



# Intellectual Property (Unjustified Threats) Act 2017

## 2017 CHAPTER 14

*Registered designs, design right and Community design*

### **4 Registered designs**

- (1) The Registered Designs Act 1949 is amended as follows.
- (2) For the heading before sections 24A to 28 substitute—

*“Legal proceedings: general”.*

- (3) For section 26 (remedy for unjustified threats of infringement proceedings) substitute—

*“Unjustified threats*

### **26 Threats of infringement proceedings**

- (1) A communication contains a “threat of infringement proceedings” if a reasonable person in the position of a recipient would understand from the communication that—
  - (a) a registered design exists, and
  - (b) a person intends to bring proceedings (whether in a court in the United Kingdom or elsewhere) against another person for infringement of the right in the registered design by—
    - (i) an act done in the United Kingdom, or
    - (ii) an act which, if done, would be done in the United Kingdom.
- (2) References in this section and in section 26C to a “recipient” include, in the case of a communication directed to the public or a section of the public, references to a person to whom the communication is directed.

## **26A Actionable threats**

- (1) Subject to subsections (2) to (5), a threat of infringement proceedings made by any person is actionable by any person aggrieved by the threat.
- (2) A threat of infringement proceedings is not actionable if the infringement is alleged to consist of—
  - (a) making a product for disposal, or
  - (b) importing a product for disposal.
- (3) A threat of infringement proceedings is not actionable if the infringement is alleged to consist of an act which, if done, would constitute an infringement of a kind mentioned in subsection (2)(a) or (b).
- (4) A threat of infringement proceedings is not actionable if the threat—
  - (a) is made to a person who has done, or intends to do, an act mentioned in subsection (2)(a) or (b) in relation to a product, and
  - (b) is a threat of proceedings for an infringement alleged to consist of doing anything else in relation to that product.
- (5) A threat of infringement proceedings which is not an express threat is not actionable if it is contained in a permitted communication.
- (6) In sections 26C and 26D an “actionable threat” means a threat of infringement proceedings that is actionable in accordance with this section.

## **26B Permitted communications**

- (1) For the purposes of section 26A(5), a communication containing a threat of infringement proceedings is a “permitted communication” if—
  - (a) the communication, so far as it contains information that relates to the threat, is made for a permitted purpose;
  - (b) all of the information that relates to the threat is information that—
    - (i) is necessary for that purpose (see subsection (5)(a) to (c) for some examples of necessary information), and
    - (ii) the person making the communication reasonably believes is true.
- (2) Each of the following is a “permitted purpose”—
  - (a) giving notice that a registered design exists;
  - (b) discovering whether, or by whom, the right in a registered design has been infringed by an act mentioned in section 26A(2)(a) or (b);
  - (c) giving notice that a person has a right in or under a registered design, where another person’s awareness of the right is relevant to any proceedings that may be brought in respect of the registered design.
- (3) The court may, having regard to the nature of the purposes listed in subsection (2)(a) to (c), treat any other purpose as a “permitted purpose” if it considers that it is in the interests of justice to do so.
- (4) But the following may not be treated as a “permitted purpose”—

- (a) requesting a person to cease doing, for commercial purposes, anything in relation to a product in which a design is incorporated or to which it is applied,
  - (b) requesting a person to deliver up or destroy a product in which a design is incorporated or to which it is applied, or
  - (c) requesting a person to give an undertaking relating to a product in which a design is incorporated or to which it is applied.
- (5) If any of the following information is included in a communication made for a permitted purpose, it is information that is “necessary for that purpose” (see subsection (1)(b)(i))—
- (a) a statement that a right in a registered design exists and is in force or that an application for registration of a design has been made;
  - (b) details of the registered design, or of a right in or under the right in the registered design, which—
    - (i) are accurate in all material respects, and
    - (ii) are not misleading in any material respect; and
  - (c) information enabling the identification of the products in which the registered design is allegedly incorporated or to which the registered design is allegedly applied.

