STATUTORY INSTRUMENTS

2013 No. 2533

DESIGNS

The Registered Designs (Isle of Man) Order 2013

Made - - - -	*9th October 2013*
Coming into force - -	*11th November 2013*

At the Court at Buckingham Palace, the 9th day of October 2013
Present,
The Queen's Most Excellent Majesty in Council

Her Majesty, in exercise of the powers conferred upon Her by sections 37(5) and 47 of the Registered Designs Act 1949(**1**) and section 304(4) and (6) of the Copyright, Designs and Patents Act 1988(**2**), is pleased, by and with the advice of Her Privy Council, to make the following Order:

Citation and commencement

1. This Order may be cited as the Registered Designs (Isle of Man) Order 2013 and shall come into force on 11th November 2013.

Commencement Information
I1 Art. 1 in force at 11.11.2013, see **art. 1**

Interpretation

2. In this Order—

(a) "the 1949 Act" means the Registered Designs Act 1949;

(b) "the 1988 Act" means the Copyright, Designs and Patents Act 1988.

Commencement Information
I2 Art. 2 in force at 11.11.2013, see **art. 1**

(**1**) 1949 c.88.
(**2**) 1988 c.48. Provisions of the 1988 Act relating to designs were extended to the Isle of Man with modifications by SI 1989/1292 and 1990/1505.

Modification of the 1949 and 1988 Acts in their application to the Isle of Man

3.—(1) The 1949 Act shall have effect in the Isle of Man subject to the modifications specified in Schedule 1 to this Order.

(2) Part IV (registered designs) of, and Schedules 3 and 4 to, the 1988 Act shall extend to the Isle of Man subject to the exceptions and modifications specified in Schedule 2 to this Order.

Commencement Information

I3 Art. 3 in force at 11.11.2013, see **art. 1**

Revocation

4.—(1) The Registered Designs (Isle of Man) Order 2001(**3**) is revoked.

(2) Nothing in paragraph (1) affects the further modifications of the 1949 Act having effect under Schedule 2 to that Order in relation to registrations under that Act made, and applications for registration made but not determined, before the coming into force of that Order.

Commencement Information

I4 Art. 4 in force at 11.11.2013, see **art. 1**

Richard Tilbrook
Clerk of the Privy Council

(**3**) S.I. 2001/3678.

SCHEDULE 1

Article 3

Modifications of the Registered Designs Act 1949 in its application to the Isle of Man

1. References to the Crown shall be construed as including the Crown in right of the Government of the Isle of Man.

Commencement Information
I5 Sch. 1 para. 1 in force at 11.11.2013, see **art. 1**

2.—(1) References to an Act of Parliament (including the 1949 Act and the 1988 Act) or to a provision of such an Act shall be construed as references to that Act or provision as it has effect in the Isle of Man.

(2) References to an Act of Tynwald shall be construed as references to it as amended or replaced by or under any other such enactment.

Commencement Information
I6 Sch. 1 para. 2 in force at 11.11.2013, see **art. 1**

3. References to a government department shall be construed as including references to a Department of the Government of the Isle of Man, and in relation to such a Department as if references to the Treasury were references to the Treasury of the Isle of Man.

Commencement Information
I7 Sch. 1 para. 3 in force at 11.11.2013, see **art. 1**

4. Notwithstanding section 47, any reference to the United Kingdom which occurs in the expression "His Majesty's Government in the United Kingdom" does not include the Isle of Man.

Commencement Information
I8 Sch. 1 para. 4 in force at 11.11.2013, see **art. 1**

5. For section 1 substitute—

"**Registration of designs**

1.—(1) A design may, subject to the following provisions of this Act, be registered under this Act on the making of an application for registration.

(2) In this Act "design" means the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture or materials of the product or its ornamentation.

(3) In this Act—

"complex product" means a product which is composed of at least two replaceable component parts permitting disassembly and reassembly of the product; and

"product" means any industrial or handicraft item other than a computer program; and, in particular, includes packaging, get-up, graphic symbols, typographic type-faces and parts intended to be assembled into a complex product.

Requirement of novelty and individual character

1B.—(1) A design shall be protected by a right in a registered design to the extent that the design is new and has individual character.

(2) For the purposes of subsection (1) above, a design is new if no identical design or no design whose features differ only in immaterial details has been made available to the public before the relevant date.

(3) For the purposes of subsection (1) above, a design has individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design which has been made available to the public before the relevant date.

(4) In determining the extent to which a design has individual character, the degree of freedom of the author in creating the design shall be taken into consideration.

(5) For the purposes of this section, a design has been made available to the public before the relevant date if—

(a) it has been published (whether following registration or otherwise), exhibited, used in trade or otherwise disclosed before that date; and

(b) the disclosure does not fall within subsection (6) below.

(6) A disclosure falls within this subsection if—

(a) it could not reasonably have become known before the relevant date in the normal course of business to persons carrying on business in **[**[F1]the geographical area comprising the United Kingdom and the European Economic Area**]** and specialising in the sector concerned;

(b) it was made to a person other than the designer, or any successor in title of his, under conditions of confidentiality (whether express or implied);

(c) it was made by the designer, or any successor in title of his, during the period of 12 months immediately preceding the relevant date;

(d) it was made by a person other than the designer, or any successor in title of his, during the period of 12 months immediately preceding the relevant date in consequence of information provided or other action taken by the designer or any successor in title of his; or

(e) it was made during the period of 12 months immediately preceding the relevant date as a consequence of an abuse in relation to the designer or any successor in title of his.

(7) In subsections (2), (3), (5) and (6) above "the relevant date" means the date on which the application for the registration of the design was made or is treated by virtue of section 3B(2), (3) or (5) or 14(2) of this Act as having been made.

(8) For the purposes of this section, a design applied to or incorporated in a product which constitutes a component part of a complex product shall only be considered to be new and to have individual character—

(a) if the component part, once it has been incorporated into the complex product, remains visible during normal use of the complex product; and

(b) to the extent that those visible features of the component part are in themselves new and have individual character.

(9) In subsection (8) above "normal use" means use by the end user; but does not include any maintenance, servicing or repair work in relation to the product.

Designs dictated by their technical function

1C.—(1) A right in a registered design shall not subsist in features of appearance of a product which are solely dictated by the product's technical function.

(2) A right in a registered design shall not subsist in features of appearance of a product which must necessarily be reproduced in their exact form and dimensions so as to permit the product in which the design is incorporated or to which it is applied to be mechanically connected to, or placed in, around or against, another product so that either product may perform its function.

(3) Subsection (2) above does not prevent a right in a registered design subsisting in a design serving the purpose of allowing multiple assembly or connection of mutually interchangeable products within a modular system.

Designs contrary to public policy or morality

1D. A right in a registered design shall not subsist in a design which is contrary to public policy or to accepted principles of morality.".

Textual Amendments

F1 Words in Sch. 1 para. 5 substituted (31.12.2020) by The Registered Designs and Trade Marks (Isle of Man) (Amendment) (EU Exit) Order 2019 (S.I. 2019/1335), art. 1, **Sch. 1 para. 2**; 2020 c. 1, Sch. 5 para. 1(1)

Commencement Information

I9 Sch. 1 para. 5 in force at 11.11.2013, see **art. 1**

6. In section 2(2), omit—

(a) the words from ", or the" to "any article,"; and

(b) the words from "or as", in the second place, onwards.

Commencement Information

I10 Sch. 1 para. 6 in force at 11.11.2013, see **art. 1**

7. For section 3 substitute—

"**Applications for registration**

3.—(1) An application for the registration of a design or designs shall be made in the prescribed form and shall be filed at the Patent Office in the prescribed manner.

(2) An application for the registration of a design or designs shall be made by the person claiming to be the proprietor of the design or designs.

(3) An application for the registration of a design or designs in which national unregistered design right subsists shall be made by the person claiming to be the design right owner.

(5) An application for the registration of a design 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.

Determination of applications for registration

3A.—(1) Subject as follows, the registrar shall not refuse to register a design included in an application under this Act.

(2) If it appears to the registrar that an application for the registration of a design or designs has not been made in accordance with any rules made under this Act, he may refuse to register any design included in it.

(3) If it appears to the registrar that the applicant is not under section 3(2) or (3) or 14 entitled to apply for the registration of a design included in the application, he shall refuse to register that design.

(4) If it appears to the registrar that the application for registration includes—

(a) something which does not fulfil the requirements of section 1(2) of this Act;

(b) a design that does not fulfil the requirements of section 1C or 1D of this Act; or

(c) a design to which a ground of refusal mentioned in Schedule A1 to this Act applies,

he shall refuse to register that thing or that design.

Modification of applications for registration

3B.—(1) The registrar may, at any time before an application for the registration of a design or designs is determined, permit the applicant to make such modifications of the application as the registrar thinks fit.

(2) Where an application for the registration of a design or designs has been modified before it has been determined in such a way that any design included in the application has been altered significantly, the registrar may, for the purpose of deciding whether and to what extent the design is new or has individual character, direct that the application so far as relating to that design shall be treated as having been made on the date on which it was so modified.

(3) Where—

(a) an application for the registration of more than one design has been modified before it has been determined to exclude one or more designs from the application; and

(b) a subsequent application for the registration of a design so excluded has, within such period (if any) as has been prescribed for such applications, been made by the person who made the earlier application or his successor in title,

the registrar may, for the purpose of deciding whether and to what extent the design is new or has individual character, direct that the subsequent application shall be treated as having been made on the date on which the earlier application was, or is treated as having been, made.

(4) Where the registration of a design has been refused on any ground mentioned in section 3A(4)(b) or (c) of this Act, the application for the design may be modified by the applicant if it appears to the registrar that—

(a) the identity of the design is retained; and

(b) the modifications have been made in accordance with any rules made under this Act.

(5) An application modified under subsection (4) above shall be treated as the original application and, in particular, as made on the date on which the original application was made or is treated as having been made.

(6) Any modification under this section may, in particular, be effected by making a partial disclaimer in relation to the application.

Date of registration of designs

3C.—(1) Subject as follows, a design, when registered, shall be registered as of the date on which the application was made or is treated as having been made.

(2) Subsection (1) above shall not apply to an application which is treated as having been made on a particular date by section 14(2) of this Act or by virtue of the operation of section 3B(3) or (5) of this Act by reference to section 14(2) of this Act.

(3) A design, when registered, shall be registered as of—

(a) in the case of an application which is treated as having been made on a particular date by section 14(2) of this Act, the date on which the application was made;

(b) in the case of an application which is treated as having been made on a particular date by virtue of the operation of section 3B(3) of this Act by reference to section 14(2) of this Act, the date on which the earlier application was made;

(c) in the case of an application which is treated as having been made on a particular date by virtue of the operation of section 3B(5) of this Act by reference to section 14(2) of this Act, the date on which the original application was made.

Appeals in relation to applications for registration

3D. An appeal lies from any decision of the registrar under section 3A or 3B of this Act.”.

Commencement Information
I11 Sch. 1 para. 7 in force at 11.11.2013, see **art. 1**

8. Omit section 4.

Commencement Information
I12 Sch. 1 para. 8 in force at 11.11.2013, see **art. 1**

9.—(1) In section 5(2) (provisions for secrecy of certain designs), omit paragraph (b) and the word “and” immediately before it.

