

Draft Order laid before Parliament under section 37(4B) of the Registered Designs Act 1949, for approval by resolution of each House of Parliament.

DRAFT STATUTORY INSTRUMENTS

2017 No. XXXX

DESIGNS

**The Designs (International Registration of Industrial Designs)
Order 2017**

Made - - - -

Coming into force in accordance with article 1(2)

The Secretary of State makes this Order in exercise of the power conferred by section 15ZA of the Registered Designs Act 1949(a).

In accordance with section 37(4B) of the Registered Designs Act 1949, a draft of the Order has been laid before and approved by resolution of, each House of Parliament.

Citation, commencement and extent

1.—(1) This Order may be cited as the Designs (International Registration of Industrial Designs) Order 2017.

(2) This Order comes into force on the date on which the United Kingdom becomes bound by the Geneva Act of the Hague Agreement concerning the International Registration of Industrial Designs(b) pursuant to article 28(3)(b) of that Act.

(3) This Order extends to England and Wales, Scotland, Northern Ireland and the Isle of Man.

Interpretation

2. In this Order—

“the 2006 Rules” means the Registered Design Rules 2006(c);

“the Act” means the Registered Designs Act 1949 and “section” means a section of that Act;

“Common Regulations” means the regulations adopted under Article 24 of the Geneva Act with effect from 1st January 2017;

(a) 1949 c.88; section 15ZA was inserted by section 8(1) of the Intellectual Property Act 2014 (c.18).

(b) Article 28(3) of the Geneva Act of the Hague Agreement provides that “(a) Any State or intergovernmental organisation that has deposited its instrument of ratification or accession three months or so before the date of entry into force of this Act shall become bound by this Act on the date of entry into force of this Act. (b) Any other State or intergovernmental organisation shall become bound by this Act three months after the date on which it has deposited its instruments of ratification or accession or at any later date indicated in that instrument.” The date will be notified in the London, Edinburgh and Belfast Gazettes. It will also be possible to find out the date on which the Geneva Act comes into force in the United Kingdom by referring to the relevant page on Gov.UK. The link to that page is <https://www.gov.uk/government/collections/treaty-series-2013>.

(c) S.I. 2006/1975, amended by S.I. 2008/2683, S.I. 2009/546, S.I. 2013/444.

“Geneva Act” means the Geneva Act of the Hague Agreement concerning the international registration of industrial designs adopted by the diplomatic conference on 2nd July 1999(a);

“holder”, in relation to an international registration, means the person in whose name an international registration is recorded in the International Register;

“International Bureau” means the International Bureau of the World Intellectual Property Organisation;

“International Register” means the register of industrial designs maintained by the International Bureau for the purposes of the Geneva Act;

“international registration” means a registration of a design in the International Register for the purpose of the Geneva Act and the Common Regulations;

“protected international registration (UK)” means a grant of protection under Rule 18bis of the Common Regulations for a design which is the subject of a request for international registration (UK), and references to “protection” and “protected” are construed accordingly;

“request for international registration (UK)” means a request for international registration made in pursuance of Article 5(1) of the Geneva Act in respect of which the United Kingdom is a designated Contracting Party.

International registration

3. The provisions of the Act (except those listed in Part 1 of Schedule 1) and the 2006 Rules (except those listed in Part 2 of Schedule 1) apply to a design which is the subject of a protected international registration (UK) and a request for international registration (UK) with the following modifications—

- (a) references to a registered design are to include references to a design which is the subject of a protected international registration (UK);
- (b) references to a registered proprietor are to include references to a holder of an international registration in respect of which a protected international registration (UK) applies;
- (c) references to an application for registration of a design are to include references to a request for international registration (UK);
- (d) references to an applicant for registration are to include references to the holder of an international registration making a request for an international registration (UK);
- (e) references to registration of a design are to include the conferring of protection for a design so that it becomes a protected international registration (UK) and include any changes to the registration;
- (f) references to the register are to the International Register;
- (g) the modifications to the Act and the 2006 Rules set out in Schedule 2; and
- (h) such further modifications as the context requires for the purpose of giving effect to those provisions as applied by this Order.

