*Draft Regulations laid before Parliament under section 2(2) of, and paragraph 2(2) of Schedule 2 to, the European Communities Act 1972 for approval by resolution of each House of Parliament.*

DRAFT STATUTORY INSTRUMENTS

# 2001 No.

# DESIGNS

## The Registered Designs Regulations 2001

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|---|---|
| *Made - - - -* | *2001* |
| *Coming into force - -* | *2001* |

Whereas a draft of the following Regulations has been approved by resolution of each House of Parliament:

Now, therefore, the Secretary of State, being designated(**1**) for the purposes of section 2(2) of the European Communities Act 1972(**2**) in relation to measures relating to the legal protection of designs, in exercise of the powers conferred on her by the said section 2(2) hereby makes the following Regulations:

### Citation, commencement and extent

**1.**—(1) These Regulations may be cited as the Registered Designs Regulations 2001 and shall come into force on the day after the day on which they are made.

(2) Subject to paragraph (3), these Regulations extend to England and Wales, Scotland and Northern Ireland.

(3) The amendments made by these Regulations to the Chartered Associations (Protection of Names and Uniforms) Act 1926 do not extend to Northern Ireland.

### Designs registrable under the 1949 Act

**2.** For section 1 of the Registered Designs Act 1949(**3**) (designs registrable under Act) there shall be substituted—

(**1**) S.I.2000/1813.
(**2**) 1972 c. 68.
(**3**) 1949 c. 88. Section 1 as originally enacted was substituted by section 265 of the Copyright, Designs and Patents Act 1988 (c. 48) ("the 1988 Act") but not in relation to applications for registration made before 1st August 1989. Subsection (6) was added by section 13(1) of the Olympic Symbol etc. (Protection) Act 1995 (c. 32) in relation to applications for registration made on or after 20th September 1995.

"**1 Registration of designs.**

(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.

**1A Substantive grounds for refusal of registration.**

(1) The following shall be refused registration under this Act—

(a) anything which does not fulfil the requirements of section 1(2) of this Act;

(b) designs which do not fulfil the requirements of sections 1B to 1D of this Act;

(c) designs to which a ground of refusal mentioned in Schedule A1 to this Act applies.

(2) A design ("the later design") shall be refused registration under this Act if it is not new or does not have individual character when compared with 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 by virtue of registration under this Act or an application for such registration.

(3) In subsection (2) above "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.

**1B Requirement of novelty and individual character.**

(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.

**1C Designs dictated by their technical function.**

(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.

**1D 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."

**Designs registrable under the 1949 Act: emblems etc.**

**3.** Before Schedule 1 to the Registered Designs Act 1949 there shall be inserted—

"SCHEDULE A1

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 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.

*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 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 6*ter*(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 6*ter*(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 6*ter*(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 6*ter*(4) or any such objection has been withdrawn.

(3) Notification under Article 6*ter*(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."

**Registration of designs: general**

**4.** For section 3 of the Registered Designs Act 1949(**4**) (proceedings for registration) there shall be substituted—

"**3 Applications 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 shall be made by the person claiming to be the proprietor of the design.

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

(4) For the purpose of deciding whether, and to what extent, a design is new or has individual character, the registrar may make such searches (if any) as he thinks fit.

(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.

**3A Determination of applications for registration.**

(1) Subject as follows, the registrar shall not refuse an application for the registration of a design.

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

(**4**) Section 3(2) to (7) was substituted by section 272 of, and paragraph 1 of Schedule 3 to, the 1988 Act.

(3) If it appears to the registrar that an application for the registration of a design has not been made in accordance with sections 3(2) and (3) and 14(1) of this Act, he shall refuse the application.

(4) If it appears to the registrar that any ground for refusal of registration mentioned in section 1A of this Act applies in relation to an application for the registration of a design, he shall refuse the application.

**3B Modification of applications for registration.**

(1) The registrar may, at any time before an application for the registration of a design 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 has been modified before it has been determined in such a way that the design 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 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 a design has disclosed more than one design and 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 an application for the registration of a design has been refused on any ground mentioned in section 1A(1)(b) or (c) of this Act, the application 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.

