



Intellectual Property (Unjustified Threats) Act 2017

2017 CHAPTER 14

Registered designs, design right and Community design

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.

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- (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

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- (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

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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 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”.”.

Commencement Information

II S. 6 in force at 1.10.2017 by S.I. 2017/771, reg. 2(1)(b) (with reg. 3)

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