in Council direct that any of the Channel Islands, any colony shall be deemed to be a convention country for the purposes of all or any of the provisions of this Act; and an Order made under this subsection may direct that any such provisions shall have effect, in relation to the territory in question, subject to such conditions or limitations, if any, as may be specified in the Order.
- (3) For the purposes of subsection (1) of this section, every colony, protectorate, territory subject to the authority or under the suzerainty of another country, and territory administered by another country under the trusteeship system of the United Nations, shall be deemed to be a country in the case of which a declaration may be made under that subsection.

**14 Registration of design where application for protection in convention country has been made**

- (1) An application for registration of a design or designs in respect of which protection has been applied for in a convention country may be made in accordance with the provisions of this Act by the person by whom the application for protection was made or his personal representative or assignee:

Provided that no application shall be made by virtue of this section after the expiration of six months from the date of the application for protection in a convention country or, where more than one such application for protection has been made, from the date of the first application.

- (2) Where an application for registration of a design or designs is made by virtue of this section, the application shall be treated, for the purpose of determining whether (and to what extent) that or any other design is new or has individual character, as made on the date of the application for protection in the convention country or, if more than one such application was made, on the date of the first such application.
- (3) Subsection (2) shall not be construed as excluding the power to give directions under section 3B(2) or (3) of this Act in relation to an application made by virtue of this section.
- (4) Where a person has applied for protection for a design by an application which—
  - (a) In accordance with the terms of a treaty subsisting between two or more convention countries, is equivalent to an application duly made in any one of those convention countries; or
  - (b) In accordance with the law of any convention country, is equivalent to an application duly made in that convention country, he shall be deemed for the purposes of this section to have applied in that convention country.

## **15 Extension of time for applications under s 14 in certain cases**

- (1) If the Secretary of State is satisfied that provision substantially equivalent to the provision to be made by or under this section has been or will be made under the law of any convention country, he may make rules empowering the registrar to extend the time for making application under subsection (1) of section fourteen of this Act for of a design in respect of which protection has been applied for in that country in any case where the period specified in the proviso to that subsection expires during a period prescribed by the rules.
- (2) Rules made under this section—
  - (a) May, where any agreement or arrangement has been made between His Majesty's Government in the United Kingdom and the government of the convention country for the supply or mutual exchange of information or products, provide, either generally or in any class of case specified in the rules, that an extension of time shall not be granted under this section unless the design has been communicated in accordance with the agreement or arrangement;
  - (b) May, either generally or in any class of case specified in the rules, fix the maximum extension which may be granted under this section;
  - (c) May prescribe or allow any special procedure in connection with applications made by virtue of this section;



- (d) May empower the registrar to extend, in relation to an application made by virtue of this section, the time limited by or under the foregoing provisions of this Act for doing any act, subject to such conditions, if any, as may be imposed by or under the rules;
- (e) May provide for securing that the rights conferred by registration on an application made by virtue of this section shall be subject to such restrictions or conditions as may be specified by or under the rules and in particular to restrictions and conditions for the protection of persons (including persons acting on behalf of His Majesty) who, otherwise than as the result of a communication made in accordance with such an agreement or arrangement as is mentioned in paragraph (a) of this subsection, and before the date of the application in question or such later date as may be allowed by the rules, may have imported or made products to which the design is applied or in which it is incorporated or may have made an application for registration of the design.

## Property in and dealing with registered designs and applications

### 15ZA Accession to the Hague Agreement<sup>7</sup>

- (1) The Secretary of State may by order make provision for giving effect in the United Kingdom to the provisions of the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs adopted by the Diplomatic Conference on 2 July 1999.
- (2) An order under this section may, in particular, make provision about –
  - (a) The making of applications for international registrations at the Patent Office;
  - (b) The procedures to be followed where an international registration designates the United Kingdom;
  - (c) The effect of an international registration which designates the United Kingdom;
  - (d) The communication of information to the International Bureau;
  - (e) The payment of fees.
- (3) An order under this section may –
  - (a) Amend this Act;
  - (b) Apply specified provisions of this Act with such modifications as may be specified.

<sup>7</sup> Inserted by IPA s. 8. Powers commenced 1st October 2014 in SI 2014/2330 but will only come into force once an order made the Secretary of State is in force (see s. 37(4B) below).

- (4) An expression used in subsection (2) and in the Agreement referred to in subsection (1) has the same meaning in that subsection as it has in the Agreement.

## **15A The nature of registered designs**

A registered design or an application for a registered design is personal property (in Scotland, incorporeal moveable property).

## **15B Assignment &c of registered designs and applications for registered designs**

- (1) A registered design or an application for a registered design is transmissible by assignment, testamentary disposition or operation of law in the same way as other personal or moveable property, subject to the following provisions of this section.
- (2) Any transmission of a registered design or an application for a registered design is subject to any rights vested in any other person of which notice is entered in the register of designs, or in the case of applications, notice is given to the registrar.
- (3) An assignment of, or an assent relating to, a registered design or application for a registered design is not effective unless it is in writing signed by or on behalf of the assignor or, as the case may be, a personal representative.
- (4) Except in Scotland, the requirement in subsection (3) may be satisfied in a case where the assignor or personal representative is a body corporate by the affixing of its seal.
- (5) Subsections (3) and (4) apply to assignment by way of security as in relation to any other assignment.
- (6) A registered design or application for a registered design may be the subject of a charge (in Scotland, security) in the same way as other personal or moveable property.
- (7) The proprietor of a registered design may grant a licence to use that registered design.
- (8) Any equities (in Scotland, rights) in respect of a registered design or an application for a registered design may be enforced in like manner as in respect of any other personal or moveable property.

**15C Exclusive licences**

- (1) In this Act an “exclusive licence” means a licence in writing signed by or on behalf of the proprietor of the registered design authorising the licensee to the exclusion of all other persons, including the person granting the licence, to exercise a right which would otherwise be exercisable exclusively by the proprietor of the registered design.
- (2) The licensee under an exclusive licence has the same rights against any successor in title who is bound by the licence as he has against the person granting the licence.

**16** [repealed]**Register of designs, &c****17 Register of designs, etc**

- (1) The registrar shall maintain the register of designs, in which shall be entered—
  - (a) The names and addresses of proprietors of registered designs;
  - (b) Notices of assignments and of transmissions of registered designs; and
  - (c) Such other matters as may be prescribed or as the registrar may think fit.
- (2) No notice of any trust, whether express, implied or constructive, shall be entered in the register of designs, and the registrar shall not be affected by any such notice.
- (3) The register need not be kept in documentary form.
- (4) Subject to the provisions of this Act and to rules made by the Secretary of State under it, the public shall have a right to inspect the register at the Patent Office at all convenient times.
- (5) Any person who applies for a certified copy of an entry in the register or a certified extract from the register shall be entitled to obtain such a copy or extract on payment of a fee prescribed in relation to certified copies and extracts; and rules made by the Secretary of State under this Act may provide that any person who applies for an uncertified copy or extract shall be entitled to such a copy or extract on payment of a fee prescribed in relation to uncertified copies and extracts.
- (6) Applications under subsection (5) above or rules made by virtue of that subsection shall be made in such manner as may be prescribed.

- (7) In relation to any portion of the register kept otherwise than in documentary form—
- (a) The right of inspection conferred by subsection (4) above is a right to inspect the material on the register; and
  - (b) The right to a copy or extract conferred by subsection (5) above or rules is a right to a copy or extract in a form in which it can be taken away and in which it is visible and legible.
- (8) The register shall be prima facie evidence of anything required or authorised to be entered in it and in Scotland shall be sufficient evidence of any such thing.
- (9) A certificate purporting to be signed by the registrar and certifying that any entry which he is authorised by or under this Act to make has or has not been made, or that any other thing which he is so authorised to do has or has not been done, shall be prima facie evidence, and in Scotland shall be sufficient evidence, of the matters so certified.
- (10) Each of the following—
- (a) A copy of an entry in the register or an extract from the register which is supplied under subsection (5) above;
  - (b) A copy of any representation, specimen or document kept in the Patent Office or an extract from any such document, which purports to be a certified copy or certified extract shall be admitted in evidence without further proof and without production of any original; and in Scotland such evidence shall be sufficient evidence.
- (11) [repealed]
- (12) In this section “certified copy” and “certified extract” mean a copy and extract certified by the registrar and sealed with the seal of the Patent Office.

## **18 Certificate of registration**

- (1) The registrar shall grant a certificate of registration in the prescribed form to the registered proprietor of a design when the design is registered.
- (2) The registrar may, in a case where he is satisfied that the certificate of registration has been lost or destroyed, or in any other case in which he thinks it expedient, furnish one or more copies of the certificate.

## **19 Registration of assignments, etc**

- (1) Where any person becomes entitled by assignment, transmission or operation of law to a registered design or to a share in a registered design, or becomes entitled as mortgagee, licensee or otherwise to any other interest in a registered design, he shall apply to the registrar in the prescribed manner for the registration of his title as proprietor or co-proprietor or, as the case may be, of notice of his interest, in the register of designs.

- (2) Without prejudice to the provisions of the foregoing subsection, an application for the registration of the title of any person becoming entitled by assignment to a registered design or a share in a registered design, or becoming entitled by virtue of a mortgage, licence or other instrument to any other interest in a registered design, may be made in the prescribed manner by the assignor, mortgagor, licensor or other party to that instrument, as the case may be.
- (3) Where application is made under this section for the registration of the title of any person, the registrar shall, upon proof of title to his satisfaction—
  - (a) Where that person is entitled to a registered design or a share in a registered design, register him in the register of designs as proprietor or co-proprietor of the design, and enter in that register particulars of the instrument or event by which he derives title; or
  - (b) Where that person is entitled to any other interest in the registered design, enter in that register notice of his interest, with particulars of the instrument (if any) creating it.
- (3A) [Repealed]<sup>8</sup>
- (3B) Where national unregistered design right subsists in a registered design and the proprietor of the registered design is also the design right owner, an assignment of the national unregistered design right shall be taken to be also an assignment of the right in the registered design, unless a contrary intention appears.
- (4) [repealed]
- (5) Except for the purposes of an application to rectify the register under the following provisions of this Act, a document in respect of which no entry has been made in the register of designs under subsection (3) of this section shall not be admitted in any court as evidence of the title of any person to a registered design or share of or interest in a registered design unless the court otherwise directs.

