

## SCHEDULE 1

Article 2(1)

### MODIFICATIONS OF THE REGISTERED DESIGNS ACT 1949 AS IT HAS EFFECT IN THE ISLE OF MAN

1. Any reference to an Act of Parliament (including the 1949 Act) or to a provision of such an Act shall be construed, unless the contrary intention appears, as a reference to that Act or provision as it has effect in the Isle of Man.

2. Notwithstanding section 47, any reference to the United Kingdom which occurs in the expression “His Majesty’s Government in the United Kingdom” does not include the Isle of Man.

3. References to the Crown (but not “crown”) include the Crown in right of the Government of the Isle of Man.

4. References to a Government department shall be construed as including references to a Department of the Government of the Isle of Man, and in relation to such a Department references to the Treasury shall be construed as references to the Treasury of the Isle of Man.

5. For section 1(1) (designs registrable under Act) substitute—

#### “1 Registration of designs

(1) A design may, subject to the following provisions of this Act, be registered under this Act on the making of an application for registration.

(2) In this Act “design” means the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture or materials of the product or its ornamentation.

(3) In this Act—

“complex product” means a product which is composed of at least two replaceable component parts permitting disassembly and reassembly of the product; and

“product” means any industrial or handicraft item other than a computer program; and, in particular, includes packaging, get-up, graphic symbols, typographic type-faces and parts intended to be assembled into a complex product.

#### 1A Substantive grounds for refusal of registration

(1) The following shall be refused registration under this Act—

- (a) anything which does not fulfil the requirements of section 1(2) of this Act;
- (b) designs which do not fulfil the requirements of sections 1B to 1D of this Act;
- (c) designs to which a ground of refusal mentioned in Schedule A1 to this Act applies.

(2) A design (“the later design”) shall be refused registration under this Act if it is not new or does not have individual character when compared with a design which—

- (a) has been made available to the public on or after the relevant date; but
- (b) is protected as from a date prior to the relevant date by virtue of registration under this Act or an application for such registration.

(3) In subsection (2) above “the relevant date” means the date on which the application for the registration of the later design was made or is treated by virtue of section 3B(2), (3) or (5) or 14(2) of this Act as having been made.

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(1) Section 1 was substituted by the 1988 Act section 265. Subsection (6) was added by the Olympic Symbol etc. (Protection) Act 1995 (c. 32), which does not extend to the Isle of Man.

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## **1B Requirement of novelty and individual character**

(1) A design shall be protected by a right in a registered design to the extent that the design is new and has individual character.

(2) For the purposes of subsection (1) above, a design is new if no identical design or no design whose features differ only in immaterial details has been made available to the public before the relevant date.

(3) For the purposes of subsection (1) above, a design has individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design which has been made available to the public before the relevant date.

(4) In determining the extent to which a design has individual character, the degree of freedom of the author in creating the design shall be taken into consideration.

(5) For the purposes of this section, a design has been made available to the public before the relevant date if—

- (a) it has been published (whether following registration or otherwise), exhibited, used in trade or otherwise disclosed before that date; and
- (b) the disclosure does not fall within subsection (6) below.

(6) A disclosure falls within this subsection if—

- (a) it could not reasonably have become known before the relevant date in the normal course of business to persons carrying on business in the European Economic Area and specialising in the sector concerned;
- (b) it was made to a person other than the designer, or any successor in title of his, under conditions of confidentiality (whether express or implied);
- (c) it was made by the designer, or any successor in title of his, during the period of 12 months immediately preceding the relevant date;
- (d) it was made by a person other than the designer, or any successor in title of his, during the period of 12 months immediately preceding the relevant date in consequence of information provided or other action taken by the designer or any successor in title of his; or
- (e) it was made during the period of 12 months immediately preceding the relevant date as a consequence of an abuse in relation to the designer or any successor in title of his.

(7) In subsections (2), (3), (5) and (6) above “the relevant date” means the date on which the application for the registration of the design was made or is treated by virtue of section 3B(2), (3) or (5) or 14(2) of this Act as having been made.

(8) For the purposes of this section, a design applied to or incorporated in a product which constitutes a component part of a complex product shall only be considered to be new and to have individual character—

- (a) if the component part, once it has been incorporated into the complex product, remains visible during normal use of the complex product; and
- (b) to the extent that those visible features of the component part are in themselves new and have individual character.

(9) In subsection (8) above “normal use” means use by the end user; but does not include any maintenance, servicing or repair work in relation to the product.

### **1C Designs dictated by their technical function**

(1) A right in a registered design shall not subsist in features of appearance of a product which are solely dictated by the product's technical function.

(2) A right in a registered design shall not subsist in features of appearance of a product which must necessarily be reproduced in their exact form and dimensions so as to permit the product in which the design is incorporated or to which it is applied to be mechanically connected to, or placed in, around or against, another product so that either product may perform its function.

(3) Subsection (2) above does not prevent a right in a registered design subsisting in a design serving the purposes of allowing multiple assembly or connection of mutually interchangeable products within a modular system.

### **1D Designs contrary to public policy or morality**

**1D.** A right in a registered design shall not subsist in a design which is contrary to public policy or to accepted principles of morality.”

6. In section 2(2)(2) (proprietaryship of designs), omit—
  - (a) the words from “, or the” to “any article,” and
  - (b) the words from “or as”, in the second place, onwards.
7. For section 3(3) (proceedings for registration) substitute—

### **“3 Applications for registration**

(1) An application for the registration of a design shall be made in the prescribed form and shall be filed at the Patent Office in the prescribed manner.

(2) An application for the registration of a design shall be made by the person claiming to be the proprietor of the design.

(3) An application for the registration of a design in which national unregistered design right subsists shall be made by the person claiming to be the design right owner.