Communication of information to the International Bureau

4. Notwithstanding any other enactment or rule of law, the registrar may communicate to the International Bureau any information which the registrar is required to communicate under the Act (as it has effect by virtue of this Order) or pursuant to the Geneva Act or Common Regulations.

Name
Minister of State for Universities, Science and Innovation

Date Department for Business, Innovation and Skills

(a) The National Archive Reference for the Geneva Act of the Hague Agreement is FO 949/1049/0: 0. The text of the Geneva Act of the Hague Agreement is also available at <http://www.wipo.int/wipolex/en/details.jsp?id=12531>.

LEGISLATIVE DISAPPLICATIONS

PART 1

PROVISIONS OF THE ACT WHICH DO NOT APPLY TO PROTECTED
INTERNATIONAL REGISTRATIONS (UK) OR REQUESTS FOR
INTERNATIONAL REGISTRATION (UK)

- section 3 (application for registration)
- section 3A(2) (determination of applications for registration)
- section 3B (modification of applications for registration)
- section 3C(2) and (3) (date of registrations of designs)
- section 5 (provisions for secrecy of certain designs)
- section 8A (restoration of lapsed right in design)
- section 8B (effect of order for restoration of right)
- section 11 (cancellation of registration)
- section 11ZD (modification of registration)
- section 14(1) and (3) (registration of design where application for protection in a convention country has been made)
- section 15 (extension of time for application under s. 14 in certain cases)
- section 15B(2) (assignment, &c. of registered designs and applications for registered designs)
- section 17 (register of designs etc.) except section 17(8)
- section 18 (certificate of registration)
- section 19 (registration of assignments, etc.)
- section 20 (rectification of register)
- section 21 (power to correct clerical errors)
- section 22 (inspection of registered designs)
- section 31A(1)(a) (power to require to use forms)
- section 33 (offences under s. 5)
- section 36(1A)(ab) and (d) (general power of Secretary of State to make rules, etc.)

PART 2

PROVISIONS OF THE 2006 RULES WHICH DO NOT APPLY TO PROTECTED
INTERNATIONAL REGISTRATIONS (UK) OR REQUESTS FOR
INTERNATIONAL REGISTRATION (UK)

- rule 4 (applications)
- rule 5 (formal requirements)

rule 6 (partial disclaimers)
rule 7(2) and (5) (convention applications)
rule 9 (representation of design for publication)
rule 10 (time limits under section 3(5) and section 3B)
rule 11 (publication)
rule 12 (extension of duration of right in registered design)
rule 13 (restoration of a lapsed right in a design under section 8A)
rule 14 (cancellation of registration)
rule 26 (certificate of registration)
rule 27 (registration of interests) (except paragraph (4) of rule 27)
rule 28 (inspection of register, representations and specimens)
rule 31 (information about rights in registered designs)
rule 32 (copies of entries in, or extracts from, the register)
rule 33 (copies of representations and specimens)
rule 34 (alteration of name or address)
rule 35 (notice of rectification of the register)

SCHEDULE 2

Article 3(g)

PART 1

MODIFICATIONS TO PROVISIONS OF THE ACT APPLIED TO PROTECTED INTERNATIONAL REGISTRATIONS (UK) AND REQUESTS FOR INTERNATIONAL REGISTRATION (UK)

1. The Act is modified as follows.
2. Section 1B (requirement of novelty and individual character) applies with the omission in subsection (7) of “3B(2), (3) or (5) or”.
3. Section 3A (determination of applications for registration) applies—
 - (a) with the substitution for subsection (3) of—

“(3) If it appears to the registrar that the holder of an international registration making a request for international registration (UK) of a design in respect of which protection has been applied for in a convention country is not the person who applied for protection in that country (or that person’s personal representative), he shall refuse the request”;
 - (b) with the substitution in subsection (4) for “register that thing or that design” of “confer protection for that design or thing so that it becomes a protected international registration (UK).”;
 - (c) with the insertion after subsection (4) of—

