



# Registered Designs Act 1949

## 1949 CHAPTER 88 12 13 and 14 Geo 6

### *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 [<sup>F1</sup>, to any extent,] validly registered, the court may certify that the validity of the registration of the design was contested in those proceedings.
- (2) Where any such certificate has been granted, then if in any subsequent proceedings before the court for infringement of [<sup>F2</sup>the right in the registered design] or for [<sup>F3</sup>invalidation] of the registration of the design, a final order or judgment is made or given in favour of the registered proprietor, he shall, unless the court otherwise directs, be entitled to his costs as between solicitor and client:  
Provided that this subsection shall not apply to the costs of any appeal in any such proceedings as aforesaid.

#### **Textual Amendments**

- F1** Words in s. 25(1) inserted (9.12.2001) by S.I. 2001/3949, reg. 9(1), **Sch. 1 para. 8(2)** (with transitional provisions in [regs. 10-14](#))
- F2** Words substituted by [Copyright, Designs and Patents Act 1988](#) (c. 48, SIF 67A), s. 272, **Sch. 3 para. 14**
- F3** Words in s. 25(2) substituted (9.12.2001) by S.I. 2001/3949, reg. 9(1), **Sch. 1 para. 8(3)** (with transitional provisions in [regs. 10-14](#))

#### **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 [<sup>F4</sup>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.

*Status: Point in time view as at 15/07/2014.*

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(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 [<sup>F4</sup>the right in a registered design] the registration of which is not shown by the [<sup>F5</sup>claimant] to be invalid, the [<sup>F5</sup>claimant] 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.

[<sup>F6</sup>(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.

#### Textual Amendments

- F4** Words substituted by [Copyright, Designs and Patents Act 1988 \(c. 48, SIF 67A\)](#), s. 272, **Sch. 3 para. 15(2)**
- F5** Words in s. 26(2) substituted (29.4.2006) by [Intellectual Property \(Enforcement, etc\) Regulations 2006 \(S.I. 2006/1028\)](#), art. 1, **Sch. 1 para. 4**
- F6** S. 26(2A) inserted by [Copyright, Designs and Patents Act 1988 \(c. 48, SIF 67A\)](#), s. 272, **Sch. 3 para. 15(3)**

#### [<sup>F7</sup>27 The court.

(1) In this Act “ the court ” means—

- (a) in England and Wales the High [<sup>F8</sup>Court,]
- (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 [<sup>F9</sup>Lord Chief Justice of England and Wales may, after consulting the Lord Chancellor, select] for the purpose.]

[<sup>F10</sup>(3) The Lord Chief Justice may nominate a judicial office holder (as defined in section 109(4) of the Constitutional Reform Act 2005) to exercise his functions under subsection (2).]

#### Textual Amendments

- F7** S. 27 substituted by [Copyright, Designs and Patents Act 1988 \(c. 48, SIF 67A\)](#), s. 272, **Sch. 3 para. 16**
- F8** Word in s. 27(1)(a) substituted (1.10.2013) by [Crime and Courts Act 2013 \(c. 22\)](#), s. 61(3), **Sch. 9 para. 21(2)**; S.I. 2013/1725, art. 3(c)
- F9** Words in s. 27(2) substituted (3.4.2006) by [Constitutional Reform Act 2005 \(c. 4\)](#), s. 148(1), **Sch. 4 para. 36(2)**; S.I. 2006/1014, art. 2(a), Sch. 1 para. 11(d)
- F10** S. 27(3) inserted (3.4.2006) by [Constitutional Reform Act 2005 \(c. 4\)](#), s. 148(1), **Sch. 4 para. 36(3)**; S.I. 2006/1014, art. 2(a), Sch. 1 para. 11(d)

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## **[<sup>F11</sup>27A Appeals from decisions of registrar**

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

### **Textual Amendments**

**F11** Ss. 27A, 27B inserted (15.7.2014 for specified purposes, 6.4.2015 in so far as not already in force) by [Intellectual Property Act 2014 \(c. 18\), ss. 10\(2\), 24\(1\); S.I. 2014/1715, art. 3; S.I. 2015/165, art. 3](#)

## **27B Persons appointed to hear and determine appeals**

- (1) A person is not eligible for appointment under section 27A(1)(a) unless the person—
  - (a) satisfies the judicial-appointment eligibility condition on a 5-year basis,
  - (b) is an advocate or solicitor in Scotland of at least 5 years' standing,
  - (c) is a member of the Bar of Northern Ireland or solicitor of the Court of Judicature of Northern Ireland of at least 5 years' standing, or
  - (d) has held judicial office.
- (2) An appointed person must hold and vacate office in accordance with his terms of appointment, subject to subsections (3) to (5).
- (3) An appointed person is to be paid such remuneration (whether by way of salary or fees) and such allowances as the Secretary of State may with the approval of the Treasury decide.
- (4) An appointed person may resign office by notice in writing to the Lord Chancellor.