(4) For the purpose of deciding whether, and to what extent, a design is new or has individual character, the registrar may make such searches (if any) as he thinks fit.

(5) An application for the registration of a design which, owing to any default or neglect on the part of the applicant, has not been completed so as to enable registration to be effected within such time as may be prescribed shall be deemed to be abandoned.

### **3A Determination of applications for registration**

(1) Subject as follows, the registrar shall not refuse an application for the registration of a design.

(2) If it appears to the registrar that an application for the registration of a design has not been made in accordance with any rules made under this Act, he may refuse the application.

(3) If it appears to the registrar that an application for the registration of a design has not been made in accordance with sections 3(2) and (3) and 14(1) of this Act, he shall refuse the application.

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(2) Section 2 was amended by the 1988 Act section 267.

(3) Subsections (2) to (7) of section 3 were substituted by the 1988 Act Schedule 3 paragraph 1.

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(4) If it appears to the registrar that any ground for refusal of registration mentioned in section 1A of this Act applies in relation to an application for the registration of a design, he shall refuse the application.

### **3B Modification of applications for registration**

(1) The registrar may, at any time before an application for the registration of a design is determined, permit the applicant to make such modifications of the application as the registrar thinks fit.

(2) Where an application for the registration of a design has been modified before it has been determined in such a way that the design has been altered significantly, the registrar may, for the purpose of deciding whether and to what extent the design is new or has individual character, direct that the application shall be treated as having been made on the date on which it was so modified.

(3) Where—

- (a) an application for the registration of a design has disclosed more than one design and has been modified before it has been determined to exclude one or more designs from the application; and
- (b) a subsequent application for the registration of a design so excluded has, within such period (if any) as has been prescribed for such applications, been made by the person who made the earlier application or his successor in title,

the registrar may, for the purpose of deciding whether and to what extent the design is new or has individual character, direct that the subsequent application shall be treated as having been made on the date on which the earlier application was, or is treated as having been, made.

(4) Where an application for the registration of a design has been refused on any ground mentioned in section 1A(1)(b) or (c) of this Act, the application may be modified by the applicant if it appears to the registrar that—

- (a) the identity of the design is retained; and
- (b) the modifications have been made in accordance with any rules made under this Act.

(5) An application modified under subsection (4) above shall be treated as the original application and, in particular, as made on the date on which the original application was made or is treated as having been made.

(6) Any modification under this section may, in particular, be effected by making a partial disclaimer in relation to the application.

### **3C Date of registration of designs**

(1) Subject as follows, a design, when registered, shall be registered as of the date on which the application was made or is treated as having been made.

(2) Subsection (1) above shall not apply to an application which is treated as having been made on a particular date by section 14(2) of this Act or by virtue of the operation of section 3B(3) or (5) of this Act by reference to section 14(2) of this Act.

(3) A design, when registered, shall be registered as of—

- (a) in the case of an application which is treated as having been made on a particular date by section 14(2) or this Act, the date on which the application was made;

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- (b) in the case of an application which is treated as having been made on a particular date by virtue of the operation of section 3B(3) of this Act by reference to section 14(2) of this Act, the date on which the earlier application was made;
- (c) in the case of an application which is treated as having been made on a particular date by virtue of the operation of section 3B(5) of this Act by reference to section 14(2) of this Act, the date on which the original application was made.

### **3D Appeals in relation to applications for registration**

**3D.** An appeal lies from any decision of the registrar under section 3A or 3B of this Act.”

**8.** Omit section 4(4) (registration of same design in respect of other articles).

**9.—**(1) In section 5(2)(5) (provisions for secrecy of certain designs), omit paragraph (b) and the word “and” immediately preceding it.

(2) In section 5(3)(b), omit the words from “, or any” to “above,”.

**10.** Omit section 6(6) (provisions as to confidential disclosure etc.).

**11.** For section 7(7) (right given by registration) substitute—

#### **“7 Right given by registration**

(1) The registration of a design under this Act gives the registered proprietor the exclusive right to use the design and any design which does not produce on the informed user a different overall impression.

(2) For the purposes of subsection (1) above and section 7A of this Act any reference to the use of a design includes a reference to—

- (a) the making, offering, putting on the market, importing, exporting or using of a product in which the design is incorporated or to which it is applied; or
- (b) stocking such a product for those purposes.

(3) In determining for the purposes of subsection (1) above whether a design produces a different overall impression on the informed user, the degree of freedom of the author in creating his design shall be taken into consideration.

(4) The right conferred by subsection (1) above is subject to any limitation attaching to the registration in question (including, in particular, any partial disclaimer or any declaration by the registrar or a court of partial invalidity).

#### **7A Infringements of rights in registered designs**

(1) Subject as follows, the right in a registered design is infringed by a person who, without the consent of the registered proprietor, does anything which by virtue of section 7 of this Act is the exclusive right of the registered proprietor.

(2) The right in a registered design is not infringed by—

- (a) an act which is done privately and for purposes which are not commercial;
- (b) an act which is done for experimental purposes;

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(4) Section 4 was amended by the 1988 Act Schedule 3 paragraph 2.

(5) Section 5 was amended by the 1988 Act Schedule 3 paragraph 3.

(6) Section 6 was amended by the 1988 Act Schedule 3 paragraph 4.

(7) Section 7 was substituted by the 1988 Act section 268.

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- (c) an act of reproduction for teaching purposes or for the purpose of making citations provided that the conditions mentioned in subsection (3) below are satisfied;
  - (d) the use of equipment on ships or aircraft which are registered in another country but which are temporarily in the United Kingdom;
  - (e) the importation into the United Kingdom of spare parts or accessories for the purpose of repairing such ships or aircraft; or
  - (f) the carrying out of repairs of such ships or aircraft.
- (3) The conditions mentioned in this subsection are—
- (a) the act of reproduction is compatible with fair trade practice and does not unduly prejudice the normal exploitation of the design; and
  - (b) mention in made of the source.

