

2013 No. 2533

DESIGNS

The Registered Designs (Isle of Man) Order 2013

Made - - - - *9th October 2013*

Coming into force - - *11th November 2013*

At the Court at Buckingham Palace, the 9th day of October 2013

Present,

The Queen's Most Excellent Majesty in Council

Her Majesty, in exercise of the powers conferred upon Her by sections 37(5) and 47 of the Registered Designs Act 1949(a) and section 304(4) and (6) of the Copyright, Designs and Patents Act 1988(b), is pleased, by and with the advice of Her Privy Council, to make the following Order:

Citation and commencement

1. This Order may be cited as the Registered Designs (Isle of Man) Order 2013 and shall come into force on 11th November 2013.

Interpretation

2. In this Order—

- (a) “the 1949 Act” means the Registered Designs Act 1949;
- (b) “the 1988 Act” means the Copyright, Designs and Patents Act 1988.

Modification of the 1949 and 1988 Acts in their application to the Isle of Man

3.—(1) The 1949 Act shall have effect in the Isle of Man subject to the modifications specified in Schedule 1 to this Order.

(2) Part IV (registered designs) of, and Schedules 3 and 4 to, the 1988 Act shall extend to the Isle of Man subject to the exceptions and modifications specified in Schedule 2 to this Order.

Revocation

4.—(1) The Registered Designs (Isle of Man) Order 2001(c) is revoked.

(a) 1949 c.88.

(b) 1988 c.48. Provisions of the 1988 Act relating to designs were extended to the Isle of Man with modifications by SI 1989/1292 and 1990/1505.

(c) S.I. 2001/3678.

(2) Nothing in paragraph (1) affects the further modifications of the 1949 Act having effect under Schedule 2 to that Order in relation to registrations under that Act made, and applications for registration made but not determined, before the coming into force of that Order.

Richard Tilbrook
Clerk of the Privy Council

SCHEDULE 1

Article 3

Modifications of the Registered Designs Act 1949 in its application to the Isle of Man

1. References to the Crown shall be construed as including the Crown in right of the Government of the Isle of Man.

2.—(1) References to an Act of Parliament (including the 1949 Act and the 1988 Act) or to a provision of such an Act shall be construed as references to that Act or provision as it has effect in the Isle of Man.

(2) References to an Act of Tynwald shall be construed as references to it as amended or replaced by or under any other such enactment.

3. References to a government department shall be construed as including references to a Department of the Government of the Isle of Man, and in relation to such a Department as if references to the Treasury were references to the Treasury of the Isle of Man.

4. Notwithstanding section 47, any reference to the United Kingdom which occurs in the expression “His Majesty’s Government in the United Kingdom” does not include the Isle of Man.

5. For section 1 substitute—

“Registration of designs

1.—(1) A design may, subject to the following provisions of this Act, be registered under this Act on the making of an application for registration.

(2) In this Act “design” means the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture or materials of the product or its ornamentation.

(3) In this Act—

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

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

Requirement of novelty and individual character

1B.—(1) A design shall be protected by a right in a registered design to the extent that the design is new and has individual character.

(2) For the purposes of subsection (1) above, a design is new if no identical design or no design whose features differ only in immaterial details has been made available to the public before the relevant date.

(3) For the purposes of subsection (1) above, a design has individual character if the overall impression it produces on the informed user differs from the overall impression

produced on such a user by any design which has been made available to the public before the relevant date.

(4) In determining the extent to which a design has individual character, the degree of freedom of the author in creating the design shall be taken into consideration.

(5) For the purposes of this section, a design has been made available to the public before the relevant date if—

- (a) it has been published (whether following registration or otherwise), exhibited, used in trade or otherwise disclosed before that date; and
- (b) the disclosure does not fall within subsection (6) below.

(6) A disclosure falls within this subsection if—

- (a) it could not reasonably have become known before the relevant date in the normal course of business to persons carrying on business in the European Economic Area and specialising in the sector concerned;
- (b) it was made to a person other than the designer, or any successor in title of his, under conditions of confidentiality (whether express or implied);
- (c) it was made by the designer, or any successor in title of his, during the period of 12 months immediately preceding the relevant date;
- (d) it was made by a person other than the designer, or any successor in title of his, during the period of 12 months immediately preceding the relevant date in consequence of information provided or other action taken by the designer or any successor in title of his; or
- (e) it was made during the period of 12 months immediately preceding the relevant date as a consequence of an abuse in relation to the designer or any successor in title of his.

(7) In subsections (2), (3), (5) and (6) above “the relevant date” means the date on which the application for the registration of the design was made or is treated by virtue of section 3B(2), (3) or (5) or 14(2) of this Act as having been made.

(8) For the purposes of this section, a design applied to or incorporated in a product which constitutes a component part of a complex product shall only be considered to be new and to have individual character—

- (a) if the component part, once it has been incorporated into the complex product, remains visible during normal use of the complex product; and
- (b) to the extent that those visible features of the component part are in themselves new and have individual character.

(9) In subsection (8) above “normal use” means use by the end user; but does not include any maintenance, servicing or repair work in relation to the product.

Designs dictated by their technical function

1C.—(1) A right in a registered design shall not subsist in features of appearance of a product which are solely dictated by the product’s technical function.

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

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

Designs contrary to public policy or morality

1D. A right in a registered design shall not subsist in a design which is contrary to public policy or to accepted principles of morality.”.

6. In section 2(2), omit—

- (a) the words from “, or the” to “any article,”; and
- (b) the words from “or as”, in the second place, onwards.

