
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.

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no evidence (other than his statement of grounds) in support of his application, the registrar may treat him as having withdrawn his application.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.

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 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.

(6) Nothing in this rule shall prevent a member of the Council of Tribunals or of its Scottish Committee from attending a hearing.

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.

Miscellaneous

Costs of proceedings

22. The registrar may, in any proceedings before him under the Act, award to any party by order such costs as he considers reasonable, and direct how and by what parties they are to be paid.

Security for costs

23.—(1) The registrar may require a person to give security for the costs of any application or appeal mentioned in section 30(3) if—

- (a) he is satisfied, having regard to all the circumstances of the case, that it is just to require such security; and
- (b) one or more of the conditions in paragraph (2) applies.

(2) The conditions are—

- (a) the person is resident outside the United Kingdom but—
 - (i) not resident in a Brussels Contracting State,
 - (ii) a Lugano Contracting State, or
 - (iii) a Regulation State,

as defined in section 1(3) of the Civil Jurisdiction and Judgments Act 1982⁽¹⁾;

- (b) the person is a company or other body (whether incorporated inside or outside the United Kingdom) and there is reason to believe that it will be unable to pay the other person's costs if ordered to do so;
- (c) the person has changed his address since filing an address for service with a view to evading the consequences of the proceedings;
- (d) the person has furnished an incorrect address for service;
- (e) the person has taken steps in relation to his assets that would make it difficult to enforce an order for costs against him;
- (f) the person has failed to pay a costs order in relation to previous proceedings before the registrar or a court (whether or not the proceedings were between the same parties).

(3) In default of such security being given the registrar may treat the application or appeal as abandoned.

Registrar shall have the powers of official referee

24. The registrar shall have the powers of an official referee of the Supreme Court as regards—

- (a) the attendance of witnesses and their examination on oath; and
- (b) the discovery and production of documents,

but he shall have no power to punish summarily for contempt.

Minimum notice of hearing

25. The registrar shall not give a person less than 14 days notice of any hearing under the Act.

(1) 1982 c. 27.