

## SCHEDULES

### SCHEDULE 3

Section 272.

#### REGISTERED DESIGNS: MINOR AND CONSEQUENTIAL AMENDMENTS OF 1949 ACT

##### *Section 3: proceedings for registration*

1 In section 3 of the Registered Designs Act 1949 (proceedings for registration) for subsections (2) to (6) substitute—

“(2) An application for the registration of a design in which design right subsists shall not be entertained unless made by the person claiming to be the design right owner.

(3) For the purpose of deciding whether a design is new, the registrar may make such searches, if any, as he thinks fit.

(4) The registrar may, in such cases as may be prescribed, direct that for the purpose of deciding whether a design is new an application shall be treated as made on a date earlier or later than that on which it was in fact made.

(5) The registrar may refuse an application for the registration of a design or may register the design in pursuance of the application subject to such modifications, if any, as he thinks fit; and a design when registered shall be registered as of the date on which the application was made or is treated as having been made.

(6) An application 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.

(7) An appeal lies from any decision of the registrar under this section.”.

##### *Section 4: registration of same design in respect of other articles, etc.*

2 In section 4 of the Registered Designs Act 1949 (registration of same design in respect of other articles, etc.), in subsection (1), for the proviso substitute—

“Provided that the right in a design registered by virtue of this section shall not extend beyond the end of the period, and any extended period, for which the right subsists in the original registered design.”.

##### *Section 5: provisions for secrecy of certain designs*

3 (1) Section 5 of the Registered Designs Act 1949 is amended as follows.

(2) For “a competent authority” or “the competent authority”, wherever occurring, substitute “the Secretary of State”; and in subsection (3)(c) for “that authority” substitute “he”.

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(3) For subsection (2) substitute—

“(2) The Secretary of State shall by rules make provision for securing that where such directions are given—

- (a) the representation or specimen of the design, and
- (b) any evidence filed in support of the applicant’s contention that the appearance of an article is material (for the purposes of section 1(3) of this Act),

shall not be open to public inspection at the Patent Office during the continuance in force of the directions.”

(4) In subsection (3)(b) after “representation or specimen of the design” insert “, or any such evidence as is mentioned in subsection (2)(b) above,”.

(5) Omit subsection (5).

*Section 6: provisions as to confidential disclosure, etc.*

4 (1) Section 6 of the Registered Designs Act 1949 (provisions as to confidential disclosure, etc.) is amended as follows.

(2) In subsection (2) (display of design at certified exhibition), in paragraph (a) for “certified by the Board of Trade” substitute “certified by the Secretary of State”.

(3) For subsections (4) and (5) (registration of designs corresponding to copyright artistic works) substitute—

“(4) Where an application is made by or with the consent of the owner of copyright in an artistic work for the registration of a corresponding design, the design shall not be treated for the purposes of this Act as being other than new by reason only of any use previously made of the artistic work, subject to subsection (5).

(5) Subsection (4) does not apply if the previous use consisted of or included the sale, letting for hire or offer or exposure for sale or hire of articles to which had been applied industrially—

- (a) the design in question, or
- (b) a design differing from it only in immaterial details or in features which are variants commonly used in the trade,

and that previous use was made by or with the consent of the copyright owner.

(6) The Secretary of State may make provision by rules as to the circumstances in which a design is to be regarded for the purposes of this section as “applied industrially” to articles, or any description of articles.”.

*Section 9: exemption of innocent infringer from liability for damages*

5 In section 9 of the Registered Designs Act 1949 (exemption of innocent infringer from liability for damages), in subsections (1) and (2) for “copyright in a registered design” substitute “the right in a registered design”.

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

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*Section 11: cancellation of registration*

- 6 (1) Section 11 of the Registered Designs Act 1949 (cancellation of registration) is amended as follows.
- (2) In subsection (2) omit “or original”.
- (3) For subsections (2A) and (3) substitute—
- “(3) At any time after a design has been registered, any person interested may apply to the registrar for the cancellation of the registration on the ground that—
- (a) the design was at the time it was registered a corresponding design in relation to an artistic work in which copyright subsisted, and
  - (b) the right in the registered design has expired in accordance with section 8(4) of this Act (expiry of right in registered design on expiry of copyright in artistic work);
- and the registrar may make such order on the application as he thinks fit.
- (4) A cancellation under this section takes effect—
- (a) in the case of cancellation under subsection (1), from the date of the registrar’s decision,
  - (b) in the case of cancellation under subsection (2), from the date of registration,
  - (c) in the case of cancellation under subsection (3), from the date on which the right in the registered design expired, or, in any case, from such other date as the registrar may direct.
- (5) An appeal lies from any order of the registrar under this section.”.