(4) The right in a registered design is not infringed by an act which relates to a product in which any design protected by the registration is incorporated or to which it is applied if the product has been put on the market in the European Economic Area by the registered proprietor or with his consent.

(5) The right in a registered design of a component part which may be used for the purpose of the repair of a complex product so as to restore its original appearance is not infringed by the use for that purpose of any design protected by the registration.

(6) No proceedings shall be taken in respect of an infringement of the right in a registered design committed before the date on which the certificate of registration of the design under this Act is granted.”

**12.** Omit section 8(5) and (6)(8) (duration of right).

**13.** In section 8B(6)(9) (effect of order for restoration of right)—

- (a) for “an article” substitute “a product”; and
- (b) for “the article” substitute “the product”.

**14.** In section 9(1)(10) (exemption of innocent infringer from liability for damages)—

- (a) for “an article” substitute “a product”; and
- (b) for “the article” substitute “, or incorporated in, the product”.

**15.** Omit section 10 (compulsory licence in respect of registered design).

**16.** For section 11(11) (cancellation of registration) substitute—

**“11 Cancellation of registration**

**11.** The registrar may, upon a request made in the prescribed manner by the registered proprietor, cancel the registration of a design.

**11ZA Grounds for invalidity of registration**

(1) The registration of a design may be declared invalid on any of the grounds mentioned in section 1A of this Act.

(2) The registration of a design may be declared invalid on the ground of the registered proprietor not being the proprietor of the design and the proprietor of the design objecting.

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(8) Section 8 was substituted by the 1988 Act section 269.

(9) Section 8B was inserted by the 1988 Act section 269.

(10) Section 9 was amended by the 1988 Act Schedule 3 paragraph 5.

(11) Section 11 was amended by the 1988 Act Schedule 3 paragraph 6.

(3) The registration of a design involving the use of an earlier distinctive sign may be declared invalid on the ground of an objection by the holder of rights to the sign which include the right to prohibit in the United Kingdom such use of the sign.

(4) The registration of a design constituting an unauthorised use of a work protected by the law of copyright in the United Kingdom may be declared invalid on the ground of an objection by the owner of the copyright.

(5) In this section and sections 11ZB, 11ZC and 11ZE of this Act (other than section 11ZE(1)) references to the registration of a design include references to the former registration of a design; and these sections shall apply, with necessary modifications, in relation to such former registrations.

### **11ZB Applications for declaration of invalidity**

(1) Any person interested may make an application to the registrar for a declaration of invalidity on the ground mentioned in section 1A(1)(a) or (b) of this Act.

(2) Any person concerned by the use in question may make an application to the registrar for a declaration of invalidity on the ground mentioned in section 1A(1)(c) of this Act.

(3) The relevant person may make an application to the registrar for a declaration of invalidity on the ground mentioned in section 1A(2) of this Act.

(4) In subsection (3) above, “the relevant person” means, in relation to an earlier design protected by virtue of registration under this Act or an application for such registration, the registered proprietor of the design or (as the case may be) the applicant.

(5) The person able to make an objection under subsection (2), (3) or (4) of section 11ZA of this Act may make an application to the registrar for a declaration of invalidity on the ground mentioned in that subsection.

(6) An application may be made under this section in relation to a design at any time after the design has been registered.

### **11ZC Determination of applications for declaration of invalidity**

(1) This section applies where an application has been made to the registrar for a declaration of invalidity in relation to a registration.

(2) If it appears to the registrar that the application has not been made in accordance with any rules made under this Act, he may refuse the application.

(3) If it appears to the registrar that the application has not been made in accordance with section 11ZB of this Act, he shall refuse the application.

(4) Subject to subsections (2) and (3) above, the registrar shall make a declaration of invalidity if it appears to him that the ground of invalidity specified in the application has been established in relation to the registration.

(5) Otherwise the registrar shall refuse the application.

(6) A declaration of invalidity may be a declaration of partial invalidity.

### **11ZD Modification of registration**

(1) Subsections (2) and (3) below apply where the registrar intends to declare the registration of a design invalid on any ground mentioned in section 1A(1)(b) or (c) or 11ZA(3) or (4) of this Act.

(2) The registrar shall inform the registered proprietor of that fact.

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(3) The registered proprietor may make an application to the registrar for the registrar to make such modifications to the registration of the design as the registered proprietor specifies in his application.

(4) Such modifications may, in particular, include the inclusion on the register of a partial disclaimer by the registered proprietor.

(5) If it appears to the registrar that the application has not been made in accordance with any rules made under this Act, the registrar may refuse the application.

(6) If it appears to the registrar that the identity of the design is not retained or the modified registration would be invalid by virtue of section 11ZA of this Act, the registrar shall refuse the application.

(7) Otherwise the registrar shall make the specified modifications.

(8) A modification of a registration made under this section shall have effect, and be treated always to have had effect, from the grant of registration.

#### **11ZE Effect of cancellation or invalidation of registration**

(1) A cancellation of registration under section 11 of this Act takes effect from the date of the registrar's decision or from such other date as the registrar may direct.

(2) Where the registrar declares the registration of a design invalid to any extent, the registration shall to that extent be treated as having been invalid from the date of registration or from such other date as the registrar may direct.

#### **11ZF Appeals in relation to cancellation or invalidation**

**11ZF.** An appeal lies from any decision of the registrar under section 11 to 11ZE of this Act.”

**17.—**(1) In section 11A(3)(**12**) (powers exercisable for protection of the public interest), omit—

- (a) paragraph (b) and the word “or” immediately preceding it, and
- (b) the words from “or may, instead” onwards.

(2) Omit section 11A(4) and (5).

