

SCHEDULES

SCHEDULE 4

Section 273.

THE REGISTERED DESIGNS ACT 1949 AS AMENDED ARRANGEMENT OF SECTIONS

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[16th December 1949]

Registrable designs and proceedings for registration

1 Designs registrable under Act

- (1) In this Act “design” means features of shape, configuration, pattern or ornament applied to an article by any industrial process, being features which in the finished article appeal to and are judged by the eye, but does not include—
 - (a) a method or principle of construction, or
 - (b) features of shape or configuration of an article which—
 - (i) are dictated solely by the function which the article has to perform, or
 - (ii) are dependent upon the appearance of another article of which the article is intended by the author of the design to form an integral part.
- (2) A design which is new may, upon application by the person claiming to be the proprietor, be registered under this Act in respect of any article, or set of articles, specified in the application.
- (3) A design shall not be registered in respect of an article if the appearance of the article is not material, that is, if aesthetic considerations are not normally taken into account to a material extent by persons acquiring or using articles of that description, and would not be so taken into account if the design were to be applied to the article.
- (4) A design shall not be regarded as new for the purposes of this Act if it is the same as a design—
 - (a) registered in respect of the same or any other article in pursuance of a prior application, or
 - (b) published in the United Kingdom in respect of the same or any other article before the date of the application,or if it differs from such a design only in immaterial details or in features which are variants commonly used in the trade.

This subsection has effect subject to the provisions of sections 4, 6 and 16 of this Act.
- (5) The Secretary of State may by rules provide for excluding from registration under this Act designs for such articles of a primarily literary or artistic character as the Secretary of State thinks fit.

2 Proprietorship of designs

- (1) 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) Where a design is created in pursuance of a commission for money or money’s worth, the person commissioning the design shall be treated as the original proprietor of the design.
 - (1B) Where, in a case not falling within subsection (1A), 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, or the right to apply a design to any article, 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 or as the proprietor of the design in relation to that article.

- (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 circumstances 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 Proceedings for registration

- (1) An application for the registration of a design shall be made in the prescribed form and shall be filed at the Patent Office in the prescribed manner.
- (2) An application for the registration of a design in which design right subsists shall not be entertained unless made by the person claiming to be the design right owner.
- (3) For the purpose of deciding whether a design is new, the registrar may make such searches, if any, as he thinks fit.
- (4) The registrar may, in such cases as may be prescribed, direct that for the purpose of deciding whether a design is new an application shall be treated as made on a date earlier or later than that on which it was in fact made.
- (5) The registrar may refuse an application for the registration of a design or may register the design in pursuance of the application subject to such modifications, if any, as he thinks fit; and a design when registered shall be registered as of the date on which the application was made or is treated as having been made.
- (6) An application 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.
- (7) An appeal lies from any decision of the registrar under this section.

4 Registration of same design in respect of other articles, etc

- (1) Where the registered proprietor of a design registered in respect of any article makes an application—
 - (a) for registration in respect of one or more other articles, of the registered design, or
 - (b) for registration in respect of the same or one or more other articles, of a design consisting of the registered design with modifications or variations not sufficient to alter the character or substantially to affect the identity thereof,the application shall not be refused and the registration made on that application shall not be invalidated by reason only of the previous registration or publication of the registered design:

Provided that the right in a design registered by virtue of this section shall not extend beyond the end of the period, and any extended period, for which the right subsists in the original registered design.

- (2) Where any person makes an application for the registration of a design in respect of any article and either—
 - (a) that design has been previously registered by another person in respect of some other article; or

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- (b) the design to which the application relates consists of a design previously registered by another person in respect of the same or some other article with modifications or variations not sufficient to alter the character or substantially to affect the identity thereof,

then, if at any time while the application is pending the applicant becomes the registered proprietor of the design previously registered, the foregoing provisions of this section shall apply as if at the time of making the application the applicant had been the registered proprietor of that design.

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, and
 - (b) any evidence filed in support of the applicant's contention that the appearance of an article is material (for the purposes of section 1(3) of this Act),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, or any such evidence as is mentioned in subsection (2)(b) above, 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 prejudicial 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

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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.

.....