*Section 14: registration where application has been made in convention country*

- 7 In section 14 of the Registered Designs Act 1949 (registration where application has been made in convention country), for subsections (2) and (3) substitute—
- “(2) Where an application for registration of a design is made by virtue of this section, the application shall be treated, for the purpose of determining whether that or any other design is new, as made on the date of the application for protection in the convention country or, if more than one such application was made, on the date of the first such application.
- (3) Subsection (2) shall not be construed as excluding the power to give directions under section 3(4) of this Act in relation to an application made by virtue of this section.”.

*Section 15: extension of time for application under s.14 in certain cases*

- 8 In section 15(1) of the Registered Designs Act 1949 (power to make rules empowering registrar to extend time for applications under s.14) for “the Board of Trade are satisfied” substitute “the Secretary of State is satisfied” and for “they” substitute “he”.

*Section 16: protection of designs communicated under international agreements*

- 9 In section 16 of the Registered Designs Act 1949 (protection of designs communicated under international agreements)—
- (a) in subsection (1) for “the Board of Trade” substitute “the Secretary of State”, and
  - (b) in subsection (3) for “the Board of Trade” substitute “the Secretary of State” and for “the Board are satisfied” substitute “the Secretary of State is satisfied”.

*Section 19: registration of assignments, &c.*

- 10 In section 19 of the Registered Designs Act 1949 (registration of assignments, &c.), after subsection (3) insert—
- “(3A) Where design right subsists in a registered design, the registrar shall not register an interest under subsection (3) unless he is satisfied that the person entitled to that interest is also entitled to a corresponding interest in the design right.
- (3B) Where design right subsists in a registered design and the proprietor of the registered design is also the design right owner, an assignment of the design right shall be taken to be also an assignment of the right in the registered design, unless a contrary intention appears.”.

*Section 20: rectification of the register*

- 11 In section 20 of the Registered Designs Act 1949 (rectification of the register), after subsection (4) add—
- “(5) A rectification of the register under this section has effect as follows—
- (a) an entry made has effect from the date on which it should have been made,
  - (b) an entry varied has effect as if it had originally been made in its varied form, and
  - (c) an entry deleted shall be deemed never to have had effect, unless, in any case, the court directs otherwise.”.

*Section 22: inspection of registered designs*

- 12 (1) Section 22 of the Registered Designs Act 1949 (inspection of registered designs) is amended as follows.
- (2) For subsection (1) substitute—
- “(1) Where a design has been registered under this Act, there shall be open to inspection at the Patent Office on and after the day on which the certificate of registration is issued—
- (a) the representation or specimen of the design, and
  - (b) any evidence filed in support of the applicant’s contention that the appearance of an article is material (for the purposes of section 1(3) of this Act).
- This subsection has effect subject to the following provisions of this section and to any rules made under section 5(2) of this Act.”.

- (3) In subsection (2), subsection (3) (twice) and subsection (4) for “representation or specimen of the design” substitute “representation, specimen or evidence”.

*Section 23: information as to existence of right in registered design*

- 13 For section 23 of the Registered Designs Act 1949 (information as to existence of right in registered design) substitute—

**“23 Information as to existence of right in registered design**

On the request of a person furnishing such information as may enable the registrar to identify the design, and on payment of the prescribed fee, the registrar shall inform him—

- (a) whether the design is registered and, if so, in respect of what articles, and
- (b) whether any extension of the period of the right in the registered design has been granted,

and shall state the date of registration and the name and address of the registered proprietor.”.

*Section 25: certificate of contested validity of registration*

- 14 In section 25 of the Registered Designs Act 1949 (certificate of contested validity of registration), in subsection (2) for “the copyright in the registered design” substitute “the right in the registered design”.