## 20 Rectification of register

- (1) The court may, on the application of the relevant person, order the register of designs to be rectified by the making of any entry therein or the variation or deletion of any entry therein.
- (1A) In subsection (1) above “the relevant person” means—
  - (a) In the case of an application invoking any ground referred to in section 11ZA(1)(c) of this Act, any person concerned by the use in question;
  - (b) In the case of an application invoking the ground mentioned section 11ZA(1A) of this Act, the appropriate person;

- (c) In the case of an application invoking any ground mentioned in section 11ZA(2), (3) or (4) of this Act, the person able to make the objection;
  - (d) In any other case, any person aggrieved.
- (1B) In subsection (1A) above “the appropriate person” means, in relation to an earlier design protected by virtue of under this Act or the Community Design Regulation or an application for such registration, the registered proprietor of the design, the holder of the registered Community design or (as the case may be) the applicant.
- (2) In proceedings under this section the court may determine any question which it may be necessary or expedient to decide in connection with the rectification of the register.
- (3) Notice of any application to the court under this section shall be given in the prescribed manner to the registrar, who shall be entitled to appear and be heard on the application, and shall appear if so directed by the court.
- (4) Any order made by the court under this section shall direct that notice of the order shall be served on the registrar in the prescribed manner; and the registrar shall, on receipt of the notice, rectify the register accordingly.
- (5) A rectification of the register under this section has effect as follows—
  - (a) An entry made has effect from the date on which it should have been made,
  - (b) An entry varied has effect as if it had originally been made in its varied form, and
  - (c) An entry deleted shall be deemed never to have had effect, unless, in any case, the court directs otherwise.
- (6) Orders which may be made by the court under this section include, in particular, declarations of partial invalidity.

## **21 Power to correct clerical errors**

- (1) The registrar may, in accordance with the provisions of this section, correct any error in an application for the registration or in the representation of a design, or any error in the register of designs.
- (2) A correction may be made in pursuance of this section either upon a request in writing made by any person interested and accompanied by the prescribed fee, or without such a request.

- (3) Where the registrar proposes to make any such correction as aforesaid otherwise than in pursuance of a request made under this section, he shall give notice of the proposal to the registered proprietor or the applicant for registration of the design, as the case may be, and to any other person who appears to him to be concerned, and shall give them an opportunity to be heard before making the correction.

## 22 Inspection of registered designs and associated documents<sup>9</sup>

- (1) Where a design has been registered under this Act, there shall be open to inspection at the Patent Office on and after the day on which the certificate of registration is granted—
- (a) The representation or specimen of the design,
  - (b) Every document kept at the Patent Office in connection with that design<sup>10</sup>
  - (c) [repealed]

This subsection has effect subject to subsection (4) to (7)<sup>11</sup> and to any rules made under section 5(2) of this Act.

- (2) [repealed]
- (3) [repealed]
- (4) Where registration of a design has been refused pursuant to an application under this Act, or an application under this Act has been abandoned in relation to any design—
- (a) The application, so far as relating to that design, and
  - (b) Any representation, specimen or other document which has been filed and relates to that design,
- shall not at any time be open to inspection at the Patent Office or be published by the registrar.
- (5) For the purposes of subsection (1), a document is not to be regarded as open for inspection unless ( in addition to being open for inspection in hard copy) it is made available by electronic transmission in such a way that members of the public may access it at a place and time individually chosen by them.<sup>12</sup>
- (6) The Secretary of State may by rules specify cases or circumstances in which a document kept at the Patent Office in connection with a registered design may not be inspected.<sup>13</sup>
- (7) Rules made under subsection (6) may confer a discretion on the registrar.<sup>14</sup>

<sup>9</sup> Inserted by IPA s. 9(2). To be commenced once suitable IT systems are in place.

<sup>10</sup> Inserted by IPA s. 9(2). To be commenced once suitable IT systems are in place.

<sup>11</sup> Inserted by IPA s. 9(3). To be commenced once suitable IT systems are in place.

<sup>12</sup> Inserted by IPA s. 9(4). To be commenced once suitable IT systems are in place.

<sup>13</sup> Inserted by IPA s. 9(5). To be commenced once suitable IT systems are in place.

<sup>14</sup> Inserted by IPA s. 9(5). To be commenced once suitable IT systems are in place.

## 23 Information as to existence of right in registered design

On the request of a person furnishing such information as may enable the registrar to identify the design, and on payment of the prescribed fee, the registrar shall inform him—

- (a) whether the design is registered, and
  - (b) whether any extension of the period of the right in the registered design has been granted,
- and shall state the date of registration and the name and address of the registered proprietor.

## 24 [repealed]

### Legal proceedings: general

#### 24A Action for infringement

- (1) An infringement of the right in a registered design is actionable by the registered proprietor.
- (2) In an action for infringement all such relief by way of damages, injunctions, accounts or otherwise is available to him as is available in respect of the infringement of any other property right.
- (3) This section has effect subject to section 24B (exemption of innocent infringer from liability).

#### 24B Exemption of innocent infringer from liability

- (1) In proceedings for the infringement of the right in a registered design damages shall not be awarded, ... <sup>15</sup>against a defendant who proves that at the date of the infringement he was not aware, and had no reasonable ground for supposing, that the design was registered.
- (2) For the purposes of subsection (1), a person shall not be deemed to have been aware or to have had reasonable grounds for supposing that the design or a relevant internet link was registered by reason only of the marking of a product with—
  - (a) The word “registered” or any abbreviation thereof, or
  - (b) Any word or words expressing or implying that the design applied to, or incorporated in, the product has been registered.

unless the number of the design accompanied the word or words or the abbreviation in question.



- (2A) The reference in subsection (2) to a relevant internet link is a reference to an address of a posting on the internet -
  - (a) which is accessible to the public free of charge, and
  - (b) which clearly associates the product with the number of the design.
- (3) Nothing in this section shall affect the power of the court to grant an injunction in any proceedings for infringement of the right in a registered design.

## **24C Order for delivery up**

- (1) Where a person—
  - (a) Has in his possession, custody or control for commercial purposes an infringing article, or
  - (b) Has in his possession, custody or control anything specifically designed or adapted for making articles to a particular design which is a registered design, knowing or having reason to believe that it has been or is to be used to make an infringing article,

the registered proprietor in question may apply to the court for an order that the infringing article or other thing be delivered up to him or to such other person as the court may direct.
- (2) An application shall not be made after the end of the period specified in the following provisions of this section; and no order shall be made unless the court also makes, or it appears to the court that there are grounds for making, an order under section 24D of this Act (order as to disposal of infringing article, &c.).
- (3) An application for an order under this section may not be made after the end of the period of six years from the date on which the article or thing in question was made, subject to subsection (4).
- (4) If during the whole or any part of that period the registered proprietor—
  - (a) Is under a disability, or
  - (b) Is prevented by fraud or concealment from discovering the facts entitling him to apply for an order, an application may be made at any time before the end of the period of six years from the date on which he ceased to be under a disability or, as the case may be, could with reasonable diligence have discovered those facts.
- (5) In subsection (4) “disability”—
  - (a) In England and Wales, has the same meaning as in the Limitation Act 1980;
  - (b) In Scotland, means legal disability within the meaning of the Prescription and Limitation (Scotland) Act 1973;

- (c) In Northern Ireland, has the same meaning as in the Statute of Limitations (Northern Ireland) 1958.
- (6) A person to whom an infringing article or other thing is delivered up in pursuance of an order under this section shall, if an order under section 24D of this Act is not made, retain it pending the making of an order, or the decision not to make an order, under that section.
- (7) The reference in subsection (1) to an act being done in relation to an article for “commercial purposes” are to its being done with a view to the article in question being sold or hired in the course of a business.
- (8) Nothing in this section affects any other power of the court.

#### **24D Order as to disposal of infringing articles, &c**

- (1) An application may be made to the court for an order that an infringing article or other thing delivered up in pursuance of an order under section 24C of this Act shall be—
  - (a) Forfeited to the registered proprietor, or
  - (b) Destroyed or otherwise dealt with as the court may think fit, or for a decision that no such order should be made.
- (2) In considering what order (if any) should be made, the court shall consider whether other remedies available in an action for infringement of the right in a registered design would be adequate to compensate the registered proprietor and to protect his interests.
- (3) Where there is more than one person interested in an article or other thing, the court shall make such order as it thinks just and may (in particular) direct that the thing be sold, or otherwise dealt with, and the proceeds divided.
- (4) If the court decides that no order should be made under this section, the person in whose possession, custody or control the article or other thing was before being delivered up is entitled to its return.
- (5) References in this section to a person having an interest in an article or other thing include any person in whose favour an order could be made in respect of it—
  - (a) Under this section;
  - (b) Under section 19 of Trade Marks Act 1994 (including that section as applied by regulation 4 of the Community Trade Mark Regulations 2006 (SI 2006/1027));
  - (c) Under section 114, 204 or 231 of the Copyright, Designs and Patents Act 1988; or
  - (d) Under regulation 1C of the Community Design Regulations 2005 (SI2005/2339).

## **24E Jurisdiction of county court and sheriff court**

- (1) In Northern Ireland a county court may entertain proceedings under the following provisions of this Act—
  - section 24C (order for delivery up of infringing article, &c.),
  - section 24D (order as to disposal of infringing article, &c.), or
  - section 24F(8) (application by exclusive licensee having concurrent rights), where the value of the infringing articles and other things in question does not exceed the county court limit for actions in tort.
- (2) In Scotland proceedings for an order under any of those provisions may be brought in the sheriff court.
- (3) Nothing in this section shall be construed as affecting the jurisdiction of the Court of Session or the High Court in Northern Ireland.