7. For section 3 substitute—

“Applications for registration

3.—(1) An application for the registration of a design or designs 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 or designs shall be made by the person claiming to be the proprietor of the design or designs.

(3) An application for the registration of a design or designs in which national unregistered design right subsists shall be made by the person claiming to be the design right owner.

(5) An application for the registration of a design which, owing to any default or neglect on the part of the applicant, has not been completed so as to enable registration to be effected within such time as may be prescribed shall be deemed to be abandoned.

Determination of applications for registration

3A.—(1) Subject as follows, the registrar shall not refuse to register a design included in an application under this Act.

(2) If it appears to the registrar that an application for the registration of a design or designs has not been made in accordance with any rules made under this Act, he may refuse to register any design included in it.

(3) If it appears to the registrar that the applicant is not under section 3(2) or (3) or 14 entitled to apply for the registration of a design included in the application, he shall refuse to register that design.

(4) If it appears to the registrar that the application for registration includes—

- (a) something which does not fulfil the requirements of section 1(2) of this Act;
- (b) a design that does not fulfil the requirements of section 1C or 1D of this Act; or
- (c) a design to which a ground of refusal mentioned in Schedule A1 to this Act applies,

he shall refuse to register that thing or that design.

Modification of applications for registration

3B.—(1) The registrar may, at any time before an application for the registration of a design or designs is determined, permit the applicant to make such modifications of the application as the registrar thinks fit.

(2) Where an application for the registration of a design or designs has been modified before it has been determined in such a way that any design included in the application has been altered significantly, the registrar may, for the purpose of deciding whether and to what extent the design is new or has individual character, direct that the application so far as relating to that design shall be treated as having been made on the date on which it was so modified.

(3) Where—

- (a) an application for the registration of more than one design has been modified before it has been determined to exclude one or more designs from the application; and
- (b) a subsequent application for the registration of a design so excluded has, within such period (if any) as has been prescribed for such applications, been made by the person who made the earlier application or his successor in title,

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

(4) Where the registration of a design has been refused on any ground mentioned in section 3A(4)(b) or (c) of this Act, the application for the design may be modified by the applicant if it appears to the registrar that—

- (a) the identity of the design is retained; and
- (b) the modifications have been made in accordance with any rules made under this Act.

(5) An application modified under subsection (4) above shall be treated as the original application and, in particular, as made on the date on which the original application was made or is treated as having been made.

(6) Any modification under this section may, in particular, be effected by making a partial disclaimer in relation to the application.

Date of registration of designs

3C.—(1) Subject as follows, a design, when registered, shall be registered as of the date on which the application was made or is treated as having been made.

(2) Subsection (1) above shall not apply to an application which is treated as having been made on a particular date by section 14(2) of this Act or by virtue of the operation of section 3B(3) or (5) of this Act by reference to section 14(2) of this Act.

(3) A design, when registered, shall be registered as of—

- (a) in the case of an application which is treated as having been made on a particular date by section 14(2) of this Act, the date on which the application was made;
- (b) in the case of an application which is treated as having been made on a particular date by virtue of the operation of section 3B(3) of this Act by reference to section 14(2) of this Act, the date on which the earlier application was made;
- (c) in the case of an application which is treated as having been made on a particular date by virtue of the operation of section 3B(5) of this Act by reference to section 14(2) of this Act, the date on which the original application was made.

Appeals in relation to applications for registration

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

8. Omit section 4.

9.—(1) In section 5(2) (provisions for secrecy of certain designs), omit paragraph (b) and the word “and” immediately before it.

(2) In section 5(3)(b), omit the words from “, or any” to “above,”.

10. Omit section 6.

11. For section 7 substitute—

“Right given by registration

7.—(1) The registration of a design under this Act gives the registered proprietor the exclusive right to use the design and any design which does not produce on the informed user a different overall impression.

(2) For the purposes of subsection (1) above and section 7A of this Act any reference to the use of a design includes a reference to—

- (a) the making, offering, putting on the market, importing, exporting or using of a product in which the design is incorporated or to which it is applied; or
- (b) stocking such a product for those purposes.

(3) In determining for the purposes of subsection (1) above whether a design produces a different overall impression on the informed user, the degree of freedom of the author in creating his design shall be taken into consideration.

(4) The right conferred by subsection (1) above is subject to any limitation attaching to the registration in question (including, in particular, any partial disclaimer or any declaration by the registrar or a court of partial invalidity).

Infringements of rights in registered designs

7A.—(1) Subject as follows, the right in a registered design is infringed by a person who, without the consent of the registered proprietor, does anything which by virtue of section 7 of this Act is the exclusive right of the registered proprietor.

(2) The right in a registered design is not infringed by—

- (a) an act which is done privately and for purposes which are not commercial;
- (b) an act which is done for experimental purposes;
- (c) an act of reproduction for teaching purposes or for the purpose of making citations provided that the conditions mentioned in subsection (3) below are satisfied;
- (d) the use of equipment on ships or aircraft which are registered in another country but which are temporarily in the United Kingdom;
- (e) the importation into the United Kingdom of spare parts or accessories for the purpose of repairing such ships or aircraft; or
- (f) the carrying out of repairs on such ships or aircraft.

(3) The conditions mentioned in this subsection are—

- (a) the act of reproduction is compatible with fair trade practice and does not unduly prejudice the normal exploitation of the design; and
- (b) mention is made of the source.