**3C Date of registration of designs.**

(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.

**3D 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."

**Right given by registration under the 1949 Act**

**5.** For section 7 of the Registered Designs Act 1949(**5**) (right given by registration) there shall be substituted—

"**7 Right given by registration.**

(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).

**7A Infringements of rights in registered designs.**

(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;

(**5**) Section 7 as originally enacted was substituted by section 268 of the 1988 Act but not in relation to a design registered in pursuance of an application made before 1st August 1989.

(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."

**Removal of compulsory licence regimes**

**6.**—(1) Section 10 of the Registered Designs Act 1949 (compulsory licence in respect of registered design) shall be omitted.

(2) In section 11A of that Act(**6**) (powers exercisable for protection of the public interest), in subsection (3) (power to ensure licences available as of right)—

(a) paragraph (b) and the word "or" immediately preceding it shall be omitted; and

(b) the words from "or may, instead" to the end of the subsection shall be omitted.

**Cancellation and invalidation of registration**

**7.** For section 11 of the Registered Designs Act 1949(**7**) (cancellation of registration) there shall be substituted—

"**11 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.

**11ZA Grounds for invalidity of registration.**

(1) The registration of a design may be declared invalid on any of the grounds mentioned in section 1A of this Act.

(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.

(**6**) Section 11A was inserted by section 270 of the 1988 Act.

(**7**) Words in subsection (2) of section 11 were repealed by section 303(2) of, and Schedule 8 to, the 1988 Act. Subsections (3) to (5) of section 11 were substituted for subsection (2A) of that section (as inserted by section 44(3) of the Copyright Act 1956 (c. 74)) by section 272 of, and paragraph 6 of Schedule 3 to, the 1988 Act.

(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.

**11ZB Applications for declaration of invalidity.**

(1) Any person interested may make an application to the registrar for a declaration of invalidity on the ground mentioned in section 1A(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 on the ground mentioned in section 1A(1)(c) of this Act.

(3) The relevant person may make an application to the registrar for a declaration of invalidity on the ground mentioned in section 1A(2) 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 an application for such registration, the registered proprietor of the 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 on the ground mentioned in 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.

**11ZC Determination of applications for declaration of invalidity.**

(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.

**11ZD Modification of registration.**

(1) Subsections (2) and (3) below apply where the registrar intends to declare the registration of a design invalid on any ground mentioned in section 1A(1)(b) or (c) or 11ZA(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.

**11ZE Effect of cancellation or invalidation of registration.**

(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.

**11ZF 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."

**Rectification of register**

**8.**—(1) Section 20 of the Registered Designs Act 1949(**8**) (rectification of register) shall be amended as follows.

(2) In subsection (1) (applications for rectification) for the words "any person aggrieved" there shall be substituted "the relevant person".

(3) After subsection (1) there shall be inserted—

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

(a) in the case of an application invoking any ground referred to in section 1A(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 1A(2) 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 an application for such registration, the registered proprietor of the design or (as the case may be) the applicant."

(4) After subsection (5) there shall be added—

(**8**) Section 20(5) was added by section 272 of, and paragraph 11 of Schedule 3 to, the 1988 Act.

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

**Other modifications of enactments**

**9.**—(1) The amendments specified in Schedule 1 (consequential amendments) shall have effect.

(2) The repeals specified in Schedule 2 shall have effect.

**Transitional provisions: pending applications**

**10.**—(1) This Regulation applies to applications for registration under the Registered Designs Act 1949 which have been made but not finally determined before the coming into force of these Regulations ("pending applications").

(2) The Act of 1949 as it has effect immediately before the coming into force of these Regulations shall continue to apply in relation to pending applications so far as it relates to the determination of such applications.

(3) Accordingly the amendments and repeals made by these Regulations shall not apply in relation to the determination of such applications.

**Transitional provisions: transitional registrations**

**11.**—(1) This Regulation applies to any registration under the Registered Designs Act 1949 which results from the determination of a pending application (within the meaning of Regulation 10).