## **24F Rights and remedies of exclusive licensee**

- (1) In relation to a registered design, an exclusive licensee has, except against the registered proprietor, the same rights and remedies in respect of matters occurring after the grant of the licence as if the licence had been an assignment.
- (2) His rights and remedies are concurrent with those of the registered proprietor; and references to the registered proprietor in the provisions of this Act relating to infringement shall be construed accordingly.
- (3) In an action brought by an exclusive licensee by virtue of this section a defendant may avail himself of any defence which would have been available to him if the action had been brought by the registered proprietor.
- (4) Where an action for infringement of the right in a registered design brought by the registered proprietor or an exclusive licensee relates (wholly or partly) to an infringement in respect of which they have concurrent rights of action, the proprietor or, as the case may be, the exclusive licensee may not, without the leave of the court, proceed with the action unless the other is either joined as a claimant or added as a defendant.
- (5) A registered proprietor or exclusive licensee who is added as a defendant in pursuance of subsection (4) is not liable for any costs in the action unless he takes part in the proceedings.
- (6) Subsections (4) and (5) do not affect the granting of interlocutory relief on the application of the registered proprietor or an exclusive licensee.
- (7) Where an action for infringement of the right in a registered design is brought which relates (wholly or partly) to an infringement in respect of which the registered proprietor and an exclusive licensee have concurrent rights of action—
  - (a) The court shall, in assessing damages, take into account—

- (i) The terms of the licence, and
  - (ii) Any pecuniary remedy already awarded or available to either of them in respect of the infringement;
- (b) No account of profits shall be directed if an award of damages has been made, or an account of profits has been directed, in favour of the other of them in respect of the infringement; and
- (c) The court shall if an account of profits is directed apportion the profits between them as the court considers just, subject to any agreement between them;

and these provisions apply whether or not the proprietor and the exclusive licensee are both parties to the action.

- (8) The registered proprietor shall notify any exclusive licensee having concurrent rights before applying for an order under section 24C of this Act (order for delivery up of infringing article, &c); and the court may on the application of the licensee make such order under that section as it thinks fit having regard to the terms of the licence.

## **24G Meaning of “infringing article”**

- (1) In this Act “infringing article”, in relation to a design, shall be construed in accordance with this section.
- (2) An article is an infringing article if its making to that design was an infringement of the right in a registered design.
- (3) An article is also an infringing article if—
- (a) It has been or is proposed to be imported into the United Kingdom, and
  - (b) Its making to that design in the United Kingdom would have been an infringement of the right in a registered design or a breach of an exclusive licensing agreement relating to that registered design.
- (4) Where it is shown that an article is made to a design which is or has been a registered design, it shall be presumed until the contrary is proved that the article was made at a time when the right in the registered design subsisted.
- (5) Nothing in subsection (3) shall be construed as applying to an article which may be lawfully imported into the United Kingdom by virtue of an enforceable Community right within the meaning of section 2(1) of the European Communities Act 1972.

## **25 Certificate of contested validity of registration**

- (1) If in any proceedings before the court the validity of the registration of a design is contested, and it is found by the court that the design is, to any extent, validly registered, the court may certify that the validity of the registration of the design was contested in those proceedings.
- (2) Where any such certificate has been granted, then if in any subsequent proceedings before the court for infringement of the right in the registered design or for invalidation of the registration of the design, a final order or judgment is made or given in favour of the registered proprietor, he shall, unless the court otherwise directs, be entitled to his costs as between solicitor and client:

Provided that this subsection shall not apply to the costs of any appeal in any such proceedings as aforesaid.

## **26 Unjustified threats Threats of infringement proceedings**

- (1) A communication contains a “threat of infringement proceedings” if a reasonable person in the position of a recipient would understand from the communication that:—
  - (a) a registered design exists, and
  - (b) a person intends to bring proceedings (whether in a court in the United Kingdom or elsewhere) against another person for infringement of the right in the registered design by—
    - (i) an act done in the United Kingdom, or
    - (ii) an act which, if done, would be done in the United Kingdom.
- (2) References in this section and in section 26C to a “recipient” include, in the case of a communication directed to the public or a section of the public, references to a person to whom the communication is directed.

## **26A Actionable threats**

- (1) Subject to subsections (2) to (5), a threat of infringement proceedings made by any person is actionable by any person aggrieved by the threat.
- (2) A threat of infringement proceedings is not actionable if the infringement is alleged to consist of—
  - (a) making a product for disposal, or
  - (b) importing a product for disposal.
- (3) A threat of infringement proceedings is not actionable if the infringement is alleged to consist of an act which, if done, would constitute an infringement of a kind mentioned in subsection (2)(a) or (b).

- (4) A threat of infringement proceedings is not actionable if the threat—
  - (a) is made to a person who has done, or intends to do, an act mentioned in subsection (2)(a) or (b) in relation to a product, and
  - (b) is a threat of proceedings for an infringement alleged to consist of doing anything else in relation to that product.
- (5) A threat of infringement proceedings which is not an express threat is not actionable if it is contained in a permitted communication.
- (6) In sections 26C and 26D an “actionable threat” means a threat of infringement proceedings that is actionable in accordance with this section.

## **26B Permitted communications**

- (1) For the purposes of section 26A(5), a communication containing a threat of infringement proceedings is a “permitted communication” if—
  - (a) the communication, so far as it contains information that relates to the threat, is made for a permitted purpose;
  - (b) all of the information that relates to the threat is information that—
    - (i) is necessary for that purpose (see subsection (5)(a) to (c) for some examples of necessary information), and
    - (ii) the person making the communication reasonably believes is true.
- (2) Each of the following is a “permitted purpose”—
  - (a) giving notice that a registered design exists;
  - (b) discovering whether, or by whom, the right in a registered design has been infringed by an act mentioned in section 26A(2)(a) or (b);
  - (c) giving notice that a person has a right in or under a registered design, where another person’s awareness of the right is relevant to any proceedings that may be brought in respect of the registered design.
- (3) The court may, having regard to the nature of the purposes listed in subsection (2)(a) to (c), treat any other purpose as a “permitted purpose” if it considers that it is in the interests of justice to do so.
- (4) But the following may not be treated as a “permitted purpose”—
  - (a) requesting a person to cease doing, for commercial purposes, anything in relation to a product in which a design is incorporated or to which it is applied,
  - (b) requesting a person to deliver up or destroy a product in which a design is incorporated or to which it is applied, or
  - (c) requesting a person to give an undertaking relating to a product in which a design is incorporated or to which it is applied.

- (5) If any of the following information is included in a communication made for a permitted purpose, it is information that is “necessary for that purpose” (see subsection (1)(b)(i))—
  - (a) a statement that a right in a registered design exists and is in force or that an application for registration of a design has been made;
  - (b) details of the registered design, or of a right in or under the right in the registered design, which—
    - (i) are accurate in all material respects, and
    - (ii) are not misleading in any material respect; and
  - (c) information enabling the identification of the products in which the registered design is allegedly incorporated or to which the registered design is allegedly applied.

## **26C Remedies and defences**

- (1) Proceedings in respect of an actionable threat may be brought against the person who made the threat for—
  - (a) a declaration that the threat is unjustified;
  - (b) an injunction against the continuance of the threat;
  - (c) damages in respect of any loss sustained by the aggrieved person by reason of the threat.
- (2) It is a defence for the person who made the threat to show that the act in respect of which proceedings were threatened constitutes (or if done would constitute) an infringement of the right in the registered design.
- (3) It is a defence for the person who made the threat to show—
  - (a) that, despite having taken reasonable steps, the person has not identified anyone who has done an act mentioned in section 26A(2)(a) or (b) in relation to the product which is the subject of the threat, and
  - (b) that the person notified the recipient, before or at the time of making the threat, of the steps taken.

## **26D Professional advisers**

- (1) Proceedings in respect of an actionable threat may not be brought against a professional adviser (or any person vicariously liable for the actions of that professional adviser) if the conditions in subsection (3) are met.
- (2) In this section “professional adviser” means a person who, in relation to the making of the communication containing the threat—
  - (a) is acting in a professional capacity in providing legal services or the services of a trade mark attorney or a patent attorney, and

- (b) is regulated in the provision of legal services, or the services of a trade mark attorney or a patent attorney, by one or more regulatory bodies (whether through membership of a regulatory body, the issue of a licence to practise or any other means).
- (3) The conditions are that—
  - (a) in making the communication the professional adviser is acting on the instructions of another person, and
  - (b) when the communication is made the professional adviser identifies the person on whose instructions the adviser is acting.
- (4) This section does not affect any liability of the person on whose instructions the professional adviser is acting.
- (5) It is for a person asserting that subsection (1) applies to prove (if required) that at the material time—
  - (a) the person concerned was acting as a professional adviser, and
  - (b) the conditions in subsection (3) were met.

## **26E Supplementary: pending registration**

- (1) In sections 26 and 26B references to a registered design include references to a design in respect of which an application for registration has been made under section 3.
- (2) Where the threat of infringement proceedings is made after an application for registration has been made (but before registration) the reference in section 26C(2) to “the registered design” is to be treated as a reference to the design registered in pursuance of that application.

## **26F Supplementary: proceedings for delivery up etc.**

In section 26(1)(b) the reference to proceedings for infringement of the right in a registered design includes a reference to—

- (a) proceedings for an order under section 24C (order for delivery up), and
- (b) proceedings for an order under section 24D (order as to disposal of infringing articles).”