(4) The right in a registered design is not infringed by an act which relates to a product in which any design protected by the registration is incorporated or to which it is applied if the product has been put on the market in the European Economic Area by the registered proprietor or with his consent.

(5) The right in a registered design of a component part which may be used for the purpose of the repair of a complex product so as to restore its original appearance is not infringed by the use for that purpose of any design protected by the registration.

(6) No proceedings shall be taken in respect of an infringement of the right in a registered design committed before the date on which the certificate of registration of the design under this Act is granted.”.

12. Omit section 8(5) and (6) (duration of right in registered design)(a).

(a) Section 8 was substituted by section 269 of the 1988 Act.

- 13.** In section 8A(5) (restoration of lapsed right in design)(a)—
- (a) for “proprietor took reasonable care” substitute “failure of the proprietor”;
 - (b) after “8(2) or (4)” insert “was unintentional”.
- 14.** In section 8B(6) (effect of order for restoration of right)(b)—
- (a) for “an article” substitute “a product”; and
 - (b) for “the article” substitute “the product”.
- 15.** Omit sections 9 and 10.
- 16.** For section 11 substitute—

“Cancellation of registration

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

Grounds for invalidity of registration

11ZA.—(1) The registration of a design may be declared invalid—

- (a) on the ground that it does not fulfil the requirements of section 1(2) of this Act;
- (b) on the ground that it does not fulfil the requirements of sections 1B to 1D of this Act; or
- (c) where any ground of refusal mentioned in Schedule A1 to this Act applies.

(1A) The registration of a design (“the later design”) may be declared invalid if it is not new or does not have individual character when compared to a design which—

- (a) has been made available to the public on or after the relevant date; but
- (b) is protected as from a date prior to the relevant date—
 - (i) by virtue of registration under this Act or the Community Design Regulation or an application for such registration, or
 - (ii) by virtue of an international registration (within the meaning of Articles 106a to 106f of that Regulation) designating the Community.

(1B) In subsection (1A) “the relevant date” means the date on which the application for the registration of the later design was made or is treated by virtue of section 3B(2), (3) or (5) or 14(2) of this Act as having been made.

(2) The registration of a design may be declared invalid on the ground of the registered proprietor not being the proprietor of the design and the proprietor of the design objecting.

(3) The registration of a design involving the use of an earlier distinctive sign may be declared invalid on the ground of an objection by the holder of rights to the sign which include the right to prohibit in the United Kingdom such use of the sign.

(4) The registration of a design constituting an unauthorised use of a work protected by the law of copyright in the United Kingdom may be declared invalid on the ground of an objection by the owner of the copyright.

(5) In this section and sections 11ZB, 11ZC and 11ZE of this Act (other than section 11ZE(1)) references to the registration of a design include references to the former registration of a design; and these sections shall apply, with necessary modifications, in relation to such former registrations.

(a) Section 8A was inserted by section 269(1) of the 1988 Act.
(b) Section 8B was inserted by section 269(1) of the 1988 Act.

Applications for declaration of invalidity

11ZB.—(1) Any person interested may make an application to the registrar for a declaration of invalidity under section 11ZA(1)(a) or (b) of this Act.

(2) Any person concerned by the use in question may make an application to the registrar for a declaration of invalidity under section 11ZA(1)(c) of this Act.

(3) The relevant person may make an application to the registrar for a declaration of invalidity under section 11ZA(1A) of this Act.

(4) In subsection (3) above “the relevant person” means, in relation to an earlier design protected by virtue of registration under this Act or the Community Design Regulation or an application for such registration, the registered proprietor of the design, the holder of the registered Community design or (as the case may be) the applicant.

(5) The person able to make an objection under subsection (2), (3) or (4) of section 11ZA of this Act may make an application to the registrar for a declaration of invalidity under that subsection.

(6) An application may be made under this section in relation to a design at any time after the design has been registered.

Determination of applications for declaration of invalidity

11ZC.—(1) This section applies where an application has been made to the registrar for a declaration of invalidity in relation to a registration.

(2) If it appears to the registrar that the application has not been made in accordance with any rules made under this Act, he may refuse the application.

(3) If it appears to the registrar that the application has not been made in accordance with section 11ZB of this Act, he shall refuse the application.

(4) Subject to subsections (2) and (3) above, the registrar shall make a declaration of invalidity if it appears to him that the ground of invalidity specified in the application has been established in relation to the registration.

(5) Otherwise the registrar shall refuse the application.

(6) A declaration of invalidity may be a declaration of partial invalidity.

Modification of registration

11ZD.—(1) Subsections (2) and (3) below apply where the registrar intends to declare the registration of a design invalid under section 11ZA(1)(b) or (c), (1A), (3) or (4) of this Act.

(2) The registrar shall inform the registered proprietor of that fact.

(3) The registered proprietor may make an application to the registrar for the registrar to make such modifications to the registration of the design as the registered proprietor specifies in his application.

(4) Such modifications may, in particular, include the inclusion on the register of a partial disclaimer by the registered proprietor.

(5) If it appears to the registrar that the application has not been made in accordance with any rules made under this Act, the registrar may refuse the application.

(6) If it appears to the registrar that the identity of the design is not retained or the modified registration would be invalid by virtue of section 11ZA of this Act, the registrar shall refuse the application.

(7) Otherwise the registrar shall make the specified modifications.

(8) A modification of a registration made under this section shall have effect, and be treated always to have had effect, from the grant of registration.