6 Provisions as to confidential disclosure, etc

- (1) An application for the registration of a design shall not be refused, and the registration of a design shall not be invalidated, by reason only of—
 - (a) the disclosure of the design by the proprietor to any other person in such circumstances as would make it contrary to good faith for that other person to use or publish the design;
 - (b) the disclosure of the design in breach of good faith by any person other than the proprietor of the design; or
 - (c) in the case of a new or original textile design intended for registration, the acceptance of a first and confidential order for goods bearing the design.
- (2) An application for the registration of a design shall not be refused and the registration of a design shall not be invalidated by reason only—
 - (a) that a representation of the design, or any article to which the design has been applied, has been displayed, with the consent of the proprietor of the design, at an exhibition certified by the Secretary of State for the purposes of this subsection;
 - (b) that after any such display as aforesaid, and during the period of the exhibition, a representation of the design or any such article as aforesaid has been displayed by any person without the consent of the proprietor; or
 - (c) that a representation of the design has been published in consequence of any such display as is mentioned in paragraph (a) of this subsection,

if the application for registration of the design is made not later than six months after the opening of the exhibition.
- (3) An application for the registration of a design shall not be refused, and the registration of a design shall not be invalidated, by reason only of the communication of the design by the proprietor thereof to a government department or to any person authorised by a government department to consider the merits of the design, or of anything done in consequence of such a communication.
- (4) Where an application is made by or with the consent of the owner of copyright in an artistic work for the registration of a corresponding design, the design shall not be treated for the purposes of this Act as being other than new by reason only of any use previously made of the artistic work, subject to subsection (5).

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- (5) Subsection (4) does not apply if the previous use consisted of or included the sale, letting for hire or offer or exposure for sale or hire of articles to which had been applied industrially—
- (a) the design in question, or
 - (b) a design differing from it only in immaterial details or in features which are variants commonly used in the trade,
- and that previous use was made by or with the consent of the copyright owner.
- (6) The Secretary of State may make provision by rules as to the circumstances in which a design is to be regarded for the purposes of this section as “applied industrially” to articles, or any description of articles.

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—
- (a) to make or import—
 - (i) for sale or hire, or
 - (ii) for use for the purposes of a trade or business, or
 - (b) to sell, hire or offer or expose for sale or hire,
- an article in respect of which the design is registered and to which that design or a design not substantially different from it has been applied.
- (2) The right in the registered design is infringed by a person who without the licence of the registered proprietor does anything which by virtue of subsection (1) is the exclusive right of the proprietor.
- (3) The right in the registered design is also infringed by a person who, without the licence of the registered proprietor makes anything for enabling any such article to be made, in the United Kingdom or elsewhere, as mentioned in subsection (1).
- (4) The right in the registered design is also infringed by a person who without the licence of the registered proprietor—
- (a) does anything in relation to a kit that would be an infringement if done in relation to the assembled article (see subsection (1)), or
 - (b) makes anything for enabling a kit to be made or assembled, in the United Kingdom or elsewhere, if the assembled article would be such an article as is mentioned in subsection (1);
- and for this purpose a “kit” means a complete or substantially complete set of components intended to be assembled into an article.
- (5) No proceedings shall be taken in respect of an infringement committed before the date on which the certificate of registration of the design under this Act is granted.
- (6) The right in a registered design is not infringed by the reproduction of a feature of the design which, by virtue of section 1(1)(b), is left out of account in determining whether the design is registrable.

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; and the registrar shall, in accordance with rules made by the Secretary of State, notify the proprietor of that fact.
- (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) Where it is shown that a registered design—
 - (a) was at the time it was registered a corresponding design in relation to an artistic work in which copyright subsists, and
 - (b) by reason of a previous use of that work would not have been registrable but for section 6(4) of this Act (registration despite certain prior applications of design),the right in the registered design expires when the copyright in that work expires, if that is earlier than the time at which it would otherwise expire, and it may not thereafter be renewed.
- (6) The above provisions have effect subject to the proviso to section 4(1) (registration of same design in respect of other articles, &c.).

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 proprietor took reasonable care to see that the period for which the right subsisted was extended in accordance with section 8(2) or (4), he

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shall, on payment of any unpaid renewal fee and any prescribed additional fee, order the restoration of the right in the design.

- (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) may—
 - (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 an article 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 article 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.

9 Exemption of innocent infringer from liability for damages

- (1) In proceedings for the infringement of the right in a registered design damages shall not be awarded 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; and a person shall not be deemed to have been aware or to have had reasonable grounds for supposing as aforesaid by reason only of the marking of an article with the word “registered” or any abbreviation thereof, or any word or words expressing or implying that the design applied to the article has been registered, unless the number of the design accompanied the word or words or the abbreviation in question.