(2) The Act of 1949 as it has effect immediately before the coming into force of these Regulations shall continue to apply in relation to registrations to which this Regulation applies ("transitional registrations") so far as the Act relates to the cancellation or invalidation of such registrations (other than cancellation by virtue of section 11(3) of that Act).

(3) Accordingly the amendments and repeals made by these Regulations shall, so far as they relate to the cancellation or invalidation of registrations, not apply in relation to transitional registrations.

(4) The amendments and repeals made by these Regulations shall otherwise (and subject to paragraphs (5) to (9) and Regulation 14) apply in relation to transitional registrations.

(5) In the application by virtue of paragraph (4) of the amendments made by Regulation 5, the fact that transitional registrations are in respect of any articles, or sets of articles, shall be disregarded.

(6) The amendments made by Regulation 4 shall not operate so as to determine the dates of registration of designs to which transitional registrations apply; and these dates shall be determined by reference to the Act of 1949 as it has effect immediately before the coming into force of these Regulations.

(7) Where—

(a) any such date of registration for the purposes of calculating the period for which the right in a registered design subsists, or any extension of that period, under section 8 of the Act of 1949 is determined by virtue of section 14(2) of that Act; and

(b) that date is earlier than the date which would otherwise have been the date of registration for those purposes;

the difference between the two dates shall be added to the first period of five years for which the right in the registered design is to subsist.

(8) Any reference in section 8 of the Act of 1949 to a period of five years shall, in the case of any such period which is extended by virtue of paragraph (7), be treated as a reference to the extended period.

(9) The repeal by these Regulations of the proviso in section 4(1) of the Act of 1949 and of the reference to it in section 8 of that Act shall not apply to the right in a design to which a transitional registration applies.

**Transitional provisions: post-1989 registrations**

**12.**—(1) This Regulation applies to—

(a) any registration under the Registered Designs Act 1949 which—

(i) has resulted from an application made on or after 1st August 1989 and before the coming into force of these Regulations; and

(ii) has given rise to a right in a registered design which is in force at the coming into force of these Regulations;

(b) any registration under the Act of 1949 which—

(i) has resulted from an application made on or after 1st August 1989 and before the coming into force of these Regulations; and

(ii) has given rise to a right in a registered design which is not in force at the coming into force of these Regulations but which is capable of being treated as never having ceased to be in force by virtue of section 8(4) of the Act of 1949 or of being restored by virtue of sections 8A and 8B of that Act; and

(c) any registration which subsequently ceases to fall within sub-paragraph (b) because the right in the registered design has been treated or restored as mentioned in paragraph (ii) of that sub-paragraph.

(2) The Act of 1949 as it has effect immediately before the coming into force of these Regulations shall continue to apply in relation to registrations to which this Regulation applies ("post-1989 registrations") so far as the Act relates to the cancellation or invalidation of such registrations (other than cancellation by virtue of section 11(3) of that Act and by reference to an expiry of copyright occurring on or after the coming into force of these Regulations).

(3) Accordingly the amendments and repeals made by these Regulations shall, so far as they relate to the cancellation or invalidation of registrations, not apply in relation to post-1989 registrations.

(4) The amendments and repeals made by these Regulations shall otherwise apply (subject to paragraphs (5) to (9) and Regulation 14) in relation to post-1989 registrations.

(5) In the application by virtue of paragraph (4) of the amendments made by Regulation 5, the fact that post-1989 registrations are in respect of any articles, or sets of articles, shall be disregarded.

(6) The amendments made by Regulation 4 shall not operate so as to alter the dates of registration of designs to which post-1989 registrations apply.

(7) Where—

(a) any such date of registration for the purposes of calculating the period for which the right in a registered design subsists, or any extension of that period, under section 8 of the Act of 1949 was determined by virtue of section 14(2) of that Act; and

(b) that date is earlier than the date which would otherwise have been the date of registration for those purposes;

the difference between the two dates shall be added to any period of five years which is current on the coming into force of these Regulations or, if no such period is current but a subsequent extension or restoration is effected under section 8, or sections 8A and 8B, of the Act of 1949, to the period resulting from that extension or restoration.