Effect of cancellation or invalidation of registration

11ZE.—(1) A cancellation of registration under section 11 of this Act takes effect from the date of the registrar’s decision or from such other date as the registrar may direct.

(2) Where the registrar declares the registration of a design invalid to any extent, the registration shall to that extent be treated as having been invalid from the date of registration or from such other date as the registrar may direct.

Appeals in relation to cancellation or invalidation

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

17.—(1) In section 11A(1) and (7)(a), for “Monopolies Commission” substitute “Competition Commission”.

(2) In section 11A(3), omit—

- (a) paragraph (b) and the word “or” immediately before it, and
- (b) the words from “or may, instead” onwards.

(3) Omit section 11A(4) and (5).

18. Omit section 11B.

19.—(1) In section 14(1), after “design” insert “or designs”.

(2) In section 14(2)(b)—

- (a) after “design” insert “or designs”;
- (b) after “whether” insert “(and to what extent)”;
- (c) after “is new” insert “or has individual character”.

(3) In section 14(3) for “section 3(4)” substitute “section 3B(2) or (3)”.

20. In section 15(2)—

- (a) in paragraph (a), for “articles” substitute “products”; and
- (b) in paragraph (e)—
 - (i) for “articles” substitute “products”; and
 - (ii) after “applied” insert “or in which it is incorporated”.

21. After section 15 insert—

“Property in and dealing with registered designs and applications

The nature of registered designs

15A. A registered design or an application for a registered design is personal property (in Scotland, incorporeal moveable property).

Assignment, &c of registered designs and applications for registered designs

15B.—(1) A registered design or an application for a registered design is transmissible by assignment, testamentary disposition or operation of law in the same way as other personal or moveable property, subject to the following provisions of this section.

(a) Sections 11A and 11B were inserted by section 270 of the 1988 Act.
(b) Section 14(2) and (3) were substituted by paragraph 7 of Schedule 3 to the 1988 Act.

(2) Any transmission of a registered design or an application for a registered design is subject to any rights vested in any other person of which notice is entered in the register of designs, or in the case of applications, notice is given to the registrar.

(3) An assignment of, or an assent relating to, a registered design or application for a registered design is not effective unless it is in writing signed by or on behalf of the assignor or, as the case may be, a personal representative.

(4) The requirement in subsection (3) may be satisfied in a case where the assignor or personal representative is a body corporate by the affixing of its seal.

(5) Subsections (3) and (4) apply to assignment by way of security as in relation to any other assignment.

(6) A registered design or application for a registered design may be the subject of a charge in the same way as other personal or moveable property.

(7) The proprietor of a registered design may grant a licence to use that registered design.

(8) Any equities in respect of a registered design or an application for a registered design may be enforced in like manner as in respect of any other personal or moveable property.

Exclusive licences

15C.—(1) In this Act an “exclusive licence” means a licence in writing signed by or on behalf of the proprietor of the registered design authorising the licensee to the exclusion of all other persons, including the person granting the licence, to exercise a right which would otherwise be exercisable exclusively by the proprietor of the registered design.

(2) The licensee under an exclusive licence has the same rights against any successor in title who is bound by the licence as he has against the person granting the licence.”.

22. Omit section 16.

23.—(1) In section 17(8) (register of designs, etc) omit “Subject to subsection (11) below,”.

(2) In section 17(10) omit “, subject to subsection (11) below,”.

24.—(1) In section 19(3A) (registration of assignments, etc)(a), for “design right” (in each place) substitute “national unregistered design right”.

(2) In section 19(3B) for “design right” (in the first and third places) substitute “national unregistered design right”.

(3) Omit section 19(4).

25.—(1) In section 20(1) (rectification of register), for “any person aggrieved” substitute “the relevant person”.

(2) After section 20(1) insert—

“(1A) In subsection (1) above “the relevant person” means—

- (a) in the case of an application invoking any ground referred to in section 11ZA(1)(c) of this Act, any person concerned by the use in question;
- (b) in the case of an application invoking the ground mentioned in section 11ZA(1A) of this Act, the appropriate person;
- (c) in the case of an application invoking any ground mentioned in section 11ZA(2), (3) or (4) of this Act, the person able to make the objection;
- (d) in any other case, any person aggrieved.

(1B) In subsection (1A) above “the appropriate person” means, in relation to an earlier design protected by virtue of registration under this Act or the Community Design

(a) Section 19(3A) and (3B) were inserted by paragraph 10 of Schedule 3 to the 1988 Act.

Regulation or an application for such registration, the registered proprietor of the design, the holder of the registered Community design or (as the case may be) the applicant.”.

(3) After section 20(5) insert—

“(6) Orders which may be made by the court under this section include, in particular, declarations of partial invalidity.”.

26.—(1) In section 22(1) (inspection of registered designs)(a)—

- (a) for “issued” substitute “granted”;
- (b) omit paragraph (b) and the word “and” immediately before it;
- (c) for “the following provisions of this subsection” substitute “subsection (4)”.

(2) Omit section 22(2) and (3).

(3) For section 22(4) substitute—

“(4) Where registration of a design has been refused pursuant to an application under this Act, or an application under this Act has been abandoned in relation to any design—

- (a) the application, so far as relating to that design, and
- (b) any representation, specimen or other document which has been filed and relates to that design,

shall not at any time be open to inspection at the Patent Office or be published by the registrar.”.

27. In section 23(a) (information as to existence of right in registered design)(b), omit “and, if so, in respect of what articles”.