(2) In section 5(3)(b), omit the words from “, or any” to “above,”.

Commencement Information
I13 Sch. 1 para. 9 in force at 11.11.2013, see **art. 1**

10. Omit section 6.

Commencement Information

I14 Sch. 1 para. 10 in force at 11.11.2013, see **art. 1**

11. For section 7 substitute—

"**Right given by registration**

7.—(1) The registration of a design under this Act gives the registered proprietor the exclusive right to use the design and any design which does not produce on the informed user a different overall impression.

(2) For the purposes of subsection (1) above and section 7A of this Act any reference to the use of a design includes a reference to—

(a) the making, offering, putting on the market, importing, exporting or using of a product in which the design is incorporated or to which it is applied; or

(b) stocking such a product for those purposes.

(3) In determining for the purposes of subsection (1) above whether a design produces a different overall impression on the informed user, the degree of freedom of the author in creating his design shall be taken into consideration.

(4) The right conferred by subsection (1) above is subject to any limitation attaching to the registration in question (including, in particular, any partial disclaimer or any declaration by the registrar or a court of partial invalidity).

Infringements of rights in registered designs

7A.—(1) Subject as follows, the right in a registered design is infringed by a person who, without the consent of the registered proprietor, does anything which by virtue of section 7 of this Act is the exclusive right of the registered proprietor.

(2) The right in a registered design is not infringed by—

(a) an act which is done privately and for purposes which are not commercial;

(b) an act which is done for experimental purposes;

(c) an act of reproduction for teaching purposes or for the purpose of making citations provided that the conditions mentioned in subsection (3) below are satisfied;

(d) the use of equipment on ships or aircraft which are registered in another country but which are temporarily in the United Kingdom;

(e) the importation into the United Kingdom of spare parts or accessories for the purpose of repairing such ships or aircraft; or

(f) the carrying out of repairs on such ships or aircraft.

(3) The conditions mentioned in this subsection are—

(a) the act of reproduction is compatible with fair trade practice and does not unduly prejudice the normal exploitation of the design; and

(b) mention is made of the source.

(4) The right in a registered design is not infringed by an act which relates to a product in which any design protected by the registration is incorporated or to which it is applied if the product has been put on the market in **[**[F2]the United Kingdom or**]** the European Economic Area by the registered proprietor or with his consent.

(5) The right in a registered design of a component part which may be used for the purpose of the repair of a complex product so as to restore its original appearance is not infringed by the use for that purpose of any design protected by the registration.

(6) No proceedings shall be taken in respect of an infringement of the right in a registered design committed before the date on which the certificate of registration of the design under this Act is granted.”.

Textual Amendments

F2 Words in Sch. 1 para. 11 inserted (31.12.2020) by The Registered Designs and Trade Marks (Isle of Man) (Amendment) (EU Exit) Order 2019 (S.I. 2019/1335), art. 1, **Sch. 1 para. 3**; 2020 c. 1, Sch. 5 para. 1(1)

Commencement Information

I15 Sch. 1 para. 11 in force at 11.11.2013, see **art. 1**

12. Omit section 8(5) and (6) (duration of right in registered design)(**4**).

Commencement Information

I16 Sch. 1 para. 12 in force at 11.11.2013, see **art. 1**

13. In section 8A(5) (restoration of lapsed right in design)(**5**)—

(a) for “proprietor took reasonable care” substitute “failure of the proprietor”;

(b) after “8(2) or (4)” insert “was unintentional”.

Commencement Information

I17 Sch. 1 para. 13 in force at 11.11.2013, see **art. 1**

14. In section 8B(6) (effect of order for restoration of right)(**6**)—

(a) for “an article” substitute “a product”; and

(b) for “the article” substitute “the product”.

Commencement Information

I18 Sch. 1 para. 14 in force at 11.11.2013, see **art. 1**

15. Omit sections 9 and 10.

Commencement Information

I19 Sch. 1 para. 15 in force at 11.11.2013, see **art. 1**

16. For section 11 substitute—

(**4**) Section 8 was substituted by section 269 of the 1988 Act.
(**5**) Section 8A was inserted by section 269(1) of the 1988 Act.
(**6**) Section 8B was inserted by section 269(1) of the 1988 Act.

"**Cancellation of registration**

11. The registrar may, upon a request made in the prescribed manner by the registered proprietor, cancel the registration of a design.

Grounds for invalidity of registration

11ZA.—(1) The registration of a design may be declared invalid—

(a) on the ground that it does not fulfil the requirements of section 1(2) of this Act;

(b) on the ground that it does not fulfil the requirements of sections 1B to 1D of this Act; or

(c) where any ground of refusal mentioned in Schedule A1 to this Act applies.

(1A) The registration of a design ("the later design") may be declared invalid if it is not new or does not have individual character when compared to a design which—

(a) has been made available to the public on or after the relevant date; but

(b) is protected as from a date prior to the relevant date **[**[F3]by virtue of registration under this Act or an application for such registration.**]**

(1B) In subsection (1A) "the relevant date" means the date on which the application for the registration of the later design was made or is treated by virtue of section 3B(2), (3) or (5) or 14(2) of this Act as having been made.

(2) The registration of a design may be declared invalid on the ground of the registered proprietor not being the proprietor of the design and the proprietor of the design objecting.

(3) The registration of a design involving the use of an earlier distinctive sign may be declared invalid on the ground of an objection by the holder of rights to the sign which include the right to prohibit in the United Kingdom such use of the sign.

(4) The registration of a design constituting an unauthorised use of a work protected by the law of copyright in the United Kingdom may be declared invalid on the ground of an objection by the owner of the copyright.

(5) In this section and sections 11ZB, 11ZC and 11ZE of this Act (other than section 11ZE(1)) references to the registration of a design include references to the former registration of a design; and these sections shall apply, with necessary modifications, in relation to such former registrations.

Applications for declaration of invalidity

11ZB.—(1) Any person interested may make an application to the registrar for a declaration of invalidity under section 11ZA(1)(a) or (b) of this Act.

(2) Any person concerned by the use in question may make an application to the registrar for a declaration of invalidity under section 11ZA(1)(c) of this Act.

(3) The relevant person may make an application to the registrar for a declaration of invalidity under section 11ZA(1A) of this Act.

(4) In subsection (3) above "the relevant person" means, in relation to an earlier design protected by virtue of registration under this Act [F4]... or an application for such registration, the registered proprietor of the design [F5]... or (as the case may be) the applicant.

(5) The person able to make an objection under subsection (2), (3) or (4) of section 11ZA of this Act may make an application to the registrar for a declaration of invalidity under that subsection.

(6) An application may be made under this section in relation to a design at any time after the design has been registered.

Determination of applications for declaration of invalidity

11ZC.—(1) This section applies where an application has been made to the registrar for a declaration of invalidity in relation to a registration.

(2) If it appears to the registrar that the application has not been made in accordance with any rules made under this Act, he may refuse the application.

(3) If it appears to the registrar that the application has not been made in accordance with section 11ZB of this Act, he shall refuse the application.

(4) Subject to subsections (2) and (3) above, the registrar shall make a declaration of invalidity if it appears to him that the ground of invalidity specified in the application has been established in relation to the registration.

(5) Otherwise the registrar shall refuse the application.

(6) A declaration of invalidity may be a declaration of partial invalidity.

Modification of registration

11ZD.—(1) Subsections (2) and (3) below apply where the registrar intends to declare the registration of a design invalid under section 11ZA(1)(b) or (c), (1A), (3) or (4) of this Act.

(2) The registrar shall inform the registered proprietor of that fact.

(3) The registered proprietor may make an application to the registrar for the registrar to make such modifications to the registration of the design as the registered proprietor specifies in his application.

(4) Such modifications may, in particular, include the inclusion on the register of a partial disclaimer by the registered proprietor.

(5) If it appears to the registrar that the application has not been made in accordance with any rules made under this Act, the registrar may refuse the application.

(6) If it appears to the registrar that the identity of the design is not retained or the modified registration would be invalid by virtue of section 11ZA of this Act, the registrar shall refuse the application.

(7) Otherwise the registrar shall make the specified modifications.

(8) A modification of a registration made under this section shall have effect, and be treated always to have had effect, from the grant of registration.

Effect of cancellation or invalidation of registration

11ZE.—(1) A cancellation of registration under section 11 of this Act takes effect from the date of the registrar's decision or from such other date as the registrar may direct.

(2) Where the registrar declares the registration of a design invalid to any extent, the registration shall to that extent be treated as having been invalid from the date of registration or from such other date as the registrar may direct.

Appeals in relation to cancellation or invalidation

11ZF. An appeal lies from any decision of the registrar under section 11 to 11ZE of this Act.".

Textual Amendments

F3 Words in Sch. 1 para. 16 substituted (31.12.2020) by The Registered Designs and Trade Marks (Isle of Man) (Amendment) (EU Exit) Order 2019 (S.I. 2019/1335), art. 1, **Sch. 1 para. 4(a)**; 2020 c. 1, Sch. 5 para. 1(1)

F4 Words in Sch. 1 para. 16 omitted (31.12.2020) by virtue of The Registered Designs and Trade Marks (Isle of Man) (Amendment) (EU Exit) Order 2019 (S.I. 2019/1335), art. 1, **Sch. 1 para. 4(b)(i)**; 2020 c. 1, Sch. 5 para. 1(1)

F5 Words in Sch. 1 para. 16 omitted (31.12.2020) by virtue of The Registered Designs and Trade Marks (Isle of Man) (Amendment) (EU Exit) Order 2019 (S.I. 2019/1335), art. 1, **Sch. 1 para. 4(b)(ii)**; 2020 c. 1, Sch. 5 para. 1(1)

Commencement Information

I20 Sch. 1 para. 16 in force at 11.11.2013, see **art. 1**

17.—(1) In section 11A(1) and (7)(**7**), for "Monopolies Commission" substitute "Competition Commission".

(2) In section 11A(3), omit—

(a) paragraph (b) and the word "or" immediately before it, and

(b) the words from "or may, instead" onwards.

(3) Omit section 11A(4) and (5).

Commencement Information

I21 Sch. 1 para. 17 in force at 11.11.2013, see **art. 1**

18. Omit section 11B.

Commencement Information

I22 Sch. 1 para. 18 in force at 11.11.2013, see **art. 1**

[F6 18A. Before section 13, insert—

"**Application of the Act to certain registered Community designs**

12A. Schedule 1A makes provision—

(a) for registered Community designs (including certain designs whose registration has expired or which have been removed from the register) to be treated as registered under this Act with effect from exit day, and

(b) about certain applications for registered Community designs made before exit day.

Application of the Act to certain international designs

12B. Schedule 1B makes provision—

(7) Sections 11A and 11B were inserted by section 270 of the 1988 Act.