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- (5) The Lord Chancellor may by notice in writing remove an appointed person (“A”) from office if—
- (a) A has become bankrupt or made an arrangement with A's creditors or, in Scotland, A's estate has been sequestrated or A has executed a trust deed for A's creditors or entered into a composition contract,
  - (b) A is incapacitated by physical or mental illness, or
  - (c) A is, in the opinion of the Lord Chancellor, otherwise unable or unfit to perform A's duties as an appointed person.
- (6) Before exercising a power under section 27A or this section, the Lord Chancellor must consult the Secretary of State.
- (7) The Lord Chancellor may remove a person from office under subsection (5) only with the concurrence of the appropriate senior judge.
- (8) The appropriate senior judge is the Lord Chief Justice of England and Wales, unless—
- (a) the person to be removed exercises functions wholly or mainly in Scotland, in which case it is the Lord President of the Court of Session, or
  - (b) the person to be removed exercises functions wholly or mainly in Northern Ireland, in which case it is the Lord Chief Justice of Northern Ireland.]

#### Textual Amendments

**F11** Ss. 27A, 27B inserted (15.7.2014 for specified purposes, 6.4.2015 in so far as not already in force) by [Intellectual Property Act 2014 \(c. 18\), ss. 10\(2\), 24\(1\)](#); [S.I. 2014/1715, art. 3](#); [S.I. 2015/165, art. 3](#)

## 28 The Appeal Tribunal.

- (1) Any appeal from the registrar under this Act shall lie to the Appeal Tribunal.
- [<sup>F12</sup>(2) The Appeal Tribunal shall consist of—
- (a) one or more judges of the High Court nominated [<sup>F13</sup>by the Lord Chief Justice of England and Wales after consulting the Lord Chancellor], and
  - (b) one judge of the Court of Session nominated by the Lord President of that Court.]
- [<sup>F14</sup>(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.

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- (5) Upon any appeal under this Act the Appeal Tribunal may by order award to any party such costs <sup>F15</sup>... as the Tribunal may consider reasonable and direct how and by what parties the costs <sup>F15</sup>... are to be paid; [<sup>F16</sup>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.]
- (6 <sup>F17</sup> The Appeal Tribunal shall, with regard to the right of audience, observe the same practice as before the first day of November, nineteen hundred and thirty—two, was observed in the hearing of appeals by the law officer.
- (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. [<sup>F18</sup>including right of audience]
- [<sup>F19</sup>(8A) At any time when the Appeal Tribunal consists of two or more judges, the power to make rules under sub—section (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.
- [<sup>F20</sup>(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. ]
- [<sup>F21</sup>(11) The Lord Chief Justice may nominate a judicial office holder (as defined in section 109(4) of the Constitutional Reform Act 2005) to exercise his functions under subsection (2)(a).]

#### Textual Amendments

- F12** S. 28(2) substituted by [Copyright, Designs and Patents Act 1988 \(c. 48, SIF 67A\)](#), s. 272, **Sch. 3 para. 17(2)**
- F13** Words in s. 28(2)(a) substituted (3.4.2006) by [Constitutional Reform Act 2005 \(c. 4\)](#), s. 148(1), **Sch. 4 para. 37(2)**; [S.I. 2006/1014](#), art. 2(a), Sch. 1 para. 11(d)
- F14** S. 28(2)(2A) substituted for s. 28(2) by [Administration of Justice Act 1969 \(c. 58\)](#), s. 24(1)(2)
- F15** Words in s. 28(5) repealed (29.4.2006) by [Intellectual Property \(Enforcement, etc\) Regulations 2006 \(S.I. 2006/1028\)](#), art. 1, **Sch. 4**
- F16** Words substituted by [Copyright, Designs and Patents Act 1988 \(c. 48, SIF 67A\)](#), s. 272, **Sch. 3 para. 17(3)**
- F17** S. 28(6) repealed (E.W.)(S) by [Administration of Justice Act 1970 \(c. 31\)](#), Sch 11
- F18** Words inserted by [Administration of Justice Act 1970 \(c. 31, SIF 37\)](#), s. 10(5) (as extended retrospectively to N.I. by [Copyright, Designs and Patents Act 1988 \(c. 48, SIF 67A\)](#), s. 272, **Sch. 3 para. 17(5)**)

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- F19** S. 28(8A) inserted by [Administration of Justice Act 1969 \(c. 58\), s. 24\(1\)\(3\)](#)
- F20** S. 28(10) substituted by [Copyright, Designs and Patents Act 1988 \(c. 48, SIF 67A\), s. 272, Sch. 3 para. 17\(4\)](#)
- F21** S. 28(11) inserted (3.4.2006) by [Constitutional Reform Act 2005 \(c. 4\), s. 148\(1\), Sch. 4 para. 37\(3\); S.I. 2006/1014, art. 2\(a\), Sch. 1 para. 11\(d\)](#)

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**Modifications etc. (not altering text)**

- C1** S. 28 extended with modifications by [Copyright, Designs and Patents Act 1988 \(c. 48, SIF 67A\), s. 249\(2\)](#)

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