**18.** Omit section 11B(**13**).

**19.—**(1) In section 14(2)(**14**) (registration of design where application for protection in convention country has been made)—

- (a) after “whether” insert “(and to what extent)”; and
- (b) after “new” insert “or has individual character”.

(2) In section 14(3) for “section 3(4)” substitute “section 3B(2) or (3)”.

**20.** In section 15(2)(**15**) (extension of time for applications under section 14 in certain cases)—

- (a) in paragraph (a), for “articles” substitute “products”; and
- (b) in paragraph (e)—
  - (i) for “articles” substitute “products”; and
  - (ii) after “applied” insert “or in which it is incorporated”.

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(12) Section 11A was inserted by the 1988 Act section 270.

(13) Section 11B was inserted by the 1988 Act section 270.

(14) Subsections (2) and (3) of section 14 were substituted by the 1988 Act Schedule 3 paragraph 7.

(15) Section 15 was amended by the 1988 Act Schedule 3 paragraph 8.



- 21.** Omit section 16(**16**) (protection of designs communicated under international agreements).
- 22.**—(1) In section 19(3A)(**17**) (registration of assignments etc.), for “design right”, in both places, substitute “national unregistered design right”.
- (2) In section 19(3B) for “design right”, in the first and third places, substitute “national unregistered design right”.
- 23.**—(1) In section 20(1)(**18**) (applications for rectification) for “any person aggrieved” substitute “the relevant person”.
- (2) After section 20(1) insert—
- “(1A) In subsection (1) above “the relevant person” means—
- (a) in the case of an application invoking any ground referred to in section 1A(1)(c) of this Act, any person concerned by the use in question;
  - (b) in the case of an application invoking the ground mentioned in section 1A(2) of this Act, the appropriate person;
  - (c) in the case of an application invoking any ground mentioned in section 11ZA(2), (3) or (4) of this Act, the person able to make the objection;
  - (d) in any other case, any person aggrieved.
- (1B) In subsection (1A) above “the appropriate person” means, in relation to an earlier design protected by virtue of registration under this Act or an application for such registration, the registered proprietor of the design or (as the case may be) the applicant.”
- (3) After section 20(5) insert—
- “(6) Orders which may be made by the court under this section include, in particular, declarations of partial invalidity.”
- 24.**—(1) In section 22(1)(**19**) (inspection of registered designs), omit paragraph (b) and the word “and” immediately preceding it.
- (2) In section 22(2)—
- (a) for the words from the beginning to “no” substitute—
- “(2) Where—
- (a) a design has been registered;
  - (b) a product to which the design was intended to be applied or in which it was intended to be incorporated was specified, in accordance with rules made under section 36 of this Act, in the application for the registration of the design; and
  - (c) the product so specified falls within any class prescribed for the purposes of this subsection,
- no”;
- (b) for “articles” substitute “products”; and
  - (c) for the words from “it is the same” to “trade” substitute “, by reference to the first-mentioned design, it is not new or does not have individual character”.
- (3) In section 22(3) for the words from “design” to “class” substitute “registered design and a specified product which falls within any class”.

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(16) Section 16 was amended by the 1988 Act Schedule 3 paragraph 9.

(17) Section 19 was amended by the 1988 Act Schedule 3 paragraph 10.

(18) Section 20 was amended by the 1988 Act Schedule 3 paragraph 11.

(19) Section 22 was amended by the 1988 Act Schedule 3 paragraph 12.

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- 25.** In section 23(a)(**20**), omit “and, if so, in respect of what articles”.
- 26.**—(1) In section 25(1)(**21**) (certificate of contested validity of registration), after “the design is” insert “, to any extent,”.
- (2) In section 25(2), for “cancellation” substitute “invalidation”.
- 27.** For section 27(**22**) substitute—
- “27.** In this Act “the court” means Her Majesty’s High Court of Justice of the Isle of Man.”.
- 28.** In section 28(5)(**23**), for paragraphs (a) and (b) substitute “in the Isle of Man, in the same way as an execution issued out of the court”.
- 29.**—(1) In section 30(2)(**24**) (costs and security for costs), for paragraphs (a) and (b) substitute “in the Isle of Man, in the same way as an execution issued out of the court”.
- (2) In section 30(3)—
- (a) in paragraph (a), for “cancellation” substitute “invalidation”; and
- (b) omit paragraph (b).
- 30.** In section 33(1)(a)(**25**), for “indictment” substitute “information”.
- 31.** In section 34(a)(**26**), for “indictment” substitute “information”.
- 32.**—(1) In section 35(1)(**27**) (fine for falsely representing a design as registered)—
- (a) for “any article” substitute “, or incorporated in, any product”;
- (b) omit “in respect of that article”;
- (c) for “an article” substitute “a product”;
- (d) for “the article”, in the first and second places, substitute “, or incorporated in, the product”;
- and
- (e) omit “in respect of the article”.
- (2) In section 35(2)—
- (a) for “any article” substitute “any product”;
- (b) after “applied” insert “or in which it has been incorporated”; and
- (c) for “such article” substitute “such product”.
- 33.** In section 36(1A)(**28**) (general power of Secretary of State to make rules etc.), after paragraph (a) insert—
- “(ab) requiring applications for registration of designs to specify—
- (i) the products to which the designs are intended to be applied or in which they are intended to be incorporated;
- (ii) the classification of the designs by reference to such test as may be prescribed;”.

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(20) Section 23 was substituted by the 1988 Act Schedule 3 paragraph 13.  
(21) Section 25 was amended by the 1988 Act Schedule 3 paragraph 14.  
(22) Section 27 was substituted by the 1988 Act Schedule 3 paragraph 16.  
(23) Section 28 was amended by the 1988 Act Schedule 3 paragraph 17.  
(24) Section 30 was substituted by the 1988 Act Schedule 3 paragraph 19.  
(25) Section 33 was amended by the 1988 Act Schedule 3 paragraph 22.  
(26) Section 34 was amended by the 1988 Act Schedule 3 paragraph 23.  
(27) Section 35 was amended by the 1988 Act Schedule 3 paragraph 24.  
(28) Section 36(1A) was inserted by the 1988 Act Schedule 3 paragraph 26.

