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STATUTORY INSTRUMENTS

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**1989 No. 1130**

**The Design Right (Proceedings before Comptroller) Rules 1989**

**Citation and commencement**

1. These Rules may be cited as the Design Right (Proceedings before Comptroller) Rules 1989 and shall come into force on 1st August 1989.

**Interpretation**

2.—(1) In these Rules, unless the context otherwise requires—

“the Act” means the Copyright, Designs and Patents Act 1988;

“applicant” means a person who has referred a dispute or made an application to the Comptroller;

“application” means an application to the Comptroller to settle or vary the terms of a licence of right or to adjust the terms of a licence;

“dispute” means a dispute as to any of the matters referred to in rule 3(1); and

“proceedings” means proceedings before the Comptroller in respect of a dispute or application.

(2) A rule or schedule referred to by number means the rule or schedule so numbered in these Rules; and a requirement under these Rules to use a form set out in Schedule 1 is satisfied by the use either of a replica of that form or of a form which contains the information required by the form set out in the said Schedule and which is acceptable to the Comptroller.

**Proceedings in respect of a dispute**

3.—(1) Proceedings under section 246 of the Act in respect of a dispute as to—

(a) the subsistence of design right,

(b) the term of design right, or

(c) the identity of the person in whom design right first vested,

shall be commenced by the service by the applicant on the Comptroller of a notice in Form 1 in Schedule 1. There shall be served with that notice a statement in duplicate setting out the name and address of the other party to the dispute (hereinafter in this rule referred to as the respondent), the issues in dispute, the applicant’s case and the documents relevant to his case.

(2) Within 14 days of the receipt of the notice the Comptroller shall send a copy of the notice, together with a copy of the applicant’s statement, to the respondent.

(3) Within 28 days of the receipt by him of the documents referred to in paragraph (2) above, the respondent shall serve on the Comptroller a counter-statement and shall at the same time serve a copy of it on the applicant. Such counter-statement shall set out full particulars of the grounds on which he contests the applicant’s case, any issues on which he and the applicant are in agreement and the documents relevant to his case.

(4) Within 21 days of the service on him of the counter-statement, the applicant may serve a further statement on the Comptroller setting out the grounds on which he contests the respondent’s case, and shall at the same time serve a copy of it on the respondent.

(5) No amended statement or further statement shall be served by either party except by leave or direction of the Comptroller.

**4.—(1)** The Comptroller shall give such directions as to the further conduct of proceedings as he considers appropriate.

(2) If a party fails to comply with any direction given under this rule, the Comptroller may in awarding costs take account of such default.

**5.—(1)** Unless the Comptroller otherwise directs, all evidence in the proceedings shall be by statutory declaration or affidavit.

(2) Where the Comptroller thinks fit in any particular case to take oral evidence in lieu of or in addition to evidence by statutory declaration or affidavit he may so direct and, unless he directs otherwise, shall allow any witness to be cross-examined on his evidence.

(3) A party to the proceedings who desires to make oral representations shall so notify the Comptroller and the Comptroller shall, unless he and the parties agree to a shorter period, give at least 14 days' notice of the time and place of the hearing to the parties.

(4) If a party intends to refer at a hearing to any document not already referred to in the proceedings, he shall, unless the Comptroller and the other party agree to a shorter period, give 14 days' notice of his intention, together with particulars of every document to which he intends to refer, to the Comptroller and the other party.

(5) At any stage of the proceedings the Comptroller may direct that such documents, information or evidence as he may require shall be filed within such time as he may specify.

(6) The hearing of any proceedings, or part of proceedings, under this rule shall be in public, unless the Comptroller, after consultation with the parties, otherwise directs.

**6.—(1)** Any party to the proceedings may appear in person or be represented by counsel or a solicitor (of any part of the United Kingdom) or, subject to paragraph (4) below, a patent agent or any other person whom he desires to represent him.

(2) Anything required or authorised by these Rules to be done by or in relation to any person may be done by or in relation to his agent.

(3) Where after a person has become a party to the proceedings he appoints an agent for the first time or appoints an agent in substitution for another, the newly appointed agent shall give written notice of his appointment to the Comptroller and to every other party to the proceedings.

(4) The Comptroller may refuse to recognise as such an agent in respect of any proceedings before him—

- (a) a person who has been convicted of an offence under section 88 of the Patents Act 1949<sup>(1)</sup> or section 114 of the Patents Act 1977<sup>(2)</sup>;
- (b) any individual whose name has been erased from and not restored to, or who is suspended from, the register of patent agents (kept in pursuance of rules made under the Patents Act 1977) on the ground of misconduct;
- (c) a person who is found by the Secretary of State to have been guilty of such conduct as would, in the case of an individual registered in the register of patent agents, render him liable to have his name erased from the register on the ground of misconduct;
- (d) a partnership or body corporate of which one of the partners or directors is a person whom the Comptroller could refuse to recognise under sub-paragraphs (a), (b) or (c) above.