(8) Any reference in section 8 of the Act of 1949 to a period of five years shall, in the case of any such period which is extended by virtue of paragraph (7), be treated as a reference to the extended period.

(9) The repeal by these Regulations of the proviso in section 4(1) of the Act of 1949 and the reference to it in section 8 of that Act shall not apply to the right in a design to which a post-1989 registration applies.

**Transitional provisions: pre-1989 registrations**

**13.**—(1) This Regulation applies to—

(a) any registration under the Registered Designs Act 1949 which—

(i) has resulted from an application made before 1st August 1989; and

(ii) has given rise to a copyright in a registered design which is in force at the coming into force of these Regulations;

(b) any registration under the Act of 1949 which—

(i) has resulted from an application made before 1st August 1989; and

(ii) has given rise to a copyright in a registered design which is not in force at the coming into force of these Regulations but which would be capable of coming back into force by virtue of an extension of the period of copyright under section 8(2) of the Act of 1949 if that provision were amended as set out in paragraph (8); and

(c) any registration which subsequently ceases to fall within sub-paragraph (b) because the copyright in the registered design has come back into force by virtue of an extension of the period of copyright under section 8(2) of the Act of 1949 as amended by paragraph (8).

(2) Subject as follows, the amendments and repeals made by these Regulations shall not apply to any provision of the Act of 1949 which only has effect in relation to applications for registration made before 1st August 1989 or any registrations resulting from such applications.

(3) Any such provision and any other provision of the Act of 1949 as it has effect immediately before the coming into force of these Regulations in relation to registrations which fall within paragraph (1) ("pre-1989 registrations") shall continue to apply so far as it relates to the cancellation or invalidation of pre-1989 registrations (other than cancellation by virtue of section 11(3) of that Act and by reference to an expiry of copyright occurring on or after the coming into force of these Regulations).

(4) Accordingly the amendments and repeals made by these Regulations shall, so far as they relate to the cancellation or invalidation of registrations, not apply in relation to pre-1989 registrations.

(5) The amendments and repeals made by these Regulations shall otherwise apply (subject to paragraphs (2) and (9) to (12) and Regulation 14) in relation to pre-1989 registrations.

(6) Amendments and repeals corresponding to the amendments and repeals made by these Regulations (other than those relating to the cancellation or invalidation of registrations) shall be treated as having effect, with necessary modifications and subject to Regulation 14, in relation to any provision of the Act of 1949 which only has effect in relation to applications for registration made before 1st August 1989 or any registrations resulting from such applications.

(7) In the application by virtue of paragraph (6) of amendments corresponding to those made by Regulation 5, the fact that pre-1989 registrations are in respect of any articles, or sets of articles, shall be disregarded.

(8) In section 8(2) of the Act of 1949 as it has effect in relation to pre-1989 registrations (period of copyright)—

(a) after the words "second period", where they appear for the second time, there shall be inserted "and for a fourth period of five years from the expiration of the third period and for a fifth period of five years from the expiration of the fourth period";

(b) after the words "second or third" there shall be inserted "or fourth or fifth"; and

(c) after the words "second period", where they appear for the third time, there shall be inserted "or the third period or the fourth period".

(9) The amendments made by Regulation 4 shall not operate so as to alter the dates of registration of designs to which pre-1989 registrations apply.

(10) Where—

(a) the date of registration for the purposes of calculating the period of copyright, or any extension of that period, under section 8(2) of the Act of 1949 as it has effect in relation to pre-1989 registrations was determined by virtue of section 14(2) of that Act; and

(b) that date is earlier than the date which would otherwise have been the date of registration for those purposes;

the difference between the two dates shall be added to any period of five years which is current on the coming into force of these Regulations or, if no such period is current but a subsequent extension is effected under section 8 of the Act of 1949 as amended by paragraph (8), to the period resulting from that extension.

(11) Any reference in section 8(2) of the Act of 1949 as amended by paragraph (8) to a period of five years shall, in the case of any such period which is extended by virtue of paragraph (10), be treated as a reference to the extended period.