**34.** In section 37(2)(**29**) for the words from “section”, where it first appears, to “Act”, where it first appears, substitute “section 15 of this Act”.

**35.**—(1) Omit section 43(1) (savings).

(2) In section 43(2), for “articles” substitute “products”.

**36.**—(1) In section 44(1)(**30**) (interpretation)—

(a) omit the definitions of “article”, “artistic work”, “corresponding design” and “set of articles”;

(b) in the definition of “design”, for “section 1(1)” substitute “section 1(2)”;

(c) at the appropriate places insert—

““complex product” has the meaning assigned to it by section 1(3) of this Act;”;

““national unregistered design right” means design right within the meaning of the Design Right Act 1991 (an Act of Tynwald)(**31**);”;

““product” has the meaning assigned to it by section 1(3) of this Act;”.

(2) After section 44(1) insert—

“(1A) References in this section to the Copyright, Designs and Patents Act 1988 are to that Act as it has effect in England and Wales.”

(3) Omit section 44(2) and (3).

(4) In section 44(4) for the words from “section”, where it first appears, to “Act” substitute “section 14 of this Act”.

**37.** Omit section 45 (Scotland) and 46 (Northern Ireland).

**38.** Omit section 48(5) (transitional provision).

**39.** Before Schedule 1 insert—

#### “SCHEDULE A1

#### GROUPS FOR REFUSAL OF REGISTRATION IN RELATION TO EMBLEMS ETC.

##### *Grounds for refusal in relation to certain emblems etc.*

**1.**—(1) A design shall be refused registration under this Act if it involves the use of—

(a) the Royal arms, or any of the principal armorial bearings of the Royal arms, or any insignia or device so nearly resembling the Royal arms or any such armorial bearing as to be likely to be mistaken for them or it;

(b) a representation of the Royal crown or any of the Royal flags;

(c) a representation of Her Majesty or any member of the Royal family, or any colourable imitation thereof; or

(d) words, letters or devices likely to lead persons to think that the applicant either has or recently has had Royal patronage or authorisation;

unless it appears to the registrar that consent for such use has been given by or on behalf of Her Majesty or (as the case may be) the relevant member of the Royal family.

(**29**) Section 37 was amended by the 1988 Act Schedule 3 paragraph 27.

(**30**) Section 44 was amended by the 1988 Act Schedule 3 paragraph 31.

(**31**) 1991 c. 9 (Isle of Man).

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- (2) A design shall be refused registration under this Act if it involves the use of—
- (a) the national flag of the United Kingdom (commonly known as the Union Jack); or
  - (b) the flag of England, Wales, Scotland, Northern Ireland or the Isle of Man,
- and it appears to the registrar that the use would be misleading or grossly offensive.
- (3) A design shall be refused registration under this Act if it involves the use of—
- (a) arms to which a person is entitled by virtue of a grant of arms by the Crown; or
  - (b) insignia so nearly resembling such arms as to be likely to be mistaken for them;
- unless it appears to the registrar that consent for such use has been given by or on behalf of the person concerned and the use is not in any way contrary to the law of arms.
- (4) A design shall be refused registration under this Act if it involves the use of a controlled representation within the meaning of the Olympic Symbol etc. (Protection) Act 1995 unless it appears to the registrar that—
- (a) the application is made by the person for the time being appointed under section 1(2) of the Olympic Symbol etc. (Protection) Act 1995 (power of Secretary of State to appoint a person as the proprietor of the Olympics association right); or
  - (b) consent for such use has been given by or on behalf of the person mentioned in paragraph (a) above.
- (5) References in this section to the Olympic Symbol etc (Protection) Act 1995 are to that Act as it has effect in the United Kingdom.

*Grounds for refusal in relation to emblems etc. of Paris Convention countries*

- 2.—(1) A design shall be refused registration under this Act if it involves the use of the flag of a Paris Convention country unless—
- (a) the authorisation of the competent authorities of that country has been given for the registration; or
  - (b) it appears to the registrar that the use of the flag in the manner proposed is permitted without such authorisation.
- (2) A design shall be refused registration under this Act if it involves the use of the armorial bearings or any other state emblem of a Paris Convention country which is protected under the Paris Convention unless the authorisation of the competent authorities of that country has been given for the registration.
- (3) A design shall be refused registration under this Act if—
- (a) the design involves the use of an official sign or hallmark adopted by a Paris Convention country and indicating control and warranty;
  - (b) the sign or hallmark is protected under the Paris Convention; and
  - (c) the design could be applied to or incorporated in goods of the same, or a similar, kind as those in relation to which the sign or hallmark indicates control and warranty;
- unless the authorisation of the competent authorities of that country has been given for the registration.
- (4) The provisions of this paragraph as to national flags and other state emblems, and official signs or hallmarks, apply equally to anything which from a heraldic point of view imitates any such flag or other emblem, or sign or hallmark.

(5) Nothing in this paragraph prevents the registration of a design on the application of a national of a country who is authorised to make use of a state emblem, or official sign or hallmark, of that country, notwithstanding that it is similar to that of another country.

*Grounds for refusal in relation to emblems etc. of certain international organisations*

3.—(1) This paragraph applies to—

- (a) the armorial bearings, flags or other emblems; and
- (b) the abbreviations and names,

of international intergovernmental organisations of which one or more Paris Convention countries are members.