(a) for certain designs which are registered in the international register maintained by the International Bureau of the World Intellectual Property Organization in respect of which the European Union is designated (including certain designs whose registration has expired) to be treated as registered under this Act with effect from exit day, and

(b) about certain applications made before exit day to register in the international register maintained by the International Bureau of the World Intellectual Property Organization a design in respect of which the European Union is designated.”.**]**

Textual Amendments

F6 Sch. 1 para. 18A inserted (31.12.2020) by The Registered Designs and Trade Marks (Isle of Man) (Amendment) (EU Exit) Order 2019 (S.I. 2019/1335), art. 1, **Sch. 1 para. 5**; 2020 c. 1, Sch. 5 para. 1(1)

19.—(1) In section 14(1), after “design” insert “or designs”.

(2) In section 14(2)(**8**)—

(a) after “design” insert “or designs”;

(b) after “whether” insert “(and to what extent)”;

(c) after “is new” insert “or has individual character”.

(3) In section 14(3) for “section 3(4)” substitute “section 3B(2) or (3)”.

Commencement Information

I23 Sch. 1 para. 19 in force at 11.11.2013, see **art. 1**

20. In section 15(2)—

(a) in paragraph (a), for “articles” substitute “products”; and

(b) in paragraph (e)—

(i) for “articles” substitute “products”; and

(ii) after “applied” insert “or in which it is incorporated”.

Commencement Information

I24 Sch. 1 para. 20 in force at 11.11.2013, see **art. 1**

21. After section 15 insert—

“Property in and dealing with registered designs and applications

The nature of registered designs

15A. A registered design or an application for a registered design is personal property (in Scotland, incorporeal moveable property).

(**8**) Section 14(2) and (3) were substituted by paragraph 7 of Schedule 3 to the 1988 Act.

Assignment, &c of registered designs and applications for registered designs

15B.—(1) A registered design or an application for a registered design is transmissible by assignment, testamentary disposition or operation of law in the same way as other personal or moveable property, subject to the following provisions of this section.

(2) Any transmission of a registered design or an application for a registered design is subject to any rights vested in any other person of which notice is entered in the register of designs, or in the case of applications, notice is given to the registrar.

(3) An assignment of, or an assent relating to, a registered design or application for a registered design is not effective unless it is in writing signed by or on behalf of the assignor or, as the case may be, a personal representative.

(4) The requirement in subsection (3) may be satisfied in a case where the assignor or personal representative is a body corporate by the affixing of its seal.

(5) Subsections (3) and (4) apply to assignment by way of security as in relation to any other assignment.

(6) A registered design or application for a registered design may be the subject of a charge in the same way as other personal or moveable property.

(7) The proprietor of a registered design may grant a licence to use that registered design.

(8) Any equities in respect of a registered design or an application for a registered design may be enforced in like manner as in respect of any other personal or moveable property.

Exclusive licences

15C.—(1) In this Act an "exclusive licence" means a licence in writing signed by or on behalf of the proprietor of the registered design authorising the licensee to the exclusion of all other persons, including the person granting the licence, to exercise a right which would otherwise be exercisable exclusively by the proprietor of the registered design.

(2) The licensee under an exclusive licence has the same rights against any successor in title who is bound by the licence as he has against the person granting the licence.".

Commencement Information
I25 Sch. 1 para. 21 in force at 11.11.2013, see **art. 1**

22. Omit section 16.

Commencement Information
I26 Sch. 1 para. 22 in force at 11.11.2013, see **art. 1**

23.—(1) In section 17(8) (register of designs, etc) omit "Subject to subsection (11) below,".

(2) In section 17(10) omit ", subject to subsection (11) below,".

Commencement Information
I27 Sch. 1 para. 23 in force at 11.11.2013, see **art. 1**

24.—(1) In section 19(3A) (registration of assignments, etc)(**9**), for "design right" (in each place) substitute "national unregistered design right".

(2) In section 19(3B) for "design right" (in the first and third places) substitute "national unregistered design right".

(3) Omit section 19(4).

Commencement Information

I28 Sch. 1 para. 24 in force at 11.11.2013, see **art. 1**

25.—(1) In section 20(1) (rectification of register), for "any person aggrieved" substitute "the relevant person".

(2) After section 20(1) insert—

"(1A) In subsection (1) above "the relevant person" means—

(a) in the case of an application invoking any ground referred to in section 11ZA(1)(c) of this Act, any person concerned by the use in question;

(b) in the case of an application invoking the ground mentioned in section 11ZA(1A) of this Act, the appropriate person;

(c) in the case of an application invoking any ground mentioned in section 11ZA(2), (3) or (4) of this Act, the person able to make the objection;

(d) in any other case, any person aggrieved.

(1B) In subsection (1A) above "the appropriate person" means, in relation to an earlier design protected by virtue of registration under this Act [F7]... or an application for such registration, the registered proprietor of the design [F8]... or (as the case may be) the applicant.".

(3) After section 20(5) insert—

"(6) Orders which may be made by the court under this section include, in particular, declarations of partial invalidity.".

Textual Amendments

F7 Words in Sch. 1 para. 25(2) omitted (31.12.2020) by virtue of The Registered Designs and Trade Marks (Isle of Man) (Amendment) (EU Exit) Order 2019 (S.I. 2019/1335), art. 1, **Sch. 1 para. 6(a)**; 2020 c. 1, Sch. 5 para. 1(1)

F8 Words in Sch. 1 para. 25(2) omitted (31.12.2020) by virtue of The Registered Designs and Trade Marks (Isle of Man) (Amendment) (EU Exit) Order 2019 (S.I. 2019/1335), art. 1, **Sch. 1 para. 6(b)**; 2020 c. 1, Sch. 5 para. 1(1)

Commencement Information

I29 Sch. 1 para. 25 in force at 11.11.2013, see **art. 1**

26.—(1) In section 22(1) (inspection of registered designs)(**10**)—

(a) for "issued" substitute "granted";

(b) omit paragraph (b) and the word "and" immediately before it;

(**9**) Section 19(3A) and (3B) were inserted by paragraph 10 of Schedule 3 to the 1988 Act.
(**10**) Section 22(1) was substituted by paragraph 12(2) of Schedule 3 to the 1988 Act.

(c) for "the following provisions of this subsection" substitute "subsection (4)".

(2) Omit section 22(2) and (3).

(3) For section 22(4) substitute—

"(4) Where registration of a design has been refused pursuant to an application under this Act, or an application under this Act has been abandoned in relation to any design—

(a) the application, so far as relating to that design, and

(b) any representation, specimen or other document which has been filed and relates to that design,

shall not at any time be open to inspection at the Patent Office or be published by the registrar.".

Commencement Information

I30 Sch. 1 para. 26 in force at 11.11.2013, see **art. 1**

27. In section 23(a) (information as to existence of right in registered design)(**11**), omit "and, if so, in respect of what articles".

Commencement Information

I31 Sch. 1 para. 27 in force at 11.11.2013, see **art. 1**

28. Immediately before section 25 insert—

"**Action for infringement**

24A.—(1) An infringement of the right in a registered design is actionable by the registered proprietor.

(2) In an action for infringement all such relief by way of damages, injunctions, accounts or otherwise is available to him as is available in respect of the infringement of any other property right.

(2A) Where in an action for infringement of the right in a registered design it is shown that the defendant knew, or had reason to believe, that he was committing an infringement, the damages awarded to the claimant shall be appropriate to the actual prejudice he suffered as a result of the infringement.

(2B) The court—

(a) in awarding such damages shall take into account all appropriate aspects, including in particular—

(i) the negative economic consequences, including any lost profits, which the claimant has suffered;

(ii) any unfair profits made by the defendant; and

(iii) elements other than economic factors, including the moral prejudice caused to the claimant by the infringement; or

(b) may where appropriate award such damages on the basis of the royalties or fees which would have been due had the defendant obtained a licence.

(**11**) Section 23 was substituted by paragraph 13 of Schedule 3 to the 1988 Act.

(3) This section has effect subject to section 24B of this Act (exemption of innocent infringer from liability).

Exemption of innocent infringer from liability

24B.—(1) In proceedings for the infringement of the right in a registered design damages shall not be awarded, and no order shall be made for an account of profits, against a defendant who proves that at the date of the infringement he was not aware, and had no reasonable ground for supposing, that the design was registered.

(2) For the purposes of subsection (1), a person shall not be deemed to have been aware or to have had reasonable grounds for supposing that the design was registered by reason only of the marking of a product with—

(a) the word "registered" or any abbreviation thereof, or

(b) any word or words expressing or implying that the design applied to, or incorporated in, the product has been registered,

unless the number of the design accompanied the word or words or the abbreviation in question.

(3) Nothing in this section shall affect the power of the court to grant an injunction in any proceedings for infringement of the right in a registered design.

Order for delivery up

24C.—(1) Where a person—

(a) has in his possession, custody or control for commercial purposes an infringing article, or

(b) has in his possession, custody or control anything specifically designed or adapted for making articles to a particular design which is a registered design, knowing or having reason to believe that it has been or is to be used to make an infringing article,

the registered proprietor in question may apply to the court for an order that the infringing article or other thing be delivered up to him or to such other person as the court may direct.

(2) An application shall not be made after the end of the period specified in the following provisions of this section; and no order shall be made unless the court also makes, or it appears to the court that there are grounds for making, an order under section 24D of this Act (order as to disposal of infringing article, &c).

(3) An application for an order under this section may not be made after the end of the period of six years from the date on which the article or thing in question was made, subject to subsection (4).

(4) If during the whole or any part of that period the registered proprietor—

(a) is under a disability, or

(b) is prevented by fraud or concealment from discovering the facts entitling him to apply for an order,

an application may be made at any time before the end of the period of six years from the date on which he ceased to be under a disability or, as the case may be, could with reasonable diligence have discovered those facts.

(5) In subsection (4) "disability" has the same meaning as in the Limitation Act 1984 (an Act of Tynwald)(**12**).

(6) A person to whom an infringing article or other thing is delivered up in pursuance of an order under this section shall, if an order under section 24D of this Act is not made, retain it pending the making of an order, or the decision not to make an order, under that section.

(7) The reference in subsection (1) to an act being done in relation to an article for "commercial purposes" are to its being done with a view to the article in question being sold or hired in the course of a business.

(8) Nothing in this section affects any other power of the court.

Order as to disposal of infringing articles, &c

24D.—(1) An application may be made to the court for an order that an infringing article or other thing delivered up in pursuance of an order under section 24C of this Act shall be—

(a) forfeited to the registered proprietor, or

(b) destroyed or otherwise dealt with as the court may think fit,

or for a decision that no such order should be made.

(2) In considering what order (if any) should be made, the court shall consider whether other remedies available in an action for infringement of the right in a registered design would be adequate to compensate the registered proprietor and to protect his interests.

(3) Where there is more than one person interested in an article or other thing, the court shall make such order as it thinks just and may (in particular) direct that the thing be sold, or otherwise dealt with, and the proceeds divided.

(4) If the court decides that no order should be made under this section, the person in whose possession, custody or control the article or other thing was before being delivered up is entitled to its return.

(5) References in this section to a person having an interest in an article or other thing include any person in whose favour an order could be made in respect of it under—

(a) this section;

(b) section 19 of the Trade Marks Act 1994(**13**)[F9]...;

(c) section 113 of the Copyright Act 1991 (an Act of Tynwald)(**14**);

(d) section 19 of the Design Right Act 1991 (an Act of Tynwald)(**15**); **[**[F10]or**]**

(e) section 26 of the Performers' Protection Act 1996 (an Act of Tynwald)(**16**); [F11]...