## **Meaning of the court and appeals**

### **27 The court**

- (1) In this Act “the court” means—
  - (a) In England and Wales the High Court or (subject to section 27A(6))<sup>16</sup> any patents county court having a jurisdiction by virtue of an order under section 287 of the Copyright, Designs and Patents Act 1988,

<sup>16</sup> Inserted by IPA s. 10(3)



- (b) In Scotland, the Court of Session, and
  - (c) In Northern Ireland, the High Court.
- (2) Provision may be made by rules of court with respect to proceedings in the High Court in England and Wales for references and applications under this Act to be dealt with by such judge of that court as the Lord Chancellor may select for the purpose.

## **27A Appeals from decisions of registrar<sup>17</sup>**

- (1) An appeal against a decision of the registrar under this Act may be made to—
- (a) A person appointed by the Lord Chancellor (an “appointed person”), or
  - (b) The court.
- (2) On an appeal under this section to an appointed person, the appointed person may refer the appeal to the court if—
- (a) It appears to the appointed person that a point of general legal importance is involved,
  - (b) The registrar requests that the appeal be so referred, or
  - (c) Such a request is made by any party to the proceedings before the registrar in which the decision appealed against was made.
- (3) Before referring an appeal to the court under subsection (2), the appointed person must give the appellant and any other party to the appeal an opportunity to make representations as to whether it should be so referred.
- (4) Where, on an appeal under this section to an appointed person, the appointed person does not refer the appeal to the court—
- (a) The appointed person must hear and determine the appeal, and
  - (b) The appointed person’s decision is final.
- (5) Sections 30 and 31 (costs, evidence) apply to proceedings before an appointed person as they apply to proceedings before the registrar.
- (6) In the application of this section to England and Wales, “the court” means the High Court.

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<sup>17</sup> Inserted by IPA 2014 s. 10(2). Commenced to the extent necessary to allow recruitment of an Appointed Person by SI 2014/1715. Full commencement expected in April 2015.

## 27B Persons appointed to hear and determine appeals<sup>18</sup>

- (1) A person is not eligible for appointment under section 27A(1)(a) unless the person—
  - (a) Satisfies the judicial-appointment eligibility condition on a 5- year basis,
  - (b) Is an advocate or solicitor in Scotland of at least 5 years' standing,
  - (c) Is a member of the Bar of Northern Ireland or solicitor of the Court of Judicature of Northern Ireland of at least 5 years' standing, or
  - (d) Has held judicial office.
- (2) An appointed person must hold and vacate office in accordance with his terms of appointment, subject to subsections (3) to (5).
- (3) An appointed person is to be paid such remuneration (whether by way of salary or fees) and such allowances as the Secretary of State may with the approval of the Treasury decide.
- (4) An appointed person may resign office by notice in writing to the Lord Chancellor.
- (5) The Lord Chancellor may by notice in writing remove an appointed person ("A") from office if—
  - (a) A has become bankrupt or made an arrangement with A's creditors or, in Scotland, A's estate has been sequestrated or A has executed a trust deed for A's creditors or entered into a composition contract,
  - (b) A is incapacitated by physical or mental illness, or
  - (c) A is, in the opinion of the Lord Chancellor, otherwise unable or unfit to perform A's duties as an appointed person.
- (6) Before exercising a power under section 27A or this section, the Lord Chancellor must consult the Secretary of State.
- (7) The Lord Chancellor may remove a person from office under subsection (5) only with the concurrence of the appropriate senior judge.
- (8) The appropriate senior judge is the Lord Chief Justice of England and Wales, unless—
  - (a) The person to be removed exercises functions wholly or mainly in Scotland, in which case it is the Lord President of the Court of Session, or
  - (b) The person to be removed exercises functions wholly or mainly in Northern Ireland, in which case it is the Lord Chief Justice of Northern Ireland.

**[Repealed]<sup>19</sup>**

<sup>18</sup> Inserted by IPA s. 10(2). Full commencement expected in April 2015.

<sup>19</sup> Repealed by IPA s. 10(4)

## Opinions service

### 28A Opinions on designs<sup>20</sup>

- (1) The Secretary of State may by regulations make provisions about the making of requests to the registrar for an opinion on specified matters relating to –
  - (a) Designs registered under this Act;
  - (b) Designs of such other description as may be specified.
- (2) The regulations must require the registrar to give an opinion in response to a request made under the regulations, except –
  - (a) In specified cases or circumstances, or
  - (b) Where for any reason the registrar considers it inappropriate in all the circumstances to do so.
- (3) The regulations may provide that a request made under the regulations must be accompanied by –
  - (a) A fee of a specified amount;
  - (b) Specified information.
- (4) The regulations must provide that an opinion given by the registrar under the regulations is not binding for any purposes.
- (5) The regulations must provide that neither the registrar nor any examiner or other officer of the Patent Office is to incur any liability by reason of or in connection with –
  - (a) Any opinion given under the regulations, or
  - (b) Any examination or investigation undertaken for the purpose of giving such an opinion.
- (6) An opinion given by the registrar under the regulations is not to be treated as a decision of the registrar for the purposes of section 27A.
- (7) But the regulations must provide for an appeal relating to an opinion given under the regulations to be made to a person appointed under Section 27A; and the regulations may make further provision in relation to such appeals.
- (8) The regulations may confer discretion on the registrar.

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<sup>20</sup> Inserted by IPA s. 11(1). Powers commenced 1st October 2014 in SI 2014/2330 but will only come into force once an order made the Secretary of State is in force (see s. 37(4A) below).

- (9) Regulations under this section –
  - (a) May make different provision for different purposes;
  - (b) May include consequential, incidental, supplementary, transitional, transitory or saving provision.
- (10) In this section, “specified” means specified in regulations under this section.

## Powers and Duties of Registrar

### **29 Exercise of discretionary powers of registrar**

Without prejudice to any provisions of this Act requiring the registrar to hear any party to proceedings thereunder, or to give to any such party an opportunity to be heard, rules made by the Secretary of State under this Act shall require the registrar to give to any applicant for registration of a design an opportunity to be heard before exercising adversely to the applicant any discretion vested in the registrar by or under this Act.

### **30 Costs and security for costs**

- (1) Rules made by the Secretary of State under this Act may make provision empowering the registrar, in any proceedings before him under this Act—
  - (a) To award any party such costs as he may consider reasonable, and
  - (b) To direct how and by what parties they are to be paid. (2) Any such order of the registrar may be enforced—
    - (a) In England and Wales or Northern Ireland, in the same way as an order of the High Court;
    - (b) In Scotland, in the same way as a decree for expenses granted by the Court of Session
- (2) Rules made by the Secretary of State under this Act may make provision empowering the registrar to require a person, in such cases as may be prescribed, to give security for the costs of—
  - (a) An application for invalidation of the registration of a design,
  - (b) [repealed]
  - (c) An appeal from any decision of the registrar under this Act,

and enabling the application or appeal to be treated as abandoned in default of such security being given.

### **31 Evidence before registrar**

Rules made by the Secretary of State under this Act may make provision -

- (a) As to the giving of evidence in proceedings before the registrar under this Act by affidavit or statutory declaration;
- (b) Conferring on the registrar the powers of an official referee of the Supreme Court as regards the examination of witnesses on oath and the discovery and production of documents; and
- (c) Applying in relation to the attendance of witnesses in proceedings before the registrar the rules applicable to the attendance of witnesses in proceedings before such a referee.

### **31A Power to require use of forms<sup>21</sup>**

- (1) The registrar may require the use of such forms as the registrar may direct for -
  - (a) An application for the registration of a design;
  - (b) Representations or specimens of designs or other documents which may be filed at the Patent Office.
- (2) The forms, and any directions by the registrar about their use, are to be published in the prescribed manner.

### **32 [repealed]**

## **Offences**

### **33 Offences under s 5**

- (1) If any person fails to comply with any direction given under section five of this Act or makes or causes to be made an application for the registration of a design in contravention of that section, he shall be guilty of an offence and liable—
  - (a) On conviction on indictment to imprisonment for a term not exceeding two years or a fine, or both;
  - (b) On summary conviction to imprisonment for a term not exceeding six months or a fine not exceeding the statutory maximum, or both.
- (2) [repealed]

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<sup>21</sup> Inserted by IPA s. 12(1)

### **34 Falsification of register, etc**

If any person makes or causes to be made a false entry in the register of designs, or a writing falsely purporting to be a copy of an entry in that register, or produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, he shall be guilty of an offence and liable—

- (3) On conviction on indictment to imprisonment for a term not exceeding two years or a fine, or both;
- (4) On summary conviction to imprisonment for a term not exceeding six months or a fine not exceeding the statutory maximum, or both.

### **35 Fine for falsely representing a design as registered**

- (1) If any person falsely represents that a design applied to, or incorporated in, any product sold by him is registered, he shall be liable on summary conviction to a fine not exceeding level 3 on the standard scale; and for the purposes of this provision a person who sells a product having stamped, engraved or impressed thereon or otherwise applied thereto the word “registered”, or any other word expressing or implying that the design applied to, or incorporated in, the product is registered, shall be deemed to represent that the design applied to, or incorporated in, the product is registered . . .
- (2) If any person, after the right in a registered design has expired, marks any product to which the design has been applied or in which it has been incorporated with the word “registered”, or any word or words implying that there is a subsisting right in the design under this Act, or causes any such product to be so marked, he shall be liable on summary conviction to a fine not exceeding level 1 on the standard scale.
- (3) For the purposes of this section, the use in the United Kingdom in relation to a design—
  - (a) Of the word “registered”, or
  - (b) Of any other word or symbol importing a reference (express or implied) to registration,

shall be deemed to be a representation as to registration under this Act unless it is shown that the reference is to registration elsewhere than in the United Kingdom and that the design is in fact so registered.