(2) A design shall be refused registration under this Act if it involves the use of any such emblem, abbreviation or name which is protected under the Paris Convention unless—

- (a) the authorisation of the international organisation concerned has been given for the registration; or
- (b) it appears to the registrar that the use of the emblem, abbreviation or name in the manner proposed—
  - (i) is not such as to suggest to the public that a connection exists between the organisation and the design; or
  - (ii) is not likely to mislead the public as to the existence of a connection between the user and the organisation.

(3) The provisions of this paragraph as to emblems of an international organisation apply equally to anything which from a heraldic point of view imitates any such emblem.

(4) Nothing in this paragraph affects the rights of a person whose *bona fide* use of the design in question began before 4th January 1962 (when the relevant provisions of the Paris Convention entered into force in relation to the United Kingdom).

*Paragraphs 2 and 3: supplementary*

4.—(1) For the purposes of paragraph 2 above state emblems of a Paris Convention country (other than the national flag), and official signs or hallmarks, shall be regarded as protected under the Paris Convention only if, or to the extent that—

- (a) the country in question has notified the United Kingdom in accordance with Article 6ter(3) of the Convention that it desires to protect that emblem, sign or hallmark;
- (b) the notification remains in force; and
- (c) the United Kingdom has not objected to it in accordance with Article 6ter(4) or any such objection has been withdrawn.

(2) For the purposes of paragraph 3 above the emblems, abbreviations and names of an international organisation shall be regarded as protected under the Paris Convention only if, or to the extent that—

- (a) the organisation in question has notified the United Kingdom in accordance with Article 6ter(3) of the Convention that it desires to protect that emblem, abbreviation or name;
- (b) the notification remains in force; and
- (c) the United Kingdom has not objected to it in accordance with Article 6ter(4) or any such objection has been withdrawn.

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(3) Notification under Article 6ter(3) of the Paris Convention shall have effect only in relation to applications for the registration of designs made more than two months after the receipt of the notification.

### *Interpretation*

**5.** In this Schedule—

“a Paris Convention country” means a country, other than the United Kingdom, which is a party to the Paris Convention; and

“the Paris Convention” means the Paris Convention for the Protection of Industrial Property of 20th March 1883.”

**40.**—(1) Schedule 1(32) (use of registered designs for the services of the Crown) is modified as follows.

(2) In paragraph 1(6) and (7), for “articles”, in each place, substitute “products”.

(3) In paragraph 2(1) for “design right” substitute “national unregistered design right”.

(4) In paragraph 2A(1) and (4)—

(a) for “articles” substitute “products”; and

(b) after “applied” insert “or in which it is incorporated”.

(5) In paragraph 3(2)(a)—

(a) after “proceedings” insert “and the department are a relevant person within the meaning of section 20 of this Act”;

(b) for “cancellation” substitute “invalidation”; and

(c) for “cancelled” substitute “declared invalid”.

(6) In paragraph 3(2)(b)—

(a) after “case” insert “and provided that the department would be the relevant person within the meaning of section 20 of this Act if they had made an application on the grounds for invalidity being raised”; and

(7) for “cancellation” substitute “invalidation”.

## SCHEDULE 2

Article 2(2)

### **TRANSITIONAL MODIFICATIONS OF THE REGISTERED DESIGNS ACT 1949 AS IT HAS EFFECT IN THE ISLE OF MAN**

#### **Pending applications**

**1.**—(1) This paragraph applies to applications for registration under the 1949 Act which have been made but not finally determined before the coming into force of this Order (“pending applications”).

(2) The 1949 Act as it has effect in the Isle of Man immediately before the coming into force of this Order shall continue to apply in relation to pending applications so far as it relates to the determination of such applications.

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(32) Paragraph 1 of Schedule 1 was amended by the Defence Contracts Act 1958 (c. 38) section 1; paragraphs 2 to 4 were amended by the 1988 Act Schedule 3 paragraph 37.

(3) Accordingly the modifications and revocations made by this Order shall not apply in relation to the determination of such applications.

### **Transitional registrations**

2.—(1) This paragraph applies to any registration under the 1949 Act which results from the determination of a pending application (within the meaning of paragraph 1 above).

(2) This 1949 Act as it has effect in the Isle of Man immediately before the coming into force of this Order shall continue to apply in relation to registrations to which this paragraph applies (“transitional registrations”) so far as that Act relates to the cancellation or invalidation of such registrations (other than cancellation by virtue of section 11(3) of that Act).

(3) Accordingly the modifications made by Schedule 1 to this Order shall, so far as they relate to the cancellation or invalidation of registrations, not apply in relation to transitional registrations.

(4) Those modifications shall otherwise (and subject to subparagraphs (5) to (9) and paragraph 5 of this Schedule) apply in relation to transitional registrations.

(5) In the application by virtue of subparagraph (4) of sections 7 and 7A of the 1949 Act (as substituted by Schedule 1 to this Order), the fact that transitional registrations are in respect of any articles, or sets of articles, shall be disregarded.

(6) Sections 3 to 3D of the 1949 Act (as substituted by Schedule 1 to this Order) shall not operate so as to determine the dates of registration of designs to which transitional registrations apply; and these dates shall be determined by reference to the 1949 Act as it has effect in the Isle of Man immediately before the coming into force of this Order.

(7) Where—

- (a) any such date of registration for the purposes of calculating the period for which the right in a registered design subsists, or any extension of that period, under section 8 of the 1949 Act is determined by virtue of section 14(2) of that Act; and
- (b) that date is earlier than the date which would otherwise have been the date of registration for those purposes;

the difference between the two dates shall be added to the first period of five years for which the right in the registered design is to subsist.

(8) Any reference in section 8 of the 1949 Act to a period of five years shall, in the case of any such period which is extended by virtue of paragraph (7), be treated as a reference to the extended period.