[F12](f) . . . . . .

Rights and remedies of exclusive licensee

24F.—(1) In relation to a registered design, an exclusive licensee has, except against the registered proprietor, the same rights and remedies in respect of matters occurring after the grant of the licence as if the licence had been an assignment.

(**12**) 1984 c.18 (Isle of Man).
(**13**) 1994 c.26.
(**14**) 1991 c.8 (Isle of Man).
(**15**) 1991 c.9 (Isle of Man).
(**16**) 1996 c.12 (Isle of Man).

(2) His rights and remedies are concurrent with those of the registered proprietor; and references to the registered proprietor in the provisions of this Act relating to infringement shall be construed accordingly.

(3) In an action brought by an exclusive licensee by virtue of this section a defendant may avail himself of any defence which would have been available to him if the action had been brought by the registered proprietor.

(4) Where an action for infringement of the right in a registered design brought by the registered proprietor or an exclusive licensee relates (wholly or partly) to an infringement in respect of which they have concurrent rights of action, the proprietor or, as the case may be, the exclusive licensee may not, without the leave of the court, proceed with the action unless the other is either joined as a claimant or added as a defendant.

(5) A registered proprietor or exclusive licensee who is added as a defendant in pursuance of subsection (4) is not liable for any costs in the action unless he takes part in the proceedings.

(6) Subsections (4) and (5) do not affect the granting of interlocutory relief on the application of the registered proprietor or an exclusive licensee.

(7) Where an action for infringement of the right in a registered design is brought which relates (wholly or partly) to an infringement in respect of which the registered proprietor and an exclusive licensee have concurrent rights of action—

(a) the court shall, in assessing damages, take into account—

(i) the terms of the licence, and

(ii) any pecuniary remedy already awarded or available to either of them in respect of the infringement;

(b) no account of profits shall be directed if an award of damages has been made, or an account of profits has been directed, in favour of the other of them in respect of the infringement; and

(c) the court shall if an account of profits is directed apportion the profits between them as the court considers just, subject to any agreement between them;

and these provisions apply whether or not the proprietor and the exclusive licensee are both parties to the action.

(8) The registered proprietor shall notify any exclusive licensee having concurrent rights before applying for an order under section 24C of this Act (order for delivery up of infringing article, &c); and the court may on the application of the licensee make such order under that section as it thinks fit having regard to the terms of the licence.

Meaning of "infringing article"

24G.—(1) In this Act "infringing article", in relation to a design, shall be construed in accordance with this section.

(2) An article is an infringing article if its making to that design was an infringement of the right in a registered design.

(3) An article is also an infringing article if—

(a) it has been or is proposed to be imported into the United Kingdom, and

(b) its making to that design in the United Kingdom would have been an infringement of the right in a registered design or a breach of an exclusive licensing agreement relating to that registered design.

(4) Where it is shown that an article is made to a design which is or has been a registered design, it shall be presumed until the contrary is proved that the article was made at a time when the right in the registered design subsisted.

(5) Nothing in subsection (3) shall be construed as applying to an article which may be lawfully imported into the Isle of Man by virtue of **[**[F13]anything which forms part of retained EU law as a result of section 3 or 4 of the European Union (Withdrawal) Act 2018**]**.".

Textual Amendments

F9 Words in Sch. 1 para. 28 omitted (31.12.2020) by virtue of The Registered Designs and Trade Marks (Isle of Man) (Amendment) (EU Exit) Order 2019 (S.I. 2019/1335), art. 1, **Sch. 1 para. 7(a)(i)**; 2020 c. 1, Sch. 5 para. 1(1)

F10 Word in Sch. 1 para. 28 inserted (31.12.2020) by The Registered Designs and Trade Marks (Isle of Man) (Amendment) (EU Exit) Order 2019 (S.I. 2019/1335), art. 1, **Sch. 1 para. 7(a)(ii)**; 2020 c. 1, Sch. 5 para. 1(1)

F11 Word in Sch. 1 para. 28 omitted (31.12.2020) by virtue of The Registered Designs and Trade Marks (Isle of Man) (Amendment) (EU Exit) Order 2019 (S.I. 2019/1335), art. 1, **Sch. 1 para. 7(a)(iii)**; 2020 c. 1, Sch. 5 para. 1(1)

F12 Words in Sch. 1 para. 28 omitted (31.12.2020) by virtue of The Registered Designs and Trade Marks (Isle of Man) (Amendment) (EU Exit) Order 2019 (S.I. 2019/1335), art. 1, **Sch. 1 para. 7(a)(iv)**; 2020 c. 1, Sch. 5 para. 1(1)

F13 Words in Sch. 1 para. 28 substituted (31.12.2020) by The Registered Designs and Trade Marks (Isle of Man) (Amendment) (EU Exit) Order 2019 (S.I. 2019/1335), art. 1, **Sch. 1 para. 7(b)**; 2020 c. 1, Sch. 5 para. 1(1)

Commencement Information

I32 Sch. 1 para. 28 in force at 11.11.2013, see **art. 1**

29.—(1) In section 25 (certificate of contested validity of registration) (1), after "the design is" insert ", to any extent,".

(2) In section 25(2), for "cancellation" substitute "invalidation".

Commencement Information

I33 Sch. 1 para. 29 in force at 11.11.2013, see **art. 1**

[[F14]**29A.** After section 25 (certificate of contested validity of registration), insert—

"**Privilege for communications with those on the special list of professional designs representatives**

25A.—(1) This section applies to communications as to any matter relating to the protection of a design as a registered design.

(2) Any such communication—

(a) between a person and a professional designs representative; or

(b) for the purposes of obtaining, or in response to a request for, information which a person is seeking for the purpose of instructing a professional designs representative,

is privileged from, or in Scotland protected against, disclosure in legal proceedings in the same way as a communication between a person and a solicitor or, as the case may be, a communication for the purpose of obtaining, or in response to a request for, information which a person is seeking for the purpose of instructing a solicitor.

(3) In subsection (2) "professional designs representative" means a person whose name appears on the special list of professional representatives for design matters maintained by the European Union Intellectual Property Office referred to in Article 78(4) of Council Regulation (EC) 6/2002 of 12th December 2001 on Community designs as it has effect in EU law.".**]**

Textual Amendments

F14 Sch. 1 para. 29A inserted (31.12.2020) by The Registered Designs and Trade Marks (Isle of Man) (Amendment) (EU Exit) Order 2019 (S.I. 2019/1335), art. 1, **Sch. 1 para. 8**; 2020 c. 1, Sch. 5 para. 1(1)

30. In section 26(2) (remedy for groundless threats of infringement proceedings), for "plaintiff" (in each place) substitute "claimant".

Commencement Information

I34 Sch. 1 para. 30 in force at 11.11.2013, see **art. 1**

31. In section 27(1) (the court)(**17**), immediately before the end insert—

"and

(d) in the Isle of Man, the High Court of Justice of the Isle of Man".

Commencement Information

I35 Sch. 1 para. 31 in force at 11.11.2013, see **art. 1**

32.—(1) In section 28(5) (the Appeal Tribunal), at the end insert—

"(c) in the Isle of Man, in the same way as an order of the court.".

(2) Omit section 28(6).

(3) In section 28(8) after "this Act" insert "including right of audience".

Commencement Information

I36 Sch. 1 para. 32 in force at 11.11.2013, see **art. 1**

33.—(1) In section 30(2) (costs and security for costs)(**18**), immediately before the end insert—

"and

(c) in the Isle of Man, in the same way as an order of the court".

(2) In section 30(3)—

(a) In paragraph (a), omit for "cancellation" substitute "invalidation";

(**17**) Section 27 was substituted by paragraph 16 of Schedule 3 to the 1988 Act.
(**18**) Section 30 was substituted by paragraph 19 of Schedule 3 to the 1988 Act.

(b) omit paragraph (b).

Commencement Information
I37 Sch. 1 para. 33 in force at 11.11.2013, see **art. 1**

34. In sections 33(1) (offences under section 5)(**19**)and 34(falsification of register)(**20**)—

(a) for "imprisonment" (in each place) substitute "custody";

(b) in paragraph (a), for "indictment" substitute "information";

(c) in paragraph (b), for "the statutory maximum" substitute "the prescribed sum within the meaning of section 32 of the Magistrates' Courts Act 1980(**21**)".

Commencement Information
I38 Sch. 1 para. 34 in force at 11.11.2013, see **art. 1**

35.—(1) In section 35(1) (fine for falsely representing a design as registered)—

(a) for "any article" substitute ", or incorporated in, any product";

(b) omit "in respect of that article";

(c) for "an article" substitute "a product";

(d) for "the article" (in the first and second places) substitute ", or incorporated in, the product";

(e) omit "in respect of the article".

(2) In section 35(2)—

(a) for "any article" substitute "any product";

(b) after "applied" insert "or in which it has been incorporated";

(c) for "such article" substitute "such product".

(3) After section 35(2) insert—

"(3) For the purposes of this section, the use in the United Kingdom in relation to a design—

(a) of the word "registered", or

(b) of any other word or symbol importing a reference (express or implied) to registration,

shall be deemed to be a representation as to registration under this Act unless it is shown that the reference is to registration elsewhere than in the United Kingdom and that the design is in fact so registered.".

Commencement Information
I39 Sch. 1 para. 35 in force at 11.11.2013, see **art. 1**

(**19**) Section 33(1) was amended by paragraph 22(2) of Schedule 3 to the 1988 Act.
(**20**) Section 34 was amended by paragraph 23(2) of Schedule 3 to the 1988 Act.
(**21**) 1980 c.43.

[[F15]35A. In section 35ZA (offence of unauthorised copying etc of design in course of business), omit subsection (7).**]**

Textual Amendments

F15 Sch. 1 para. 35A inserted (31.12.2020) by The Registered Designs and Trade Marks (Isle of Man) (Amendment) (EU Exit) Order 2019 (S.I. 2019/1335), art. 1, **Sch. 1 para. 9**; 2020 c. 1, Sch. 5 para. 1(1)

36. In section 36(1A) (general power of Secretary of State to make rules)(**22**), after paragraph (a) insert—

"(ab) requiring applications for registration of designs to specify—

(i) the products to which the designs are intended to be applied or in which they are intended to be incorporated;

(ii) the classification of the designs by reference to such test as may be prescribed.

Commencement Information

I40 Sch. 1 para. 36 in force at 11.11.2013, see **art. 1**

37. In section 37(2) (provisions as to rules and Orders), for "section fifteen or section sixteen of this Act" substitute "section 15 of this Act".

Commencement Information

I41 Sch. 1 para. 37 in force at 11.11.2013, see **art. 1**

38. Immediately after section 37 insert—

"**Use of electronic communications**

37A.—(1) The registrar may give directions as to the form and manner in which documents to be delivered to the registrar—

(a) in electronic form; or

(b) using electronic communications,

are to be delivered to him.

(2) A direction under subsection (1) may provide that in order for a document to be delivered in compliance with the direction it shall be accompanied by one or more additional documents specified in the direction.