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(1) 1949 c. 87.

(2) 1977 c. 37.

7.—(1) A person who claims to have a substantial interest in a dispute in respect of which proceedings have been commenced may apply to the Comptroller to be made a party to the dispute in Form 2 in Schedule 1, supported by a statement of his interest. He shall serve a copy of his application, together with his statement, on every party to the proceedings.

(2) The Comptroller shall, upon being satisfied of the substantial interest of that person in the dispute, grant the application and shall give such directions or further directions under rule 4(1) as may be necessary to enable that person to participate in the proceedings as a party to the dispute.

8. A party (including a person made a party to the proceedings under rule 7) may at any time before the Comptroller's decision withdraw from the proceedings by serving a notice to that effect on the Comptroller and every other party to the proceedings, but such withdrawal shall be without prejudice to the Comptroller's power to make an order as to the payment of costs incurred up to the time of service of the notice.

9. After hearing the party or parties desiring to be heard, or if none of the parties so desires, then without a hearing, the Comptroller shall decide the dispute and notify his decision to the parties, giving written reasons for his decision if so required by any party.

#### **Proceedings in respect of application to settle terms of licence of right or adjust terms of licence**

10.—(1) Proceedings in respect of an application to the Comptroller—

- (a) under section 247 of the Act, to settle the terms of a licence available as of right by virtue of section 237 or under an order under section 238 of the Act, or
- (b) under paragraph 19(2) of Schedule 1 to the Act, to settle the terms of a licence available as of right in respect of a design recorded or embodied in a design document or model before 1st August 1989, or
- (c) brought by virtue of paragraph 19(5) of Schedule 1 to the Act, to adjust the terms of a licence granted before 1st August 1989 in respect of a design referred to in subparagraph (b) above,

shall be commenced by the service by the applicant on the Comptroller of a notice in Form 3 in Schedule 1.

(2) There shall be served with the notice a statement in duplicate setting out—

- (a) in the case of an application referred to in paragraph (1)(a) or (b) above, the terms of the licence which the applicant requires the Comptroller to settle and, unless the application is one to which rule 13 relates, the name and address of the owner of the design right or, as the case may be, the copyright owner of the design;
- (b) in the case of an application referred to in paragraph (1)(c) above, the date and terms of the licence and the grounds on which the applicant requires the Comptroller to adjust those terms and the name and address of the grantor of the licence.

(3) Within 14 days of the receipt of the notice the Comptroller shall send a copy of it, together with a copy of the applicant's statement, to the person (hereinafter in this rule referred to as the respondent) shown in the application as the design right owner, copyright owner or grantor of the licence, as appropriate.

(4) Within 6 weeks of the receipt by him of the notice sent under paragraph (3) above the respondent shall, if he does not agree to the terms of the licence required by the applicant to be settled or, as the case may be, adjusted, serve a notice of objection on the Comptroller with a statement setting out the grounds of his objection and at the same time shall serve a copy of the same on the applicant.

(5) Within 4 weeks of the receipt of the notice of objection the applicant may serve on the Comptroller a counter-statement and at the same time serve a copy of it on the respondent.

(6) No amended statement or further statement shall be served by either party except by leave or direction of the Comptroller.

**11.** Rules 4, 5, 6 and 8 shall apply in respect of proceedings under rule 10 as they apply in respect of proceedings under rule 3.

**12.** After hearing the party or parties desiring to be heard, or if none of the parties so desires, then without a hearing, the Comptroller shall decide the application and notify his decision to the parties, giving written reasons for his decision if so required by any party.

### **Settlement of terms where design right owner unknown**

**13.—**(1) Where a person making an application under rule 10(1)(a) or (b) is unable (after making such inquiries as he considers reasonable) to discover the identity of the design right owner or, as the case may be, the copyright owner, he shall serve with his notice under that rule a statement to that effect, setting out particulars of the inquiries made by him as to the identity of the owner of the right and the result of those inquiries.

(2) The Comptroller may require the applicant to make such further inquiries into the identity of the owner of the right as he thinks fit and, may for that purpose, require him to publish in such a manner as the Comptroller considers appropriate particulars of the application.

(3) The Comptroller shall, upon being satisfied from the applicant's statement or the further inquiries made under paragraph (2) above that the identity of the owner of the right cannot be discovered, consider the application and settle the terms of the licence.

### **Proceedings in respect of application by design right owner to vary terms of licence**

**14.—**(1) Where the Comptroller has, in settling the terms of the licence under rule 13, ordered that the licence shall be free of any obligation as to royalties or other payments, the design right owner or copyright owner (as the case may be) may serve on the Comptroller a notice in Form 4 in Schedule 1 applying for the terms of the licence to be varied from the date of his application. There shall be served with the notice a statement in duplicate setting out the particulars of the grounds for variation and the terms required to be varied.