### **35ZA Offence of unauthorised copying etc. of design in course of business<sup>22</sup>**

- (1) A person commits an offence if –
  - (a) In the course of a business, the person intentionally copies a registered design so as to make a product –
    - (i) Exactly to that design, or
    - (ii) With features that differ only in immaterial details from that design, and
  - (b) The person does so –
    - (i) Knowing, or having reason to believe, that the design is a registered design, and
    - (ii) Without the consent of the registered proprietor of the design.
- (2) Subsection (3) applies in relation to a product where a registered design has been intentionally copied so as to make the product –
  - (a) Exactly to the design, or
  - (b) With features that differ only in immaterial details from the design.
- (3) A person commits an offence if –
  - (a) In the course of a business, the person offers, puts on the market, imports, exports or uses the product, or stocks it for one or more of those purposes,
  - (b) The person does so without the consent of the registered proprietor of the design, and
  - (c) The person does so knowing, or having reason to believe, that –
    - (i) A design has been intentionally copied without the consent of the registered proprietor so as to make the product exactly to the design or with features that differ only in immaterial details from the design, and
    - (ii) The design is a registered design.
- (4) It is a defence for a person charged with an offence under this section to show that the person reasonably believed that the registration of the design was invalid.
- (5) It is also a defence for a person charged with an offence under this section to show that the person –
  - (a) Did not infringe the right in the design, or

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<sup>22</sup> Inserted by IPA s. 13

- (b) Reasonably believed that the person did not do so.
- (6) The reference in subsection (3) to using a product in the course of a business does not include a reference to using it for a purpose which is merely incidental to the carrying on of the business.
- (7) In this section “registered design” includes a registered Community design; and a reference to the registered proprietor is, in the case of a registered Community design, to be read as a reference to the holder.
- (8) A person guilty of an offence under this section is liable –
  - (a) On conviction on indictment, to imprisonment for a term not exceeding ten years or to a fine or to both;
  - (b) On summary conviction in England and Wales or Northern Ireland, to imprisonment for a term not exceeding six months or to a fine not exceeding the statutory maximum or to both;
  - (c) On summary conviction in Scotland, to imprisonment for a term not exceeding 12 months or to a fine not exceeding the statutory maximum or to both.

### **35ZB Section 35ZA: enforcement<sup>23</sup>**

- (1) The following provisions of the Trade Descriptions Act 1968 (which provide for the enforcement of that Act by local weights and measures authorities or the relevant Northern Ireland Department) apply as if section 35ZA were a provision of that Act –
  - (a) Section 27 (power to make test purchases);
  - (b) Section 28 (power to enter premises and inspect and seize goods and documents);
  - (c) Section 29 (obstruction of authorised officers);
  - (d) Section 33 (compensation for loss etc. of seized goods).
- (2) Any enactment which authorises the disclosure of information for the purpose of facilitating the enforcement of the Trade Descriptions Act 1968 applies –
  - (a) As if section 35ZA were a provision of that Act, and
  - (b) As if the functions of any person in relation to the enforcement of that section were functions under that Act.
- (3) Nothing in this section is to be construed as authorising a local weights and measures authority to bring proceedings in Scotland.



### **35ZC Section 35ZA: forfeiture in England and Wales or Northern Ireland<sup>24</sup>**

- (1) In England and Wales or Northern Ireland, a person who, in connection with the investigation or prosecution of an offence under section 35ZA, has come into the possession of relevant products or articles may apply under this section for an order for the forfeiture of the products or articles.
- (2) “Relevant product” means a product which is made to exactly to a registered design, or with features that differ only in immaterial details from a registered design, by copying that design intentionally.
- (3) “Relevant article” means an article which is specifically designed or adapted for making copies of a registered design intentionally.
- (4) An application under this section may be made –
  - (a) Where proceedings have been brought in any court for an offence under section 35ZA relating to some or all of the products or articles, to that court;
  - (b) Where no application for the forfeiture of the products or articles has been made under paragraph (a), by way of complaints to a magistrates’ court.
- (5) On an application under this section, the court may make an order for the forfeiture of products or articles only if it is satisfied that an offence under section 35ZA has been committed in relation to the products or articles.
- (6) A court may infer for the purposes of this section that such an offence has been committed in relation to any products or articles if it is satisfied that such an offence has been committed in relation to products or articles which are representations of them (whether by reason of being of the same design or part of the same consignment or batch or otherwise).
- (7) Any person aggrieved by an order made under this section by a magistrates’ court, or by a decision of such a court not to make such an order, may appeal against that order or decision –
  - (a) In England and Wales, to the Crown Court;
  - (b) In Northern Ireland, to the county court.
- (8) An order so made may contain such provision as appears to the court to be appropriate for delaying the coming into force of the order pending the making and determination of any appeal (including any application under section 111 of the Magistrates’ Courts Act 1980 or Article 146 of the Magistrates’ Courts (Northern Ireland) Order 1981).

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<sup>24</sup> Inserted by IPA s. 13

- (9) Subject to subsection (10), any products or articles forfeited under this section are to be destroyed in accordance with such directions as the court may give.
- (10) On making an order under this section, the court may, if it considers it appropriate to do so, direct that the products or articles to which the order relates shall (instead of being destroyed) be released to such person and on such conditions as the court may specify.

### **35ZD Section 35ZA: forfeiture in Scotland<sup>25</sup>**

- (1) In Scotland, the court may make an order for the forfeiture of any relevant products or articles (as defined by section 35ZC).
- (2) An order under this section may be made –
  - (a) On an application by the procurator fiscal made in the manner specified in section 134 of the Criminal Procedure (Scotland) Act 1995, or
  - (b) Where a person is convicted of an offence under section 35ZA, in addition to any other penalty which the court may impose.
- (3) On an application under subsection (2)(a), the court may make an order for the forfeiture of relevant products or articles only if it is satisfied that an offence under section 35ZA has been committed in relation to the relevant products or articles.
- (4) The court may infer for the purposes of this section that such an offence has been committed in relation to any relevant products or articles if it is satisfied that such an offence has been committed in relation to products or articles<sup>26</sup> which are representative of them (whether by reason of being of the same design or part of the same consignment or batch or otherwise).
- (5) The procurator fiscal making the application under subsection (2)(a) must serve on any person appearing to the procurator fiscal to be the owner of, or otherwise have an interest in, the products or articles to ...<sup>27</sup> which the application relates a copy of the application, together with a notice giving the person the opportunity to appear at the hearing of the application to show cause why the products or articles should not be forfeited.
- (6) Service under subsection (5) must be carried out, and such service may be proved, in the manner specified for citation of an accused in summary proceedings under the Criminal Procedures (Scotland) Act 1995.
- (7) Any person upon whom notice is served under subsection (5) and any other person claiming to be the owner of, or otherwise have an interest in, products or articles to which an application under this section relates is entitled to appear at the hearing of the application to show cause why the products or articles should not be forfeited.

<sup>25</sup> Inserted by IPA s. 13

<sup>26</sup> Inserted by Intellectual Property Act 2014 (Amendment) Regulations 2014 s. 3(1), SI 2014/2329

<sup>27</sup> Substituted by Intellectual Property Act 2014 (Amendment) Regulations 2014 s. 3(2), SI 2014/2329

- (8) The court must not make an order following an application under subsection (2)(a) —
- (a) If any person on whom notice is served under subsection (5) does not appear, unless service of the notice on that person is proved, or
  - (b) If no notice under subsection (5) has been served, unless the court is satisfied that in the circumstances it was reasonable not to serve such notice.
- (9) Where an order for the forfeiture of any products or articles is made following an application under subsection (2)(a), any person who appeared, or was entitled to appear, to show cause why goods, material or articles should not be forfeited may, within 21 days of making the order, appeal to the High Court of Justiciary by bill of suspension.
- (10) Section 182(5)(a) to (e) of the Criminal Procedure (Scotland) Act 1995 applies to an appeal under subsection (9) as it applies to a stated case under Part 2 of that Act.
- (11) An order following an application under subsection (2)(a) does not take effect —
- (a) Until the end of the period of 21 days beginning with the day after the day on which the order is made, or
  - (b) If an appeal is made under subsection (9) within that period, until the appeal is dismissed or abandoned.
- (12) An order under subsection (2)(b) does not take effect —
- (a) Until the end of the period within which an appeal against the order could be brought under the Criminal Procedure (Scotland) Act 1995, or
  - (b) If an appeal is made within that period, until the appeal is determined or abandoned.
- (13) Subject to subsection (14), products or articles forfeited under this section must be destroyed in accordance with such directions as the court may give.
- (14) On making an order under this section, the court may, if it considers it appropriate to do so, direct that the products or articles to which the order relates shall (instead of being destroyed) be released, to such person and on such conditions as the court may specify.
- (15) In this section, “the court” means —
- (a) In relation to an order made on an application under subsection (2)(a), the sheriff;
  - (b) In relation to an order made under subsection (2)(b), the court which imposed the penalty.”