(3) Subject to subsections (11) and (12), if a document to which a direction under subsection (1) or (2) applies is delivered to the registrar in a form or manner which does not comply with the direction the registrar may treat the document as not having been delivered.

(4) Subsection (5) applies in relation to a case where—

(a) a document is delivered using electronic communications, and

(b) there is a requirement for a fee to accompany the document.

(5) The registrar may give directions specifying—

(**22**) Section 36(1A) was inserted by paragraph 26(3) of Schedule 3 to the 1988 Act.

(a) how the fee shall be paid; and

(b) when the fee shall be deemed to have been paid.

(6) The registrar may give directions specifying that a person who delivers a document to the registrar in electronic form or using electronic communications cannot treat the document as having been delivered unless its delivery has been acknowledged.

(7) The registrar may give directions specifying how a time of delivery is to be accorded to a document delivered to him in electronic form or using electronic communications.

(8) A direction under this section may be given—

(a) generally;

(b) in relation to a description of cases specified in the direction;

(c) in relation to a particular person or persons.

(9) A direction under this section may be varied or revoked by a subsequent direction under this section.

(10) The delivery using electronic communications to any person by the registrar of any document is deemed to be effected, unless the registrar has otherwise specified, by transmitting an electronic communication containing the document to an address provided or made available to the registrar by that person as an address of his for the receipt of electronic communications; and unless the contrary is proved such delivery is deemed to be effected immediately upon the transmission of the communication.

(11) A requirement of this Act that something must be done in the prescribed manner is satisfied in the case of something that is done—

(a) using a document in electronic form, or

(b) using electronic communications,

only if the directions under this section that apply to the manner in which it is done are complied with.

(12) In the case of an application made as mentioned in subsection (11)(a) or (b) above, a reference in this Act to the application not having been made in accordance with rules under this Act includes a reference to its not having been made in accordance with any applicable directions under this section.

(13) This section applies—

(a) to delivery at the Patent Office as it applies to delivery to the registrar; and

(b) to delivery by the Patent Office as it applies to delivery by the registrar.”.

Commencement Information

I42 Sch. 1 para. 38 in force at 11.11.2013, see **art. 1**

39.—(1) Omit section 43(1) (savings).

(2) In section 43(2), for “articles” substitute “products”.

Commencement Information

I43 Sch. 1 para. 39 in force at 11.11.2013, see **art. 1**

40.—(1) In section 44(1) (interpretation)—

(a) omit the definitions of "article", "artistic work", "corresponding design" and "set of articles";

(b) in the definition of "design", for "section 1(1)" substitute "section 1(2)";

(c) at the appropriate places insert—

F16"…";

""complex product" has the meaning assigned to it by section 1(3) of this Act;";

""electronic communication" has the same meaning as in the Electronic Communications Act 2000(**23**);";

""national unregistered design right" means design right within the meaning of the Design Right Act 1991 (an Act of Tynwald);";

""product" has the meaning assigned to it by section 1(3) of this Act;";

F16"…".

(2) Omit section 44(2) and (3).

(3) In section 44(4) for "section fourteen and of section sixteen of this Act" substitute "section 14 of this Act".

Textual Amendments

F16 Words in Sch. 1 para. 40(1)(c) omitted (31.12.2020) by virtue of The Registered Designs and Trade Marks (Isle of Man) (Amendment) (EU Exit) Order 2019 (S.I. 2019/1335), art. 1, **Sch. 1 para. 10**; 2020 c. 1, Sch. 5 para. 1(1)

Commencement Information

I44 Sch. 1 para. 40 in force at 11.11.2013, see **art. 1**

41. Omit section 48(5) (repeals, savings and transitional provisions).

Commencement Information

I45 Sch. 1 para. 41 in force at 11.11.2013, see **art. 1**

42. Immediately before Schedule 1 insert—

"SCHEDULE A1 Sections 3A(4)(c) and 11ZA(1)(c)

Grounds for refusal of registration in relation to emblems etc.

Grounds for refusal in relation to certain emblems etc.

1.—(1) A design shall be refused registration under this Act if it involves the use of—

(a) the Royal arms, or any of the principal armorial bearings of the Royal arms, or any insignia or device so nearly resembling the Royal arms or any such armorial bearing as to be likely to be mistaken for them or it;

(b) a representation of the Royal crown or any of the Royal flags;

(**23**) 2000 c.7.

(c) a representation of Her Majesty or any member of the Royal family, or any colourable imitation thereof; or

(d) words, letters or devices likely to lead persons to think that the applicant either has or recently has had Royal patronage or authorisation;

unless it appears to the registrar that consent for such use has been given by or on behalf of Her Majesty or (as the case may be) the relevant member of the Royal family.

(2) A design shall be refused registration under this Act if it involves the use of—

(a) the national flag of the United Kingdom (commonly known as the Union Jack); or

(b) the flag of England, Wales, Scotland, Northern Ireland or the Isle of Man,

and it appears to the registrar that the use would be misleading or grossly offensive.

(3) A design shall be refused registration under this Act if it involves the use of—

(a) arms to which a person is entitled by virtue of a grant of arms by the Crown; or

(b) insignia so nearly resembling such arms as to be likely to be mistaken for them;

unless it appears to the registrar that consent for such use has been given by or on behalf of the person concerned and the use is not in any way contrary to the law of arms.

(4) A design shall be refused registration under this Act if it involves the use of a controlled representation within the meaning of the Olympic Symbol etc. (Protection) Act 1995(**24**) unless it appears to the registrar that—

(a) the application is made by the person for the time being appointed under section 1(2) of the Olympic Symbol etc. (Protection) Act 1995 (power of Secretary of State to appoint a person as the proprietor of the Olympics association right); or

(b) consent for such use has been given by or on behalf of the person mentioned in paragraph (a) above.

(5) References in this section to the Olympic Symbol etc (Protection) Act 1995 are to that Act as it has effect in the United Kingdom.

Grounds for refusal in relation to emblems etc. of Paris Convention countries

2.—(1) A design shall be refused registration under this Act if it involves the use of the flag of a Paris Convention country unless—

(a) the authorisation of the competent authorities of that country has been given for the registration; or

(b) it appears to the registrar that the use of the flag in the manner proposed is permitted without such authorisation.

(2) A design shall be refused registration under this Act if it involves the use of the armorial bearings or any other state emblem of a Paris Convention country which is protected under the Paris Convention unless the authorisation of the competent authorities of that country has been given for the registration.

(3) A design shall be refused registration under this Act if—

(a) the design involves the use of an official sign or hallmark adopted by a Paris Convention country and indicating control and warranty;

(b) the sign or hallmark is protected under the Paris Convention; and

(**24**) 1995 c.32.

(c) the design could be applied to or incorporated in goods of the same, or a similar, kind as those in relation to which the sign or hallmark indicates control and warranty;

unless the authorisation of the competent authorities of that country has been given for the registration.

(4) The provisions of this paragraph as to national flags and other state emblems, and official signs or hallmarks, apply equally to anything which from a heraldic point of view imitates any such flag or other emblem, or sign or hallmark.

(5) Nothing in this paragraph prevents the registration of a design on the application of a national of a country who is authorised to make use of a state emblem, or official sign or hallmark, of that country, notwithstanding that it is similar to that of another country.

Grounds for refusal in relation to emblems etc. of certain international organisations

3.—(1) This paragraph applies to—

(a) the armorial bearings, flags or other emblems; and

(b) the abbreviations and names,

of international intergovernmental organisations of which one or more Paris Convention countries are members.

(2) A design shall be refused registration under this Act if it involves the use of any such emblem, abbreviation or name which is protected under the Paris Convention unless—

(a) the authorisation of the international organisation concerned has been given for the registration; or

(b) it appears to the registrar that the use of the emblem, abbreviation or name in the manner proposed—

(i) is not such as to suggest to the public that a connection exists between the organisation and the design; or

(ii) is not likely to mislead the public as to the existence of a connection between the user and the organisation.

(3) The provisions of this paragraph as to emblems of an international organisation apply equally to anything which from a heraldic point of view imitates any such emblem.

(4) Nothing in this paragraph affects the rights of a person whose bona fide use of the design in question began before 4th January 1962 (when the relevant provisions of the Paris Convention entered into force in relation to the United Kingdom).

Paragraphs 2 and 3: supplementary

4.—(1) For the purposes of paragraph 2 above state emblems of a Paris Convention country (other than the national flag), and official signs or hallmarks, shall be regarded as protected under the Paris Convention only if, or to the extent that—

(a) the country in question has notified the United Kingdom in accordance with Article 6*ter*(3) of the Convention that it desires to protect that emblem, sign or hallmark;

(b) the notification remains in force; and

(c) the United Kingdom has not objected to it in accordance with Article 6*ter*(4) or any such objection has been withdrawn.

(2) For the purposes of paragraph 3 above the emblems, abbreviations and names of an international organisation shall be regarded as protected under the Paris Convention only if, or to the extent that—

(a) the organisation in question has notified the United Kingdom in accordance with Article 6*ter*(3) of the Convention that it desires to protect that emblem, abbreviation or name;

(b) the notification remains in force; and

(c) the United Kingdom has not objected to it in accordance with Article 6*ter*(4) or any such objection has been withdrawn.

(3) Notification under Article 6*ter*(3) of the Paris Convention shall have effect only in relation to applications for the registration of designs made more than two months after the receipt of the notification.

Interpretation

5. In this Schedule—

"a Paris Convention country" means a country, other than the United Kingdom, which is a party to the Paris Convention; and

"the Paris Convention" means the Paris Convention for the Protection of Industrial Property of 20th March 1883.".

Commencement Information
I46 Sch. 1 para. 42 in force at 11.11.2013, see **art. 1**

43.—(1) Schedule 1 (use of registered designs for the services of the Crown) is modified as follows.

(2) In paragraph 1(6) and (7), for "articles" (in each place) substitute "products".

(3) In paragraph 2(1), for "design right" substitute "national unregistered design right".

(4) In paragraph 2A(1) and (4)(**25**)—

(a) for "articles" substitute "products"; and

(b) after "applied" insert "or in which it is incorporated".

(5) In paragraph 3(2)(a)—

(a) after "proceedings" insert "and the department are a relevant person within the meaning of section 20 of this Act";

(b) for "cancellation" substitute "invalidation"; and

(c) for "cancelled" substitute "declared invalid".

(6) In paragraph 3(2)(b)—

(a) after "case" insert "and provided that the department would be the relevant person within the meaning of section 20 of this Act if they had made an application on the grounds for invalidity being raised"; and

(b) for "cancellation" substitute "invalidation".

(**25**) Paragraph 2A was inserted by section 271(1) of the 1988 Act.

Commencement Information
I47 Sch. 1 para. 43 in force at 11.11.2013, see **art. 1**

[[F17]44. After Schedule 1, insert—

"SCHEDULE 1A Section 12A

EUROPEAN COMMUNITY REGISTERED DESIGNS

PART 1

Existing registered Community designs

Designs registered as Community designs to be treated as registered under the Act

1.—(1) A design which, immediately before exit day, is entered in the RCD register and has been published in the Community Designs Bulletin as mentioned in Article 73(1) (an "existing registered Community design") is to be treated on and after exit day as if an application for its registration had been made, and it had been registered, under this Act.