(2) Within 14 days of the receipt of the notice the Comptroller shall send a copy of the notice, together with the design right or copyright owner's statement, to the applicant under rule 10 (hereinafter in this rule referred to as the licensee).

(3) The licensee shall, if he does not agree to the terms as required to be varied by the design right or copyright owner, within 6 weeks of the receipt of the notice serve notice of objection on the Comptroller with a statement setting out the grounds of his objection and at the same time shall serve a copy of the same on the design right or copyright owner, as the case may be.

(4) Within 4 weeks of the receipt of the notice of objection the design right or copyright owner may serve on the Comptroller a counter-statement, and at the same time shall serve a copy of it on the licensee.

(5) No amended statement or further statement shall be served by either party except by leave or direction of the Comptroller.

**15.** Rules 4, 5, 6 and 8 shall apply in respect of proceedings under rule 14 as they apply in respect of proceedings under rule 3.

**16.** After hearing the party or parties desiring to be heard, or if none of the parties so desires, then without a hearing, the Comptroller shall decide the application and notify his decision to the parties, giving written reasons for his decision if so required by any party.

## General

17. Any document filed in any proceedings may, if the Comptroller thinks fit, be amended, and any irregularity in procedure may be rectified by the Comptroller on such terms as he may direct.

18.—(1) Any statutory declaration or affidavit filed in any proceedings shall be made and subscribed as follows—

- (a) in the United Kingdom, before any justice of the peace or any commissioner or other officer authorised by law in any part of the United Kingdom to administer an oath for the purpose of any legal proceedings;
- (b) in any other part of Her Majesty's dominions or in the Republic of Ireland, before any court, judge, justice of the peace or any officer authorised by law to administer an oath there for the purpose of any legal proceedings; and
- (c) elsewhere, before a British Minister, or person exercising the functions of a British Minister, or a Consul, Vice-Consul or other person exercising the functions of a British Consul or before a notary public, judge or magistrate.

(2) Any document purporting to have fixed, impressed or subscribed thereto or thereon the seal or signature of any person authorised by paragraph (1) above to take a declaration may be admitted by the Comptroller without proof of the genuineness of the seal or signature or of the official character of the person or his authority to take the declaration.

(3) In England and Wales, the Comptroller shall, in relation to the giving of evidence (including evidence on oath), the attendance of witnesses and the discovery and production of documents, have all the powers of a judge of the High Court, other than the power to punish summarily for contempt of court.

(4) In Scotland, the Comptroller shall, in relation to the giving of evidence (including evidence on oath), have all the powers which a Lord Ordinary of the Court of Session has in an action before him, other than the power to punish summarily for contempt of court, and, in relation to the attendance of witnesses and the recovery and production of documents, have all the powers of the Court of Session.

19. The Comptroller may appoint an adviser to assist him in any proceedings and shall settle the question or instructions to be submitted or given to such an adviser.

20.—(1) The times or periods prescribed by these Rules for doing any act or taking any proceedings thereunder may be extended by the Comptroller if he thinks fit, upon such notice and upon such terms as he may direct, and such extension may be granted although the time for doing such act or taking such proceedings has already expired.

(2) Where the last day for the doing of any act falls on a day on which the Patent Office is closed and by reason thereof the act cannot be done on that day, it may be done on the next day on which the Office is open.

21. For the purposes of these Rules the Patent Office shall be open Monday to Friday—

- (a) between 10.00 a.m. and midnight, for the filing of applications, forms and other documents, and
- (b) between 10.00 a.m. and 4.00 p.m. for all other purposes,

excluding Good Friday, Christmas Day and any day specified or proclaimed to be a bank holiday under section 1 of the Banking and Financial Dealings Act 1971(3).

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(3) 1971 c. 80.

**22.**—(1) The Comptroller may, in respect of any proceedings, by order award such costs or, in Scotland, such expenses as he considers reasonable and direct how, to what party and from what parties they are to be paid.

(2) Where any applicant or a person making an application under rule 7 neither resides nor carries on business in the United Kingdom or another member State of the European Economic Community the Comptroller may require him to give security for the costs or expenses of the proceedings and in default of such security being given may treat the reference or application as abandoned.

**23.**—(1) Every person concerned in any proceedings to which these Rules relate shall furnish to the Comptroller an address for service in the United Kingdom, and that address may be treated for all purposes connected with such proceedings as the address of the person concerned.

(2) Where any document or part of a document which is in a language other than English is served on the Comptroller or any party to proceedings or filed with the Comptroller in pursuance of these Rules, it shall be accompanied by a translation into English of the document or part, verified to the satisfaction of the Comptroller as corresponding to the original text.

**24.** The fees specified in Schedule 2 shall be payable in respect of the matters there mentioned.

27th June 1989

*Eric Forth*  
Parliamentary Under Secretary of State  
Department of Trade and Industry

We consent to the fees prescribed in these Rules.

4th July 1989

*David Maclean*  
*Stephen Dorrell*  
Two of the Lords Commissioners of Her  
Majesty's Treasury