



Copyright, Designs and Patents Act 1988

1988 CHAPTER 48

PART III **U.K.**

DESIGN RIGHT

CHAPTER V **U.K.**

MISCELLANEOUS AND GENERAL

f¹ Unjustified threats

Textual Amendments

- F1** S. 253 253 and crossheading substituted for (1.10.2017) by [Intellectual Property \(Unjustified Threats\) Act 2017 \(c. 14\), ss. 5\(2\), 8](#) (with art. 7(4)); S.I. 2017/771, reg. 2(1)(b) (with reg. 3)

253 Threats of infringement proceedings **U.K.**

- (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) design right subsists in a design, 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 design right 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 253C 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.

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253A Actionable threats **U.K.**

- (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 an article for disposal, or
 - (b) importing an article 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 an article, and
 - (b) is a threat of proceedings for an infringement alleged to consist of doing anything else in relation to that article.
- (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 253C and 253D an “actionable threat” means a threat of infringement proceedings that is actionable in accordance with this section.

253B Permitted communications **U.K.**

- (1) For the purposes of section 253A(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 design right subsists in a design;
 - (b) discovering whether, or by whom, design right in a design has been infringed by an act mentioned in section 253A(2)(a) or (b);
 - (c) giving notice that a person has a right in or under the design right in a design, where another person's awareness of the right is relevant to any proceedings that may be brought in respect of the design right in the 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 an article made to a design,
 - (b) requesting a person to deliver up or destroy an article made to a design, or

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- (c) requesting a person to give an undertaking relating to an article made to a design.
- (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 design right subsists in a design;
 - (b) details of the design, or of a right in or under the design right in the 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 articles that are alleged to be infringing articles in relation to the design.

253C Remedies and defences **U.K.**

- (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 design right.
- (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 253A(2)(a) or (b) in relation to the article 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.

253D Professional advisers **U.K.**

- (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

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- (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.

253E Supplementary: proceedings for delivery up etc. **U.K.**

In section 253(1)(b) the reference to proceedings for infringement of design right includes a reference to—

- (a) proceedings for an order under section 230 (order for delivery up), and
- (b) proceedings for an order under section 231 (order as to disposal of infringing articles).]

[^{F2}Licensee under licence of right not to claim connection with design right owner]

Textual Amendments

- F2** S. 254 cross-heading inserted (1.10.2017) by Intellectual Property (Unjustified Threats) Act 2017 (c. 14), ss. 5(3), 8; S.I. 2017/771, reg. 2(1)(b) (with reg. 3)

254 Licensee under licence of right not to claim connection with design right owner. **U.K.**

- (1) A person who has a licence in respect of a design by virtue of section 237 or 238 (licences of right) shall not, without the consent of the design right owner—
 - (a) apply to goods which he is marketing, or proposes to market, in reliance on that licence a trade description indicating that he is the licensee of the design right owner, or
 - (b) use any such trade description in an advertisement in relation to such goods.
- (2) A contravention of subsection (1) is actionable by the design right owner.
- (3) In this section “trade description”, the reference to applying a trade description to goods and “advertisement” have the same meaning as in the ^{M1}Trade Descriptions Act 1968.

Marginal Citations

- M1** 1968 c. 29.

Extent of operation of this Part

255 Countries to which this Part extends. U.K.

- (1) This Part extends to England and Wales, Scotland and Northern Ireland.
- (2) Her Majesty may by Order in Council direct that this Part shall extend, subject to such exceptions and modifications as may be specified in the Order, to—
 - (a) any of the Channel Islands,
 - (b) the Isle of Man, or
 - (c) any colony.
- (3) That power includes power to extend, subject to such exceptions and modifications as may be specified in the Order, any Order in Council made under section 221 (further provision as to qualification for design right protection) or section 256 (countries enjoying reciprocal protection).
- (4) The legislature of a country to which this Part has been extended may modify or add to the provisions of this Part, in their operation as part of the law of that country, as the legislature may consider necessary to adapt the provisions to the circumstances of that country; but not so as to deny design right protection in a case where it would otherwise exist.
- (5) Where a country to which this Part extends ceases to be a colony of the United Kingdom, it shall continue to be treated as such a country for the purposes of this Part until—
 - (a) an Order in Council is made under section 256 designating it as a country enjoying reciprocal protection, or
 - (b) an Order in Council is made declaring that it shall cease to be so treated by reason of the fact that the provisions of this Part as part of the law of that country have been amended or repealed.
- (6) A statutory instrument containing an Order in Council under subsection (5)(b) shall be subject to annulment in pursuance of a resolution of either House of Parliament.

256 Countries enjoying reciprocal protection. U.K.

- (1) Her Majesty may, if it appears to Her that the law of a country provides adequate protection for British designs, by Order in Council designate that country as one enjoying reciprocal protection under this Part.
- (2) If the law of a country provides adequate protection only for certain classes of British design, or only for designs applied to certain classes of article, any Order designating that country shall contain provision limiting, to a corresponding extent, the protection afforded by this Part in relation to designs connected with that country.
- (3) An Order under this section shall be subject to annulment in pursuance of a resolution of either House of Parliament.

