
STATUTORY INSTRUMENTS

2006 No. 1975

The Registered Designs Rules 2006

PART 4

PROCEEDINGS HEARD BEFORE THE REGISTRAR

Conduct of proceedings

Procedure for applying for a declaration of invalidity

- 15.**—(1) An application for a declaration of invalidity under section 11ZB shall—
- (a) be made on Form DF19A; and
 - (b) include a statement of the grounds on which the application is made.
- (2) The statement of grounds shall include a concise statement of the facts and grounds on which the applicant relies and shall be verified by a statement of truth.
- (3) The registrar shall send a copy of Form DF19A and the statement of case to the registered proprietor.
- (4) The registrar shall specify a period within which the registered proprietor shall file a counter-statement.
- (5) The registered proprietor, within that period, shall—
- (a) file his counter-statement on Form DF19B; and
 - (b) send a copy of it to the applicant,
- otherwise the registrar may treat him as not opposing the application.
- (6) In his counter-statement the registered proprietor shall—
- (a) include a concise statement of the facts on which he relies;
 - (b) state which of the allegations in the statement of grounds he denies;
 - (c) state which of the allegations he is unable to admit or deny, but which he requires the applicant to prove;
 - (d) state which allegations he admits,
- and it shall be verified by a statement of truth.
- (7) In this Part—
- (a) “statement of case” means the statement of grounds filed by the applicant or the counter-statement filed by the registered proprietor; and
 - (b) references to the statement of case include part of the statement of case.

[^{F1}Invalidation of existing registered Community design: invalidation notice and procedure on application for derogation; Schedule 1A paragraph 9A

- 15A.**—(1) An invalidation notice under paragraph 9A of Schedule 1A must—

- (a) identify the existing registered Community design by the number under which it was registered in the RCD register immediately before IP completion day, together with a representation of the design,
 - (b) be accompanied by a copy of the decision (including any decision determined on appeal) pursuant to which the existing registered Community design was declared to be invalid, and
 - (c) include a statement confirming that the decision pursuant to which the registered Community design was declared invalid (whether wholly or partly) has been finally determined.
- (2) Where an invalidation notice is sent to the registrar by the proprietor of the re-registered design which derives from the existing registered Community design, the invalidation notice must be accompanied by—
 - (a) a notice (a “derogation notice”) in writing to the registrar that, based upon the provisions in paragraph 9A(4) of Schedule 1A, the re-registered design should not be declared invalid (whether wholly or partly), and
 - (b) a statement of the reasons why paragraph 9A of Schedule 1A applies (a “statement”) together with relevant supporting evidence (“supporting evidence”).
- (3) Where the proprietor of a re-registered design submits an invalidation notice to the registrar but fails to send a derogation notice, a statement, or supporting evidence, the registration of the re-registered design which derives from the existing registered Community design identified in the invalidation notice must be declared invalid to the same extent as the existing registered Community design, unless the registrar directs otherwise.
- (4) Where the registrar has received an invalidation notice from a person other than the proprietor of the re-registered design which derives from the existing registered Community design, the registrar must as soon as reasonably practicable after receipt of the invalidation notice—
 - (a) send a copy of the invalidation notice to the proprietor of the re-registered design which derives from the existing registered Community design identified in the invalidation notice, and
 - (b) notify the proprietor of the re-registered design which derives from the existing registered Community design that based upon the declaration of invalidity of the existing registered Community design, the re-registered design will be declared invalid to the same extent as the existing registered Community design from which it derives.
- (5) Where the registrar has become aware of the situation referred to in paragraph 9A of Schedule 1A otherwise than by an invalidation notice, the registrar must as soon as reasonably practicable after becoming aware of that situation notify the proprietor of the re-registered design which derives from the existing registered Community design in the terms provided in paragraph (4) (b).
- (6) The proprietor of the re-registered design referred to in paragraphs (4) and (5) must, within such period of not less than one month as may be specified in the notice referred to in paragraphs (4)(b) and 5, send to the registrar a derogation notice accompanied by a statement and supporting evidence as referred to in paragraph (2), failing which the registration of the re-registered design must be declared invalid to the same extent as the registered Community design from which the re-registered design derives, unless the registrar directs otherwise.
- (7) The registrar must, in reaching a decision as to whether paragraph 9A of Schedule 1A applies to a re-registered design, have regard to the statement and supporting evidence filed by the proprietor of the re-registered design and must send written notice of the decision to the proprietor, stating the reasons for that decision.

(8) For the purposes of any appeal against a decision referred to in sub-paragraph (7), the date on which the notice is sent must be taken to be the date of the decision.]

Textual Amendments

- F1** Rule 15A inserted by [The Designs and International Trade Marks \(Amendment etc.\) \(EU Exit\) Regulations 2019 \(S.I. 2019/638\)](#), reg. 1, **Sch. 6 para. 3A** (as inserted by [S.I. 2020/1050](#), regs. 1(2), **24(b)**); 2020 c. 1, **Sch. 5 para. 1(1)**

Evidence rounds

16.—(1) When the period specified under rule 15(4) has expired, the registrar shall specify the periods within which evidence may be filed by the parties.