- (2) 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.

10 Compulsory licence in respect of registered design

- (1) At any time after a design has been registered any person interested may apply to the registrar for the grant of a compulsory licence in respect of the design on the ground that the design is not applied in the United Kingdom by any industrial process or means to the article in respect of which it is registered to such an extent as is reasonable in the circumstances of the case; and the registrar may make such order on the application as he thinks fit.
- (2) An order for the grant of a licence shall, without prejudice to any other method of enforcement, have effect as if it were a deed executed by the registered proprietor and all other necessary parties, granting a licence in accordance with the order.
- (3) No order shall be made under this section which would be at variance with any treaty, convention, arrangement or engagement applying to the United Kingdom and any convention country.
- (4) An appeal shall lie from any order of the registrar under this section.

11 Cancellation of registration

- (1) The registrar may, upon a request made in the prescribed manner by the registered proprietor, cancel the registration of a design.
- (2) At any time after a design has been registered any person interested may apply to the registrar for the cancellation of the registration of the design on the ground that the design was not, at the date of the registration thereof, new..., or on any other ground on which the registrar could have refused to register the design; and the registrar may make such order on the application as he thinks fit.
- (3) At any time after a design has been registered, any person interested may apply to the registrar for the cancellation of the registration on the ground that—
- (a) the design was at the time it was registered a corresponding design in relation to an artistic work in which copyright subsisted, and
 - (b) the right in the registered design has expired in accordance with section 8(4) of this Act (expiry of right in registered design on expiry of copyright in artistic work);
- and the registrar may make such order on the application as he thinks fit.
- (4) A cancellation under this section takes effect—
- (a) in the case of cancellation under subsection (1), from the date of the registrar’s decision,
 - (b) in the case of cancellation under subsection (2), from the date of registration,

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- (c) in the case of cancellation under subsection (3), from the date on which the right in the registered design expired,
or, in any case, from such other date as the registrar may direct.
- (5) An appeal lies from any order of the registrar under this section.

11A Powers exercisable for protection of the public interest

- (1) Where a report of the Monopolies and Mergers Commission has been laid before Parliament containing conclusions to the effect—
 - (a) on a monopoly reference, that a monopoly situation exists and facts found by the Commission operate or may be expected to operate against the public interest,
 - (b) on a merger reference, that a merger situation qualifying for investigation has been created and the creation of the situation, or particular elements in or consequences of it specified in the report, operate or may be expected to operate against the public interest,
 - (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 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, or
 - (b) a refusal by the proprietor of a registered design to grant licences on reasonable terms,he may by order cancel or modify any such condition or may, instead or in addition, make an entry in the register to the effect that licences in respect of the design are to be available as of right.
- (4) The terms of a licence available by virtue of this section shall, in default of agreement, be settled by the registrar on an application by the person requiring the licence; and terms so settled shall authorise the licensee to do everything which would be an infringement of the right in the registered design in the absence of a licence.
- (5) Where the terms of a licence are settled by the registrar, the licence has effect from the date on which the application to him was made.

- (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 Monopolies and Mergers Commission was made.

11B Undertaking to take licence of right in infringement proceedings

- (1) If in proceedings for infringement of the right in a registered design in respect of which a licence is available as of right under section 11A of this Act the defendant undertakes to take a licence on such terms as may be agreed or, in default of agreement, settled by the registrar under that section—
 - (a) no injunction shall be granted against him, and
 - (b) the amount recoverable against him by way of damages or on an account of profits shall not exceed double the amount which would have been payable by him as licensee if such a licence on those terms had been granted before the earliest infringement.
- (2) An undertaking may be given at any time before final order in the proceedings, without any admission of liability.
- (3) Nothing in this section affects the remedies available in respect of an infringement committed before licences of right were available.

12 Use for services of the 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 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 is made by virtue of this section, the application shall be treated, for the purpose of determining whether that or any other design is new, 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 3(4) 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 14 of this Act for registration 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 articles, 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;

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- (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 articles to which the design is applied or may have made any application for registration of the design.

