

2006 No. 1229

INTELLECTUAL PROPERTY

**The Registered Designs Act 1949 and Patents Act 1977
(Electronic Communications) Order 2006**

<i>Made</i>	- - - -	<i>26th April 2006</i>
<i>Laid before Parliament</i>		<i>3rd May 2006</i>
<i>Coming into force</i>	- -	<i>1st October 2006</i>

The Secretary of State, in exercise of the powers conferred on him by sections 8 and 9 of the Electronic Communications Act 2000(a), makes the following Order:

Citation and commencement

1. This Order may be cited as the Registered Designs Act 1949 and Patents Act 1977 (Electronic Communications) Order 2006 and shall come into force on 1st October 2006.

Insertion of new section 37A

2. The following section shall be inserted after section 37 of the Registered Designs Act 1949(b)—

“Use of electronic communications

37A.—(1) The registrar may give directions as to the form and manner in which documents to be delivered to the registrar—

- (a) in electronic form; or
- (b) using electronic communications,

are to be delivered to him.

(2) A direction under subsection (1) may provide that in order for a document to be delivered in compliance with the direction it shall be accompanied by one or more additional documents specified in the direction.

(3) Subject to subsections (11) and (12), if a document to which a direction under subsection (1) or (2) applies is delivered to the registrar in a form or manner which does not comply with the direction the registrar may treat the document as not having been delivered.

(4) Subsection (5) applies in relation to a case where—

- (a) a document is delivered using electronic communications, and
- (b) there is a requirement for a fee to accompany the document.

(a) 2000 c. 7.
(b) 1949 c. 88, to which there are amendments not relevant to these Regulations.

(5) The registrar may give directions specifying—

- (a) how the fee shall be paid; and
- (b) when the fee shall be deemed to have been paid.

(6) The registrar may give directions specifying that a person who delivers a document to the registrar in electronic form or using electronic communications cannot treat the document as having been delivered unless its delivery has been acknowledged.

(7) The registrar may give directions specifying how a time of delivery is to be accorded to a document delivered to him in electronic form or using electronic communications.

(8) A direction under this section may be given—

- (a) generally;
- (b) in relation to a description of cases specified in the direction;
- (c) in relation to a particular person or persons.

(9) A direction under this section may be varied or revoked by a subsequent direction under this section.

(10) The delivery using electronic communications to any person by the registrar of any document is deemed to be effected, unless the registrar has otherwise specified, by transmitting an electronic communication containing the document to an address provided or made available to the registrar by that person as an address of his for the receipt of electronic communications; and unless the contrary is proved such delivery is deemed to be effected immediately upon the transmission of the communication.

(11) A requirement of this Act that something must be done in the prescribed manner is satisfied in the case of something that is done—

- (a) using a document in electronic form, or
- (b) using electronic communications,

only if the directions under this section that apply to the manner in which it is done are complied with.

(12) In the case of an application made as mentioned in subsection (11)(a) or (b) above, a reference in this Act to the application not having been made in accordance with rules under this Act includes a reference to its not having been made in accordance with any applicable directions under this section.

(13) This section applies—

- (a) to delivery at the Patent Office as it applies to delivery to the registrar; and
- (b) to delivery by the Patent Office as it applies to delivery by the registrar.”.

Insertion of new definition

3. In section 44(1) of the Registered Designs Act 1949 (interpretation), at the appropriate place, there shall be inserted—

““electronic communication” has the same meaning as in the Electronic Communications Act 2000;”.

Amendment of section 124A of the Patents Act 1977

4.—(1) Section 124A of the Patents Act 1977(a) shall be amended as follows.

(2) In subsection (1) for the word “make” there shall be substituted “give”.

(3) In subsection (3), for the words from the beginning to “(1)” there shall be substituted “Subject to subsections (14) and (15), if a document to which a direction under subsection (1) or (2)”.

(a) 1977 c. 37, section 124A was inserted by SI 2003/512; there are other amendments but none is relevant.

(4) In subsection (5)—

- (a) for the word “make” there shall be substituted “give”;
- (b) immediately before paragraph (b) there shall be inserted “and”.

(5) In subsection (6) for the word “make” there shall be substituted “give”.

(6) In subsection (7) for the word “make” there shall be substituted “give”.

(7) Subsections (9), (10) and (12) shall be omitted.

(8) For subsections (13) to (15) there shall be substituted—

“(13) The delivery using electronic communications to any person by the comptroller of any document is deemed to be effected, unless the comptroller has otherwise specified, by transmitting an electronic communication containing the document to an address provided or made available to the comptroller by that person as an address of his for the receipt of electronic communications; and unless the contrary is proved such delivery is deemed to be effected immediately upon the transmission of the communication.

(14) A requirement of this Act that something must be done in the prescribed manner is satisfied in the case of something that is done—

- (a) using a document in electronic form, or
- (b) using electronic communications,

only if the directions under this section that apply to the manner in which it is done are complied with.

(15) In the case of an application made as mentioned in subsection (14)(a) or (b) above, a reference in this Act to the application not having been made in compliance with rules or requirements of this Act includes a reference to its not having been made in compliance with any applicable directions under this section.

(16) This section applies—

- (a) to delivery at, in, with or to the Patent Office as it applies to delivery to the comptroller; and
- (b) to delivery by the Patent Office as it applies to delivery by the comptroller.”.

26th April 2006

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

EXPLANATORY NOTE

(This note is not part of the Order)

This Order amends the Registered Designs Act 1949 (c. 88) (“the 1949 Act”) and the Patents Act 1977 (c. 37) (“the 1977 Act”) to facilitate the use of electronic communications with the Patent Office.

Article 2 inserts a new section 37A into the 1949 Act. This provision gives the registrar the power to:

- (a) direct the form and manner in which a document is delivered to the registrar where the document is to be delivered in electronic form or using electronic communications;
- (b) require a document which is to be delivered in electronic form or using electronic communications to be accompanied by one or more additional documents;
- (c) treat a document as not having been delivered if the form and manner of its delivery does not comply with directions;
- (d) give directions as to how a fee shall be paid and when the fee shall be deemed to have been paid where a document is delivered using electronic communications and there is a requirement for a fee to accompany the document;
- (e) direct that a person delivering a document to the registrar in electronic form or using electronic communications cannot treat it as having been delivered unless its delivery has been acknowledged;
- (f) direct how the time of delivery is to be accorded to a document which is sent to the registrar in electronic form or using electronic communications.

Article 3 provides that “electronic communication” in the 1949 Act is to have the same meaning as in the Electronic Communications Act 2000 (c. 7).

Article 4 makes amendments to section 124A of the 1977 Act. This section was inserted into the 1977 Act by the Patents Act 1977 (Electronic Communications) Order 2003 (SI 2003/512). The amendments made to that provision are intended to bring it into line with section 37A, which is inserted into the 1949 Act by this Order.

A Regulatory Impact Assessment is available, copies of which have been placed in the libraries of both Houses of Parliament. Copies of the assessment are also available from the Trade Marks and Designs Directorate, The Patent Office, Concept Office, Cardiff Road, Newport, NP10 8QQ.

£3.00

© Crown copyright 2006

Printed and published in the UK by The Stationery Office Limited
under the authority and superintendence of Carol Tullo, Controller of Her Majesty’s
Stationery Office and Queen’s Printer of Acts of Parliament.

E0640 5/2006 160640T 19585