### **35A Offence by body corporate or partnership: liability of officers or partners<sup>28</sup>**

- (1) Where an offence under this Act committed by a body corporate is proved to have been committed with the consent or connivance of a director, manager, secretary or other similar officer of the body, or a person purporting to act in any such capacity, he as well as the body corporate is guilty of the offence and liable to be proceeded against and punished accordingly.
- (2) In relation to a body corporate whose affairs are managed by its members “director” means a member of the body corporate.
- (3) Proceedings for an offence under this Act alleged to have been committed by a partnership are to be brought against the partnership in the name of the firm and not in that of the partners; but without prejudice to any liability of the partners under subsection (6) or (7).<sup>29</sup>
- (4) The following provisions apply for the purposes of such proceedings as in relation to a body corporate —
  - (a) Any rules of court relating to the service of documents;
  - (b) In England and Wales, Schedule 3 to the Magistrates’ Courts Act 1980;
  - (c) In Northern Ireland, Schedule 4 to the Magistrates’ Courts (Northern Ireland) Order 1981.<sup>30</sup>
- (5) A fine imposed on a partnership (other than a Scottish partnership) on its conviction in such proceedings must be paid out of the partnership assets.<sup>31</sup>
- (6) Where a partnership (other than a Scottish partnership) is guilty of an offence under this Act, every partner, other than a partner who is proved to have been ignorant of or to have attempted to prevent the commission of the offence, is also guilty of the offence and liable to be proceeded against and punished accordingly.<sup>32</sup>
- (7) Where an offence under this Act committed by a Scottish partnership is proved to have been committed with the consent or connivance of a partner in the partnership, or a person purporting to act in that capacity, he as well as the partnership is guilty of the offence and liable to be proceeded against and punished accordingly.<sup>33</sup>

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28 Inserted by IPA s. 14

29 Inserted by IPA s. 14

30 Inserted by IPA s. 14

31 Inserted by IPA s. 14

32 Inserted by IPA s. 14

33 Inserted by IPA s. 14

## Rules, &c

### 36 General power of Secretary of State to make rules, etc

- (1) Subject to the provisions of this Act, the Secretary of State may make such rules as he thinks expedient for regulating the business of the Patent Office in relation to designs and for regulating all matters by this Act placed under the direction or control of the registrar or the Secretary of State.
- (1A) Rules may, in particular, make provision—
- (a) ...<sup>34</sup> Requiring the furnishing of copies of such representations or specimens of designs or other documents as may be filed at the Patent Office;
  - (b) (ab) Requiring applications for registration of designs to specify—
    - (i) The products to which the designs are intended to be applied or in which they are intended to be incorporated;
    - (ii) The classification of the designs by reference to such test as may be prescribed;
  - (c) Regulating the procedure to be followed in connection with any application or request to the registrar or in connection with any proceeding before him, and authorising the rectification of irregularities of procedure;
  - (d) Providing for the appointment of advisers to assist the registrar in proceedings before him;
  - (e) Regulating the keeping of the register of designs;
  - (f) Authorising the publication and sale of copies of representations of designs and other documents in the Patent Office;
  - (g) Prescribing anything authorised or required by this Act to be prescribed by rules.
- (1B) The remuneration of an adviser appointed to assist the registrar shall be determined by the Secretary of State with the consent of the Treasury and shall be defrayed out of money provided by Parliament.
- (2) Rules made under this section may provide for the establishment of branch offices for designs and may authorise any document or thing required by or under this Act to be filed or done at the Patent Office to be filed or done at the branch office at Manchester or any other branch office established in pursuance of the rules.

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<sup>34</sup> Substituted by IPA s. 12(3). For transitional arrangements see IPA s. 12(6). See also IPA s. 12(7).

### **37 Provisions as to rules, regulations<sup>35</sup> and Orders**

- (1) [repealed]
- (2) Any rules made by the Secretary of State in pursuance of section 15 or 22(6)<sup>36</sup> of this Act, and any order made, direction given, or other action taken under the rules by the registrar, may be made, given or taken so as to have effect as respects things done or omitted to be done on or after such date, whether before or after the coming into operation of the rules or of this Act, as may be specified in the rules.
- (3) Any power to make rules conferred by this Act on the Secretary of State ...<sup>37</sup>and the power to make an order under section 15ZA<sup>38</sup> and the power to make regulations under section 28A<sup>39</sup> shall be exercisable by statutory instrument...<sup>40</sup> .
- (4) Any statutory instrument containing rules made by the Secretary of State under this Act or regulations under section 28A<sup>41</sup> shall be subject to annulment in pursuance of a resolution of either House of Parliament.
- (4A) Subsection (4) does not apply to the first regulations to be made under section 28A, but the Secretary of State may not make those regulations unless a draft of the statutory instrument containing them has been laid before, and approved by a resolution of, each House of Parliament.<sup>42</sup>
- (4B) The Secretary of State may not make and order under section 15ZA unless a draft of the statutory instrument containing the order has been laid before, and approved by a resolution of, each House of Parliament.<sup>43</sup>
- (5) Any Order in Council made under this Act may be revoked or varied by a subsequent Order in Council.

### **37A Use of electronic communications<sup>44</sup>**

- (1) The registrar may give directions as to the form and manner in which documents to be delivered to the registrar –
  - (a) In electronic form; or
  - (b) Using electronic communications, are to be delivered to him.

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35 Inserted by IPA s. 11(3)

36 Inserted by IPA s. 9(6)

37 Deleted by IPA s. 10(5)

38 Inserted by IPA s. 8(2)

39 Inserted by IPA s. 11(3)(a)

40 Deleted by IPA s. 10(5)(b)

41 Inserted by IPA s. 11(3)(b)

42 Inserted by IPA s. 11(3)(c)

43 Inserted by IPA s. 8(2)(b)

44 Inserted by The Registered Designs Act 1949 and Patents Act 1977 (Electronic Communications) Order 2006. SI 2006/ 1229

- (2) A direction under subsection (1) may provide that in order for a document to be delivered in compliance with the direction it shall be accompanied by one or more additional documents specified in the direction.
- (3) Subject to subsections (11) and (12), if a document to which a direction under subsection (1) or (2) applies is delivered to the registrar in a form or manner which does not comply with the direction the registrar may treat the document as not having been delivered.
- (4) Subsection (5) applies in relation to a case where —
  - (a) A document is delivered using electronic communications, and
  - (b) There is a requirement for a fee to accompany the document.
- (5) The registrar may give directions specifying —
  - (a) Now the fee shall be paid; and
  - (b) When the fee shall be deemed to have been paid.
- (6) The registrar may give directions specifying that a person who delivers a document to the registrar in electronic form or using electronic communications cannot treat the document as having been delivered unless its delivery has been acknowledged.
- (7) The registrar may give directions specifying how a time of delivery is to be accorded to a document delivered to him in electronic form or using electronic communications.
- (8) A direction under this section may be given —
  - (a) Generally;
  - (b) In relation to a description of cases specified in the direction;
  - (c) In relation to a particular person or persons.
- (9) A direction under this section may be varied or revoked by a subsequent direction under this section.
- (10) The delivery using electronic communications to any person by the registrar of any document is deemed to be effected, unless the registrar has otherwise specified, by transmitting an electronic communication containing the document to an address provided or made available to the registrar by that person as an address of his for the receipt of electronic communications; and unless the contrary is proved such delivery is deemed to be effected immediately upon the transmission of the communication.

- (11) A requirement of this Act that something must be done in the prescribed manner is satisfied in the case of something that is done —
- (a) Using a document in electronic form, or
  - (b) Using electronic communications, only if the directions under this section that apply to the manner in which it is done are complied with.
- (12) In the case of an application made as mentioned in subsection (11)(a) or (b) above, a reference in this Act to the application not having been made in accordance with rules under this Act includes a reference to its not having been made in accordance with any applicable directions under this section.
- (13) This section applies —
- (a) To delivery at the Patent Office as it applies to delivery to the registrar; and
  - (b) To delivery by the Patent Office as it applies to delivery by the registrar.

### **38 [repealed]**

### **39 Hours of business and excluded days**

- (1) ... The registrar may give directions specifying<sup>45</sup> the hour at which the Patent Office shall be deemed to be closed on any day for the purposes of the transaction by the public of business under this Act or of any class of such business, ...and specifying<sup>46</sup> days as excluded days for any such purposes.
- (2) Any business done under this Act on any day after the hour specified as aforesaid in relation to business of that class, or on a day which is an excluded day in relation to business of that class, shall be deemed to have been done on the next following day not being an excluded day; and where the time for doing anything under this Act expires on an excluded day, that time shall be extended to the next following day not being an excluded day.

### **40 Fees**

There shall be paid in respect of the registration of designs and applications therefore, and in respect of other matters relating to designs arising under this Act, such fees as may be prescribed by rules made by the Secretary of State with the consent of the Treasury.

<sup>45</sup> Substituted by IPA s. 12(4)(a). For transitional arrangements see IPA s. 12(8). See also IPA s. 12(9)

<sup>46</sup> Substituted by IPA s. 12(4)(b). For transitional arrangements see IPA s. 12(8). See also IPA s. 12(9)



#### **41 Service of notices, etc, by post**

Any notice required or authorised to be given by or under this Act, and any application or other document so authorised or required to be made or filed, may be given, made or filed by post.

#### **42 Annual report of registrar**

The Comptroller-General of Patents, Designs and Trade Marks shall, in his annual report with respect to the execution of the Patents Act 1977, a report with respect to the execution of this Act as if it formed a part of or was included in that Act.

#### **43 Savings**

- (1) [repealed]
- (2) Nothing in this Act shall affect the right of the Crown or of any person deriving title directly or indirectly from the Crown to sell or use products forfeited under the laws relating to customs or excise.

#### **44 Interpretation**

- (1) In this Act, except where the context otherwise requires, the following expressions have the meanings hereby respectively assigned by them, that is to say—

[Repealed]<sup>47</sup>

“assignee” includes the personal representative of a deceased assignee, and references to the assignee of any person include references to the assignee of the personal representative or assignee of that person;

“author” in relation to a design, has the meaning given by section 2(3) and 4

“Community Design Regulation” means Council Regulation (EC) 6/2002 of 12th December 2001 on Community Designs;

“complex product” has the meaning assigned to it by section 1(3) of this Act;

“the court” shall be construed in accordance with section 27 of this Act;

“design” has the meaning assigned to it by section 1(2) of this Act;

“electronic communication” has the same meaning as in the Electronic Communications Act 2000<sup>48</sup>;

“employee”, “employment” and “employer” refer to employment under a contract of service or of apprenticeship,

“national unregistered design right” means design right within the meaning of Part III of the Copyright, Designs and Patents Act 1988;

<sup>47</sup> By IPA s. 10(6)

<sup>48</sup> Inserted by The Registered Designs Act 1949 and Patents Act 1977 (Electronic Communications) Order 2006. SI 2006/1229

“prescribed” means prescribed by rules made by the Secretary of State under this Act;

“product” has the meaning assigned to it by section 1(3) of this Act;

“proprietor” has the meaning assigned to it by section two of this Act;

“registered Community design” means a design that complies with the conditions contained in, and is registered in the manner provided for in, the Community Design Regulation;

“registered proprietor” means the person or persons for the time being entered in the register of designs as proprietor of the design;

“registrar” means the Comptroller-General of Patents Designs and Trade Marks;

(2) [repealed]

(3) [repealed]

(4) For the purposes of subsection (1) of section 14 of this Act, the expression “personal representative”, in relation to a deceased person, includes the legal representative of the deceased appointed in any country outside the United Kingdom.