### **26C Remedies and defences**

- (1) Proceedings in respect of an actionable threat may be brought against the person who made the threat for—
- (a) a declaration that the threat is unjustified;
  - (b) an injunction against the continuance of the threat;
  - (c) damages in respect of any loss sustained by the aggrieved person by reason of the threat.
- (2) It is a defence for the person who made the threat to show that the act in respect of which proceedings were threatened constitutes (or if done would constitute) an infringement of the right in the registered design.
- (3) It is a defence for the person who made the threat to show—
- (a) that, despite having taken reasonable steps, the person has not identified anyone who has done an act mentioned in section 26A(2)(a) or (b) in relation to the product which is the subject of the threat, and
  - (b) that the person notified the recipient, before or at the time of making the threat, of the steps taken.

### **26D Professional advisers**

- (1) Proceedings in respect of an actionable threat may not be brought against a professional adviser (or any person vicariously liable for the actions of that professional adviser) if the conditions in subsection (3) are met.
- (2) In this section “professional adviser” means a person who, in relation to the making of the communication containing the threat—
- (a) is acting in a professional capacity in providing legal services or the services of a trade mark attorney or a patent attorney, and

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*Status: This is the original version (as it was originally enacted).*

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- (b) is regulated in the provision of legal services, or the services of a trade mark attorney or a patent attorney, by one or more regulatory bodies (whether through membership of a regulatory body, the issue of a licence to practise or any other means).
- (3) The conditions are that—
  - (a) in making the communication the professional adviser is acting on the instructions of another person, and
  - (b) when the communication is made the professional adviser identifies the person on whose instructions the adviser is acting.
- (4) This section does not affect any liability of the person on whose instructions the professional adviser is acting.
- (5) It is for a person asserting that subsection (1) applies to prove (if required) that at the material time—
  - (a) the person concerned was acting as a professional adviser, and
  - (b) the conditions in subsection (3) were met.

#### **26E Supplementary: pending registration**

- (1) In sections 26 and 26B references to a registered design include references to a design in respect of which an application for registration has been made under section 3.
- (2) Where the threat of infringement proceedings is made after an application for registration has been made (but before registration) the reference in section 26C(2) to “the registered design” is to be treated as a reference to the design registered in pursuance of that application.

#### **26F Supplementary: proceedings for delivery up etc.**

In section 26(1)(b) the reference to proceedings for infringement of the right in a registered design includes a reference to—

- (a) proceedings for an order under section 24C (order for delivery up), and
  - (b) proceedings for an order under section 24D (order as to disposal of infringing articles).”
- (4) Before section 27 insert—

*“Meaning of “the court” and appeals”.*

- (5) In section 45 (application to Scotland) after subsection (1) insert—

“(1A) In the application of section 26C(1)(a) (remedy for unjustified threat of infringement proceedings) to Scotland, “declaration” means “declarator”.”

## **5 Design right**

- (1) Part 3 of the Copyright, Designs and Patents Act 1988 (design right) is amended as follows.

- (2) For section 253 (remedy for unjustified threats of infringement proceedings), and the heading immediately before that section, substitute—

*“Unjustified threats*

**253 Threats of infringement proceedings**

- (1) A communication contains a “threat of infringement proceedings” if a reasonable person in the position of a recipient would understand from the communication that—
- (a) design right subsists in a design, and
  - (b) a person intends to bring proceedings (whether in a court in the United Kingdom or elsewhere) against another person for infringement of the design right by—
    - (i) an act done in the United Kingdom, or
    - (ii) an act which, if done, would be done in the United Kingdom.
- (2) References in this section and in section 253C to a “recipient” include, in the case of a communication directed to the public or a section of the public, references to a person to whom the communication is directed.