“(5) Where the registrar—

 - (a) refuses a request for international registration (UK); or

- (b) proceeds with the grant of a request for international registration (UK) on consideration of the applicant's observations or representations or successful appeal of a decision to refuse a request for international registration (UK), the registrar must notify the International Bureau in accordance with Article 12 of the Geneva Act and Rule 18 of the Common Regulations.”.
- 4.** Section 3C (date of registrations of designs) applies with the substitution for subsection (1) of—
- “(1) A design which is the subject of a request for international registration (UK) shall be protected from and including the date on which the international registration produces the effect as a grant of protection under this Act notified in the statement of grant of protection under Rule 18bis of the Common Regulations.”.
- 5.** Section 3D (appeals in relation to applications for registration) applies with the reference to section 3A as modified under paragraph 3 and the omission of the reference to section 3B.
- 6.** Section 7A (infringement of rights in registered design) applies with the substitution for subsection (6) of—
- “(6) No proceedings shall be taken in respect of an infringement of the right in a design which is the subject of a protected international registration (UK) committed before the date of issue of the statement of grant of protection under Rule 18bis of the Common Regulations.”.
- 7.** Subsection (2) of section 7B (right of prior use) applies—
- (a) with the omission in paragraph (a) of “under section 3”;
- (b) with the substitution for paragraph (b) of—
- “(b) where a request was made for international registration (UK) for a design in respect of which protection has been applied for in a convention country, the date on which it was treated as having been so made.”.
- 8.** Section 8 (duration of right in registered design) applies with the substitution for subsections (2) and (3) of—
- “(2) The period for which the right subsists may be extended for a second, third, fourth and fifth period of five years, by applying to the International Bureau, in accordance with Article 17 of the Geneva Act and subject to the payment of the fees specified under the Common Regulations.
- (3) If the first, second, third or fourth period expires without such application and payment being made, the protected international registration (UK) shall cease to have effect.”.
- 9.** Section 11ZA(1B) (grounds for invalidity of registration) applies, with the omission of “3B(2), (3) or (5) or”.
- 10.** Section 11ZB (applications for declarations of invalidity) applies—
- (a) with the insertion in subsection (2) of “or the court” after “registrar”;
- (b) with the insertion in subsection (3) of “or the court” after “registrar”;
- (c) with the insertion in subsection (5) of “or the court” after “registrar”.
- 11.** Section 11ZE (effect of cancellation or invalidation of registration) applies—
- (a) with the omission of subsection (1);
- (b) with the insertion in subsection (2) of “or the court” after “registrar”.
- 12.** Section 11ZF (appeals in relation to cancellation or invalidation) applies with substitution for “11 to 11ZE” of “11ZA, 11ZB, 11ZC and 11ZE”.

13. Section 14 (registration of design where application for protection in convention country has been made) applies with the reference in subsection (2) to an application for registration of a design made by virtue of section 14 being read as a request for international registration (UK) for a design in respect of which protection has been applied for in a convention country.

14. Section 15B (assignment, &c. of registered designs and applications for registered designs), applies, with the substitution for subsection (1) of—

“(1) A protected international registration (UK) is transmissible by assignment, testamentary disposition or operation of law in the same way as other personal or moveable property.”.

15. Section 40 (fees) applies with the omission of the words “the registration of designs and applications therefore, and in respect of other”.

16. Section 44 (interpretation) applies with the insertion after paragraph (4) of—

“(5) Any expression defined for the purposes of the Designs (International Registration of Industrial Designs) Order 2017(a) which is used in this Act as modified by that Order has the same meaning as in that Order.”.

PART 2

MODIFICATION OF RULES APPLIED TO PROTECTED INTERNATIONAL REGISTRATIONS (UK) AND REQUESTS FOR INTERNATIONAL REGISTRATION (UK)

17. The 2006 Rules are modified as follows.

18. Rule 2 applies with the insertion after paragraph (2) of—

“(3) Any expression defined for the purposes of the Designs (International Registration of Industrial Designs) Order 2017 which is used in the Rules as modified by that Order has the same meaning as in that Order.”