(2) A registered design which comes into being by virtue of sub-paragraph (1) is referred to in this Schedule as a "re-registered design".

(3) This Act applies to a re-registered design as it applies to other registered designs except as otherwise provided in this Schedule.

(4) For the purposes of this Act—

(a) the date of registration of a re-registered design is the date on which the existing registered Community design from which the re-registered design derives was treated as registered under the Community Design Regulation, and

(b) the date of the application of a re-registered design is the date treated, under Article 38, as the date of filing of the application for the registration of the existing registered Community design from which the re-registered design derives.

(5) Any fee provided for by regulations under Schedule 4 to the European Union (Withdrawal) Act 2018 in respect of any matter relating to a re-registered design applies in the Isle of Man in respect of that matter.

(6) The following provisions of this Act do not apply to a re-registered design—

(a) section 7A(6);

(b) section 18.

(7) In this Schedule—

(a) "the RCD register" means the register of registered Community designs maintained under Article 72;

(b) "the Community Design Regulation" means Council Regulation (EC) No 6/2002 of 12th December 2001 on Community Designs as it had effect immediately before exit day.

Entries to be made in the register in relation to designs treated as registered under this Act

2.—(1) The registrar must as soon as reasonably practicable on or after exit day enter a re-registered design in the register of designs.

(2) The obligation under section 22(1) (inspection of registered designs) applies to a reregistered design on and after the day on which the re-registered design is entered in the register (notwithstanding that no certificate of registration has been granted).

Opt out

3.—(1) Subject to sub-paragraph (2), the proprietor of an existing registered Community design may at any time on or after exit day serve a notice on the registrar that the design is not to be treated as if it had been registered under this Act.

(2) A notice under sub-paragraph (1) may not be served where on or after exit day—

(a) the re-registered design which derives from the existing registered Community design (or any interest in it)—

(i) has been assigned or otherwise transferred except by an assent by personal representatives, or

(ii) has had an interest created in it by a mortgage, licence or other instrument; or

(b) proceedings based on the re-registered design have been initiated by the proprietor or with the proprietor's consent.

(3) A notice served under sub-paragraph (1) must—

(a) identify the existing registered Community design; and

(b) include the name and address of any person having an interest in the existing registered Community design which had effect before exit day in the United Kingdom and in respect of which an entry was recorded in the RCD register.

(4) A notice under sub-paragraph (1) is of no effect unless the proprietor in that notice certifies that any such person—

(a) has been given not less than three months' notice of the proprietor's intention to serve such a notice; or

(b) is not affected by, or if affected consents to, the notice.

(5) Where a notice has been served under sub-paragraph (1)—

(a) the design ceases with effect from exit day to be treated as if it had been registered under this Act,

(b) the obligation imposed on the registrar under paragraph 2 (entries to be made in the register in relation to designs treated as registered under this Act) ceases to have effect, and

(c) the registrar must make any necessary amendments to the register.

Effect of claim of priority

4.—(1) This paragraph applies where a right of priority has been claimed in accordance with Article 42 in respect of an existing registered Community design.

(2) The proprietor of the re-registered design which derives from the existing registered Community design is to be treated on and after exit day as having the same claim of priority.

(3) Accordingly, the relevant date for the purposes of establishing whether (or to what extent) the re-registered design is new or has individual character is the date of filing of the application for registration of a design in a convention country which formed the basis for the claim of priority.

Unregistered pre-exit transfers

5.—(1) This paragraph applies where immediately before exit day there is a transfer of an existing registered Community design that has not been entered in the RCD register (a "relevant transfer").

(2) Section 19 (registration of assignments, etc.) applies in relation to a relevant transfer as if it were an assignment of the re-registered design which derives from the existing registered Community design which has been transferred.

Pre-exit licences to continue to have effect in the United Kingdom

6.—(1) This paragraph applies where immediately before exit day an existing registered Community design is the subject of a licence which—

(a) authorises the doing of acts in the United Kingdom which would otherwise infringe an existing registered Community design, and

(b) does not expire on exit day (a "relevant licence").

(2) Subject to any agreement to the contrary between the licensee and the licensor, a relevant licence continues to authorise the doing of acts which would otherwise infringe the right in the re-registered design which derives from the existing registered Community design.

(3) Sub-paragraph (2) is subject to the terms on which the relevant licence was granted, subject to such modifications as are necessary for their application in the United Kingdom.

(4) Section 19 (registration of assignments, etc.) applies in relation to a relevant licence as if it were a licence of the re-registered design deriving from the existing registered Community design which is subject to the relevant licence, subject to the following modification.

(5) Where immediately before exit day there is an entry in the RCD register relating to the relevant licence, section 19(5) does not apply to the licence until after the expiry of the period of 12 months beginning with the day after that on which exit day falls.

Security interests in existing registered Community designs

7.—(1) This paragraph applies where immediately before exit day an existing registered Community design is the subject of an interest which has been granted as security and does not expire on exit day (a "relevant security interest").

(2) References to the existing registered Community design in any document which grants or refers to the relevant security interest are to be read as including references to the re-registered design which derives from the existing registered Community design.

(3) Section 19 (registration of assignments, etc.) applies in relation to a relevant security interest as if it were a security interest granted in respect of the re-registered design deriving from the existing registered Community design which is subject to the relevant security interest, subject to the following modification.

(4) Where immediately before exit day there is an entry in the RCD register relating to the relevant security interest, section 19(5) does not apply to the document granting the interest until after the expiry of the period of 12 months beginning with the day after that on which exit day falls.

Continuity of rights in relation to an existing registered Community design

8.—(1) References to an existing registered Community design or the registration of an existing registered Community design in any document entered into before exit day shall, unless there is evidence that the document was not intended to have effect in the United Kingdom, be read on and after exit day as including references to the re-registered design or the registration of the re-registered design which derives from the existing registered Community design.

(2) Subject to any agreement to the contrary, a consent granted before exit day by the proprietor of an existing registered Community design to the doing on or after exit day of an act in the United Kingdom which would otherwise infringe the right in the re-registered design which derives from the existing registered Community design is to be treated for the purposes of section 7A as a consent to the doing of that act granted by the registered proprietor of the re-registered design.

Pending proceedings concerning an existing registered Community design

9.—(1) This paragraph applies where on exit day an existing registered Community design is the subject of proceedings which are pending ("pending proceedings") before a court in the United Kingdom designated for the purposes of Article 80 ("a Community design court").

(2) Subject to sub-paragraphs (3) and (4), the provisions contained or referred to in Title IX of the Community Design Regulation (with the exception of Articles 86(2), (4), (5) and 91) shall continue to apply to the pending proceedings as if the United Kingdom were still a Member State with effect from exit day.

(3) Where the pending proceedings involve a claim for infringement or for threatened infringement of an existing registered Community design, without prejudice to any other relief by way of damages, accounts or otherwise available to the proprietor of the existing registered Community design, the Community design court may grant an injunction to prohibit unauthorised use of the re-registered design which derives from the existing registered Community design.

(4) Where the pending proceedings involve a counterclaim for a declaration of invalidity in relation to an existing registered Community design, the Community design court may declare the registration of the re-registered design which derives from the existing registered Community design to be invalid (wholly or in part).

(5) Where the registration of a re-registered design is declared invalid to any extent, the registration shall to that extent be treated as having been invalid from the date of registration or from such other date as the court may direct.

(6) For the purposes of this paragraph proceedings are treated as pending on exit day if they were instituted but not finally determined before exit day.

Effect of injunction protecting an existing registered Community design

10.—(1) This paragraph applies where immediately before exit day an injunction is in force prohibiting the performance of acts in the United Kingdom which infringe or would infringe an existing registered Community design (a "relevant injunction").

(2) Subject to any order of the court to the contrary, a relevant injunction will have effect and be enforceable to prohibit the performance of acts which infringe or would infringe the right in a re-registered design to the same extent as in relation to the existing registered Community design from which the re-registered design derives as if it were an injunction granted by the court.

PART 2

Applications for registered Community designs which are pending at exit day

Applications for registration pending immediately before exit day

11.—(1) In this Part references to an existing EU application are to an application for registration of a design under the Community Design Regulation in respect of which the conditions in sub-paragraph (2) are satisfied.

(2) The conditions referred to in sub-paragraph (1) are that immediately before exit day—

(a) the application has been accorded a filing date pursuant to Article 38; and

(b) the application has been neither granted nor refused by the European Union Intellectual Property Office.

12.—(1) Where a person who has filed an existing EU application or a successor in title of that person applies for registration of the same design under this Act within a period beginning with exit day and ending with the end of the relevant period, the relevant date for the purposes of establishing whether (or to what extent) the design which is the subject of the application under this Act is new or has individual character is the earliest of—

(a) the filing date accorded pursuant to Article 38 to the existing EU application;

(b) the date of priority (if any) claimed under Article 42 in respect of the existing EU application.

(2) In sub-paragraph (1), the "relevant period" means the period of nine months beginning with the day after that on which exit day falls.

(3) For the purposes of this Act—

(a) where an application is made of the type referred to in sub-paragraph (1) within the period referred to in that sub-paragraph, the date of the application is the filing date accorded pursuant to Article 38 to the existing EU application, and

(b) where the registrar registers a design which is the subject of an application of the type referred to in sub-paragraph (1) which is made within the period referred to in that sub-paragraph, the date of registration of the design is the filing date accorded pursuant to Article 38 to the existing EU application.

(4) Accordingly section 3C does not apply in relation to the design.

PART 3

Registered Community designs where publication is deferred at exit day

Designs registered at the EUIPO immediately before exit day where publication is deferred

13.—(1) In this Part references to a deferred design are to a design registered under the Community Design Regulation in respect of which the conditions in sub-paragraph (2) are satisfied.

(2) The conditions referred to in sub-paragraph (1) are that immediately before exit day—

(a) the design is entered in the RCD register, and

(b) publication of the design is deferred under Article 50.

14.—(1) This paragraph applies where the proprietor of a deferred design or a successor in title of that person applies for registration of the same design under this Act within a period beginning with exit day and ending with the end of the relevant period.

(2) Sections 3A(4) and 3B do not apply in relation to the application.

(3) The relevant date for the purposes of establishing whether (or to what extent) the design which is the same as the deferred design is new or has individual character is the earliest of—

(a) the filing date accorded pursuant to Article 38 to the application for the deferred design;

(b) the date of priority (if any) claimed under Article 42 in respect of the application for the deferred design.

(4) If the registrar registers a design which is the subject of an application of the type referred to in sub-paragraph (1) which is made within the period referred to in that sub-paragraph, the date of registration of the design is the date on which the deferred design which is the same as that design was treated as registered under the Community Design Regulation.

(5) Accordingly section 3C does not apply in relation to the design.

(6) In sub-paragraph (1), the "relevant period" means, the period of nine months beginning with the day after that on which exit day falls.

PART 4

Treatment of registered Community designs whose registrations expire during the period of six months ending on exit day

Application of Part

15.—(1) This Part applies to a design in respect of which the conditions in sub-paragraph (2) are satisfied (an "expired Community design").

