

SCHEDULES

SCHEDULE 5

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

PART III

REGISTERED DESIGNS

- 13 (1) Where an agreement to which this Schedule applies contains provision—
- (a) conferring authority under paragraph 1(1) of Schedule 1 to the Registered Designs Act 1949 for the use of a registered design for a purpose referable to the functions of the Post Office ; or
 - (b) providing for the conferring by the Post Office on a person of such an authority under that paragraph,
- then, on and after the appointed day.—
- (i) the authority conferred by the Agreement, and any authority conferred before that day in pursuance of such a provision as is mentioned in head (b), shall continue in force and shall have effect so as to authorise the use of the design for a purpose referable to the functions of the Corporation, being a purpose corresponding to that mentioned in head (a); and
 - (ii) the provision described in head (b) shall have effect as if it provided for the conferring by the Corporation of an authority having such effect as is mentioned in head (i).
- (2) For the purpose of fulfilling obligations imposed on it by virtue of this paragraph, the Corporation shall, on and after the appointed day, have power to confer such an authority as is mentioned in head (ii) of sub-paragraph (1).
- 14 Where, by an agreement to which this Schedule applies, being an agreement made in pursuance of sub-paragraph (3) of paragraph 1 of Schedule 1 to the Registered Designs Act 1949 and continued in force by paragraph 13 of Schedule 10 to the 1969 Act, terms are agreed upon which use of a design may be made by virtue of the said paragraph 13 for the manufacture of articles by the Post Office, or the manufacture and supply to the Post Office of articles by a person authorised by it.—
- (a) the agreement shall (so far as it relates to the use of the design by, or with the authority of the Post Office) have effect as from the appointed day as if, for any reference to use by virtue of the said paragraph 13 for any purpose referable to functions of the Post Office, there were substituted a reference to use by virtue of this paragraph for any purpose referable to functions of the Corporation corresponding to a purpose referable to functions of the Post Office, being a purpose in the case of which use of the design therefor fell within the agreement;
 - (b) the Corporation shall have power to use the design for the manufacture of articles on the terms of the agreement as it has effect by virtue of this

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- paragraph, and any person authorised by the Corporation in writing shall have power to use the design for manufacture and supply to the Corporation on such terms.
- 15 (1) Subject to sub-paragraph (3), where, on or after the appointed day, use of a registered design is begun under an authority continued in force by, or conferred by virtue of, paragraph 13, the Corporation shall notify the registered proprietor as soon as practicable after the use is begun.
- (2) Subject as aforesaid, the Corporation shall furnish the registered proprietor with such information as he may from time to time require as to the extent of use, if any, of the registered design after the beginning of the appointed day under such an authority as is mentioned in sub-paragraph (2) or by virtue of paragraph 14.
- (3) Nothing in the foregoing provisions of this paragraph shall impose on the Corporation an obligation to give notification or furnish information if the Secretary of State notifies it that it is contrary to the public interest to do so.
- 16 Where, in the case of a design, an authority for its use is continued in force by, or is conferred by virtue of, paragraph 13, then—
- (a) if and so far as the design has, before the date of registration thereof, been duly recorded by or applied by or on behalf of a government department otherwise than in consequence of the communication of the design, directly or indirectly, by the registered proprietor or a person from whom he derives title, any use of the design by virtue of paragraph 13 may be made free of any royalty or other payment to the registered proprietor ;
- (b) if and so far as the design has not been so recorded or applied as aforesaid, any use of the design by virtue of paragraph 13 at any time after the date of registration thereof or in consequence of any such communication as aforesaid, shall—
- (i) except in a case where an agreement as to terms for the use of the design was made before 1st October 1969 under paragraph 1(3) of Schedule 1 to the Registered Designs Act 1949 or before the appointed day under paragraph 15 of Schedule 10 to the 1969 Act, or a determination as to those terms 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 made upon such terms as may be agreed upon, either before or after the use, between the Corporation and the registered proprietor or as may, in default of such an agreement, be determined by the court on a reference under paragraph 20;
- (ii) in the said excepted case, be made upon the terms of the said agreement or determination.
- 17 The authority of the Corporation in respect of a design may be given under paragraph 13 or 14 either before or after the design is registered and either before or after the acts in respect of which the authority is given are done, but not so as to authorise the doing before the appointed day of any act; and such authority may be given to any person whether or not he is authorised, directly or indirectly, by the registered proprietor to use the design.
- 18 (1) In the case of articles vested in the Corporation and—
- (a) made before 1st October 1969, in the exercise of powers conferred by paragraph 1 of Schedule 1 to the Registered Designs Act 1949 ;