257 Territorial waters and the continental shelf. U.K.

- (1) For the purposes of this Part the territorial waters of the United Kingdom shall be treated as part of the United Kingdom.

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- (2) This Part 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 ^{M2}Continental Shelf Act 1964.

Marginal Citations

M2 1964 c. 29.

Interpretation

258 Construction of references to design right owner. **U.K.**

- (1) Where different persons are (whether in consequence of a partial assignment or otherwise) entitled to different aspects of design right in a work, the design right owner for any purpose of this Part is the person who is entitled to the right in the respect relevant for that purpose.
- (2) Where design right (or any aspect of design right) is owned by more than one person jointly, references in this Part to the design right owner are to all the owners, so that, in particular, any requirement of the licence of the design right owner requires the licence of all of them.

259 Joint designs. **U.K.**

- (1) In this Part a “joint design” means a design produced by the collaboration of two or more designers in which the contribution of each is not distinct from that of the other or others.
- (2) References in this Part to the designer of a design shall, except as otherwise provided, be construed in relation to a joint design as references to all the designers of the design.

260 Application of provisions to articles in kit form. **U.K.**

- (1) The provisions of this Part apply in relation to a kit, that is, a complete or substantially complete set of components intended to be assembled into an article, as they apply in relation to the assembled article.
- (2) Subsection (1) does not affect the question whether design right subsists in any aspect of the design of the components of a kit as opposed to the design of the assembled article.

261 Requirement of signature: application in relation to body corporate. **U.K.**

The requirement in the following provisions that an instrument be signed by or on behalf of a person is also satisfied in the case of a body corporate by the affixing of its seal—

section 222(3) (assignment of design right),

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section 223(1) (assignment of future design right),
section 225(1) (grant of exclusive licence).

262 Adaptation of expressions in relation to Scotland. **U.K.**

In the application of this Part to Scotland—

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

“accounts” means count, reckoning and payment;

“assignment” means assignation;

“costs” means expenses;

[^{F3}“declaration” means “declarator”];

“defendant” means defender;

“delivery up” means delivery;

“injunction” means interdict;

“interlocutory relief” means interim remedy; and

“plaintiff” means pursuer.

Textual Amendments

F3 Words in s. 262 inserted (1.10.2017) by [Intellectual Property \(Unjustified Threats\) Act 2017 \(c. 14\)](#), ss. 5(4), 8; S.I. 2017/771, reg. 2(1)(b) (with reg. 3)

263 Minor definitions. **U.K.**

(1) In this Part—

“British design” means a design which qualifies for design right protection by reason of a connection with the United Kingdom of the designer or the person by whom ^{F4}... the designer is employed;

“business” includes a trade or profession;

^{F5}...

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

“computer-generated”, in relation to a design, means that the design is generated by computer in circumstances such that there is no human designer,

“country” includes any territory;

“the Crown” includes the Crown in right of Her Majesty’s Government in Northern Ireland [^{F6}and the Crown in right of the Scottish Administration][^{F7}and the Crown in right of the Welsh Assembly Government];

“design document” means any record of a design, whether in the form of a drawing, a written description, a photograph, data stored in a computer or otherwise;

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

“government department” includes a Northern Ireland department [^{F8}and any part of the Scottish Administration][^{F9}and any part of the Welsh Assembly Government].

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computer-generated	section 263(1)
costs (in Scotland)	section 262
country	section 263(1)
the Crown	section 263(1)
Crown use	sections 240(5) and 244(2)
defendant (in Scotland)	section 262
delivery up (in Scotland)	section 262
design	section 213(2)
design document	section 263(1)
designer	sections 214 and 259(2)
design right	section 213(1)
design right owner	sections 234(2) and 258
employee, employment and employer	section 263(1)
exclusive licence	section 225(1)
government department	section 263(1)
government department concerned (in relation to Crown use)	section 240(5)
infringing article	section 228
injunction (in Scotland)	section 262
interlocutory relief (in Scotland)	section 262
joint design	section 259(1)
licence (of the design right owner)	sections 222(4), 223(3) and 258
making articles to a design	section 226(2)
marketing (and related expressions)	section 263(2)
original	section 213(4)
plaintiff (in Scotland)	section 262
F11	F11
...	...
qualifying person	sections 217(1) and (2)
signed	section 261

Textual Amendments

F10 Words in s. 264 omitted (1.10.2014) by virtue of [Intellectual Property Act 2014 \(c. 18\)](#), **ss. 2(2)(k)**, [24\(1\)](#) (with [s. 2\(3\)](#)); [S.I. 2014/2330](#), [art. 3](#), [Sch.](#)

F11 Words in s. 264 omitted (1.10.2014) by virtue of [Intellectual Property Act 2014 \(c. 18\)](#), **ss. 3(5)**, [24\(1\)](#) (with [s. 3\(6\)](#)); [S.I. 2014/2330](#), [art. 3](#), [Sch.](#)

Changes to legislation:

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