

## SCHEDULE 1

### Amendments to the Registered Designs Act 1949

#### 3. Before section 25 there shall be inserted—

##### **“Action for infringement**

**24A.**—(1) An infringement of the right in a registered design is actionable by the registered proprietor.

(2) In an action for infringement all such relief by way of damages, injunctions, accounts or otherwise is available to him as is available in respect of the infringement of any other property right.

(3) This section has effect subject to section 24B of this Act (exemption of innocent infringer from liability).

##### **Exemption of innocent infringer from liability**

**24B.**—(1) In proceedings for the infringement of the right in a registered design damages shall not be awarded, and no order shall be made for an account of profits, against a defendant who proves that at the date of the infringement he was not aware, and had no reasonable ground for supposing, that the design was registered.

(2) For the purposes of subsection (1), a person shall not be deemed to have been aware or to have had reasonable grounds for supposing that the design was registered by reason only of the marking of a product with—

- (a) the word “registered” or any abbreviation thereof, or
- (b) any word or words expressing or implying that the design applied to, or incorporated in, the product has been registered,

unless the number of the design accompanied the word or words or the abbreviation in question.

(3) Nothing in this section shall affect the power of the court to grant an injunction in any proceedings for infringement of the right in a registered design.

##### **Order for delivery up**

**24C.**—(1) Where a person—

- (a) has in his possession, custody or control for commercial purposes an infringing article, or
- (b) has in his possession, custody or control anything specifically designed or adapted for making articles to a particular design which is a registered design, knowing or having reason to believe that it has been or is to be used to make an infringing article,

the registered proprietor in question may apply to the court for an order that the infringing article or other thing be delivered up to him or to such other person as the court may direct.

(2) An application shall not be made after the end of the period specified in the following provisions of this section; and no order shall be made unless the court also makes, or it appears to the court that there are grounds for making, an order under section 24D of this Act (order as to disposal of infringing article, &c.).

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(3) An application for an order under this section may not be made after the end of the period of six years from the date on which the article or thing in question was made, subject to subsection (4).

(4) If during the whole or any part of that period the registered proprietor—

- (a) is under a disability, or
- (b) is prevented by fraud or concealment from discovering the facts entitling him to apply for an order,

an application may be made at any time before the end of the period of six years from the date on which he ceased to be under a disability or, as the case may be, could with reasonable diligence have discovered those facts.

(5) In subsection (4) “disability”—

- (a) in England and Wales, has the same meaning as in the Limitation Act 1980;
- (b) in Scotland, means legal disability within the meaning of the Prescription and Limitation (Scotland) Act 1973;
- (c) in Northern Ireland, has the same meaning as in the Statute of Limitations (Northern Ireland) 1958.

(6) A person to whom an infringing article or other thing is delivered up in pursuance of an order under this section shall, if an order under section 24D of this Act is not made, retain it pending the making of an order, or the decision not to make an order, under that section.

(7) The reference in subsection (1) to an act being done in relation to an article for “commercial purposes” are to its being done with a view to the article in question being sold or hired in the course of a business.

(8) Nothing in this section affects any other power of the court.

### **Order as to disposal of infringing articles, &c**

**24D.**—(1) An application may be made to the court for an order that an infringing article or other thing delivered up in pursuance of an order under section 24C of this Act shall be—

- (a) forfeited to the registered proprietor, or
- (b) destroyed or otherwise dealt with as the court may think fit,

or for a decision that no such order should be made.

(2) In considering what order (if any) should be made, the court shall consider whether other remedies available in an action for infringement of the right in a registered design would be adequate to compensate the registered proprietor and to protect his interests.

(3) Where there is more than one person interested in an article or other thing, the court shall make such order as it thinks just and may (in particular) direct that the thing be sold, or otherwise dealt with, and the proceeds divided.

(4) If the court decides that no order should be made under this section, the person in whose possession, custody or control the article or other thing was before being delivered up is entitled to its return.