(12) The repeal by these Regulations of the proviso in section 4(1) of the Act of 1949 shall not apply to the right in a design to which a pre-1989 registration applies.

**Other transitional provisions**

**14.**—(1) Any licence which—

(a) permits anything which would otherwise be an infringement under the Registered Designs Act 1949 of the right in a registered design or the copyright in a registered design; and

(b) was granted by the registered proprietor of the design, or under section 10 or 11A of the Act of 1949, before the coming into force of these Regulations,

shall continue in force, with necessary modifications, on or after the making of these Regulations.

(2) In determining the effect of any such licence on or after the coming into force of these Regulations, regard shall be had to the purpose for which the licence was granted; and, in particular, a licence granted for the full term or extent of the right in a registered design or the copyright in a registered design shall be treated as applying, subject to its other terms and conditions, to the full term or extent of that right as extended by virtue of these Regulations.

(3) The right in a registered design conferred by virtue of these Regulations in relation to registrations to which Regulation 11, 12 or 13 applies shall not enable the registered proprietor to prevent any person from continuing to carry out acts begun by him before the coming into force of these Regulations and which, at that time, the registered proprietor or, in the case of registrations to which Regulation 11 applies, a registered proprietor would have been unable to prevent.

(4) The right in a registered design conferred by virtue of these Regulations in relation to registrations to which Regulation 12 or 13 applies shall, in particular, not apply in relation to infringements committed in relation to those registrations before the coming into force of these Regulations.

(5) The repeals by these Regulations in section 5 of the Registered Designs Act 1949 shall not apply in relation to any evidence filed in support of an application made before the coming into force of these Regulations.

(6) The amendments and repeals made by these Regulations in section 22 of the Act of 1949 (other than the amendment to the proviso in subsection (2) of that section) shall not apply in relation to any registration which has resulted from an application made before the coming into force of these Regulations.

(7) The amendment to the proviso in section 22(2) of the Act of 1949 shall not apply where—

(a) the registration of the first-mentioned design resulted from an application made before the coming into force of these Regulations; and

(b) the application for the registration of the other design was also made before the coming into force of these Regulations.

(8) The amendments and repeals made by these Regulations in section 35 of the Act of 1949 shall not apply in relation to any offences committed before the coming into force of these Regulations.

(9) The repeal by these Regulations of provisions in section 44 of the Act of 1949 which relate to the meaning of a set of articles shall not apply so far as those provisions are required for the purposes of paragraph 6(2)(a) of Schedule 1 to the Copyright, Designs and Patents Act 1988.

(10) Any amendment or repeal by these Regulations of a provision in section 44 of the Act of 1949 or in any enactment other than the Act of 1949 shall not apply so far as that provision is required for the purposes of any other transitional provision made by these Regulations.

(11) The Act of 1949 as it has effect immediately before the coming into force of these Regulations shall continue to apply in relation to former registrations, whose registration resulted from an application made before the coming into force of these Regulations, so far as the Act relates to the cancellation or invalidation of such registrations.

(12) Paragraph (13) applies in relation to any registration to which Regulation 11, 12 or 13 applies which is in respect of any features of shape, configuration, pattern or ornament which do not fall within the new definition of "design" inserted into section 1 of the Act of 1949 by Regulation 2 of these Regulations.

(13) The Act of 1949 shall, so far as it applies in relation to any such registration, apply as if the features concerned were included within the new definition of "design" in that Act.

Parliamentary Under-Secretary of State for
Competition, Consumers and Markets
Department of Trade and Industry

2001

## SCHEDULE 1

## CONSEQUENTIAL AMENDMENTS

### *Chartered Associations (Protection of Names and Uniforms) Act 1926*

**1.** In section 3 of the Chartered Associations (Protection of Names and Uniforms) Act 1926 (savings)—

(a) for the word "article", in the first place where it appears, there shall be substituted "product";

(b) for the words from "in respect of " to "1907", there shall be substituted "where a design is applied to, or incorporated in, the product and the design is protected by virtue of registration under the Registered Designs Act 1949";

(c) for the words "such registered design", in both places where they appear, there shall be substituted "the design"; and

(d) for the words "such article" there shall be substituted "the product".