## **45 Application to Scotland**

(1) In the application of this Act to Scotland—

“account of profits” means accounting and payment of profits;

“accounts” means count, reckoning and payment;

“arbitrator” means arbiter;

“assignment” means assignation;

“claimant” means pursuer;

“costs” means expenses;

“defendant” means defender;

“delivery up” means delivery;

“injunction” means interdict;

“interlocutory relief” means interim remedy.

(1A) In the application of section 26C(1)(a) (remedy for unjustified threat of infringement proceedings) to Scotland, “declaration” means “declarator”.

(2) References to the Crown shall be construed as including references to the Crown in right of the Scottish Administration.

## **46 Application to Northern Ireland**

- (1) [repealed]
- (2) [repealed]
- (3) References to enactments include enactments comprised in Northern Ireland legislation:
- (3A) References to the Crown include the Crown in right of Her Majesty's Government in Northern Ireland:
- (4) References to a Government department shall be construed as including references to a Northern Ireland department and in relation to a Northern Ireland department references to the Treasury shall be construed as references to the Department of Finance and Personnel:
- (4A) Any reference to a claimant includes a reference to a plaintiff.
- (5) [repealed]

## **47 Application to Isle of Man**

This Act extends to the Isle of Man, subject to any modifications contained in an Order made by Her Majesty in Council, and accordingly, subject to any such Order, references in this Act to the United Kingdom shall be construed as including the Isle of Man.

## **47A Territorial waters and the continental shelf**

- (1) For the purposes of this Act the territorial waters of the United Kingdom shall be treated as part of the United Kingdom.
- (2) This Act applies to things done in the United Kingdom sector of the continental shelf on a structure or vessel which is present there for purposes directly connected with the exploration of the sea bed or subsoil or the exploitation of their natural resources as it applies to things done in the United Kingdom.
- (3) The United Kingdom sector of the continental shelf means the areas designated by order under section 1(7) of the Continental Shelf Act 1964.

## **48 Repeals, savings, and transitional provisions**

- (1) [repealed]
- (2) Subject to the provisions of this section, any Order in Council, rule, order, requirement, certificate, notice, decision, direction, authorisation, consent, application, request or thing made, issued, given or done under any enactment repealed by this Act shall, if in force at the commencement of this Act, and so far as it could have been made, issued, given or done under this Act, continue in force and have effect as if made, issued, given or done under the corresponding enactment of this Act.
- (3) Any register kept under the Patents and Designs Act 1907, shall be deemed to

form part of the corresponding register under this Act.

- (4) Any design registered before the commencement of this Act shall be deemed to be registered under this Act in respect of articles of the class in which it is registered.
- (5) [repealed]
- (6) Any document referring to any enactment repealed by this Act shall be construed as referring to the corresponding enactment of this Act.
- (7) Nothing in the foregoing provisions of this section shall be taken as prejudicing the operation of section thirty-eight of the Interpretation Act 1889, (which relates to the effect of repeals).

#### **49 Short title and commencement**

- (1) This Act may be cited as the Registered Designs Act 1949.
- (2) This Act shall come into operation on the first day of January, nineteen hundred and fifty, immediately after the coming into operation of the Patents and Designs Act 1949.

### **Schedule A1**

#### **Grounds for refusal in relation to certain emblems etc**

- (1) 1 A design shall be refused registration under this Act if it involves the use of—
  - (a) The Royal arms, or any of the principal armorial bearings of the Royal arms, or any insignia or device so nearly resembling the Royal arms or any such armorial bearing as to be likely to be mistaken for them or it;
  - (b) A representation of the Royal crown or any of the Royal flags;
  - (c) A representation of Her Majesty or any member of the Royal family, or any colourable imitation thereof; or
  - (d) Words, letters or devices likely to lead persons to think that the applicant either has or recently has had Royal patronage or authorisation

unless it appears to the registrar that consent for such use has been given by or on behalf of Her Majesty or (as the case may be) the relevant member of the Royal family.
- (2) A design shall be refused registration under this Act if it involves the use of—
  - (a) The national flag of the United Kingdom (commonly known as the Union Jack); or
  - (b) The flag of England, Wales, Scotland, Northern Ireland or the Isle of Man,

and it appears to the registrar that the use would be misleading or grossly offensive.

- (3) A design shall be refused registration under this Act if it involves the use of—
- (a) Arms to which a person is entitled by virtue of a grant of arms by the Crown; or
  - (b) Insignia so nearly resembling such arms as to be likely to be mistaken for them;
- unless it appears to the registrar that consent for such use has been given by or on behalf of the person concerned and the use is not in any way contrary to the law of arms.
- (4) A design shall be refused registration under this Act if it involves the use of a controlled representation within the meaning of the Olympic Symbol etc (Protection) Act 1995 unless it appears to the registrar that—
- (a) The application is made by the person for the time being appointed under section 1(2) of the Olympic Symbol etc (Protection) Act 1995 (power of Secretary of State to appoint a person as the proprietor of the Olympics association right); or
  - (b) Consent for such use has been given by or on behalf of the person mentioned in paragraph (a) above.

### **Grounds for refusal in relation to emblems etc of Paris Convention countries**

- (1) A design shall be refused registration under this Act if it involves the use of the flag of a Paris Convention country unless—
- (a) The authorisation of the competent authorities of that country has been given for the registration; or
  - (b) It appears to the registrar that the use of the flag in the manner proposed is permitted without such authorisation.
- (2) A design shall be refused registration under this Act if it involves the use of the armorial bearings or any other state emblem of a Paris Convention country which is protected under the Paris Convention unless the authorisation of the competent authorities of that country has been given for the registration.
- (3) A design shall be refused registration under this Act if—
- (a) The design involves the use of an official sign or hallmark adopted by a Paris Convention country and indicating control and warranty;
  - (b) The sign or hallmark is protected under the Paris Convention; and
  - (c) The design could be applied to or incorporated in goods of the same, or a similar, kind as those in relation to which the sign or hallmark indicates control and warranty;
- unless the authorisation of the competent authorities of that country

has been given for the registration.

- (4) The provisions of this paragraph as to national flags and other state emblems, and official signs or hallmarks, apply equally to anything which from a heraldic point of view imitates any such flag or other emblem, or sign or hallmark.
- (5) Nothing in this paragraph prevents the registration of a design on the application of a national of a country who is authorised to make use of a state emblem, or official sign or hallmark, of that country, notwithstanding that it is similar to that of another country.

### **Grounds of refusal in relation to emblems etc of certain international organisations**

- 3 (1) This paragraph applies to—
  - (a) The armorial bearings, flags or other emblems; and
  - (b) The abbreviations and names, of international intergovernmental organisations of which one or more Paris Convention countries are members.
- (2) A design shall be refused registration under this Act if it involves the use of any such emblem, abbreviation or name which is protected under the Paris Convention unless—
  - (a) The authorisation of the international organisation concerned has been given for the registration; or
  - (b) It appears to the registrar that the use of the emblem, abbreviation or name in the manner proposed—
    - (i) Is not such as to suggest to the public that a connection exists between the organisation and the design; or
    - (ii) Is not likely to mislead the public as to the existence of a connection between the user and the organisation.
- (3) The provisions of this paragraph as to emblems of an international organisation apply equally to anything which from a heraldic point of view imitates any such emblem.
- (4) Nothing in this paragraph affects the rights of a person whose bona fide use of the design in question began before 4th January 1962 (when the relevant provisions of the Paris Convention entered into force in relation to the United Kingdom).

### Paragraphs 2 and 3: supplementary

- 4 (1) For the purposes of paragraph 2 above state emblems of a Paris Convention country (other than the national flag), and official signs or hallmarks, shall be regarded as protected under the Paris Convention only if, or to the extent that—
- (a) The country in question has notified the United Kingdom in accordance with Article 6ter(3) of the Convention that it desires to protect that emblem, sign or hallmark;
  - (b) The notification remains in force; and
  - (c) The United Kingdom has not objected to it in accordance with Article 6ter(4) or any such objection has been withdrawn.
- (2) For the purposes of paragraph 3 above the emblems, abbreviations and names of an international organisation shall be regarded as protected under the Paris Convention only if, or to the extent that—
- (a) The organisation in question has notified the United Kingdom in accordance with Article 6ter(3) of the Convention that it desires to protect that emblem, abbreviation or name;
  - (b) The notification remains in force; and
  - (c) The United Kingdom has not objected to it in accordance with Article 6ter(4) or any such objection has been withdrawn.
- (3) Notification under Article 6ter(3) of the Paris Convention shall have effect only in relation to applications for the registration of designs made more than two months after the receipt of the notification.

### Interpretation

- (5) In this Schedule—
- “a Paris Convention country” means a country, other than the United Kingdom, which is a party to the Paris Convention; and
- “the Paris Convention” means the Paris Convention for the Protection of Industrial Property of 20th March 1883.