28. Immediately before section 25 insert—

“Action for infringement

24A.—(1) An infringement of the right in a registered design is actionable by the registered proprietor.

(2) In an action for infringement all such relief by way of damages, injunctions, accounts or otherwise is available to him as is available in respect of the infringement of any other property right.

(2A) Where in an action for infringement of the right in a registered design it is shown that the defendant knew, or had reason to believe, that he was committing an infringement, the damages awarded to the claimant shall be appropriate to the actual prejudice he suffered as a result of the infringement.

(2B) The court—

- (a) in awarding such damages shall take into account all appropriate aspects, including in particular—
 - (i) the negative economic consequences, including any lost profits, which the claimant has suffered;
 - (ii) any unfair profits made by the defendant; and
 - (iii) elements other than economic factors, including the moral prejudice caused to the claimant by the infringement; or
- (b) may where appropriate award such damages on the basis of the royalties or fees which would have been due had the defendant obtained a licence.

(3) This section has effect subject to section 24B of this Act (exemption of innocent infringer from liability).

(a) Section 22(1) was substituted by paragraph 12(2) of Schedule 3 to the 1988 Act.

(b) Section 23 was substituted by paragraph 13 of Schedule 3 to the 1988 Act.

Exemption of innocent infringer from liability

24B.—(1) In proceedings for the infringement of the right in a registered design damages shall not be awarded, and no order shall be made for an account of profits, against a defendant who proves that at the date of the infringement he was not aware, and had no reasonable ground for supposing, that the design was registered.

(2) For the purposes of subsection (1), a person shall not be deemed to have been aware or to have had reasonable grounds for supposing that the design was registered by reason only of the marking of a product with—

- (a) the word “registered” or any abbreviation thereof, or
- (b) any word or words expressing or implying that the design applied to, or incorporated in, the product has been registered,

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

(3) Nothing in this section shall affect the power of the court to grant an injunction in any proceedings for infringement of the right in a registered design.

Order for delivery up

24C.—(1) Where a person—

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

the registered proprietor in question may apply to the court for an order that the infringing article or other thing be delivered up to him or to such other person as the court may direct.

(2) An application shall not be made after the end of the period specified in the following provisions of this section; and no order shall be made unless the court also makes, or it appears to the court that there are grounds for making, an order under section 24D of this Act (order as to disposal of infringing article, &c).

(3) An application for an order under this section may not be made after the end of the period of six years from the date on which the article or thing in question was made, subject to subsection (4).

(4) If during the whole or any part of that period the registered proprietor—

- (a) is under a disability, or
- (b) is prevented by fraud or concealment from discovering the facts entitling him to apply for an order,

an application may be made at any time before the end of the period of six years from the date on which he ceased to be under a disability or, as the case may be, could with reasonable diligence have discovered those facts.

(5) In subsection (4) “disability” has the same meaning as in the Limitation Act 1984 (an Act of Tynwald)(a).

(6) A person to whom an infringing article or other thing is delivered up in pursuance of an order under this section shall, if an order under section 24D of this Act is not made, retain it pending the making of an order, or the decision not to make an order, under that section.

(a) 1984 c.18 (Isle of Man).

(7) The reference in subsection (1) to an act being done in relation to an article for “commercial purposes” are to its being done with a view to the article in question being sold or hired in the course of a business.

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

Order as to disposal of infringing articles, &c

24D.—(1) An application may be made to the court for an order that an infringing article or other thing delivered up in pursuance of an order under section 24C of this Act shall be—

- (a) forfeited to the registered proprietor, or
- (b) destroyed or otherwise dealt with as the court may think fit,

or for a decision that no such order should be made.

(2) In considering what order (if any) should be made, the court shall consider whether other remedies available in an action for infringement of the right in a registered design would be adequate to compensate the registered proprietor and to protect his interests.

(3) Where there is more than one person interested in an article or other thing, the court shall make such order as it thinks just and may (in particular) direct that the thing be sold, or otherwise dealt with, and the proceeds divided.

(4) If the court decides that no order should be made under this section, the person in whose possession, custody or control the article or other thing was before being delivered up is entitled to its return.

(5) References in this section to a person having an interest in an article or other thing include any person in whose favour an order could be made in respect of it under—

- (a) this section;
- (b) section 19 of the Trade Marks Act 1994^(a)(including that section as applied in relation to Community trade marks by any statutory provision having effect in the Isle of Man);
- (c) section 113 of the Copyright Act 1991 (an Act of Tynwald)^(b);
- (d) section 19 of the Design Right Act 1991 (an Act of Tynwald)^(c);
- (e) section 26 of the Performers’ Protection Act 1996 (an Act of Tynwald)^(d); or
- (f) any corresponding statutory provision relating to Community designs and having effect in the Isle of Man.

Rights and remedies of exclusive licensee

24F.—(1) In relation to a registered design, an exclusive licensee has, except against the registered proprietor, the same rights and remedies in respect of matters occurring after the grant of the licence as if the licence had been an assignment.

(2) His rights and remedies are concurrent with those of the registered proprietor; and references to the registered proprietor in the provisions of this Act relating to infringement shall be construed accordingly.

(3) In an action brought by an exclusive licensee by virtue of this section a defendant may avail himself of any defence which would have been available to him if the action had been brought by the registered proprietor.

(a) 1994 c.26.
(b) 1991 c.8 (Isle of Man).
(c) 1991 c.9 (Isle of Man).
(d) 1996 c.12 (Isle of Man).