**253A Actionable threats**

- (1) Subject to subsections (2) to (5), a threat of infringement proceedings made by any person is actionable by any person aggrieved by the threat.
- (2) A threat of infringement proceedings is not actionable if the infringement is alleged to consist of—
- (a) making an article for disposal, or
  - (b) importing an article for disposal.
- (3) A threat of infringement proceedings is not actionable if the infringement is alleged to consist of an act which, if done, would constitute an infringement of a kind mentioned in subsection (2)(a) or (b).
- (4) A threat of infringement proceedings is not actionable if the threat—
- (a) is made to a person who has done, or intends to do, an act mentioned in subsection (2)(a) or (b) in relation to an article, and
  - (b) is a threat of proceedings for an infringement alleged to consist of doing anything else in relation to that article.
- (5) A threat of infringement proceedings which is not an express threat is not actionable if it is contained in a permitted communication.
- (6) In sections 253C and 253D an “actionable threat” means a threat of infringement proceedings that is actionable in accordance with this section.

**253B Permitted communications**

- (1) For the purposes of section 253A(5), a communication containing a threat of infringement proceedings is a “permitted communication” if—

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*Status: This is the original version (as it was originally enacted).*

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- (a) the communication, so far as it contains information that relates to the threat, is made for a permitted purpose;
  - (b) all of the information that relates to the threat is information that—
    - (i) is necessary for that purpose (see subsection (5)(a) to (c) for some examples of necessary information), and
    - (ii) the person making the communication reasonably believes is true.
- (2) Each of the following is a “permitted purpose”—
- (a) giving notice that design right subsists in a design;
  - (b) discovering whether, or by whom, design right in a design has been infringed by an act mentioned in section 253A(2)(a) or (b);
  - (c) giving notice that a person has a right in or under the design right in a design, where another person’s awareness of the right is relevant to any proceedings that may be brought in respect of the design right in the design.
- (3) The court may, having regard to the nature of the purposes listed in subsection (2)(a) to (c), treat any other purpose as a “permitted purpose” if it considers that it is in the interests of justice to do so.
- (4) But the following may not be treated as a “permitted purpose”—
- (a) requesting a person to cease doing, for commercial purposes, anything in relation to an article made to a design,
  - (b) requesting a person to deliver up or destroy an article made to a design, or
  - (c) requesting a person to give an undertaking relating to an article made to a design.
- (5) If any of the following information is included in a communication made for a permitted purpose, it is information that is “necessary for that purpose” (see subsection (1)(b)(i))—
- (a) a statement that design right subsists in a design;
  - (b) details of the design, or of a right in or under the design right in the design, which—
    - (i) are accurate in all material respects, and
    - (ii) are not misleading in any material respect; and
  - (c) information enabling the identification of articles that are alleged to be infringing articles in relation to the design.

### **253C Remedies and defences**

- (1) Proceedings in respect of an actionable threat may be brought against the person who made the threat for—
- (a) a declaration that the threat is unjustified;
  - (b) an injunction against the continuance of the threat;
  - (c) damages in respect of any loss sustained by the aggrieved person by reason of the threat.

- (2) It is a defence for the person who made the threat to show that the act in respect of which proceedings were threatened constitutes (or if done would constitute) an infringement of design right.
- (3) It is a defence for the person who made the threat to show—
  - (a) that, despite having taken reasonable steps, the person has not identified anyone who has done an act mentioned in section 253A(2) (a) or (b) in relation to the article which is the subject of the threat, and
  - (b) that the person notified the recipient, before or at the time of making the threat, of the steps taken.