*Section 26: remedy for groundless threats of infringement proceedings*

- 15 (1) Section 26 of the Registered Designs Act 1949 (remedy for groundless threats of infringement proceedings) is amended as follows.
- (2) In subsections (1) and (2) for “the copyright in a registered design” substitute “the right in a registered design”.
- (3) After subsection (2) insert—
- “(2A) Proceedings may not be brought under this section in respect of a threat to bring proceedings for an infringement alleged to consist of the making or importing of anything.”.

*Section 27: the court*

- 16 For section 27 of the Registered Designs Act 1949 (the court) substitute—

**“27 The court**

- (1) In this Act “the court” means—
- (a) in England and Wales the High Court or any patents county court having jurisdiction by virtue of an order under section 287 of the Copyright, Designs and Patents Act 1988,
  - (b) in Scotland, the Court of Session, and
  - (c) in Northern Ireland, the High Court.

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- (2) Provision may be made by rules of court with respect to proceedings in the High Court in England and Wales for references and applications under this Act to be dealt with by such judge of that court as the Lord Chancellor may select for the purpose.”.

*Section 28: the Appeal Tribunal*

- 17 (1) Section 28 of the Registered Designs Act 1949 (the Appeal Tribunal) is amended as follows.
- (2) For subsection (2) (members of Tribunal) substitute—
- “(2) The Appeal Tribunal shall consist of—
- (a) one or more judges of the High Court nominated by the Lord Chancellor, and
- (b) one judge of the Court of Session nominated by the Lord President of that Court.”.
- (3) In subsection (5) (costs), after “costs” (twice) insert “or expenses”, and for the words from “and any such order” to the end substitute—
- “and any such order may be enforced—
- (a) in England and Wales or Northern Ireland, in the same way as an order of the High Court;
- (b) in Scotland, in the same way as a decree for expenses granted by the Court of Session.”.
- (4) For subsection (10) (seniority of judges) substitute—
- “(10) In this section “the High Court” means the High Court in England and Wales; and for the purposes of this section the seniority of judges shall be reckoned by reference to the dates on which they were appointed judges of that court or the Court of Session.”.
- (5) The amendments to section 28 made by section 10(5) of the Administration of Justice Act 1970 (power to make rules as to right of audience) shall be deemed always to have extended to Northern Ireland.

*Section 29: exercise of discretionary powers of registrar*

- 18 In section 29 of the Registered Designs Act 1949 (exercise of discretionary powers of registrar) for “the registrar shall give” substitute “rules made by the Secretary of State under this Act shall require the registrar to give”.

*Section 30: costs and security for costs*

- 19 For section 30 of the Registered Designs Act 1949 (costs and security for costs) substitute—

**“30 Costs and security for costs**

- (1) Rules made by the Secretary of State under this Act may make provision empowering the registrar, in any proceedings before him under this Act—

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- (a) to award any party such costs as he may consider reasonable, and
  - (b) to direct how and by what parties they are to be paid.
- (2) Any such order of the registrar may be enforced—
- (a) in England and Wales or Northern Ireland, in the same way as an order of the High Court;
  - (b) in Scotland, in the same way as a decree for expenses granted by the Court of Session.
- (3) Rules made by the Secretary of State under this Act may make provision empowering the registrar to require a person, in such cases as may be prescribed, to give security for the costs of—
- (a) an application for cancellation of the registration of a design,
  - (b) an application for the grant of a licence in respect of a registered design, or
  - (c) an appeal from any decision of the registrar under this Act,
- and enabling the application or appeal to be treated as abandoned in default of such security being given.”.

*Section 31: evidence before registrar*

20 For section 31 of the Registered Designs Act 1949 (evidence before registrar) substitute—

**“31 Evidence before registrar**

Rules made by the Secretary of State under this Act may make provision—

- (a) as to the giving of evidence in proceedings before the registrar under this Act by affidavit or statutory declaration;
- (b) conferring on the registrar the powers of an official referee of the Supreme Court as regards the examination of witnesses on oath and the discovery and production of documents; and
- (c) applying in relation to the attendance of witnesses in proceedings before the registrar the rules applicable to the attendance of witnesses in proceedings before such a referee.”.

*Section 32: power of registrar to refuse to deal with certain agents*

21 Section 32 of the Registered Designs Act 1949 (power of registrar to refuse to deal with certain agents) is repealed.

*Section 33: offences under s.5 (secrecy of certain designs)*

22 (1) Section 33 of the Registered Designs Act 1949 (offences under s.5 (secrecy of certain designs)) is amended as follows.