### *Registered Designs Act 1949*

**2.** In section 8B(6) of the Registered Designs Act 1949(**9**) (effect of order for restoration of right)—

(a) for the words "an article" there shall be substituted "a product"; and

(b) for the words "the article" there shall be substituted "the product".

**3.** In section 9(1) of that Act(**10**) (exemption of innocent infringer from liability for damages)—

(a) for the words "an article" there shall be substituted "a product"; and

(b) for the words "the article" there shall be substituted ", or incorporated in, the product".

**4.**—(1) Section 14 of that Act(**11**) (registration of design where application for protection in convention country has been made) shall be amended as follows.

(2) In subsection (2)—

(a) after the word "whether" there shall be inserted "(and to what extent)"; and

(b) after the word "new" there shall be inserted "or has individual character".

(3) In subsection (3) for the words "section 3(4)" there shall be substituted "section 3B(2) or (3)".

**5.** In section 15(2) of that Act (extension of time for applications under section 14 in certain cases)—

(a) in paragraph (a), for the word "articles" there shall be substituted "products"; and

(b) in paragraph (e)—

(i) for the word "articles" there shall be substituted "products"; and

(ii) after the word "applied" there shall be inserted "or in which it is incorporated".

**6.**—(1) Section 19 (registration of assignments etc.)(**12**) of that Act shall be amended as follows.

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(**9**) Section 8B was inserted by section 269 of the 1988 Act.
(**10**) Section 9 was amended by section 272 of, and paragraph 5 of Schedule 3 to, the 1988 Act.
(**11**) Section 14(2) and (3) were substituted by section 272 of, and paragraph 7 of Schedule 3 to, the 1988 Act.
(**12**) Section 19(3A) and (3B) were inserted by section 272 of, and paragraph 10 of Schedule 3 to, the 1988 Act.

(2) In subsection (3A) for the words "design right", in both places where they appear, there shall be substituted "national unregistered design right".

(3) In subsection (3B) for the words "design right", in the first and third places where they appear, there shall be substituted "national unregistered design right".

**7.**—(1) Section 22 of that Act(**13**) (inspection of registered designs) shall be amended as follows.

(2) In subsection (2) for the words from the beginning to "no" there shall be substituted—

"Where—

(a) a design has been registered;

(b) a product to which the design was intended to be applied or in which it was intended to be incorporated was specified, in accordance with rules made under section 36 of this Act, in the application for the registration of the design; and

(c) the product so specified falls within any class prescribed for the purposes of this subsection,

no".

(3) Also in subsection (2)—

(a) for the word "articles" there shall be substituted "products"; and

(b) for the words from "it is the same" to "trade" there shall be substituted ", by reference to the first-mentioned design, it is not new or does not have individual character".

(4) In subsection (3) for the words from "design" to "class" there shall be substituted "registered design and a specified product which falls within any class".

**8.**—(1) Section 25 of that Act(**14**) (certificate of contested validity of registration) shall be amended as follows.

(2) In subsection (1) after the words "the design is" there shall be inserted ", to any extent,".

(3) In subsection (2) for the word "cancellation" there shall be substituted "invalidation".

**9.** In section 30(3)(a) of that Act(**15**) (costs and security for costs) for the word "cancellation" there shall be substituted "invalidation".

**10.**—(1) Section 35 of that Act(**16**) (fine for falsely representing a design as registered) shall be amended as follows.

(2) In subsection (1)—

(a) for the words "any article" there shall be substituted ", or incorporated in, any product";

(b) the words "in respect of that article" shall be omitted;

(c) for the words "an article" there shall be substituted "a product";

(d) for the words "the article", in the first and second places where they appear, there shall be substituted ", or incorporated in, the product"; and

(e) the words "in respect of the article" shall be omitted.