### **253D Professional advisers**

- (1) Proceedings in respect of an actionable threat may not be brought against a professional adviser (or any person vicariously liable for the actions of that professional adviser) if the conditions in subsection (3) are met.
- (2) In this section “professional adviser” means a person who, in relation to the making of the communication containing the threat—
  - (a) is acting in a professional capacity in providing legal services or the services of a trade mark attorney or a patent attorney, and
  - (b) is regulated in the provision of legal services, or the services of a trade mark attorney or a patent attorney, by one or more regulatory bodies (whether through membership of a regulatory body, the issue of a licence to practise or any other means).
- (3) The conditions are that—
  - (a) in making the communication the professional adviser is acting on the instructions of another person, and
  - (b) when the communication is made the professional adviser identifies the person on whose instructions the adviser is acting.
- (4) This section does not affect any liability of the person on whose instructions the professional adviser is acting.
- (5) It is for a person asserting that subsection (1) applies to prove (if required) that at the material time—
  - (a) the person concerned was acting as a professional adviser, and
  - (b) the conditions in subsection (3) were met.

### **253E Supplementary: proceedings for delivery up etc.**

In section 253(1)(b) the reference to proceedings for infringement of design right includes a reference to—

- (a) proceedings for an order under section 230 (order for delivery up), and
  - (b) proceedings for an order under section 231 (order as to disposal of infringing articles).”
- (3) Before section 254 insert—

*“Licensee under licence of right not to claim connection with design right owner”.*

- (4) In section 262 (adaptation of expressions in relation to Scotland) at the appropriate place insert—

““declaration” means “declarator”.”.

## 6 Community design

- (1) The Community Design Regulations 2005 (S.I. 2005/2339) are amended as follows.
- (2) For regulation 2 (remedy for unjustified threats of infringement proceedings) substitute—

### **“2 Unjustified threats: threats of infringement proceedings**

- (1) A communication contains a “threat of infringement proceedings” if a reasonable person in the position of a recipient would understand from the communication that—
- (a) a Community design exists, and
  - (b) a person intends to bring proceedings (whether in a court in the United Kingdom or elsewhere) against another person for infringement of the Community design by—
    - (i) an act done in the United Kingdom, or
    - (ii) an act which, if done, would be done in the United Kingdom.
- (2) References in this regulation and in regulation 2C to a “recipient” include, in the case of a communication directed to the public or a section of the public, references to a person to whom the communication is directed.

### **2A Unjustified threats: actionable threats**

- (1) Subject to paragraphs (2) to (5), a threat of infringement proceedings made by any person is actionable by any person aggrieved by the threat.
- (2) A threat of infringement proceedings is not actionable if the infringement is alleged to consist of—
- (a) making an article for disposal, or
  - (b) importing an article for disposal.
- (3) A threat of infringement proceedings is not actionable if the infringement is alleged to consist of an act which, if done, would constitute an infringement of a kind mentioned in paragraph (2)(a) or (b).
- (4) A threat of infringement proceedings is not actionable if the threat—
- (a) is made to a person who has done, or intends to do, an act mentioned in paragraph (2)(a) or (b) in relation to an article, and
  - (b) is a threat of proceedings for an infringement alleged to consist of doing anything else in relation to that article.
- (5) A threat of infringement proceedings which is not an express threat is not actionable if it is contained in a permitted communication.
- (6) In regulations 2C and 2D an “actionable threat” means a threat of infringement proceedings that is actionable in accordance with this regulation.