(4) Where an action for infringement of the right in a registered design brought by the registered proprietor or an exclusive licensee relates (wholly or partly) to an infringement in respect of which they have concurrent rights of action, the proprietor or, as the case may be, the exclusive licensee may not, without the leave of the court, proceed with the action unless the other is either joined as a claimant or added as a defendant.

(5) A registered proprietor or exclusive licensee who is added as a defendant in pursuance of subsection (4) is not liable for any costs in the action unless he takes part in the proceedings.

(6) Subsections (4) and (5) do not affect the granting of interlocutory relief on the application of the registered proprietor or an exclusive licensee.

(7) Where an action for infringement of the right in a registered design is brought which relates (wholly or partly) to an infringement in respect of which the registered proprietor and an exclusive licensee have concurrent rights of action—

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

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

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

Meaning of “infringing article”

24G.—(1) In this Act “infringing article”, in relation to a design, shall be construed in accordance with this section.

(2) An article is an infringing article if its making to that design was an infringement of the right in a registered design.

(3) An article is also an infringing article if—

- (a) it has been or is proposed to be imported into the United Kingdom, and
- (b) its making to that design in the United Kingdom would have been an infringement of the right in a registered design or a breach of an exclusive licensing agreement relating to that registered design.

(4) Where it is shown that an article is made to a design which is or has been a registered design, it shall be presumed until the contrary is proved that the article was made at a time when the right in the registered design subsisted.

(5) Nothing in subsection (3) shall be construed as applying to an article which may be lawfully imported into the Isle of Man by virtue of an enforceable EU right within the meaning of the European Communities (Isle of Man) Act 1973 (an Act of Tynwald)(a). ”.

29.—(1) In section 25 (certificate of contested validity of registration) (1), after “the design is” insert “, to any extent,”.

(a) 1973 c.14 (Isle of Man) as amended by section 5 of and the Schedule to the European Union (Amendment) Act 2011 (c.11) (Isle of Man).

(2) In section 25(2), for “cancellation” substitute “invalidation”.

30. In section 26(2) (remedy for groundless threats of infringement proceedings), for “plaintiff” (in each place) substitute “claimant”.

31. In section 27(1) (the court)(a), immediately before the end insert—

“and

(d) in the Isle of Man, the High Court of Justice of the Isle of Man”.

32.—(1) In section 28(5) (the Appeal Tribunal), at the end insert—

“(c) in the Isle of Man, in the same way as an order of the court.”.

(2) Omit section 28(6).

(3) In section 28(8) after “this Act” insert “including right of audience”.

33.—(1) In section 30(2) (costs and security for costs)(b), immediately before the end insert—

“and

(c) in the Isle of Man, in the same way as an order of the court”.

(2) In section 30(3)—

(a) In paragraph (a), omit for “cancellation” substitute “invalidation”;

(b) omit paragraph (b).

34. In sections 33(1) (offences under section 5)(c)and 34(falsification of register)(d)—

(a) for “imprisonment” (in each place) substitute “custody”;

(b) in paragraph (a), for “indictment” substitute “information”;

(c) in paragraph (b), for “the statutory maximum” substitute “the prescribed sum within the meaning of section 32 of the Magistrates’ Courts Act 1980(e)”.

35.—(1) In section 35(1) (fine for falsely representing a design as registered)—

(a) for “any article” substitute “, or incorporated in, any product”;

(b) omit “in respect of that article”;

(c) for “an article” substitute “a product”;

(d) for “the article” (in the first and second places) substitute “, or incorporated in, the product”;

(e) omit “in respect of the article”.

(2) In section 35(2)—

(a) for “any article” substitute “any product”;

(b) after “applied” insert “or in which it has been incorporated”;

(c) for “such article” substitute “such product”.

(3) After section 35(2) insert—

“(3) For the purposes of this section, the use in the United Kingdom in relation to a design—

(a) of the word “registered”, or

(b) of any other word or symbol importing a reference (express or implied) to registration,

(a) Section 27 was substituted by paragraph 16 of Schedule 3 to the 1988 Act.

(b) Section 30 was substituted by paragraph 19 of Schedule 3 to the 1988 Act.

(c) Section 33(1) was amended by paragraph 22(2) of Schedule 3 to the 1988 Act.

(d) Section 34 was amended by paragraph 23(2) of Schedule 3 to the 1988 Act.

(e) 1980 c.43.

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

36. In section 36(1A) (general power of Secretary of State to make rules)(a), after paragraph (a) insert—

- “(ab) requiring applications for registration of designs to specify—
- (i) the products to which the designs are intended to be applied or in which they are intended to be incorporated;
 - (ii) the classification of the designs by reference to such test as may be prescribed.”.

37. In section 37(2) (provisions as to rules and Orders), for “section fifteen or section sixteen of this Act” substitute “section 15 of this Act”.

38. Immediately after section 37 insert—

“Use of electronic communications

37A.—(1) The registrar may give directions as to the form and manner in which documents to be delivered to the registrar—

- (a) in electronic form; or
- (b) using electronic communications,

are to be delivered to him.

(2) A direction under subsection (1) may provide that in order for a document to be delivered in compliance with the direction it shall be accompanied by one or more additional documents specified in the direction.

(3) Subject to subsections (11) and (12), if a document to which a direction under subsection (1) or (2) applies is delivered to the registrar in a form or manner which does not comply with the direction the registrar may treat the document as not having been delivered.

(4) Subsection (5) applies in relation to a case where—

- (a) a document is delivered using electronic communications, and
- (b) there is a requirement for a fee to accompany the document.