(9) The omission by this Order of the proviso to section 4(1) of the 1949 Act and of the reference to it in section 8 of that Act shall not apply to the right in a design to which a transitional registration applies.

### **Post-1989 registrations**

3.—(1) This paragraph applies to—

- (a) any registration under the 1949 Act which—
  - (i) has resulted from an application made on or after 1st August 1989 and before the coming into force of this Order; and
  - (ii) has given rise to a right in a registered design which is in force at the coming into force of this Order;
- (b) any registration under the 1949 Act which—
  - (i) has resulted from an application made on or after 1st August 1989 and before the coming into force of this Order; and

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- (ii) has given rise to a right in a registered design which is not in force at the coming into force of this Order but which is capable of being treated as never having ceased to be in force by virtue of section 8(4) of the 1949 Act or of being restored by virtue of sections 8A and 8B of that Act; and
- (c) any registration which subsequently ceases to fall within paragraph (b) because the right in the registered design has been treated or restored as mentioned in paragraph (ii) of that sub-paragraph.

(2) The 1949 Act as it has effect in the Isle of Man immediately before the coming into force of this Order shall continue to apply in relation to registrations to which this paragraph applies (“post-1989 registrations”) so far as the Act relates to the cancellation or invalidation of such registrations (other than cancellation by virtue of section 11(3) of that Act and by reference to an expiry of copyright occurring on or after the coming into force of this Order).

(3) Accordingly the modifications made by Schedule 1 to this Order shall, so far as they relate to the cancellation or invalidation of registrations, not apply in relation to post-1989 registrations.

(4) The modifications made by Schedule 1 to this Order shall otherwise apply (subject to subparagraphs (5) to (9) and paragraph 5 of this Schedule) in relation to post-1989 registrations.

(5) In the application by virtue of subparagraph (4) of sections 7 and 7A of the 1949 Act (as substituted by Schedule 1 to this Order), the fact that post-1989 registrations are in respect of any articles, or sets of articles, shall be disregarded.

(6) Sections 3 to 3D of the 1949 Act (as substituted by Schedule 1 to this Order) shall not operate so as to alter the dates of registration of designs to which post-1989 registrations apply.

(7) Where—

- (a) any such date of registration for the purposes of calculating the period for which the right in a registered design subsists, or any extension of that period, under section 8 of the 1949 Act was determined by virtue of section 14(2) of that Act; and
- (b) that date is earlier than the date which would otherwise have been the date of registration for those purposes;

the difference between the two dates shall be added to any period of five years which is current on the coming into force of this Order or, if no such period is current but a subsequent extension or restoration is effected under section 8, or sections 8A and 8B, of the 1949 Act, to the period resulting from that extension or restoration.

(8) Any reference in section 8 of the 1949 Act to a period of five years shall, in the case of any such period which is extended by virtue of subparagraph (7), be treated as a reference to the extended period.

(9) The omission by this Order of the proviso in section 4(1) of the 1949 Act and the reference to it in section 8 of that Act shall not apply to the right in a design to which a post-1989 registration applies.

#### **Pre-1989 registrations**

4.—(1) This paragraph applies to—

- (a) any registration under the 1949 Act which—
  - (i) has resulted from an application made before 1st August 1989; and
  - (ii) has given rise to a copyright in a registered design which is in force at the coming into force of this Order;
- (b) any registration under the 1949 Act which—
  - (i) has resulted from an application made before 1st August 1989; and



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- (ii) has given rise to a copyright in a registered design which is not in force at the coming into force of this Order but which would be capable of coming back into force by virtue of an extension of the period of copyright under section 8(2) of the 1949 Act if that provision were amended as set out in paragraph (8); and
  - (c) any registration which subsequently ceases to fall within paragraph (b) because the copyright in the registered design has come back into force by virtue of an extension of the period of copyright under section 8(2) of the 1949 Act as amended by subparagraph (8).
- (2) Subject as follows, the amendments and repeals made by this Order shall not apply to any provision of the 1949 Act which only has effect in relation to applications for registration made before 1st August 1989 or any registrations resulting from such applications.
- (3) Any such provision and any other provision of the 1949 Act as it has effect immediately before the coming into force of this Order in relation to registrations which fall within subparagraph (1) (“pre-1989 registrations”) shall continue to apply so far as it relates to the cancellation or invalidation of pre-1989 registrations (other than cancellation by virtue of section 11(3) of that Act and by reference to an expiry of copyright occurring on or after the coming into force of this Order).
- (4) Accordingly the modifications made by this Order shall, so far as they relate to the cancellation or invalidation of registrations, not apply in relation to pre-1989 registrations.
- (5) The modifications made by this Order shall otherwise apply (subject to paragraphs (2) and (9) to (12) and paragraph 5 of this Schedule) in relation to pre-1989 registrations.
- (6) Modifications corresponding to the modifications made by Schedule 1 to this Order (other than those relating to the cancellation or invalidation of registrations) shall be treated as having effect, with necessary modifications and subject to paragraph 5 of this Schedule, in relation to any provision of the 1949 Act which only has effect in relation to applications for registration made before 1st August 1989 or any registrations resulting from such applications.
- (7) In the application by virtue of subparagraph (6) of modifications relating to sections 7 and 7A of the 1949 Act corresponding to those made by Schedule 1, the fact that pre-1989 registrations are in respect of any articles, or sets of articles, shall be disregarded.
- (8) In section 8(2) of the 1949 Act as it has effect in the Isle of Man in relation to pre-1989 registrations (period of copyright)—
- (a) after “second period”, in the second place, insert “and for a fourth period of five years from the expiration of the third period and for a fifth period of five years from the expiration of the fourth period”;
  - (b) after “second or third” insert “or fourth or fifth”; and
  - (c) after “second period”, in the third place, insert “or the third period or the fourth period”.
- (9) Sections 3 to 3D of the 1949 Act (as substituted by Schedule 1 to this Order) shall not operate so as to alter the dates of registration of designs to which pre-1989 registrations apply.
- (10) Where—
- (a) the date of registration for the purposes of calculating the period of copyright, or any extension of that period, under section 8(2) of the 1949 Act as it has effect in relation to pre-1989 registrations was determined by virtue of section 14(2) of that Act; and
  - (b) that date is earlier than the date which would otherwise have been the date of registration for those purposes;
- the difference between the two dates shall be added to any period of five years which is current on the coming into force of this Order or, if no such period is current but a subsequent extension is effected under section 8 of the 1949 Act as modified by subparagraph (8), to the period resulting from that extension.

