



# 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

- (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”.”