16 Protection of designs communicated under international agreements

- (1) Subject to the provisions of this section, the Secretary of State may make rules for securing that, where a design has been communicated in accordance with an agreement or arrangement made between His Majesty's Government in the United Kingdom and the government of any other country for the supply or mutual exchange of information or articles,—
 - (a) an application for the registration of the design made by the person from whom the design was communicated or his personal representative or assignee shall not be prejudiced, and the registration of the design in pursuance of such an application shall not be invalidated, by reason only that the design has been communicated as aforesaid or that in consequence thereof—
 - (i) the design has been published or applied, or
 - (ii) an application for registration of the design has been made by any other person, or the design has been registered on such an application;
 - (b) any application for the registration of a design made in consequence of such a communication as aforesaid may be refused and any registration of a design made on such an application may be cancelled.
- (2) Rules made under subsection (1) of this section may provide that the publication or application of a design, or the making of any application for registration thereof shall, in such circumstances and subject to such conditions or exceptions as may be prescribed by the rules, be presumed to have been in consequence of such a communication as is mentioned in that subsection.
- (3) The powers of the Secretary of State under this section, so far as they are exercisable for the benefit of persons from whom designs have been communicated to His Majesty's Government in the United Kingdom by the government of any other country, shall only be exercised if and to the extent that the Secretary of State is satisfied that substantially equivalent provision has been or will be made under the law of that country for the benefit of persons from whom designs have been communicated by His Majesty's Government in the United Kingdom to the government of that country.
- (4) References in the last foregoing subsection to the communication of a design to or by His Majesty's Government or the government of any other country shall be construed as including references to the communication of the design by or to any person authorised in that behalf by the government in question.

Register of designs, etc.

17 Register of designs

- (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) Subject to subsection (11) below, 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 or 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, subject to subsection (11) below, be admitted in evidence without further proof and without production of any original; and in Scotland such evidence shall be sufficient evidence.

- (11) In the application of this section to England and Wales nothing in it shall be taken as detracting from section 69 or 70 of the Police and Criminal Evidence Act 1984 or any provision made by virtue of either of them.
- (12) In this section “certified copy” and “certified extract” means 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) Where design right subsists in a registered design, the registrar shall not register an interest under subsection (3) unless he is satisfied that the person entitled to that interest is also entitled to a corresponding interest in the design right.
- (3B) Where design right subsists in a registered design and the proprietor of the registered design is also the design right owner, an assignment of the design right shall be taken to be also an assignment of the right in the registered design, unless a contrary intention appears.
- (4) Subject to any rights vested in any other person of which notice is entered in the register of designs, the person or persons registered as proprietor of a registered design shall have power to assign, grant licences under, or otherwise deal with the design,

and to give effectual receipts for any consideration for any such assignment, licence or dealing.

Provided that any equities in respect of the design may be enforced in like manner as in respect of any other personal property.

- (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 any person aggrieved, order the register of designs to be rectified by the making of any entry therein or the variation or deletion of any entry therein.
- (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.

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

- (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 issued—
- (a) the representation or specimen of the design, and
 - (b) any evidence filed in support of the applicant's contention that the appearance of an article is material (for the purposes of section 1(3) of this Act).

This subsection has effect subject to the following provisions of this section and to any rules made under section 5(2) of this Act.

- (2) In the case of a design registered in respect of an article of any class prescribed for the purposes of this subsection, no representation, specimen or evidence filed in pursuance of the application shall, until the expiration of such period after the day on which the certificate of registration is issued as may be prescribed in relation to articles of that class, be open to inspection at the Patent Office except by the registered proprietor, a person authorised in writing by the registered proprietor, or a person authorised by the registrar or by the court:

Provided that where the registrar proposes to refuse an application for the registration of any other design on the ground that it is the same as the first-mentioned design or differs from that design only in immaterial details or in features which are variants commonly used in the trade, the applicant shall be entitled to inspect the representation or specimen of the first-mentioned design filed in pursuance of the application for registration of that design.

- (3) In the case of a design registered in respect of an article of any class prescribed for the purposes of the last foregoing subsection, the representation, specimen or evidence shall not, during the period prescribed as aforesaid, be inspected by any person by virtue of this section except in the presence of the registrar or of an officer acting under him; and except in the case of an inspection authorised by the proviso to that subsection, the person making the inspection shall not be entitled to take a copy of the representation, specimen or evidence or any part thereof.
- (4) Where an application for the registration of a design has been abandoned or refused, neither the application for registration nor any representation, specimen or evidence filed in pursuance thereof shall at any time be open to inspection at the Patent Office or be published by the registrar.

