
STATUTORY INSTRUMENTS

2006 No. 1028

The Intellectual Property (Enforcement, etc.) Regulations 2006

Citation and commencement

1. These Regulations may be cited as the Intellectual Property (Enforcement, etc.) Regulations 2006 and shall come into force on 29th April 2006.

Amendments of legislation

- 2.—(1) Schedule 1 (amendments to the Registered Designs Act 1949) shall have effect.
- (2) Schedule 2 (amendments to other primary legislation) shall have effect.
- (3) Schedule 3 (amendments to secondary legislation) shall have effect.
- (4) The enactments set out in Schedule 4 (repeals) shall be repealed or revoked to the extent specified.

Assessment of damages

3.—(1) Where in an action for infringement of an intellectual property right the defendant knew, or had reasonable grounds to know, that he engaged in infringing activity, the damages awarded to the claimant shall be appropriate to the actual prejudice he suffered as a result of the infringement.

- (2) When awarding such damages—
- (a) all appropriate aspects shall be taken into account, including in particular—
- (i) the negative economic consequences, including any lost profits, which the claimant has suffered, and any unfair profits made by the defendant; and
- (ii) elements other than economic factors, including the moral prejudice caused to the claimant by the infringement; or
- (b) where appropriate, they may be awarded on the basis of the royalties or fees which would have been due had the defendant obtained a licence.
- (3) This regulation does not affect the operation of any enactment or rule of law relating to remedies for the infringement of intellectual property rights except to the extent that it is inconsistent with the provisions of this regulation.
- (4) In the application of this regulation to—
- (a) Scotland, “claimant” includes pursuer; “defendant” includes defender; and “enactment” includes an enactment comprised in, or an instrument made under, an Act of the Scottish Parliament; and
- (b) Northern Ireland, “claimant” includes plaintiff.

Order in Scotland for disclosure of information

4.—(1) This regulation applies to proceedings in Scotland concerning an infringement of an intellectual property right.

(2) The pursuer may apply to the court for an order that information regarding the origin and distribution networks of goods or services which infringe an intellectual property right shall be disclosed to him by the relevant person.

(3) The court may only order the information to be disclosed where it considers it just and proportionate having regard to the rights and privileges of the relevant person and others; such an order may be subject to such conditions as the court thinks fit.

(4) The relevant person is—

(a) the alleged infringer,

(b) any person who—

(i) was found in possession of the infringing goods on a commercial scale,

(ii) was found to be using the infringing services on a commercial scale, or

(iii) was found to be providing services on a commercial scale, which are used in activities which infringe an intellectual property right, or

(c) any person who has been identified by a person specified in sub-paragraph (b) as being involved in—

(i) the production, manufacture or distribution of the infringing goods, or

(ii) the provision of the infringing services.

(5) For the purposes of paragraph (3), the court may order the disclosure of any of the following types of information—

(a) the names and addresses of—

(i) each producer, manufacturer, distributor or supplier of the infringing goods or services;

(ii) any person who previously possessed the infringing goods; and

(iii) the intended wholesaler and retailer of the infringing goods or services; and

(b) information relating to—

(i) the quantities of infringing goods or the amount of infringing services provided, produced, manufactured, delivered, received or ordered; and

(ii) the price paid for the infringing goods or infringing services in question.

(6) Nothing in this regulation affects—

(a) any right of the pursuer to receive information under any other enactment (including an enactment comprised in, or an instrument made under, an Act of the Scottish Parliament) or rule of law; and

(b) any other power of the court.

(7) For the purposes of this regulation and regulation 5, “court” means the Court of Session or the sheriff.

Order in Scotland for publication of judgments

5. In Scotland, where the court finds that an intellectual property right has been infringed, the court may, at the request of the pursuer, order appropriate measures for the dissemination and publication of the judgment to be taken at the defender’s expense.

5th April 2006

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