(2) The conditions referred to in sub-paragraph (1) are that—

(a) immediately before the transitional period, the design was the subject of a registration under the Community Design Regulation,

(b) the registration of the design expired during the transitional period (such that the design did not fall within paragraph 1(1)), and

(c) the registration of the design would have been capable of being renewed under Article 13 for at least one further period of five years had a request for renewal been made under Article 13 prior to that expiry.

(3) An expired Community design is to be treated as if it were an existing registered Community design.

(4) The provisions of Part 1 of this Schedule apply to an expired Community design as they apply to an existing Community design subject to the provisions of this Part of the Schedule.

(5) Notwithstanding the entry in the register of designs (under paragraph 2, as applied by sub-paragraph (4)) of a re-registered design which derives from an expired Community design, the right in the re-registered design is expired until the period for which it subsists is extended in accordance with paragraph 16 (or the re-registered design is removed from the register in accordance with paragraph 16(3)).

(6) In this paragraph, "transitional period" means the period of six months ending with exit day.

Renewal of registration of an expired Community design

16.—(1) Where the registration of an expired Community design is renewed in accordance with Article 13(3) of the Continuing Community Design Regulation the registrar must, as soon as reasonably practicable after the date of such renewal, record in the register of designs the extension of the period for which subsists the right in the reregistered design which derives from the expired Community design.

(2) Where the period for which the right in a re-registered design subsists is extended under sub-paragraph (1), the right is to be treated as if it had never expired, with the result that—

(a) anything done under or in relation to the right in the period beginning with exit day and ending with the extension under sub-paragraph (1) is to be treated as valid,

(b) an act which would have constituted an infringement of the right if it had not expired is to be treated as an infringement, and

(c) an act which would have constituted use of the design for the services of the Crown if the right had not expired is to be treated as such use.

(3) If the registration of an expired Community design is not renewed within the time period permitted by Article 13(3) of the Continuing Community Design Regulation—

(a) the registrar must remove from the register of designs the re-registered design which derives from the expired Community design; and

(b) the re-registered design ceases with effect from exit day to be treated as if it had been registered under this Act.

(4) In this Schedule "the Continuing Community Design Regulation" means the Council Regulation (EC) No 6/2002 of 12th December 2001 on Community Designs as it has effect in EU law.

PART 5

Restoration of registered Community design registrations and applications

Restoration of registered Community design to the RCD register

17.—(1) This paragraph applies where—

(a) before exit day a registered Community design is removed from the RCD register pursuant to the Community Design Regulation, and

(b) on or after exit day the registration of the said design is restored pursuant to Article 67 of the Continuing Community Design Regulation.

(2) Where the proprietor of the design files a request with the registrar within the period of six months beginning with the date of such restoration—

(a) the design will be treated as if it were an existing registered Community design on exit day;

(b) the provisions of Part 1 apply to the re-registered design which derives from the existing registered Community design.

Restoration of application for registered Community design

18.—(1) This paragraph applies where—

(a) before exit day an application for a registered Community design is refused pursuant to the Community Design Regulation; and

(b) on or after exit day the application is restored pursuant to Article 67 of the Continuing Community Design Regulation (a "relevant application").

(2) Where a person who has filed a relevant application or a successor in title of that person applies for registration of the same design under this Act within a period beginning with exit day and ending with the end of the relevant period, the relevant date for the purposes of establishing whether the design which is the subject of the application under this Act is new or has individual character is the earliest of—

(a) the filing date accorded pursuant to Article 38 to the relevant application;

(b) the date of priority (if any) claimed under Article 42 in respect of the relevant application.

(3) In sub-paragraph (2), the "relevant period" means the period of nine months beginning with the day on which the application is restored as referred to in sub-paragraph (1)(b).

PART 6

Interpretation

Interpretation

19. In this Schedule—

"the Community Design Regulation" has the meaning given by paragraph 1(7);

"the Continuing Community Design Regulation" has the meaning given by paragraph 16(4);

"existing registered Community design" has the meaning given by paragraph 1(1);

"expired Community design" has the meaning given by paragraph 15(1);

"RCD register" has the meaning given by paragraph 1(7);

"re-registered design" has the meaning given by paragraph 1(2).

20. References in this Schedule to an "Article" are to an Article of the Community Design Regulation.

SCHEDULE 1B

Section 12B

INTERNATIONAL DESIGNS

PART 1

Existing international designs

International designs in respect of which the European Union is designated to be treated as registered under the Act

1.—(1) A design which, immediately before exit day, meets the requirements of subparagraph (2) (a "protected international registered design (EU))" is to be treated on and after exit day as if an application for its registration had been made, and it had been registered, under this Act.

(2) The requirements referred to in sub-paragraph (1) are—

(a) the design is the subject of an international registration which designates the European Union;

(b) the international registration has been published by the International Bureau pursuant to Article 10(3) of the Geneva Act;

(c) the European Union Intellectual Property Office has sent to the International Bureau a statement under Rule 18*bis* of the Common Regulations under the 1999 Act and the 1960 Act of the Hague Agreement to the effect that protection is granted in relation to the design, or the period under Article 106e(1) of the Community Design Regulation for communicating to the International Bureau a notification of refusal in respect of the international registration has expired; and

(d) the effects of the international registration so far as they relate to the design have neither been—

(i) refused by the European Union Intellectual Property Office pursuant to Article 106e(1) of the Community Design Regulation; nor

(ii) declared wholly invalid pursuant to Article 106f of the Community Design Regulation.

(3) Where prior to exit day the effects of the international registration to which a protected international registered design (EU) is subject are declared partly invalid so far as relating to that design pursuant to Article 106f of the Community Design Regulation, the re-registered international design which derives from the protected international registered design (EU) has effect under this Act to the extent that the effects of the international registration so far as relating to the design have not been declared invalid.

(4) A registered design which comes into being by virtue of sub-paragraph (1) is referred to in this Schedule as a "re-registered international design".

(5) This Act applies to a re-registered international design as it applies to other registered designs except as otherwise provided in this Schedule.

(6) For the purposes of this Act—

(a) the date of registration of a re-registered international design is the date on which the protected international registered design (EU) from which the re-registered international design derives was treated as registered under the Geneva Act, and

(b) the date of the application of a re-registered international design is the date treated, under Article 9 of the Geneva Act, as the filing date of the application for the registration of the protected international registered design (EU) from which the re-registered international design derives.

(7) Any fee provided for by regulations under Schedule 4 to the European Union (Withdrawal) Act 2018 in respect of any matter relating to a re-registered international design applies in the Isle of Man in respect of that matter.

(8) The following provisions of this Act do not apply to a re-registered international design—

(a) section 7A(6);

(b) section 18.

(9) In this Schedule—

(a) "the Community Design Regulation" means Council Regulation (EC) No 6/2002 of 12th December 2001 on Community Designs as it had effect immediately before exit day;

(b) "the Geneva Act" means the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs adopted by the Diplomatic Conference on 2 July 1999;

(c) "the International Bureau" means the International Bureau of the World Intellectual Property Organization; and

(d) "international registration" means the international registration of an industrial design effected according to the Geneva Act.

Entries to be made in the register in relation to designs treated as registered under this Act

2.—(1) The registrar must as soon as reasonably practicable on or after exit day enter a re-registered international design in the register of designs.

(2) The obligation under section 22(1) (inspection of registered designs) applies to a reregistered international design on and after the day on which the re-registered international design is entered in the register (notwithstanding that no certificate of registration has been granted).

Opt out

3.—(1) Subject to sub-paragraph (2), the holder of the international registration to which a protected international registered design (EU) is subject ("the proprietor") may at any time on or after exit day serve a notice on the registrar that the design is not to be treated as if it had been registered under this Act.

(2) A notice under sub-paragraph (1) may not be served where on or after exit day—

(a) the re-registered international design which derives from the protected international registered design (EU) (or any interest in it)—

(i) has been assigned or otherwise transferred except by an assent by personal representatives, or

(ii) has had an interest created in it by a mortgage, licence or other instrument; or

(b) proceedings based on the re-registered international design have been initiated by the proprietor or with the proprietor's consent.

(3) A notice served under sub-paragraph (1) must:

(a) identify the protected international registered design (EU); and

(b) include the name and address of any person who, to the best of the proprietor's knowledge, has an interest in the protected international registered design (EU).

(4) A notice under sub-paragraph (1) is of no effect unless the proprietor in that notice certifies that any such person—

(a) has been given not less than three months' notice of the proprietor's intention to serve such a notice; or

(b) is not affected by, or if affected consents to, the notice.

(5) Where a notice has been served under sub-paragraph (1)—

(a) the design ceases with effect from exit day to be treated as if it had been registered under this Act,

(b) the obligation imposed on the registrar under paragraph 2 (entries to be made in the register in relation to designs treated as registered under this Act) ceases to have effect, and

(c) the registrar must make any necessary amendments to the register.

Effect of claim of priority

4.—(1) This paragraph applies where a right of priority has been claimed in accordance with Article 6 of the Geneva Act in respect of the international registration to which a protected international registered design (EU) is subject.

(2) The proprietor of the re-registered international design which derives from the protected international registered design (EU) is to be treated on and after exit day as having the same claim of priority.

(3) Accordingly, the relevant date for the purposes of establishing whether (or to what extent) the re-registered international design is new or has individual character is the date of filing of the application for registration of a design in a convention country or a member of the World Trade Organization which formed the basis for the claim of priority.

Unregistered pre-exit transfers

5.—(1) This paragraph applies where immediately before exit day—

(a) there is a change in ownership of the international registration to which a protected international registered design (EU) is subject,

(b) the change in ownership has effect in respect of the European Union and the protected international registered design (EU), and

(c) the change in ownership has not been entered in the international register (a "relevant transfer").

(2) Section 19 (registration of assignments, etc.) applies in relation to a relevant transfer as if it were an assignment of the re-registered international design which derives from the protected international registered design (EU) which has been transferred.

Pre-exit licences to continue to have effect in the United Kingdom

6.—(1) This paragraph applies where immediately before exit day a protected international registered design (EU) is the subject of a licence which—

(a) authorises the doing of acts in the United Kingdom which would otherwise infringe the protected international registered design (EU), and

(b) does not expire on exit day (a "relevant licence").

(2) Subject to any agreement to the contrary between the licensee and the licensor, a relevant licence continues to authorise the doing of acts which would otherwise infringe the re-registered international design which derives from the protected international registered design (EU).

(3) Sub-paragraph (2) is subject to the terms on which the relevant licence was granted, subject to such modifications as are necessary for their application in the United Kingdom.

(4) Section 19 (registration of assignments, etc.) applies in relation to a relevant licence as if it were a licence of the re-registered international design deriving from the protected international registered design (EU) which is subject to the relevant licence, subject to the following modification.

(5) Section 19(5) does not apply to the licence until after the expiry of the period of 12 months beginning with the day after that on which exit day falls.

Security interests in protected international registered designs (EU)

7.—(1) This paragraph applies where immediately before exit day a protected international registered design (EU) is the subject of an interest which has been granted as security and does not expire on exit day (a "relevant security interest").