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, if so, in respect of what articles, 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.

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Legal proceedings and appeals

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 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 cancellation 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 Remedy for groundless threats of infringement proceedings

- (1) Where any person (whether entitled to or interested in a registered design or an application for registration of a design or not) by circulars, advertisements or otherwise threatens any other person with proceedings for infringement of the right in a registered design, any person aggrieved thereby may bring an action against him for any such relief as is mentioned in the next following subsection.
- (2) Unless in any action brought by virtue of this section the defendant proves that the acts in respect of which proceedings were threatened constitute or, if done, would constitute, an infringement of the right in a registered design the registration of which is not shown by the plaintiff to be invalid, the plaintiff shall be entitled to the following relief, that is to say:—
 - (a) a declaration to the effect that the threats are unjustifiable;
 - (b) an injunction against the continuance of the threats; and
 - (c) such damages, if any, as he has sustained thereby.
- (2A) Proceedings may not be brought under this section in respect of a threat to bring proceedings for an infringement alleged to consist of the making or importing of anything.
- (3) For the avoidance of doubt it is hereby declared that a mere notification that a design is registered does not constitute a threat of proceedings within the meaning of this section.

27 The court

- (1) In this Act “the court” means—
 - (a) in England and Wales, the High Court or any patents county court having jurisdiction by virtue of an order under section 287 of the Copyright, Designs and Patents Act 1988,
 - (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.

28 The Appeal Tribunal

- (1) Any appeal from the registrar under this Act shall lie to the Appeal Tribunal.
- (2) The Appeal Tribunal shall consist of—
- (a) one or more judges of the High Court nominated by the Lord Chancellor, and
 - (b) one judge of the Court of Session nominated by the Lord President of that Court.
- (2A) At any time when it consists of two or more judges, the jurisdiction of the Appeal Tribunal—
- (a) where in the case of any particular appeal the senior of those judges so directs, shall be exercised in relation to that appeal by both of the judges, or (if there are more than two) by two of them, sitting together, and
 - (b) in relation to any appeal in respect of which no such direction is given, may be exercised by any one of the judges;
- and, in the exercise of that jurisdiction, different appeals may be heard at the same time by different judges.
- (3) The expenses of the Appeal Tribunal shall be defrayed and the fees to be taken therein may be fixed as if the Tribunal were a court of the High Court.
- (4) The Appeal Tribunal may examine witnesses on oath and administer oaths for that purpose.
- (5) Upon any appeal under this Act the Appeal Tribunal may by order award to any party such costs or expenses as the Tribunal may consider reasonable and direct how and by what parties the costs or expenses are to be paid; and any such order 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.
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- (7) Upon any appeal under this Act the Appeal Tribunal may exercise any power which could have been exercised by the registrar in the proceeding from which the appeal is brought.
- (8) Subject to the foregoing provisions of this section the Appeal Tribunal may make rules for regulating all matters relating to proceedings before it under this Act, including right of audience.
- (8A) At any time when the Appeal Tribunal consists of two or more judges, the power to make rules under subsection (8) of this section shall be exercisable by the senior of those judges:

Provided that another of those judges may exercise that power if it appears to him that it is necessary for rules to be made and that the judge (or, if more than one, each of the

judges) senior to him is for the time being prevented by illness, absence or otherwise from making them.

- (9) An appeal to the Appeal Tribunal under this Act shall not be deemed to be a proceeding in the High Court.
- (10) In this section “the High Court” means the High Court in England and Wales; and for the purposes of this section the seniority of judges shall be reckoned by reference to the dates on which they were appointed judges of that court or the Court of Session.

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.
- (3) 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 cancellation of the registration of a design,
 - (b) an application for the grant of a licence in respect of a registered design, or
 - (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.
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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.
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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—

- (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.

35 Fine for falsely representing a design as registered

- (1) If any person falsely represents that a design applied to any article sold by him is registered in respect of that article, 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 an article 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 the article is registered, shall be deemed to represent that the design applied to the article is registered in respect of that article.
- (2) If any person, after the right in a registered design has expired, marks any article to which the design has been applied 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 article to be so marked, he shall be liable on summary conviction to a fine not exceeding level 1 on the standard scale.

35A Offence by body corporate: liability of officers

- (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.

Rules, etc.