(5) The registrar may give directions specifying—

- (a) how the fee shall be paid; and
- (b) when the fee shall be deemed to have been paid.

(6) The registrar may give directions specifying that a person who delivers a document to the registrar in electronic form or using electronic communications cannot treat the document as having been delivered unless its delivery has been acknowledged.

(7) The registrar may give directions specifying how a time of delivery is to be accorded to a document delivered to him in electronic form or using electronic communications.

(8) A direction under this section may be given—

- (a) generally;
- (b) in relation to a description of cases specified in the direction;
- (c) in relation to a particular person or persons.

(9) A direction under this section may be varied or revoked by a subsequent direction under this section.

(a) Section 36(1A) was inserted by paragraph 26(3) of Schedule 3 to the 1988 Act.

(10) The delivery using electronic communications to any person by the registrar of any document is deemed to be effected, unless the registrar has otherwise specified, by transmitting an electronic communication containing the document to an address provided or made available to the registrar by that person as an address of his for the receipt of electronic communications; and unless the contrary is proved such delivery is deemed to be effected immediately upon the transmission of the communication.

(11) A requirement of this Act that something must be done in the prescribed manner is satisfied in the case of something that is done—

- (a) using a document in electronic form, or
- (b) using electronic communications,

only if the directions under this section that apply to the manner in which it is done are complied with.

(12) In the case of an application made as mentioned in subsection (11)(a) or (b) above, a reference in this Act to the application not having been made in accordance with rules under this Act includes a reference to its not having been made in accordance with any applicable directions under this section.

(13) This section applies—

- (a) to delivery at the Patent Office as it applies to delivery to the registrar; and
- (b) to delivery by the Patent Office as it applies to delivery by the registrar.”.

39.—(1) Omit section 43(1) (savings).

(2) In section 43(2), for “articles” substitute “products”.

40.—(1) In section 44(1) (interpretation)—

- (a) omit the definitions of “article”, “artistic work”, “corresponding design” and “set of articles”;
- (b) in the definition of “design”, for “section 1(1)” substitute “section 1(2)”;
- (c) at the appropriate places insert—

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

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

““electronic communication” has the same meaning as in the Electronic Communications Act 2000(b);”;

““national unregistered design right” means design right within the meaning of the Design Right Act 1991 (an Act of Tynwald);”;

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

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

(2) Omit section 44(2) and (3).

(3) In section 44(4) for “section fourteen and of section sixteen of this Act” substitute “section 14 of this Act”.

41. Omit section 48(5) (repeals, savings and transitional provisions).

42. Immediately before Schedule 1 insert—

(a) OJ No. L 3, 5.1.2002, p.1.

(b) 2000 c.7.

Grounds for refusal of registration in relation to emblems etc.

Grounds for refusal in relation to certain emblems etc.

1.—(1) A design shall be refused registration under this Act if it involves the use of—

- (a) the Royal arms, or any of the principal armorial bearings of the Royal arms, or any insignia or device so nearly resembling the Royal arms or any such armorial bearing as to be likely to be mistaken for them or it;
- (b) a representation of the Royal crown or any of the Royal flags;
- (c) a representation of Her Majesty or any member of the Royal family, or any colourable imitation thereof; or
- (d) words, letters or devices likely to lead persons to think that the applicant either has or recently has had Royal patronage or authorisation;

unless it appears to the registrar that consent for such use has been given by or on behalf of Her Majesty or (as the case may be) the relevant member of the Royal family.

(2) A design shall be refused registration under this Act if it involves the use of—

- (a) the national flag of the United Kingdom (commonly known as the Union Jack); or
- (b) the flag of England, Wales, Scotland, Northern Ireland or the Isle of Man,

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

(3) A design shall be refused registration under this Act if it involves the use of—

- (a) arms to which a person is entitled by virtue of a grant of arms by the Crown; or
- (b) insignia so nearly resembling such arms as to be likely to be mistaken for them;

unless it appears to the registrar that consent for such use has been given by or on behalf of the person concerned and the use is not in any way contrary to the law of arms.

(4) A design shall be refused registration under this Act if it involves the use of a controlled representation within the meaning of the Olympic Symbol etc. (Protection) Act 1995^(a) unless it appears to the registrar that—

- (a) the application is made by the person for the time being appointed under section 1(2) of the Olympic Symbol etc. (Protection) Act 1995 (power of Secretary of State to appoint a person as the proprietor of the Olympics association right); or
- (b) consent for such use has been given by or on behalf of the person mentioned in paragraph (a) above.

(5) References in this section to the Olympic Symbol etc (Protection) Act 1995 are to that Act as it has effect in the United Kingdom.

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

2.—(1) A design shall be refused registration under this Act if it involves the use of the flag of a Paris Convention country unless—

- (a) the authorisation of the competent authorities of that country has been given for the registration; or
- (b) it appears to the registrar that the use of the flag in the manner proposed is permitted without such authorisation.

(2) A design shall be refused registration under this Act if it involves the use of the armorial bearings or any other state emblem of a Paris Convention country which is

(a) 1995 c.32.

protected under the Paris Convention unless the authorisation of the competent authorities of that country has been given for the registration.

(3) A design shall be refused registration under this Act if—

- (a) the design involves the use of an official sign or hallmark adopted by a Paris Convention country and indicating control and warranty;
- (b) the sign or hallmark is protected under the Paris Convention; and
- (c) the design could be applied to or incorporated in goods of the same, or a similar, kind as those in relation to which the sign or hallmark indicates control and warranty;

unless the authorisation of the competent authorities of that country has been given for the registration.