(3) In subsection (2)—

(a) for the words "any article" there shall be substituted "any product";

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(**13**) Section 22(2) and (3) were amended by section 272 of, and paragraph 12 of Schedule 3 to, the 1988 Act.
(**14**) Section 25(2) was amended by section 272 of, and paragraph 14 of Schedule 3 to, the 1988 Act.
(**15**) Section 30 was substituted by section 272 of, and paragraph 19 of Schedule 3 to, the 1988 Act.
(**16**) Section 35 was amended by section 272 of, and paragraph 24 of Schedule 3 to, the 1988 Act but not, in the case of the amendment to section 35(1), in relation to offences committed before 1st August 1989.

(b) after the word "applied" there shall be inserted "or in which it has been incorporated"; and

(c) for the words "such article" there shall be substituted "such product".

**11.** In section 36(1A) of that Act(**17**) (general power of Secretary of State to make rules etc.), after paragraph (a), there shall be inserted—

"(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;".

**12.** In section 37(2) of that Act for the words from "section", where it first appears, to "Act", where it first appears, there shall be substituted "section 15 of this Act".

**13.** In section 43(2) of that Act (savings) for the word "articles" there shall be substituted "products".

**14.**—(1) Section 44 of that Act (interpretation) shall be amended as follows.

(2) In subsection (1), in the definition of "design"(**18**) for the words "section 1(1)" there shall be substituted "section 1(2)".

(3) In subsection (1), at the appropriate places, there shall be inserted—

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

""national unregistered design right" means design right within the meaning of Part III of the Copyright, Designs and Patents Act 1988;";

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

(4) In subsection (4) for the words from "section", where it first appears, to "Act" there shall be substituted "section 14 of this Act".

**15.**—(1) Schedule 1 to that Act (use of registered designs for the services of the Crown) shall be amended as follows.

(2) In paragraph 1(6)(**19**) and (7), for the word "articles", in each place where it appears, there shall be substituted "products".

(3) In paragraph 2(1)(**20**) for the words "design right" there shall be substituted "national unregistered design right".

(4) In paragraph 2A(1) and (4)(**21**)—

(a) for the word "articles" there shall be substituted "products"; and

(b) after the word "applied" there shall be inserted "or in which it is incorporated".

(5) In paragraph 3(2)(a)—

(a) after the word "proceedings" there shall be inserted "and the department are a relevant person within the meaning of section 20 of this Act";

(b) for the word "cancellation" there shall be substituted "invalidation"; and

(c) for the word "cancelled" there shall be substituted "declared invalid".

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(**17**) Section 36 was amended by section 272 of, and paragraph 26 of Schedule 3 to, the 1988 Act.
(**18**) The definition of "design" was amended by section 272 of, and paragraph 31(7) of Schedule 3 to, the 1988 Act.
(**19**) Paragraph 1(6) was substituted by section 1(1) and (4) of the Defence Contracts Act 1958 (c. 38).
(**20**) The words "design right" were inserted into paragraph 2(1) by section 272 of, and paragraph 37(2) of Schedule 3 to, the 1988 Act.
(**21**) Paragraph 2A was inserted by section 271 of the 1988 Act in relation to any Crown use of a registered design after 1st August 1989 even if the terms for such use were settled before that date.

(6) In paragraph 3(2)(b)—

(a) after the word "case" there shall be inserted "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 the word "cancellation" there shall be substituted "invalidation".

*Copyright, Designs and Patents Act 1988*

**16.** In section 53(1)(b) of the Copyright, Designs and Patents Act 1988(**22**) (things done in reliance on registration of design) after the word "cancellation" there shall be inserted "or invalidation".