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) prescribing the form of applications for registration of designs and of any representations or specimens of designs or other documents which may be filed at the Patent Office, and requiring copies to be furnished of any such representations, specimens or documents;
- (b) 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;
- (c) providing for the appointment of advisers to assist the registrar in proceedings before him;
- (d) regulating the keeping of the register of designs;
- (e) authorising the publication and sale of copies of representations of designs and other documents in the Patent Office;
- (f) 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.

37 Provisions as to rules and Orders

(1)

(2) Any rules made by the Secretary of State in pursuance of section 15 or section 16 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 or on the Appeal Tribunal shall be exercisable by statutory instrument; and the Statutory Instruments Act 1946 shall apply to a statutory instrument containing rules made by

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the Appeal Tribunal in like manner as if the rules had been made by a Minister of the Crown.

- (4) Any statutory instrument containing rules made by the Secretary of State under this Act shall be subject to annulment in pursuance of a resolution of either House of Parliament.
- (5) Any Order in Council made under this Act may be revoked or varied by a subsequent Order in Council.

.....

Supplemental

39 Hours of business and excluded days

- (1) Rules made by the Secretary of State under this Act may specify the hour at which the Patent Office shall be deemed to be closed on any day for purposes of the transaction by the public of business under this Act or of any class of such business, and may specify 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 therefor, 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.

41 Service of notices, &c., 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, include 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) Nothing in this Act shall be construed as authorising or requiring the registrar to register a design the use of which would, in his opinion, be contrary to law or morality.

- (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 articles 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—

“Appeal Tribunal” means the Appeal Tribunal constituted and acting in accordance with section 28 of this Act as amended by the Administration of Justice Act 1969;

“article” means any article of manufacture and includes any part of an article if that part is made and sold separately;

“artistic work” has the same meaning as in Part I of the Copyright, Designs and Patents Act 1988;

“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);

.....
“corresponding design”, in relation to an artistic work, means a design which if applied to an article would produce something which would be treated for the purposes of Part I of the Copyright, Designs and Patents Act 1988 as a copy of that work;

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

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

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

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

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

“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;

“set of articles” means a number of articles of the same general character ordinarily on sale or intended to be used together, to each of which the same design, or the same design with modifications or variations not sufficient to alter the character or substantially to affect the identity thereof, is applied.

- (2) Any reference in this Act to an article in respect of which a design is registered shall, in the case of a design registered in respect of a set of articles, be construed as a reference to any article of that set.
- (3) Any question arising under this Act whether a number of articles constitute a set of articles shall be determined by the registrar; and notwithstanding anything in this Act any determination of the registrar under this subsection shall be final.

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- (4) For the purposes of subsection (1) of section 14 and of section 16 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

In the application of this Act to Scotland—

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- (3) The expression “injunction” means “interdict”; the expression “arbitrator” means “arbiter”;
the expression “plaintiff” means “pursuer”; the expression “defendant” means “defender”.

46 Application to Northern Ireland

In the application of this Act to Northern Ireland—

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- (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.

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)
- (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) Where, in relation to any design, the time for giving notice to the registrar under section 59 of the Patents and Designs Act 1907 expired before the commencement of this Act and the notice was not given, subsection (2) of section 6 of this Act shall not apply in relation to that design or any registration of that design.
- (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 38 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.

FIRST SCHEDULE

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

Use of registered designs for services of the Crown

- 1 (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.

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- (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 practicable 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 articles 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 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 articles 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 articles the supply of which is authorised by this sub-paragraph, and to sell to any person any articles 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 articles 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.

Rights of third parties in respect of Crown use

- 2 (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 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 that 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

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- (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.

Compensation for loss of profit

- 2A (1) Where Crown use is made of a registered design, the government department concerned shall pay—
- (a) to the registered proprietor, or
- (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 articles to which the design is applied.

- (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 under-used.
- (4) No compensation is payable in respect of any failure to secure contracts for the supply of articles to which the design is applied 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.

Reference of disputes as to Crown use

- 3 (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, apply for cancellation of the registration of the design upon any ground upon which the registration of a design may be cancelled on an application to the court under section twenty of this Act;
 - (b) in any case, put in issue the validity of the registration of the design without applying for its cancellation.
- (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.

Special provisions as to Crown use during emergency

- 4 (1) During any period of emergency within the meaning of this paragraph, the 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;

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- (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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