

SCHEDULES

SCHEDULE 5

SPECIAL TRANSITIONAL PROVISIONS WITH RESPECT TO PATENTS FOR INVENTIONS AND REGISTERED DESIGNS

PART III

REGISTERED DESIGNS

- 19 (1) In relation to any use of a registered design or a design in respect of which an application for registration is pending, being a use made on or after the appointed day for purposes referable to functions of the Corporation—
- (a) by the Corporation under any power conferred by or by virtue of the foregoing provisions of this Act;
 - (b) by a person authorised by an authority continued in force by paragraph 13 or conferred by virtue of that paragraph or paragraph 14 ; or
 - (c) by the registered proprietor or applicant for registration for the purpose of satisfying a liability under an agreement to which this Part applies,
- the provisions of any licence, assignment or agreement made.—
- (i) before 1st October 1969, between the registered proprietor or applicant for registration or any person who derives title from him or from whom he derives title and any person other than a government department;
 - (ii) on or after 1st October 1969, between the registered proprietor or applicant for registration or any person who derives title from him or from whom he derives title and any person other than the Post Office ; or
 - (iii) on or after the appointed day between the registered proprietor or applicant for registration or any person who derives title from him or from whom he derives title and any person other than the Corporation,
- shall be of no effect so far as those provisions restrict or regulate the use of the design, or any model, document or information relating thereto, or provide for the making of payments in respect of any such use, or calculated by reference thereto ; and the reproduction or publication of any model or document in connection with the said use shall not be deemed to be an infringement of any copyright subsisting in the model or document.
- (2) Where an exclusive licence granted otherwise than for royalties or other benefits determined by reference to the use of the design is in force under the registered design, then—
- (a) in relation to any use of the design which, but for the provisions of this paragraph and paragraph 13 would constitute an infringement of the rights of the licensee, paragraph 16 shall have effect as if for the reference in subparagraph (b) thereof to the registered proprietor there were substituted a reference to the licensee ; and

Status: This is the original version (as it was originally enacted).

- (b) in relation to any use of the design by the licensee by virtue of an authority continued in force by, or conferred by virtue of, paragraph 13, paragraph 16 shall have effect as if sub-paragraph (b) were omitted.
- (3) Subject to the provisions of sub-paragraph (2), where the registered design or the right to apply for or obtain registration of the design has been assigned to the registered proprietor in consideration of royalties or other benefits determined by reference to the use of the design, then—
 - (a) in relation to any use of the design by virtue of paragraph 13, paragraph 16 shall have effect as if, in sub-paragraph (b), the reference to the registered proprietor included a reference to the assignor, and any sum payable by virtue of that paragraph or an agreement referred to in paragraph 14 shall—
 - (i) except in a case where an agreement as to the proportions in which any sum payable in relation to the use of the design should be divided was made before 1st October 1969 under paragraph 2(3) of Schedule 1 to the Registered Designs Act 1949 or before the appointed day under paragraph 18(3) of Schedule 10 to the 1969 Act, or a determination as to those proportions was made by the court before that date under paragraph 3 of the said Schedule 1 or before that day under paragraph 19 of the said Schedule 10, be divided between them in such proportions as may be agreed between them or as may in default of agreement be determined by the court on a reference under paragraph 20 ;
 - (ii) in the said excepted case, be divided in such proportions as may be provided for by the said agreement or determination ; and
 - (b) in relation to any use of the design made after the beginning of the appointed day, being use referable to the functions of the Corporation and made by the registered proprietor for the purpose mentioned in sub-paragraph (1)(c), paragraph 16(b) shall have effect as if that use were made by virtue of an authority continued in force by paragraph 13.
- (4) Where, under paragraph 16 or such an agreement as is referred to in paragraph 14, payments are required to be made by the Corporation to a registered proprietor in respect of any use of a design, any person, being the holder of an exclusive licence under the registered design (not being such a licence as is mentioned in sub-paragraph (2)) authorising him to make that use of the design, shall—
 - (a) except where an agreement as to the recovery from the registered proprietor of a part of the payments made under paragraph 1(3) of Schedule 1 to the Registered Designs Act 1949 in respect of the use of the design was made before 1st October 1969 under paragraph 2(4) of that Schedule or before the appointed day under paragraph 18(4) of Schedule 10 to the 1969 Act, or a determination as to such recovery was made by the court before that date under paragraph 3 of the said Schedule 1 or before the appointed day under paragraph 19 of the said Schedule 10, be entitled to recover from the registered proprietor such part (if any) of those payments as may be agreed upon between that person and the registered proprietor or as may, in default of agreement, be determined by the court on a reference under paragraph 20 to be just having regard to any expenditure incurred by that person—
 - (i) in developing the said design ; or
 - (ii) in making payments to the registered proprietor, other than royalties or other payments determined by reference to the use of the design, in consideration of the licence;

- (b) in the said excepted case, be entitled to recover such part, if any, of the payments as may be provided for by the said agreement or determination ;
and if, at any time before the amount of any such payment has been settled, that person gives to the Corporation notice in writing of his interest, any agreement as to the amount of that payment shall be of no effect unless it is made with his consent; and for the purposes of this sub-paragraph, a notice given before 1st October 1969 to the department of the Postmaster General in pursuance of paragraph 2(4) of the said Schedule 1 or before the appointed day to the Post Office in pursuance of paragraph 18 of the said Schedule 10 shall have effect as if it had been given to the Corporation.
- (5) Where any models, documents or information relating to a registered design are used in connection with any such use of the design as is described in sub-paragraph (1), paragraph 16 shall, whether or not it applies to the use of the design, apply to the use of the models, documents or information as if for the reference therein to the registered proprietor there were substituted a reference to the person entitled to the benefit of any provision of a licence, assignment or agreement which is rendered inoperative by sub-paragraph (1) in relation to that use.
- (6) Nothing in this paragraph shall be construed as authorising the disclosure to the Corporation or any other person of any model, document or information to the use of which this paragraph applies in contravention of any such licence, assignment or agreement as aforesaid.