(2) Where the applicant for a declaration of invalidity files no evidence (other than his statement of grounds) in support of his application, the registrar may treat him as having withdrawn his application.

(3) The registrar may, at any time if he thinks fit, give leave to either party to file evidence upon such terms as he thinks fit.

(4) Under this rule, evidence shall only be considered to be filed when—

- (a) it has been received by the registrar; and
- (b) it has been sent to all other parties to the proceedings.

(5) The registrar shall give the parties an opportunity to be heard.

(6) Where any party requests to be heard, the registrar shall send to the parties notice of a date for the hearing.

Decision of registrar on invalidity

17.—(1) When the registrar has made a decision on the application for a declaration of invalidity, he shall send to the parties written notice of it, stating the reasons for his decision.

(2) The date on which the decision was sent to the applicant shall be deemed to be the date of the decision for the purposes of any appeal.

Exercise of discretionary powers of registrar

18. The registrar shall give to any applicant for registration of a design an opportunity to be heard before exercising adversely to the applicant any discretion vested in the registrar by or under the Act.

General powers of registrar in relation to proceedings before him

19.—(1) The registrar may extend or shorten (or further extend or shorten) any period which has been specified under any provision of this Part.

(2) At any stage of proceedings before him, the registrar may direct that the parties to the proceedings attend a case management conference or pre-hearing review.

(3) Except where the Act or these Rules otherwise provide, the registrar may give such directions as to the management of the proceedings as he thinks fit, and in particular he may—

- (a) require a document, information or evidence to be filed;
- (b) require a translation of any document;
- (c) require a party or a party's legal representative to attend a hearing;

- (d) hold a hearing and receive evidence by telephone or by using any other method of direct oral communication;
 - (e) allow a statement of case to be amended;
 - (f) stay the whole, or any part, of the proceedings either generally or until a specified date or event;
 - (g) consolidate proceedings;
 - (h) direct that part of any proceedings be dealt with as separate proceedings.
- (4) The registrar may control the evidence by giving directions as to—
- (a) the issues on which he requires evidence;
 - (b) the nature of the evidence which he requires to decide those issues; and
 - (c) the way in which the evidence is to be placed before him,
- and the registrar may use his power under this paragraph to exclude evidence which would otherwise be admissible.
- (5) When the registrar gives directions under any provision of this Part, he may—
- (a) make them subject to conditions; and
 - (b) specify the consequences of failure to comply with the directions or a condition.

Modifications etc. (not altering text)

C1 Rule 19 applied (6.4.2015) by [The Appointed Person \(Designs\) Rules 2015 \(S.I. 2015/169\)](#), [rules 1, 7\(4\)](#)

Hearings in public

- 20.**—(1) Subject to paragraphs (3) and (4), any hearing before the registrar of proceedings between two or more parties relating to an application for a registered design or a registered design, shall be held in public.
- (2) Any party to the proceedings may apply to the registrar for the hearing to be held in private.
- (3) The registrar shall only grant an application under paragraph (2) where—
- (a) it is in the interests of justice for the hearing to be in held in private; and
 - (b) all the parties to the proceedings have had an opportunity to be heard on the matter,
- and where the application is granted the hearing shall be in private.
- (4) Any hearing of an application under paragraph (2) shall be held in private.
- (5) In this rule a reference to a hearing includes any part of a hearing.
- ^{F2}(6)

Textual Amendments

F2 Rule 20(6) omitted (3.11.2008) by virtue of [The Tribunals, Courts and Enforcement Act 2007 \(Transitional and Consequential Provisions\) Order 2008 \(S.I. 2008/2683\)](#), [art. 1, Sch. 1 para. 318](#)

Modifications etc. (not altering text)

C2 Rule 20 applied (6.4.2015) by [The Appointed Person \(Designs\) Rules 2015 \(S.I. 2015/169\)](#), [rules 1, 7\(5\)](#)

Evidence in proceedings before the registrar

- 21.**—(1) Subject as follows, evidence filed under this Part may be given—
- (a) by witness statement, statement of case, affidavit, statutory declaration; or
 - (b) in any other form which would be admissible as evidence in proceedings before the court.
- (2) A witness statement or a statement of case may only be given in evidence if it includes a statement of truth.
- (3) The general rule is that evidence at hearings is to be by witness statement unless the registrar or any enactment requires otherwise.
- (4) For the purposes of this Part, a statement of truth—
- (a) means a statement that the person making the statement believes that the facts stated in a particular document are true; and
 - (b) shall be dated and signed by—
 - (i) in the case of a witness statement, the maker of the statement,
 - (ii) in any other case, the party or his legal representative.
- (5) In this Part, a witness statement is a written statement signed by a person that contains the evidence which that person would be allowed to give orally.

Changes to legislation:

There are currently no known outstanding effects for the The Registered Designs Rules 2006, Conduct of proceedings.