(2) References to the protected international registered design (EU), or the international registration to which the protected international registered design (EU) is subject, in any document which grants or refers to the relevant security interest are to be read as including references to the re-registered international design which derives from the protected international registered design (EU).

(3) Section 19 (registration of assignments, etc.) applies in relation to a relevant security interest as if it were a security interest granted in respect of the re-registered design deriving from the protected international registered design (EU) which is subject to the relevant security interest, subject to the following modification.

(4) Section 19(5) does not apply to the interest until after the expiry of 12 months beginning with the day after that on which exit day falls.

Continuity of rights in relation to a protected international registered design (EU)

8.—(1) References to a protected international registered design (EU), or the international registration to which a protected international registered design (EU) is subject, in any document entered into before exit day shall, unless there is evidence that the document was not intended to have effect in the United Kingdom, be read on and after exit day as including references to the re-registered international design or the registration of the reregistered international design which derives from the protected international registered design (EU).

(2) Subject to any agreement to the contrary, a consent granted before exit day by the holder of the international registration to which a protected international registered design (EU) is subject to the doing on or after exit day of an act in the United Kingdom which would otherwise infringe the re-registered international design which derives from the protected international registered design (EU) is to be treated for the purposes of section 7A as a consent to the doing of that act granted by the registered proprietor of the re-registered international design.

Pending proceedings concerning a protected international registered design (EU)

9.—(1) This paragraph applies where on exit day a protected international registered design (EU) is the subject of proceedings which are pending ("pending proceedings") before a court in the United Kingdom designated for the purposes of Article 80 ("a Community design court").

(2) Subject to sub-paragraphs (3) and (4), the provisions contained or referred to in Title IX of the Community Design Regulation (with the exceptions of Articles 86(2), (4), (5) and 91) shall continue to apply to the pending proceedings as if the United Kingdom were still a Member State with effect from exit day.

(3) Where the pending proceedings involve a claim for infringement or for threatened infringement of a protected international registered design (EU), without prejudice to any other relief by way of damages, accounts or otherwise available to the holder of the international registration to which the protected international registered design (EU) is subject, the Community design court may grant an injunction to prohibit unauthorised use of the re-registered international design which derives from the protected international registered design (EU).

(4) Where the pending proceedings involve a counterclaim for a declaration of invalidity in relation to a protected international registered design (EU), the Community design court may declare the registration of the re-registered international design which derives from the protected international registered design (EU) to be invalid (wholly or in part).

(5) Where the registration of a re-registered international design is declared invalid to any extent, the registration shall to that extent be treated as having been invalid from the date of registration or from such other date as the court may direct.

(6) For the purposes of this paragraph proceedings are treated as pending on exit day if they were instituted but not finally determined before exit day.

Effect of injunction protecting a protected international registered design (EU)

10.—(1) This paragraph applies where immediately before exit day an injunction is in force prohibiting the performance of acts in the United Kingdom which infringe or would infringe a protected international registered design (EU) (a "relevant injunction").

(2) Subject to any order of the court to the contrary, a relevant injunction will have effect and be enforceable to prohibit the performance of acts which infringe or would infringe the right in a re-registered international design to the same extent as in relation to the protected international registered design (EU) from which the re-registered international design derives as if it were an injunction granted by the court.

PART 2

International registrations in respect of which the period for refusal has not expired before exit day etc.

11.—(1) In this Part references to a "pending international design (EU)" are to a design which, immediately before exit day, meets the requirements of sub-paragraph (2).

(2) The requirements referred to in sub-paragraph (1) are—

(a) the design is the subject of an international registration which designates the European Union;

(b) the design is not the subject of—

(i) a refusal by the European Union Intellectual Property Office pursuant to Article 106e(1) of the Community Design Regulation; or

(ii) a statement by the European Union Intellectual Property Office under Rule 18*bis* of the Common Regulations under the 1999 Act and the 1960 Act of the Hague Agreement to the effect that protection is granted in relation to it;

(c) the international registration to which the design is subject—

(i) has not been published by the International Bureau pursuant to Article 10(3) of the Geneva Act; or

(ii) has been published by the International Bureau but the period under Article 106e(1) of the Community Design Regulation for communicating to the International Bureau a notification of refusal in respect of the international registration has not expired.

12.—(1) Where the holder of the international registration to which a pending international design (EU) is subject, or a successor in title of that person, makes an application for registration of the same design under this Act within a period beginning with exit day and ending with the end of the relevant period, the relevant date for the purposes of establishing whether (or to what extent) the design which is the subject of the application under this Act is new or has individual character is the earliest of—

(a) the date on which the international registration was treated as registered pursuant to Article 10(2) of the Geneva Act;

(b) the date of priority (if any) claimed under Article 41 of the Community Design Regulation as applied by Article 106a of that Regulation in respect of the pending international design (EU).

(2) In sub-paragraph (1), the "relevant period" means the period of nine months beginning with the day after that on which exit day falls.

(3) For the purposes of this Act—

(a) where an application is made of the type referred to in sub-paragraph (1) within the period referred to in that sub-paragraph, the date of the application is the date on which the international registration to which the pending international design (EU) is subject was treated as registered pursuant to Article 10(2) of the Geneva Act, and

(b) where the registrar registers a design which is the subject of an application of the type referred to in sub-paragraph (1) which is made within the period referred to in that sub-paragraph, the date of registration of the design is the date on which the international registration to which the pending international design (EU) is subject was treated as registered pursuant to Article 10(2) of the Geneva Act.

(4) Accordingly section 3C does not apply in relation to the design.

PART 3

Treatment of international registered designs whose registrations expire during the period of six months ending on exit day

Application of Part

13.—(1) This Part applies to a design which met the requirements set out in paragraph 1(2)(b) to (d) in respect of which the conditions in sub-paragraph (2) are satisfied (an "expired international design").

(2) The conditions referred to in sub-paragraph (1) are that—

(a) immediately before the transitional period, the design was the subject of an international registration which designated the European Union,

(b) the international registration expired during the transitional period (such that the design did not fall within paragraph 1(1)), and

(c) the renewal of the international registration would have been capable of being effected for the European Union in accordance with Article 17 of the Geneva Act for at least one further period of five years had a request for renewal been made in accordance with Article 17(2) prior to that expiry.

(3) An expired international design is to be treated as if it were a protected international registered design (EU).

(4) The provisions of Part 1 of this Schedule apply to an expired international design as they apply to a protected international registered design (EU) subject to the provisions of this Part of the Schedule.

(5) Notwithstanding the entry in the register of designs (under paragraph 2, as applied by sub-paragraph (4)) of a re-registered international design which derives from an expired international design, the right in the re-registered international design is expired until it is extended in accordance with paragraph 14 (or the re- registered design is removed from the register in accordance with paragraph 14(3)).

(6) In this paragraph, "transitional period" means the period of six months ending with exit day.

Renewal of registration of an expired international design

14.—(1) Where within the period beginning with exit day and ending with the end of the relevant period—

(a) the international registration to which an expired international design was subject is renewed in accordance with Article 17(2) of the Geneva Act,

(b) the renewal has effect in respect of the European Union and the expired international design, and

(c) the holder of that international registration notifies the registrar of such renewal,

the registrar must, as soon as reasonably practicable after the date of notification, record in the register of designs the extension of the period for which subsists the right in the re-registered international design which derives from the expired international design.

(2) Where the period for which the right in a re-registered international design subsists is extended under sub-paragraph (1), the right is to be treated as if it had never expired, with the result that—

(a) anything done under or in relation to the right in the period beginning with exit day and ending with the extension under sub-paragraph (1) is to be treated as valid,

(b) an act which would have constituted an infringement of the right if it had not expired is to be treated as an infringement, and

(c) an act which would have constituted use of the design for the services of the Crown if the right had not expired is to be treated as such use.

(3) If within the period referred to in sub-paragraph (1) the holder fails to notify the registrar in accordance with sub-paragraph (1)(c)—

(a) the registrar must remove from the register of designs the re-registered international design which derives from the expired international design, and

(b) the re-registered international design ceases with effect from exit day to be treated as if it had been registered under this Act.

(4) In sub-paragraph (1), the "relevant period" means the period of nine months beginning with the day after that on which exit day falls.

PART 4

Interpretation

Interpretation

15.—(1) In this Schedule—

"the Community Design Regulation" has the meaning given by paragraph 1(9);

"expired international design" has the meaning given by paragraph 13(1);

"the Geneva Act" has the meaning given by paragraph 1(9);

"the International Bureau" has the meaning given by paragraph 1(9);

"international registration" has the meaning given by paragraph 1(9);

"protected international registered design (EU)" has the meaning given by paragraph 1(1);

"re-registered international design" has the meaning given by paragraph 1(4).

(2) For the purposes of paragraphs 1(2)(b) and 11(2)(c), where the international registration to which a design is subject has not been published in its entirety but the design itself has been by

virtue of a request made under Article 11(4)(a) of the Geneva Act, the international registration is to be treated as having been published.”.**]**

Textual Amendments

F17 Sch. 1 para. 44 inserted (31.12.2020) by The Registered Designs and Trade Marks (Isle of Man) (Amendment) (EU Exit) Order 2019 (S.I. 2019/1335), art. 1, **Sch. 1 para. 11**; 2020 c. 1, Sch. 5 para. 1(1)

SCHEDULE 2

Article 3(2)

Modifications of provisions of the Copyright, Designs and Patents Act 1988 as it has effect in the Isle of Man

1. Any reference to an Act of Parliament (including the 1949 Act and the 1988 Act) or to a provision of such an Act shall be construed as a reference to that Act or provision as it has effect in the Isle of Man.

Commencement Information

I48 Sch. 2 para. 1 in force at 11.11.2013, see **art. 1**

2. Omit sections 265 and 268.

Commencement Information

I49 Sch. 2 para. 2 in force at 11.11.2013, see **art. 1**

3. In Schedule 3, omit paragraph 1, 2, 3(4), 4, 6, 9 and 31(2) and (5).

Commencement Information

I50 Sch. 2 para. 3 in force at 11.11.2013, see **art. 1**

4. Schedule 4 shall have effect as if the text of the 1949 Act contained therein were the text of that Act as modified by Schedule 1 to this Order.

Commencement Information

I51 Sch. 2 para. 4 in force at 11.11.2013, see **art. 1**

EXPLANATORY NOTE

(This note is not part of the Order)

This Order modifies the Registered Designs Act 1949, and certain provisions of the Copyright, Designs and Patents Act 1988 relating to registered designs, in their application to the Isle of Man. It replaces the Registered Designs (Isle of Man) Order 2001 (SI 2001/3678), and makes additional modifications to correspond to the amendments made to the 1949 Act (as it has effect in the United Kingdom) by the Registered Designs Regulations 2003 (SI 2003/550), the Community Design Regulations 2005 (SI 2005/2339), the Intellectual Property (Enforcement, etc.) Regulations 2006 (SI 2006/1028), the Registered Designs Act 1949 and Patents Act 1977 (Electronic Communications) Order 2006 (SI 2006/1229) and the Regulatory Reform (Registered Designs) Order 2006 (SI 2006/1974).

Changes to legislation:
There are currently no known outstanding effects for the The Registered Designs (Isle of Man) Order 2013.