



# Copyright, Designs and Patents Act 1988

## 1988 CHAPTER 48

### PART III

#### DESIGN RIGHT

### CHAPTER II

#### RIGHTS OF DESIGN RIGHT OWNER AND REMEDIES

##### *Infringement of design right*

#### **226 Primary infringement of design right**

- (1) The owner of design right in a design has the exclusive right to reproduce the design for commercial purposes—
  - (a) by making articles to that design, or
  - (b) by making a design document recording the design for the purpose of enabling such articles to be made.
- (2) Reproduction of a design by making articles to the design means copying the design so as to produce articles exactly or substantially to that design, and references in this Part to making articles to a design shall be construed accordingly.
- (3) Design right is infringed by a person who without the licence of the design right owner does, or authorises another to do, anything which by virtue of this section is the exclusive right of the design right owner.
- (4) For the purposes of this section reproduction may be direct or indirect, and it is immaterial whether any intervening acts themselves infringe the design right.
- (5) This section has effect subject to the provisions of Chapter III (exceptions to rights of design right owner).

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## **227 Secondary infringement: importing or dealing with infringing article**

- (1) Design right is infringed by a person who, without the licence of the design right owner—
  - (a) imports into the United Kingdom for commercial purposes, or
  - (b) has in his possession for commercial purposes, or
  - (c) sells, lets for hire, or offers or exposes for sale or hire, in the course of a business,an article which is, and which he knows or has reason to believe is, an infringing article.
- (2) This section has effect subject to the provisions of Chapter III (exceptions to rights of design right owner).

## **228 Meaning of “infringing article”**

- (1) In this Part “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 design right in the 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 design right in the design or a breach of an exclusive licence agreement relating to the design.
- (4) Where it is shown that an article is made to a design in which design right subsists or has subsisted at any time, it shall be presumed until the contrary is proved that the article was made at a time when design right subsisted.
- (5) Nothing in subsection (3) shall be construed as applying to an article which may lawfully be imported into the United Kingdom by virtue of any enforceable Community right within the meaning of section 2(1) of the European Communities Act 1972.
- (6) The expression “infringing article” does not include a design document, notwithstanding that its making was or would have been an infringement of design right.

### *Remedies for infringement*

## **229 Rights and remedies of design right owner**

- (1) An infringement of design right is actionable by the design right owner.
- (2) In an action for infringement of design right all such relief by way of damages, injunctions, accounts or otherwise is available to the plaintiff as is available in respect of the infringement of any other property right.
- (3) The court may in an action for infringement of design right, having regard to all the circumstances and in particular to—
  - (a) the flagrancy of the infringement, and
  - (b) any benefit accruing to the defendant by reason of the infringement,

award such additional damages as the justice of the case may require.

(4) This section has effect subject to section 233 (innocent infringement).

### **230 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, knowing or having reason to believe that it has been or is to be used to make an infringing article,

the owner of the design right in the design 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 231 (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 design right owner—

- (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 231 is not made, retain it pending the making of an order, or the decision not to make an order, under that section.

(7) Nothing in this section affects any other power of the court.

### **231 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 230 shall be—

- (a) forfeited to the design right owner, or
- (b) destroyed or otherwise dealt with as the court may think fit,

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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 design right would be adequate to compensate the design right owner and to protect his interests.
- (3) Provision shall be made by rules of court as to the service of notice on persons having an interest in the article or other thing, and any such person is entitled—
  - (a) to appear in proceedings for an order under this section, whether or not he was served with notice, and
  - (b) to appeal against any order made, whether or not he appeared;
 and an order shall not take effect until the end of the period within which notice of an appeal may be given or, if before the end of that period notice of appeal is duly given, until the final determination or abandonment of the proceedings on the appeal.
- (4) 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.
- (5) 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 or seized is entitled to its return.
- (6) 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 under this section or under section 114 or 204 of this Act or section 58C of the Trade Marks Act 1938 (which make similar provision in relation to infringement of copyright, rights in performances and trade marks).

### **232 Jurisdiction of county court and sheriff court**

- (1) In England, Wales and Northern Ireland a county court may entertain proceedings under—
  - section 230 (order for delivery up of infringing article, &c.),
  - section 231 (order as to disposal of infringing article, &c.), or
  - section 235(5) (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 High Court or, in Scotland, the Court of Session.

### **233 Innocent infringement**

- (1) Where in an action for infringement of design right brought by virtue of section 226 (primary infringement) it is shown that at the time of the infringement the defendant did not know, and had no reason to believe, that design right subsisted in the design to which the action relates, the plaintiff is not entitled to damages against him, but without prejudice to any other remedy.

- (2) Where in an action for infringement of design right brought by virtue of section 227 (secondary infringement) a defendant shows that the infringing article was innocently acquired by him or a predecessor in title of his, the only remedy available against him in respect of the infringement is damages not exceeding a reasonable royalty in respect of the act complained of.
- (3) In subsection (2) “innocently acquired” means that the person acquiring the article did not know and had no reason to believe that it was an infringing article.

### **234 Rights and remedies of exclusive licensee**

- (1) An exclusive licensee has, except against the design right owner, 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 design right owner; and references in the relevant provisions of this Part to the design right owner 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 design right owner.

### **235 Exercise of concurrent rights**

- (1) Where an action for infringement of design right brought by the design right owner or an exclusive licensee relates (wholly or partly) to an infringement in respect of which they have concurrent rights of action, the design right owner 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 plaintiff or added as a defendant.
- (2) A design right owner or exclusive licensee who is added as a defendant in pursuance of subsection (1) is not liable for any costs in the action unless he takes part in the proceedings.
- (3) The above provisions do not affect the granting of interlocutory relief on the application of the design right owner or an exclusive licensee.
- (4) Where an action for infringement of design right is brought which relates (wholly or partly) to an infringement in respect of which the design right owner 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 design right owner and the exclusive licensee are both parties to the action.

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- (5) The design right owner shall notify any exclusive licensee having concurrent rights before applying for an order under section 230 (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.