(2) In subsection (1), for paragraphs (a) and (b) substitute—

- “(a) on conviction on indictment to imprisonment for a term not exceeding two years or a fine, or both;
- (b) on summary conviction to imprisonment for a term not exceeding six months or a fine not exceeding the statutory maximum, or both.”.

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- (3) Omit subsection (2).
- (4) The above amendments do not apply in relation to offences committed before the commencement of Part IV.

*Section 34: falsification of register, &c.*

- 23 (1) In section 34 of the Registered Designs Act 1949 (falsification of register, &c.) for “shall be guilty of a misdemeanour” substitute—
  - “shall be guilty of an offence and liable—
  - (a) on conviction on indictment to imprisonment for a term not exceeding two years or a fine, or both;
  - (b) on summary conviction to imprisonment for a term not exceeding six months or a fine not exceeding the statutory maximum, or both.”.
- (2) The above amendment does not apply in relation to offences committed before the commencement of Part IV.

*Section 35: fine for falsely representing a design as registered*

- 24 (1) Section 35 of the Registered Designs Act 1949 (fine for falsely representing a design as registered) is amended as follows.
- (2) In subsection (1) for the words from “a fine not exceeding £50” substitute “a fine not exceeding level 3 on the standard scale”.
- (3) In subsection (2)—
  - (a) for “the copyright in a registered design” substitute “the right in a registered design”;
  - (b) for “subsisting copyright in the design” substitute “subsisting right in the design under this Act”; and
  - (c) for the words from “a fine” to the end substitute “a fine not exceeding level 1 on the standard scale”.
- (4) The amendment in sub-paragraph (2) does not apply in relation to offences committed before the commencement of Part IV.

*Section 35A: offence by body corporate -liability of officers*

- 25 (1) In the Registered Designs Act 1949 after section 35 insert—

**“35A Offence by body corporate: liability of officers**

- (1) Where an offence under this Act committed by a body corporate is proved to have been committed with the consent or connivance of a director, manager, secretary or other similar officer of the body, or a person purporting to act in any such capacity, he as well as the body corporate is guilty of the offence and liable to be proceeded against and punished accordingly.
- (2) In relation to a body corporate whose affairs are managed by its members “director” means a member of the body corporate.”.



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- (2) The above amendment does not apply in relation to offences committed before the commencement of Part IV.

*Section 36: general power to make rules, &c.*

- 26 (1) Section 36 of the Registered Designs Act 1949 (general power to make rules, &c.) is amended as follows.
- (2) In subsection (1) for “the Board of Trade” and “the Board” substitute “the Secretary of State”, and for “as they think expedient” substitute “as he thinks expedient”.
- (3) For the words in subsection (1) from “and in particular” to the end substitute the following subsections—
- “(1A) Rules may, in particular, make provision—
- (a) prescribing the form of applications for registration of designs and of any representations or specimens of designs or other documents which may be filed at the Patent Office, and requiring copies to be furnished of any such representations, specimens or documents;
  - (b) regulating the procedure to be followed in connection with any application or request to the registrar or in connection with any proceeding before him, and authorising the rectification of irregularities of procedure;
  - (c) providing for the appointment of advisers to assist the registrar in proceedings before him;
  - (d) regulating the keeping of the register of designs;
  - (e) authorising the publication and sale of copies of representations of designs and other documents in the Patent Office;
  - (f) prescribing anything authorised or required by this Act to be prescribed by rules.
- (1B) The remuneration of an adviser appointed to assist the registrar shall be determined by the Secretary of State with the consent of the Treasury and shall be defrayed out of money provided by Parliament.”.

*Section 37: provisions as to rules and Orders*

- 27 (1) Section 37 of the Registered Designs Act 1949 (provisions as to rules and orders) is amended as follows.
- (2) Omit subsection (1) (duty to advertise making of rules).
- (3) In subsections (2), (3) and (4) for “the Board of Trade” substitute “the Secretary of State”.

*Section 38: proceedings of the Board of Trade*

- 28 Section 38 of the Registered Designs Act 1949 (proceedings of the Board of Trade) is repealed.

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

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*Section 39: hours of business and excluded days*

- 29 In section 39 of the Registered Designs Act 1949 (hours of business and excluded days), in subsection (1) for “the Board of Trade” substitute “the Secretary of State”.