## **2B Unjustified threats: permitted communications**

- (1) For the purposes of regulation 2A(5), a communication containing a threat of infringement proceedings is a “permitted communication” if—
  - (a) the communication, so far as it contains information that relates to the threat, is made for a permitted purpose;
  - (b) all of the information that relates to the threat is information that—
    - (i) is necessary for that purpose (see paragraph (5)(a) to (c) for some examples of necessary information), and
    - (ii) the person making the communication reasonably believes is true.
- (2) Each of the following is a “permitted purpose”—
  - (a) giving notice that a Community design exists;
  - (b) discovering whether, or by whom, a Community design has been infringed by an act mentioned in regulation 2A(2)(a) or (b);
  - (c) giving notice that a person has a right in or under a Community design, where another person’s awareness of the right is relevant to any proceedings that may be brought in respect of the Community design.
- (3) The court may, having regard to the nature of the purposes listed in paragraph (2)(a) to (c), treat any other purpose as a “permitted purpose” if it considers that it is in the interests of justice to do so.
- (4) But the following may not be treated as a “permitted purpose”—
  - (a) requesting a person to cease doing, for commercial purposes, anything in relation to an article made to a design, in which a design is incorporated or to which it is applied,
  - (b) requesting a person to deliver up or destroy an article made to a design, in which a design is incorporated or to which it is applied, or
  - (c) requesting a person to give an undertaking relating to an article made to a design, in which a design is incorporated or to which it is applied.
- (5) If any of the following information is included in a communication made for a permitted purpose, it is information that is “necessary for that purpose” (see paragraph (1)(b)(i))—
  - (a) a statement—
    - (i) that a design is a registered Community design and the registration is in force,
    - (ii) that an application for a registered Community design has been made, or
    - (iii) that a design is protected as an unregistered Community design;
  - (b) details of the Community design, or of a right in or under the Community design, which—
    - (i) are accurate in all material respects, and
    - (ii) are not misleading in any material respect; and
  - (c) information enabling the identification of the article that is alleged to be infringing an article in relation to the design.

## **2C Unjustified threats: remedies and defences**

- (1) Proceedings in respect of an actionable threat may be brought against the person who made the threat for—
  - (a) a declaration that the threat is unjustified;
  - (b) an injunction against the continuance of the threat;
  - (c) damages in respect of any loss sustained by the aggrieved person by reason of the threat.
- (2) It is a defence for the person who made the threat to show that the act in respect of which proceedings were threatened constitutes (or if done would constitute) an infringement of the Community design.
- (3) It is a defence for the person who made the threat to show—
  - (a) that, despite having taken reasonable steps, the person has not identified anyone who has done an act mentioned in regulation 2A(2) (a) or (b) in relation to the article which is the subject of the threat, and
  - (b) that the person notified the recipient, before or at the time of making the threat, of the steps taken.

## **2D Unjustified threats: professional advisers**

- (1) Proceedings in respect of an actionable threat may not be brought against a professional adviser (or any person vicariously liable for the actions of that professional adviser) if the conditions in paragraph (3) are met.
- (2) In this section “professional adviser” means a person who, in relation to the making of the communication containing the threat—
  - (a) is acting in a professional capacity in providing legal services or the services of a trade mark attorney or a patent attorney, and
  - (b) is regulated in the provision of legal services, or the services of a trade mark attorney or a patent attorney, by one or more regulatory bodies (whether through membership of a regulatory body, the issue of a licence to practise or any other means).
- (3) The conditions are that—
  - (a) in making the communication the professional adviser is acting on the instructions of another person, and
  - (b) when the communication is made the professional adviser identifies the person on whose instructions the adviser is acting.
- (4) This section does not affect any liability of the person on whose instructions the professional adviser is acting.
- (5) It is for a person asserting that paragraph (1) applies to prove (if required) that at the material time—
  - (a) the person concerned was acting as a professional adviser, and
  - (b) the conditions in paragraph (3) were met.

### **2E Unjustified threats: supplementary: pending registration**

- (1) In the application of regulations 2 and 2B in relation to a registered Community design, references to a Community design include references to a Community design in respect of which an application for registration has been filed in accordance with Article 35 of the Community Design Regulation.
- (2) Where the threat of infringement proceedings is made after an application for registration has been filed (but before registration) the reference in regulation 2C(2) to “the Community design” is to be treated as a reference to the design registered in pursuance of that application.

### **2F Unjustified threats: supplementary: proceedings for delivery up etc.**

In regulation 2(1)(b) the reference to proceedings for infringement of the Community design includes a reference to—

- (a) proceedings for an order under regulation 1B (order for delivery up), and
  - (b) proceedings for an order under regulation 1C (order as to disposal of infringing articles).”
- (3) In regulation 5A(1) (application to Scotland) at the appropriate place insert—  
““declaration” means “declarator”,”.