SCHEDULE 2

REPEALS

| Chapter | Short title | Extent of repeal |
|---|---|---|
| 1949 c. 88. | The Registered Designs Act 1949. | In section 2(2), the words from ", or the" to "any article," and the words from "or as", where they appear for a second time, to the end of the subsection.<br>Section 4.<br>In section 5, in subsection (2), paragraph (b) and the word "and" immediately preceding it and, in subsection (3)(b), the words from ", or any" to "above,".<br>Section 6.<br>Section 8(5) and (6).<br>Section 10.<br>In section 11A(3), paragraph (b) and the word "or" immediately preceding it, and the words from "or may, instead" to the end of the subsection.<br>Section 11A(4) and (5).<br>Section 11B.<br>Section 16. |

(**22**) 1988 c. 48.

| Chapter | Short title | Extent of repeal |
|---|---|---|
| | | In section 22(1), paragraph (b) and the word "and" immediately preceding it. |
| | | In section 23(a), the words "and, if so, in respect of what articles". |
| | | In section 30(3), paragraph (b). |
| | | In section 35(1), the words "in respect of that article" and the words "in respect of the article". |
| | | Section 43(1). |
| | | In section 44, in subsection (1), the definitions of "article", "artistic work", "corresponding design" and "set of articles" and subsections (2) and (3). |
| | | Section 48(5). |
| 1988 c. 48. | The Copyright, Designs and Patents Act 1988. | Section 265. |
| | | Section 268. |
| | | In Schedule 3, paragraphs 1, 2, 3(4), 4, 6, 9 and 31(2) and (5). |
| 1995 c. 21. | The Merchant Shipping Act 1995. | In Schedule 13, paragraph 26. |
| 1995 c. 32. | The Olympic Symbol etc. (Protection) Act 1995. | Section 13(1). |

## EXPLANATORY NOTE

*(This note is not part of the Regulations)*

These regulations implement Directive 98/71/EC of the European Parliament and of the Council of 13th October 1998 on the legal protection of designs (O.J. No. L289, 28.10.1998, p.28) ("the Directive") which provides for harmonisation in the EC of the matters of registered design protection which most closely affect the functioning of the internal market. The Directive was extended to the European Economic Area by Decision No.21/2000 of the EEA Joint Committee.

The Registered Designs Act 1949 ("the Act") already provides a very similar protection to that required under the Directive. These regulations amend the Act insofar as its provisions do not comply

with the requirements of the Directive. It also makes transitional provisions and consequential amendments to other Acts.

Regulations 2 to 8 implement the main requirements of the Directive. In particular they:

(a) extend the definition of "design" and amend the requirements for a design to be protectable, including amending the test for novelty and introducing a test for "individual character";

(b) amend the field of earlier disclosures against which a design is tested for novelty and individual character;

(c) allow the designer to apply for protection up to a year after he first discloses a design without his own disclosures counting against the registration;

(d) amend the period of protection to a maximum of 25 years from the filing date of the application (or date deemed as the filing date because of an amendment which changes the design or because an application has been "divided out" from an application which contained more than one design), rather than from the date of filing any earlier "priority" application as may be the case at present;

(e) amend the grounds on which the registrar may refuse an application or a third party may request a declaration of invalidity;

(f) amend the rights which are conferred by registration of a design, including types of use of the design which the right-holder can and cannot control;

(g) provide that the use of the design of a component part used for the purpose of the repair of a complex product so as to restore its original appearance shall not be an infringement of the rights in the design;

(h) make explicit the principle of "exhaustion of rights", whereby a right-holder cannot continue to use these rights to control movement or use of a product after it has been put on the market in the EEA by him or with his consent.

Regulations 9 to 14 make consequential amendments to the Act and other Acts, together with transitional provisions for applications and registrations already existing when the regulations come into force, including the following:

(a) the validity of existing registrations, or registrations resulting from existing applications, will continue to be measured according to the Act as it applied to them immediately before these regulations came into force;

(b) amended rights in existing registrations cannot be used to prevent the continuation of actions begun by a third party prior to these regulations coming into force, which could not have been prevented before that time;

(c) the maximum period of protection for certain existing registrations which had been subject to a 15 year limit is extended to 25 years;

(d) the period of protection for existing registrations which depend on an earlier "priority" application is extended so that the term expires on an anniversary of the filing date rather than the priority date (which may be up to six months earlier).

A regulatory impact assessment is available, copies of which have been placed in the libraries of both Houses of Parliament. Copies of the assessment are also available from the Intellectual Property Policy Directorate of the Patent Office, Room 3B38, Concept House, Cardiff Road, Newport NP10 8QQ.