

SCHEDULE 3

Amendments to secondary legislation

Amendment of the Community Design Regulations 2005

9. After regulation 1 there shall be inserted—

“Infringement proceedings

1A.—(1) This regulation and regulations 1B to 1D are without prejudice to the duties of the Community design court under the provisions of Article 89(1)(a) to (c) of the Community Design Regulation.

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

Order for delivery up

1B.—(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 Community design, knowing or having reason to believe that it has been or is to be used to make an infringing article,

the holder of the Community design in question may apply to the Community design 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 regulation; 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 regulation 1C (order as to disposal of infringing articles, &c.).

(3) An application for an order under this regulation 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 paragraph (4).

- (4) If during the whole or any part of that period the holder of the Community design—
- (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 paragraph (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.

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(6) A person to whom an infringing article or other thing is delivered up in pursuance of an order under this regulation shall, if an order under regulation 1C is not made, retain it pending the making of an order, or the decision not to make an order, under that regulation.

(7) The reference in paragraph (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 regulation affects any other power of the court.

Order as to disposal of infringing articles, &c

1C.—(1) An application may be made to the Community design court for an order that an infringing article or other thing delivered up in pursuance of an order under regulation 1B shall be—

- (a) forfeited to the holder of the Community design, 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 Community design would be adequate to compensate the holder 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 regulation, 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 regulation 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 regulation;
- (b) under section 24D of the Registered Designs Act 1949;
- (c) under section 114, 204 or 231 of the Copyright, Designs and Patents Act 1988; or
- (d) under section 19 of the Trade Marks Act 1994 (including that section as applied by regulation 4 of the Community Trade Mark Regulations 2006 (SI 2006/1027)).

Meaning of “infringing article”

1D.—(1) In these Regulations “infringing article”, in relation to a design, shall be construed in accordance with this regulation.

(2) An article is an infringing article if its making to that design was an infringement of a Community 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 a Community design or a breach of an exclusive licensing agreement relating to that Community design.

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

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(5) Nothing in paragraph (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.”.