

2006 No. 1974

REGULATORY REFORM

DESIGNS

The Regulatory Reform (Registered Designs) Order 2006

Made - - - - 26th July 2006

Coming into force - - 1st October 2006

The Secretary of State for Trade and Industry (“the Secretary of State”) has—

- (a) consulted(a), in accordance with section 5(1) of the Regulatory Reform Act 2001(b),
 - (i) such organisations as appear to him to be representative of interests substantially affected by his proposals for this Order,
 - (ii) the Comptroller-General of Patents, Designs and Trade Marks,
 - (iii) the Law Commission,
 - (iv) the National Assembly for Wales,
 - (v) such other persons as he considers appropriate;
- (b) following that consultation, considered it appropriate to proceed with the making of this Order;
- (c) laid a document containing his proposals before Parliament as required by section 6 of the Regulatory Reform Act 2001 and the period for Parliamentary consideration under section 8 of that Act has expired;
- (d) had regard to the representations made during this period, in particular the Seventeenth Report of Session 2005-6 of the Delegated Powers and Regulatory Reform Committee of the House of Lords(c) and the Fifth Report of Session 2005-6 of the Regulatory Reform Committee of the House of Commons(d);
- (e) laid a draft of this Order before Parliament with a statement giving details of those representations and the changes he has made to his proposals in light of them;
- (f) reached the opinion that this Order does not remove any necessary protection or prevent any person from continuing to exercise any right or freedom which he might reasonably expect to continue to exercise.

The draft of this Order has been approved by a resolution of each House of Parliament pursuant to section 4(2) of the Regulatory Reform Act 2001.

(a) A consultation document on the modernisation of design practice entitled “Consultation on the Modernisation of the UK System of Registration of Designs” was published by the Patent Office on 7th July 2005. Copies may be obtained from the Trade Marks and Designs Directorate, The Patent Office, Concept House, Cardiff Road, Newport, NP10 8QQ.
(b) 2001 c. 6.
(c) Seventeenth Report published on 3rd April 2006, HL 160.
(d) Fifth Report published on 26th May 2006, HC 1142.

Accordingly, the Secretary of State makes the following Order in exercise of the powers conferred by section 1 of the Regulatory Reform Act 2001:

Introductory

1.—(1) This Order may be cited as the Regulatory Reform (Registered Designs) Order 2006 and it shall come into force on 1st October 2006.

(2) This Order extends to England and Wales, Scotland and Northern Ireland.

2. The Registered Designs Act 1949(a) shall be amended as follows.

Substantive examination for novelty

3. Section 1A (substantive grounds for refusal of registration) shall be omitted.

4. In section 3 (applications for registration), subsection (4) shall be omitted.

5. In section 3A (determination of applications for registration), for subsection (4) there shall be substituted—

“(4) If it appears to the registrar that the application for registration includes—

- (a) something which does not fulfil the requirements of section 1(2) of this Act;
- (b) a design that does not fulfil the requirements of section 1C or 1D of this Act; or
- (c) a design to which a ground of refusal mentioned in Schedule A1 to this Act applies,

he shall refuse to register that thing or that design.”.

6. In section 3B (modification of applications for registration), in subsection (4), for “section 1A(1)(b) or (c)” there shall be substituted “section 3A(4)(b) or (c)”.

7.—(1) Section 11ZA (grounds for invalidity of registration) shall be amended as follows.

(2) In subsection (1), for “on any of the grounds mentioned in section 1A of this Act.” there shall be substituted—

- “(a) on the ground that it does not fulfil the requirements of section 1(2) of this Act;
- (b) on the ground that it does not fulfil the requirements of sections 1B to 1D of this Act; or
- (c) where any ground of refusal mentioned in Schedule A1 to this Act applies.”.

(3) After subsection (1), there shall be inserted—

“(1A) The registration of a design (“the later design”) may be declared invalid if it is not new or does not have individual character when compared to 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 the Community Design Regulation or an application for such registration.

(1B) In subsection (1A) “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.”.

8.—(1) Section 11ZB (applications for declaration of invalidity) shall be amended as follows.

(a) 1949 c. 88; section 8 was inserted by section 269 of the Copyright, Designs and Patents Act 1988 (c. 48), sections 14 and 20 were amended by section 272 of, and paragraphs 7 and 11 of Schedule 3 to, that Act; sections 1A, 3 to 3B, 11ZA to 11ZD were inserted by the Registered Designs Regulations 2001 (SI 2001/3939), sections 14 and 20 were also amended by those Regulations; further amendments to sections 1A, 11ZB and 20 were made by the Registered Designs Regulations 2003 (SI 2003/550); there are other amendments but none is relevant.

(2) In subsection (1), for “on the ground mentioned in section 1A(1)(a) or (b)” there shall be substituted “under section 11ZA(1)(a) or (b)”.

(3) In subsection (2), for “on the ground mentioned in section 1A(1)(c)” there shall be substituted “under section 11ZA(1)(c)”.

(4) In subsection (3), for “on the ground mentioned in section 1A(2)” there shall be substituted “under section 11ZA(1A)”.

(5) In subsection (5), for “on the ground mentioned in” there shall be substituted “under”.

9. In section 11ZD (modification of registration), for the words in subsection (1) from “on any ground” to “or (4)” there shall be substituted “under section 11ZA(1)(b) or (c), (1A), (3) or (4)”.

10.—(1) Section 20 (rectification of register) shall be amended as follows.

(2) In subsection (1A)(a), for “section 1A(1)(c)” there shall be substituted “section 11ZA(1)(c)”.

(3) In subsection (1A)(b), for “section 1A(2)” there shall be substituted “section 11ZA(1A)”.