(4) The provisions of this paragraph as to national flags and other state emblems, and official signs or hallmarks, apply equally to anything which from a heraldic point of view imitates any such flag or other emblem, or sign or hallmark.

(5) Nothing in this paragraph prevents the registration of a design on the application of a national of a country who is authorised to make use of a state emblem, or official sign or hallmark, of that country, notwithstanding that it is similar to that of another country.

Grounds for refusal in relation to emblems etc. of certain international organisations

3.—(1) This paragraph applies to—

- (a) the armorial bearings, flags or other emblems; and
- (b) the abbreviations and names,

of international intergovernmental organisations of which one or more Paris Convention countries are members.

(2) A design shall be refused registration under this Act if it involves the use of any such emblem, abbreviation or name which is protected under the Paris Convention unless—

- (a) the authorisation of the international organisation concerned has been given for the registration; or
- (b) it appears to the registrar that the use of the emblem, abbreviation or name in the manner proposed—
 - (i) is not such as to suggest to the public that a connection exists between the organisation and the design; or
 - (ii) is not likely to mislead the public as to the existence of a connection between the user and the organisation.

(3) The provisions of this paragraph as to emblems of an international organisation apply equally to anything which from a heraldic point of view imitates any such emblem.

(4) Nothing in this paragraph affects the rights of a person whose bona fide use of the design in question began before 4th January 1962 (when the relevant provisions of the Paris Convention entered into force in relation to the United Kingdom).

Paragraphs 2 and 3: supplementary

4.—(1) For the purposes of paragraph 2 above state emblems of a Paris Convention country (other than the national flag), and official signs or hallmarks, shall be regarded as protected under the Paris Convention only if, or to the extent that—

- (a) the country in question has notified the United Kingdom in accordance with Article 6ter(3) of the Convention that it desires to protect that emblem, sign or hallmark;
- (b) the notification remains in force; and
- (c) the United Kingdom has not objected to it in accordance with Article 6ter(4) or any such objection has been withdrawn.

(2) For the purposes of paragraph 3 above the emblems, abbreviations and names of an international organisation shall be regarded as protected under the Paris Convention only if, or to the extent that—

- (a) the organisation in question has notified the United Kingdom in accordance with Article 6ter(3) of the Convention that it desires to protect that emblem, abbreviation or name;
- (b) the notification remains in force; and
- (c) the United Kingdom has not objected to it in accordance with Article 6ter(4) or any such objection has been withdrawn.

(3) Notification under Article 6ter(3) of the Paris Convention shall have effect only in relation to applications for the registration of designs made more than two months after the receipt of the notification.

Interpretation

5. In this Schedule—

“a Paris Convention country” means a country, other than the United Kingdom, which is a party to the Paris Convention; and

“the Paris Convention” means the Paris Convention for the Protection of Industrial Property of 20th March 1883.”.

43.—(1) Schedule 1 (use of registered designs for the services of the Crown) is modified as follows.

- (2) In paragraph 1(6) and (7), for “articles” (in each place) substitute “products”.
- (3) In paragraph 2(1), for “design right” substitute “national unregistered design right”.
- (4) In paragraph 2A(1) and (4)(a)—
 - (a) for “articles” substitute “products”; and
 - (b) after “applied” insert “or in which it is incorporated”.
- (5) In paragraph 3(2)(a)—
 - (a) after “proceedings” insert “and the department are a relevant person within the meaning of section 20 of this Act”;
 - (b) for “cancellation” substitute “invalidation”; and
 - (c) for “cancelled” substitute “declared invalid”.
- (6) In paragraph 3(2)(b)—
 - (a) after “case” insert “and provided that the department would be the relevant person within the meaning of section 20 of this Act if they had made an application on the grounds for invalidity being raised”; and
 - (b) for “cancellation” substitute “invalidation”.

SCHEDULE 2

Article 3(2)

Modifications of provisions of the Copyright, Designs and Patents Act 1988 as it has effect in the Isle of Man

1. Any reference to an Act of Parliament (including the 1949 Act and the 1988 Act) or to a provision of such an Act shall be construed as a reference to that Act or provision as it has effect in the Isle of Man.

2. Omit sections 265 and 268.

(a) Paragraph 2A was inserted by section 271(1) of the 1988 Act.

3. In Schedule 3, omit paragraph 1, 2, 3(4), 4, 6, 9 and 31(2) and (5).

4. Schedule 4 shall have effect as if the text of the 1949 Act contained therein were the text of that Act as modified by Schedule 1 to this Order.

EXPLANATORY NOTE

(This note is not part of the Order)

This Order modifies the Registered Designs Act 1949, and certain provisions of the Copyright, Designs and Patents Act 1988 relating to registered designs, in their application to the Isle of Man. It replaces the Registered Designs (Isle of Man) Order 2001 (SI 2001/3678), and makes additional modifications to correspond to the amendments made to the 1949 Act (as it has effect in the United Kingdom) by the Registered Designs Regulations 2003 (SI 2003/550), the Community Design Regulations 2005 (SI 2005/2339), the Intellectual Property (Enforcement, etc.) Regulations 2006 (SI 2006/1028), the Registered Designs Act 1949 and Patents Act 1977 (Electronic Communications) Order 2006 (SI 2006/1229) and the Regulatory Reform (Registered Designs) Order 2006 (SI 2006/1974).

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