- (b) made before the appointed day, under an authority continued in force by, or conferred by virtue of, paragraph 12 of Schedule 10 to the 1969 Act; or
- (c) made on or after the appointed day, under an authority continued in force by, or conferred by virtue of, paragraph 13,

the Corporation, if the circumstance are such that their supply to the government of a country outside the United Kingdom is, by virtue of paragraph 1(6) of the said Schedule 1 included among the services of the Crown, shall have power to sell them to that government, and if the circumstances are such that their supply to the United Nations is, by virtue of that paragraph, so included, shall have power to sell them to that organisation.

- (2) In the case of articles mentioned in sub-paragraph (1) and articles vested in the Corporation and—

- (a) made on or after 1st October 1969 by virtue of paragraph 13 of Schedule 10 to the 1969 Act; or
- (b) made on or after the appointed day by virtue of paragraph 14,

the Corporation shall have power to sell to any person such, if any, of them as are not required for a purpose referable to functions of the Corporation.

- (3) The purchaser of any articles sold in the exercise of powers conferred by this paragraph, and any person claiming through him, shall have power to deal with them in the same manner as if the rights in the registered design were held by or on behalf of the Corporation.

- 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.

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- (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 sub-paragraph (b) thereof to the registered proprietor there were substituted a reference to the licensee ; and
 - (b) in relation to any use of the design by the licensee by virtue of an authority 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.
- 20 (1) Any dispute as to the exercise by the Corporation or a person authorised by it of powers subsisting by virtue of this Part, or as to terms for use thereunder of a design, or any models, documents or information relating to a design, or as to the right of any person to receive any part of a payment made in pursuance of paragraph 16 or any such agreement as is referred to in paragraph 14 may be referred to the court by either party to the dispute in such manner as is prescribed by the rules for the time being in force for the purposes of paragraph 3(1) of Schedule 1 to the Registered Designs Act 1949.
- (2) Sub-paragraphs (2) to (5) of paragraph 3 of the said Schedule shall have effect in relation to proceedings under sub-paragraph (1) and disputes that may be determined thereunder as they do in relation to proceedings and disputes that may be determined under sub-paragraph (1) of the said paragraph 3, but subject to the modifications that—
 - (a) in sub-paragraph (2), for references to a government department there shall be substituted references to the Corporation;
 - (b) in sub-paragraph (3), for the references to paragraph 1 of that Schedule and to the opinion of the government department there shall be substituted respectively references to paragraph 16(a) and to the opinion of the Secretary of State stated in a certificate signed by him ; and
 - (c) in sub-paragraph (4), for the first reference to a government department there shall be substituted a reference to the Post Office, for the second such

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reference there shall be substituted a reference to the department of the Postmaster General or the Post Office, and the reference to the services of the Crown shall include a reference to the purposes of the Post Office.

- (3) Any proceedings under the said paragraph 3 which are in progress immediately before the appointed day, being proceedings to which the Post Office is a party and which, if they had been commenced on or after that day, would have been commenced under this paragraph, may be continued with the substitution of the Corporation for the Post Office.
- 21 (1) Where, in pursuance of an agreement to which this Schedule applies, being an agreement made in relation to a design, communication of the design is made to the Corporation or a person authorised by it to consider the merits of the design, an application for the registration of the design shall not be invalidated by reason only of that communication or of anything done in consequence thereof.
- (2) An authorisation to consider the merits of a design given under subsection (3) of section 6 of the Registered Designs Act 1949 which is in force immediately before the appointed day and has effect as if given by the Post Office shall, so far as may be necessary in consequence of the enactment of Part I of this Act, have effect on and after that day as if given by the Corporation and, in relation to that design, the said subsection (3) shall have effect as if references to a government department included references to the Corporation.
- 22 Expressions to which meanings are assigned by the Registered Designs Act 1949 for the purposes of that Act have those meanings also for the purposes of this Part.