19. Rule 7 applies—

(a) with the substitution for paragraph (1) of—

“(1) Where a request was made for international registration (UK) of a design in respect of which protection has been applied for in a convention country, the applicant shall comply with the following provisions.”;

(b) with the substitution for paragraph (3) of—

“(3) At the request of the registrar the applicant must file at the Patent Office a copy of the representation of the design that was the subject of each convention application within such period as the registrar may specify in that request.”.

20. Rule 8 applies with the substitution for paragraph (1) of—

“(1) Where it appears to the registrar that the requirements for conferral of protection for a design so that it becomes a protected international registration (UK) are not met—

(a) by reason of the request for international registration (UK) not being made in accordance with the rules applicable to international registration (UK); or

(b) by reason of section 3A(3) or (4),

the registrar must give notice of refusal to the International Bureau in accordance with article 12 of the Geneva Act and rule 18 of the Common Regulations.”.

21. Rule 17 applies with the insertion after paragraph (2) of—

(a) S.I. 2017/XXXX.

“(3) The registrar must notify the International Bureau of the decision on the application for a declaration of invalidity under section 11ZB in accordance with article 15 of the Geneva Act and rule 20 of the Common Regulations.

(4) The decision mentioned in paragraph (3) means a decision from which no appeal may be brought on whether the finding of invalidation should be upheld.”.

22. Rule 36(2)(a) applies with the omission at the end of paragraph (iii) of “or” and the insertion after the final “or” of—

“(iv) making an application for a protected international registration (UK); or”.

EXPLANATORY NOTE

(This note is not part of the Order)

This Order is made under the powers conferred by section 15ZA of the Registered Designs Act 1949 ('RDA') to give effect in the United Kingdom to the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs and the Commons Regulations made under that Act. The Geneva Act, which was adopted on 2nd July 1999 and entered into force on 23rd December 2003, allows designers to obtain design protection in a number of countries through a single international registration. The text of the Geneva Act and the Common Regulations is available electronically from <http://www.wipo.int/treaties/en/registration/hague>.

As a result of the United Kingdom's ratification of the Geneva Act, it will be possible for applicants for an international registration to apply for protection of their designs in the United Kingdom and the Isle of Man (the expression "United Kingdom" in the RDA includes the Isle of Man – See section 47 of the RDA). An international registration designating the United Kingdom has, from the date of its protection in the United Kingdom, the same effect as the registration of a design in the United Kingdom under the Act.

Article 2 sets out definitions of terms used in the Order.

Article 3 provides for the provisions of the RDA and the Registered Designs Rules 2006 ("the 2006 Rules") to apply to a design which is the subject of a protected international registration (UK) and a request for international registration (UK). Schedule 1 sets out the provisions of the RDA and the 2006 Rules that do not apply to a protected international registration (UK) or request for international registration (UK). Schedule 2 sets out the modifications of the provisions of the RDA and the 2006 Rules that apply to these registrations.

Article 4 provides that the registrar may communicate such information as is required to the International Bureau.

A full impact assessment of the effect that ratification of the Geneva Act will have on the costs of business, the voluntary sector and the public sector was prepared for the Intellectual Property Act 2014 which amended the RDA to include the powers for ratification of the Geneva Act of the Hague Agreement. This is available from the Intellectual Property Office, Concept House, Cardiff Road, Newport NP10 8QQ. An Explanatory Memorandum has been prepared and is available alongside the instrument on www.legislation.gov.uk. Copies have also been placed in the libraries of both Houses of Parliament. Copies of the Geneva Act and Common Regulations are also available from the Intellectual Property Office.

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£6.00

UK201710191005 10/2017 19585

<http://www.legislation.gov.uk/id/ukdsi/2017/9780111160794>

ISBN 978-0-11-116079-4



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