## First Schedule Section 12

### Provisions as to the use of Registered Designs for the services of The Crown and as to the rights of third parties in respect of such use

#### **1 Use of registered designs for services of the Crown**

- (1) Notwithstanding anything in this Act, any Government department, and any person authorised in writing by a Government department, may use any registered design for the services of the Crown in accordance with the following provisions of this paragraph.
- (2) If and so far as the design has before the date of registration thereof been duly recorded by or applied by or on behalf of a Government department otherwise than in consequence of the communication of the design directly or indirectly by the registered proprietor or any person from whom he derives title, any use of the design by virtue of this paragraph may be made free of any royalty or other payment to the registered proprietor.
- (3) If and so far as the design has not been so recorded or applied as aforesaid, any use of the design made by virtue of this paragraph at any time after the date of registration thereof, or in consequence of any such communication as aforesaid, shall be made upon such terms as may be agreed upon, either before or after the use, between the Government department and the registered proprietor with the approval of the Treasury, or as may in default of agreement be determined by the court on a reference under paragraph 3 of this Schedule.
- (4) The authority of a Government department in respect of a design may be given under this paragraph either before or after the design is registered and either before or after the acts in respect of which the authority is given are done, and may be given to any person whether or not he is authorised directly or indirectly by the registered proprietor to use the design.
- (5) Where any use of a design is made by or with the authority of a Government department under this paragraph, then, unless it appears to the department that it would be contrary to the public interest so to do, the department shall notify the registered proprietor as soon as after the use is begun, and furnish him with such information as to the extent of the use as he may from time to time require.



- (6) For the purposes of this and the next following paragraph “the services of the Crown” shall be deemed to include—
- (a) The supply to the government of any country outside the United Kingdom, in pursuance of an agreement or arrangement between Her Majesty’s Government in the United Kingdom and the government of that country, of products required—
    - (i) For the defence of that country; or
    - (ii) For the defence of any other country whose government is party to any agreement or arrangement with Her Majesty’s said Government in respect of defence matters;
  - (b) The supply to the United Nations, or to the government of any country belonging to that organisation, in pursuance of an agreement or arrangement between Her Majesty’s Government and that organisation or government, of products required for any armed forces operating in pursuance of a resolution of that organisation or any organ of that organisation;
 

and the power of a Government department or a person authorised by a Government department under this paragraph to use a design shall include power to sell to any such government or to the said organisation any products the supply of which is authorised by this sub-paragraph and to sell to any person any products made in the exercise of the powers conferred by this paragraph which are no longer required for the purpose for which they were made.
- (7) The purchaser of any products sold in the exercise of powers conferred by this paragraph, and any person claiming through him, shall have power to deal with them in the same manner as if the rights in the registered design were held on behalf of His Majesty.

## **2 Rights of third parties in respect of Crown use**

- (1) In relation to any use of a registered design, or a design in respect of which an application for registration is pending, made for the services of the Crown—
- (a) By a Government department or a person authorised by a Government department under the last foregoing paragraph; or

- (b) By the registered proprietor or applicant for registration to the order of a Government department,

the provisions of any licence, assignment or agreement made, whether before or after the commencement of this Act, between the registered proprietor or applicant for registration or any person who derives title from him or from whom he derives title and any person other than a Government department shall be of no effect so far as those provisions restrict or regulate the use of the design, or any model, document or information relating thereto, or provide for the making of payments in respect of any such use, or calculated by reference thereto; and the reproduction or publication of any model or document in connection with the said use shall not be deemed to be an infringement of any copyright or national unregistered design right subsisting in the model or document.

- (2) Where an exclusive licence granted otherwise than for royalties or other benefits determined by reference to the use of the design is in force under the registered design then—

(a) In relation to any use of the design which, but for the provisions of this and the last foregoing paragraph, would constitute an infringement of the rights of the licensee, sub-paragraph (3) of the last foregoing paragraph shall have effect as if for the reference to the registered proprietor there were substituted a reference to the licensee; and

(b) In relation to any use of the design by the licensee by virtue of an authority given under the last foregoing paragraph, that paragraph shall have effect as if the said sub-paragraph (3) were omitted.

- (3) Subject to the provisions of the last foregoing sub-paragraph, where the registered design or the right to apply for or obtain registration of the design has been assigned to the registered proprietor in consideration of royalties or other benefits determined by reference to the use of the design, then—

(a) In relation to any use of the design by virtue of paragraph 1 of this Schedule, sub-paragraph (3) of that paragraph shall have effect as if the reference to the registered proprietor included a reference to the assignor, and any sum payable by virtue of that sub-paragraph shall be divided between the registered proprietor and the assignor in such proportion as may be agreed upon between them or as may in default of agreement be determined by the court on a reference under the next following paragraph; and

(b) In relation to any use of the design made for the services of the Crown by the registered proprietor to the order of a Government department, sub-paragraph (3) of paragraph 1 of this Schedule shall have effect as if that use were made by virtue of an authority given under that paragraph.

- (4) Where, under sub-paragraph (3) of paragraph 1 of this Schedule, payments are required to be made by a Government department to a registered proprietor in respect of any use of a design, any person being the holder of an exclusive licence under the registered design (not being such a licence as is mentioned in sub-paragraph (2) of this paragraph) authorising him to make use of the design shall be entitled to recover from the registered proprietor such part (if any) of those payments as may be agreed upon between that person and the registered proprietor, or as may in default of agreement be determined by the court under the next following paragraph to be just having regard to any expenditure incurred by that person—
- (a) In developing the said design; or
  - (b) In making payments to the registered proprietor, other than royalties or other payments determined by reference to the use of the design, in consideration of the licence;
- and if, at any time before the amount of any such payment has been agreed upon between the Government department and the registered proprietor, that person gives notice in writing of his interest to the department, any agreement as to the amount of that payment shall be of no effect unless it is made with his consent.
- (5) In this paragraph “exclusive licence” means a licence from a registered proprietor which confers on the licensee, or on the licensee and persons authorised by him, to the exclusion of all other persons (including the registered proprietor), any right in respect of the registered design.

## **2A Compensation for loss of profit**

- (1) to the registered proprietor, or
- (a) If there is an exclusive licence in force in respect of the design, to the exclusive licensee,
  - (b) If there is an exclusive licence in force in respect of the design, to the exclusive licensee,
- compensation for any loss resulting from his not being awarded a contract to supply the products to which the design is applied or in which it is incorporated.
- (2) Compensation is payable only to the extent that such a contract could have been fulfilled from his existing manufacturing capacity; but is payable notwithstanding the existence of circumstances rendering him ineligible for the award of such a contract.
- (3) In determining the loss, regard shall be had to the profit which would have been made on such a contract and to the extent to which any manufacturing capacity was underused.

- (4) No compensation is payable in respect of any failure to secure contracts for the supply of products to which the design is applied or in which it is incorporated otherwise than for the services of the Crown.
- (5) The amount payable under this paragraph shall, if not agreed between the registered proprietor or licensee and the government department concerned with the approval of the Treasury, be determined by the court on a reference under paragraph 3; and it is in addition to any amount payable under paragraph 1 or 2 of this Schedule.
- (6) In this paragraph—
  - “Crown use”, in relation to a design, means the doing of anything by virtue of paragraph 1 which would otherwise be an infringement of the right in the design; and
  - “the government department concerned”, in relation to such use, means the government department by whom or on whose authority the act was done.

### **3 Reference of disputes as to Crown use**

- (1) Any dispute as to—
  - (a) The exercise by a Government department, or a person authorised by a Government department, of the powers conferred by paragraph 1 of this Schedule,
  - (b) Terms for the use of a design for the services of the Crown under that paragraph,
  - (c) The right of any person to receive any part of a payment made under paragraph 1(3), or
  - (d) The right of any person to receive a payment under paragraph 2A, may be referred to the court by either party to the dispute.
- (2) In any proceedings under this paragraph to which a Government department are a party, the department may—
  - (a) If the registered proprietor is a party to the proceedings and the department are a relevant person within the meaning of section 20 of this Act, apply for invalidation of the registration of the design upon any ground upon which the registration of a design may be declared invalid on an application to the court under section twenty of this Act;
  - (b) In any case and provided that the department would be the relevant person within the meaning of section 20 of this Act if they had made an application on the grounds for invalidity being raised, put in issue the validity of the registration of the design applying for its invalidation.

- (3) If in such proceedings as aforesaid any question arises whether a design has been recorded or applied as mentioned in paragraph 1 of this Schedule, and the disclosure of any document recording the design, or of any evidence of the application thereof, would in the opinion of the department be prejudicial to the public interest, the disclosure may be made confidentially to counsel for the other party or to an independent expert mutually agreed upon.
- (4) In determining under this paragraph any dispute between a Government department and any person as to terms for the use of a design for the services of the Crown, the court shall have regard to any benefit or compensation which that person or any person from whom he derives title may have received, or may be entitled to receive, directly or indirectly from any Government department in respect of the design in question.
- (5) In any proceedings under this paragraph the court may at any time order the whole proceedings or any question or issue of fact arising therein to be referred to a special or official referee or an arbitrator on such terms as the court may direct; and references to the court in the foregoing provisions of this paragraph shall be construed accordingly.

#### **4 Special provisions as to Crown use during emergency**

- (1) During any period of emergency within the meaning of this paragraph, powers exercisable in relation to a design by a Government department, or a person authorised by a Government department under paragraph 1 of this Schedule shall include power to use the design for any purpose which appears to the department necessary or expedient—
  - (a) For the efficient prosecution of any war in which His Majesty may be engaged;
  - (b) For the maintenance of supplies and services essential to the life of the community;
  - (c) For securing a sufficiency of supplies and services essential to the well-being of the community;
  - (d) For promoting the productivity of industry, commerce and agriculture;
  - (e) For fostering and directing exports and reducing imports, or imports of any classes, from all or any countries and for redressing the balance of trade;
  - (f) Generally for ensuring that the whole resources of the community are available for use, and are used, in a manner best calculated to serve the interests of the community; or

(g) For assisting the relief of suffering and the restoration and distribution of essential supplies and services in any part of His Majesty's dominions or any foreign countries that are in grave distress as the result of war;

and any reference in this Schedule to the services of the Crown shall be construed as including a reference to the purposes aforesaid.

- (2) In this paragraph the expression "period of emergency" means a period beginning on such date as may be declared by Order in Council to be the commencement, and ending on such date as may be so declared to be the termination, of a period of emergency for the purposes of this paragraph.
- (3) No Order in Council under this paragraph shall be submitted to Her Majesty unless a draft of it has been laid before and approved by a resolution of each House of Parliament.



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