Multiple applications

11.—(1) Section 3 (applications for registration) shall be amended as follows.

(2) In subsection (1), after “a design” there shall be inserted “or designs”.

(3) In subsection (2), after “design”, in both places it occurs, there shall be inserted “ or designs”.

(4) In subsection (3), after “a design” there shall be inserted “or designs”.

12.—(1) Section 3A (determination of applications for registration) shall be amended as follows.

(2) In subsection (1), for “an application for the registration of a design” there shall be substituted “to register a design included in an application under this Act”.

(3) In subsection (2)—

(a) for “a design” there shall be inserted “or designs”; and

(b) for “the application” there shall be substituted “to register any design included in it”.

(4) In subsection (3), for the words from “an application” to the end of the subsection there shall be substituted “the applicant is not under section 3(2) or (3) or 14 entitled to apply for the registration of a design included in the application, he shall refuse to register that design.”.

13.—(1) Section 3B (modification of applications for registration) shall be amended as follows.

(2) In subsection (1), after “a design” there shall be inserted “or designs”.

(3) In subsection (2)—

(a) after “a design” there shall be inserted “or designs”;

(b) for “the design”, where it first occurs, there shall be substituted “any design included in the application”; and

(c) after “direct that the application” there shall be inserted “so far as relating to that design”.

(4) In subsection (3), for “a design has disclosed more than one design and” there shall be substituted “more than one design”.

(5) In subsection (4)—

(a) “an application for” shall be omitted; and

(b) after “the application” there shall be inserted “for the design”.

14.—(1) Section 14 (registration of design where application for protection in convention country has been made) is amended as follows.

(2) In subsection (1), after “a design” there shall be inserted “or designs”.

(3) In subsection (2), after “a design” there shall be inserted “or designs”.

15. In section 22 (inspection of registered designs), for subsection (4) there shall be substituted—

“(4) Where registration of a design has been refused pursuant to an application under this Act, or an application under this Act has been abandoned in relation to any design—

- (a) the application, so far as relating to that design, and
- (b) any representation, specimen or other document which has been filed and relates to that design,

shall not at any time be open to inspection at the Patent Office or be published by the registrar.”.

Inspection

16.—(1) Section 22 (inspection of registered designs) shall be amended as follows.

(2) In subsection (1)—

- (a) for “issued” there shall be substituted “granted”; and
- (b) for “the following provisions of this section” there shall be substituted “subsection (4)”.

(3) Subsections (2) and (3) shall be omitted.

Lowering the standard of care for restoration of lapsed right in design

17. In section 8A (restoration of lapsed right in design), in subsection (4)—

- (a) for “proprietor took reasonable care” there shall be substituted “failure of the proprietor”; and
- (b) after “section 8(2) or (4)” there shall be inserted “was unintentional”.

Transitional provisions

18.—(1) The amendments made to the Registered Designs Act 1949 by articles 7 to 10 shall not apply to post-1989 registrations or pre-1989 registrations.

(2) In paragraph (1)—

“post-1989 registrations” means registrations to which regulation 12 of the Registered Designs Regulations 2001^(a) applies;

“pre-1989 registrations” means registrations which fall within regulation 13(1) of those Regulations.

19. The amendments made to section 22 of the Registered Designs Act 1949 by article 16(2)(b) and (3) shall not apply to any registration under the Act which has resulted from an application made before the coming into force of this Order.

26th July 2006

Sainsbury of Turville
Parliamentary Under Secretary of State for Science and Innovation
Department of Trade and Industry

(a) SI 2001/3949.

EXPLANATORY NOTE

(This note is not part of the Order)

This Order is made under section 1 of the Regulatory Reform Act 2001 (c. 6). It amends the Registered Designs Act 1949 (c. 88) (“the 1949 Act”).

Article 3 repeals section 1A of the 1949 Act, which set out the substantive grounds for refusing to register a design.

Article 4 repeals section 3(4) of the 1949 Act, which gave the registrar the power to make searches for determining whether a design was new or had individual character.

Article 5 substitutes a new section 3A(4) for that in the 1949 Act. The new provision sets out the remaining substantive grounds for refusing to register a design (those grounds, other than novelty and individual character, found in section 1A of the 1949 Act before its repeal by article 3).

Articles 6 to 10 make consequential amendments to sections 3B, 11ZA, 11ZB, 11ZD and 20 of the 1949 Act as a result of the repeal of section 1A.

Articles 11 to 14 amend sections 3, 3A, 3B and 14 of the 1949 Act so as to permit an application to include multiple designs.

Article 15 makes a consequential amendment to section 22(4) of the 1949 Act related to multiple designs.

Article 16 repeals section 22(2) and (3) of the 1949 Act, thereby removing restrictions on inspecting certain registered designs. It also makes minor amendments to section 22(1) of the 1949 Act.

Article 17 amends section 8A of the 1949 Act. This amendment will mean that an applicant will only have to show that their failure to pay the renewal fee on time was unintentional, instead of having to prove that they exercised reasonable care to see that the renewal fee was paid on time.

Articles 18 and 19 provide transitional provisions.

A Regulatory Impact Assessment together with a more detailed explanation of the changes made by this Order, in particular the impact the changes have on certain burdens, on any necessary protection and on the maintenance of rights and freedoms, is available either from the Patent Office website (www.patent.gov.uk) or by contacting the Trade Marks and Designs Directorate, The Patent Office, Concept House, Cardiff Road, Newport, NP10 8QQ.

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£3.00

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Stationery Office and Queen's Printer of Acts of Parliament.

E1064 8/2006 161064T 19585