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(11) Any reference in section 8(2) of the 1949 Act as modified by subparagraph (8) to a period of five years shall, in the case of any such period which is extended by virtue of subparagraph (10), be treated as a reference to the extended period.

(12) The omission by this Order of the proviso in section 4(1) of the 1949 Act shall not apply to the right in a design to which a pre-1989 registration applies.

### **Other transitional modifications**

5.—(1) Any licence which—

- (a) permits anything which would otherwise be an infringement under the 1949 Act of the right in a registered design or the copyright in a registered design; and
- (b) was granted by the registered proprietor of the design, or under section 10 or 11A of the 1949 Act, before the coming into force of this Order,

shall continue in force, with necessary modifications, on or after the making of this Order.

(2) In determining the effect of any such licence on or after the coming into force of this Order, regard shall be had to the purpose for which the licence was granted; and, in particular, a licence granted for the full term or extent of the right in a registered design or the copyright in a registered design shall be treated as applying, subject to its other terms and conditions, to the full term or extent of that right as extended by virtue of this Order.

(3) The right in a registered design conferred by virtue of this Order in relation to registrations to which paragraph 2, 3 or 4 of this Schedule applies shall not enable the registered proprietor to prevent any person from continuing to carry out acts begun by him before the coming into force of this Order and which, at that time, the registered proprietor or, in the case of registrations to which paragraph 2 applies, a registered proprietor would have been unable to prevent.

(4) The right in a registered design conferred by virtue of this Order in relation to registrations to which paragraph 3 or 4 of this Schedule applies shall, in particular, not apply in relation to infringements committed in relation to those registrations before the coming into force of this Order.

(5) The omission by Schedule 1 to this Order of provisions in section 5 of the 1949 Act shall not apply in relation to any evidence filed in support of an application made before the coming into force of this Order.

(6) The modifications made by Schedule 1 to this Order of section 22 of the 1949 Act (other than the amendment to the proviso in subsection (2) of that section) shall not apply in relation to any registration which has resulted from an application made before the coming into force of this Order.

(7) The modification of the proviso in section 22(2) of the 1949 Act shall not apply where—

- (a) the registration of the first-mentioned design resulted from an application made before the coming into force of this Order; and
- (b) the application for the registration of the other design was also made before the coming into force of this Order.

(8) The modifications made by Schedule 1 to this Order of section 35 of the 1949 Act shall not apply in relation to any offences committed before the coming into force of this Order.

(9) The omission by Schedule 1 to this Order of provisions in section 44 of the 1949 Act which relate to the meaning of a set of articles shall not apply so far as those provisions are required for the purposes of paragraph 6(2)(a) of Schedule 1 to the Copyright Act 1991 (an Act of Tynwald)(33).

(10) Any modification by Schedule 1 to this Order of a provision in section 44 of the 1949 Act or in any enactment other than the 1949 Act shall not apply so far as that provision is required for the purposes of any other transitional provision made by this Order.

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(33) 1991 c. 8 (Isle of Man).

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(11) The 1949 Act as it has effect in the Isle of Man immediately before the coming into force of this Order shall continue to apply in relation to former registrations, whose registration resulted from an application made before the coming into force of this Order, so far as the Act relates to the cancellation or invalidation of such registrations.

(12) Subparagraph (13) applies in relation to any registration to which paragraph 2, 3 or 4 applies which is in respect of any features of shape, configuration, pattern or ornament which do not fall within the new definition of “design” inserted into section 1 of the 1949 Act by Schedule 1 to this Order.

(13) The 1949 Act shall, so far as it applies in relation to any such registration, apply as if the features concerned were included within the new definition of “design” in that Act.

### SCHEDULE 3

Article 3

#### MODIFICATIONS OF PROVISIONS OF THE COPYRIGHT, DESIGNS AND PATENTS ACT 1988 AS IT HAS EFFECT IN THE ISLE OF MAN

1. Any reference to an Act of Parliament (including the 1949 Act and the 1988 Act) or to a provision of such an Act shall be construed, unless the contrary intention appears, as a reference to that Act or provision as it has effect in the Isle of Man.

2. Omit sections 265 and 268.

3. In Schedule 3, omit paragraph 1, 2, 3(4), 4, 6, 9 and 31(2) and (5).

4. Schedule 4 shall have effect as if the text of the 1949 Act contained therein were the text of that Act as modified by Schedule 1 to this Order.

### SCHEDULE 4

Article 4

#### REVOCATIONS

<i>Reference</i>	<i>Title</i>	<i>Extent of revocation</i>
<a href="#">SI 1989/982</a>	The Registered Designs Act 1949 (Isle of Man) Order 1989.	The whole Order.
<a href="#">SI 1989/1292</a>	The Copyright, Designs and Patents Act 1988 (Isle of Man) (No.2) Order 1989.	In article 2(1), subparagraphs (a) and (c).
<a href="#">SI 1990/1505</a>	The Copyright, Designs and Patents Act 1988 (Isle of Man) Order 1990.	In article 2, paragraphs (a) and (b). In the Schedule, paragraph 2.