*Section 40: fees*

- 30 In section 40 of the Registered Designs Act 1949 (fees) for “the Board of Trade” substitute “the Secretary of State”.

*Section 44: interpretation*

- 31 (1) In section 44 of the Registered Designs Act 1949 (interpretation), subsection (1) is amended as follows.
- (2) In the definition of “artistic work” for “the Copyright Act 1956” substitute “Part I of the Copyright, Designs and Patents Act 1988”.
- (3) At the appropriate place insert—
- ““author” in relation to a design, has the meaning given by section 2(3) and (4);”.
- (4) Omit the definition of “copyright”.
- (5) In the definition of “corresponding design”, for the words from “has the same meaning” to the end substitute “, in relation to an artistic work, means a design which if applied to an article would produce something which would be treated for the purposes of Part I of the Copyright, Designs and Patents Act 1988 as a copy of that work;”.
- (6) For the definition of “court” substitute—
- ““the court” shall be construed in accordance with section 27 of this Act;”.
- (7) In the definition of “design” for “subsection (3) of section one of this Act” substitute “section 1(1) of this Act”.
- (8) At the appropriate place insert—
- ““employee”, “employment” and “employer” refer to employment under a contract of service or of apprenticeship;”.
- (9) Omit the definition of “Journal”.
- (10) In the definition of “prescribed” for “the Board of Trade” substitute “the Secretary of State”.

*Section 45: application to Scotland*

- 32 In section 45 of the Registered Designs Act 1949 (application to Scotland), omit paragraphs (1) and (2).

*Section 46: application to Northern Ireland*

- 33 (1) Section 46 of the Registered Designs Act 1949 (application to Northern Ireland) is amended as follows.

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- (2) Omit paragraphs (1) and (2).
- (3) For paragraph (3) substitute—
  - “(3) References to enactments include enactments comprised in Northern Ireland legislation.”.
- (4) After paragraph (3) insert—
  - “(3A) References to the Crown include the Crown in right of Her Majesty’s Government in Northern Ireland.”.
- (5) In paragraph (4) for “a department of the Government of Northern Ireland” substitute “a Northern Ireland department”, and at the end add “and in relation to a Northern Ireland department references to the Treasury shall be construed as references to the Department of Finance and Personnel”.

*Section 47: application to Isle of Man*

- 34 For section 47 of the Registered Designs Act 1949 (application to Isle of Man) substitute—

**“47 Application to Isle of Man**

This Act extends to the Isle of Man, subject to any modifications contained in an Order made by Her Majesty in Council, and accordingly, subject to any such Order, references in this Act to the United Kingdom shall be construed as including the Isle of Man.”.

*Section 47A: territorial waters and the continental shelf*

- 35 In the Registered Designs Act 1949, after section 47 insert—

**“47A Territorial waters and the continental shelf**

- (1) For the purposes of this Act the territorial waters of the United Kingdom shall be treated as part of the United Kingdom.
- (2) This Act applies to things done in the United Kingdom sector of the continental shelf on a structure or vessel which is present there for purposes directly connected with the exploration of the sea bed or subsoil or the exploitation of their natural resources as it applies to things done in the United Kingdom.
- (3) The United Kingdom sector of the continental shelf means the areas designated by order under section 1(7) of the Continental Shelf Act 1964.”.

*Section 48: repeals, savings and transitional provisions*

- 36 In section 48 of the Registered Designs Act 1949 (repeals, savings and transitional provisions), omit subsection (1) (repeals).

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

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*Schedule 1: provisions as to Crown use of registered designs*

- 37 (1) The First Schedule to the Registered Designs Act 1949 (provisions as to Crown use of registered designs) is amended as follows.
- (2) In paragraph 2(1) after “copyright” insert “or design right”.
- (3) In paragraph 3(1) omit “in such manner as may be prescribed by rules of court”.
- (4) In paragraph 4(2) (definition of “period of emergency”) for the words from “the period ending” to “any other period” substitute “a period”.
- (5) For paragraph 4(3) substitute—
- “(3) No Order in Council under this paragraph shall be submitted to Her Majesty unless a draft of it has been laid before and approved by a resolution of each House of Parliament.”.

*Schedule 2: enactments repealed*

- 38 Schedule 2 to the Registered Designs Act 1949 (enactments repealed) is repealed.