(5) References in this section to a person having an interest in an article or other thing include any person in whose favour an order could be made in respect of it—

- (a) under this section;
- (b) under section 19 of Trade Marks Act 1994 (including that section as applied by regulation 4 of the Community Trade Mark Regulations 2006 (SI 2006/1027));
- (c) under section 114, 204 or 231 of the Copyright, Designs and Patents Act 1988; or

- (d) under regulation 1C of the Community Design Regulations 2005 ([SI 2005/2339](#)).

### **Jurisdiction of county court and sheriff court**

**24E.**—(1) In Northern Ireland a county court may entertain proceedings under the following provisions of this Act—

- section 24C (order for delivery up of infringing article, &c.),
- section 24D (order as to disposal of infringing article, &c.), or
- section 24F(8) (application by exclusive licensee having concurrent rights),

where the value of the infringing articles and other things in question does not exceed the county court limit for actions in tort.

(2) In Scotland proceedings for an order under any of those provisions may be brought in the sheriff court.

(3) Nothing in this section shall be construed as affecting the jurisdiction of the Court of Session or the High Court in Northern Ireland.

### **Rights and remedies of exclusive licensee**

**24F.**—(1) In relation to a registered design, an exclusive licensee has, except against the registered proprietor, the same rights and remedies in respect of matters occurring after the grant of the licence as if the licence had been an assignment.

(2) His rights and remedies are concurrent with those of the registered proprietor; and references to the registered proprietor in the provisions of this Act relating to infringement shall be construed accordingly.

(3) In an action brought by an exclusive licensee by virtue of this section a defendant may avail himself of any defence which would have been available to him if the action had been brought by the registered proprietor.

(4) Where an action for infringement of the right in a registered design brought by the registered proprietor or an exclusive licensee relates (wholly or partly) to an infringement in respect of which they have concurrent rights of action, the proprietor or, as the case may be, the exclusive licensee may not, without the leave of the court, proceed with the action unless the other is either joined as a claimant or added as a defendant.

(5) A registered proprietor or exclusive licensee who is added as a defendant in pursuance of subsection (4) is not liable for any costs in the action unless he takes part in the proceedings.

(6) Subsections (4) and (5) do not affect the granting of interlocutory relief on the application of the registered proprietor or an exclusive licensee.

(7) Where an action for infringement of the right in a registered design is brought which relates (wholly or partly) to an infringement in respect of which the registered proprietor and an exclusive licensee have concurrent rights of action—

- (a) the court shall, in assessing damages, take into account—
  - (i) the terms of the licence, and
  - (ii) any pecuniary remedy already awarded or available to either of them in respect of the infringement;
- (b) no account of profits shall be directed if an award of damages has been made, or an account of profits has been directed, in favour of the other of them in respect of the infringement; and

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(c) the court shall if an account of profits is directed apportion the profits between them as the court considers just, subject to any agreement between them;  
and these provisions apply whether or not the proprietor and the exclusive licensee are both parties to the action.

(8) The registered proprietor shall notify any exclusive licensee having concurrent rights before applying for an order under section 24C of this Act (order for delivery up of infringing article, &c); and the court may on the application of the licensee make such order under that section as it thinks fit having regard to the terms of the licence.

### **Meaning of “infringing article”**

**24G.—**(1) In this Act “infringing article”, in relation to a design, shall be construed in accordance with this section.

(2) An article is an infringing article if its making to that design was an infringement of the right in a registered design.

(3) An article is also an infringing article if—

- (a) it has been or is proposed to be imported into the United Kingdom, and
- (b) its making to that design in the United Kingdom would have been an infringement of the right in a registered design or a breach of an exclusive licensing agreement relating to that registered design.

(4) Where it is shown that an article is made to a design which is or has been a registered design, it shall be presumed until the contrary is proved that the article was made at a time when the right in the registered design subsisted.

(5) Nothing in subsection (3) shall be construed as applying to an article which may be lawfully imported into the United Kingdom by virtue of an enforceable Community right within the meaning of section 2(1) of the European Communities Act 1972.”.