

2006 No. 1028

INTELLECTUAL PROPERTY

The Intellectual Property (Enforcement, etc.) Regulations 2006

Made - - - - *5th April 2006*

Laid before Parliament *6th April 2006*

Coming into force - - *29th April 2006*

The Secretary of State has been designated for the purposes of section 2(2) of the European Communities Act 1972(a) in relation to intellectual property (including both registered and unregistered rights)(b).

He makes the following Regulations under the powers conferred by that section:

Citation and commencement

1. These Regulations may be cited as the Intellectual Property (Enforcement, etc.) Regulations 2006 and shall come into force on 29th April 2006.

Amendments of legislation

- 2.—(1) Schedule 1 (amendments to the Registered Designs Act 1949) shall have effect.
(2) Schedule 2 (amendments to other primary legislation) shall have effect.
(3) Schedule 3 (amendments to secondary legislation) shall have effect.
(4) The enactments set out in Schedule 4 (repeals) shall be repealed or revoked to the extent specified.

Assessment of damages

3.—(1) Where in an action for infringement of an intellectual property right the defendant knew, or had reasonable grounds to know, that he engaged in infringing activity, the damages awarded to the claimant shall be appropriate to the actual prejudice he suffered as a result of the infringement.

- (2) When awarding such damages—
(a) all appropriate aspects shall be taken into account, including in particular—
(i) the negative economic consequences, including any lost profits, which the claimant has suffered, and any unfair profits made by the defendant; and
(ii) elements other than economic factors, including the moral prejudice caused to the claimant by the infringement; or

(a) 1972 c. 68. Under section 57(1) of the Scotland Act 1998 (c. 46), despite the transfer to Scottish Ministers of functions in relation to implementing obligations under Community law in relation to devolved matters, the function of the Secretary of State in relation to implementing those obligations continues to be exercisable by him as regards Scotland.
(b) SI 2006/608.

(b) where appropriate, they may be awarded on the basis of the royalties or fees which would have been due had the defendant obtained a licence.

(3) This regulation does not affect the operation of any enactment or rule of law relating to remedies for the infringement of intellectual property rights except to the extent that it is inconsistent with the provisions of this regulation.

(4) In the application of this regulation to—

(a) Scotland, “claimant” includes pursuer; “defendant” includes defender; and “enactment” includes an enactment comprised in, or an instrument made under, an Act of the Scottish Parliament; and

(b) Northern Ireland, “claimant” includes plaintiff.

Order in Scotland for disclosure of information

4.—(1) This regulation applies to proceedings in Scotland concerning an infringement of an intellectual property right.

(2) The pursuer may apply to the court for an order that information regarding the origin and distribution networks of goods or services which infringe an intellectual property right shall be disclosed to him by the relevant person.

(3) The court may only order the information to be disclosed where it considers it just and proportionate having regard to the rights and privileges of the relevant person and others; such an order may be subject to such conditions as the court thinks fit.

(4) The relevant person is—

(a) the alleged infringer,

(b) any person who—

(i) was found in possession of the infringing goods on a commercial scale,

(ii) was found to be using the infringing services on a commercial scale, or

(iii) was found to be providing services on a commercial scale, which are used in activities which infringe an intellectual property right, or

(c) any person who has been identified by a person specified in sub-paragraph (b) as being involved in—

(i) the production, manufacture or distribution of the infringing goods, or

(ii) the provision of the infringing services.

(5) For the purposes of paragraph (3), the court may order the disclosure of any of the following types of information—

(a) the names and addresses of—

(i) each producer, manufacturer, distributor or supplier of the infringing goods or services;

(ii) any person who previously possessed the infringing goods; and

(iii) the intended wholesaler and retailer of the infringing goods or services; and

(b) information relating to—

(i) the quantities of infringing goods or the amount of infringing services provided, produced, manufactured, delivered, received or ordered; and

(ii) the price paid for the infringing goods or infringing services in question.

(6) Nothing in this regulation affects—

(a) any right of the pursuer to receive information under any other enactment (including an enactment comprised in, or an instrument made under, an Act of the Scottish Parliament) or rule of law; and

(b) any other power of the court.

(7) For the purposes of this regulation and regulation 5, “court” means the Court of Session or the sheriff.

Order in Scotland for publication of judgments

5. In Scotland, where the court finds that an intellectual property right has been infringed, the court may, at the request of the pursuer, order appropriate measures for the dissemination and publication of the judgment to be taken at the defender’s expense.

5th April 2006

Barry Gardiner
Minister for Competitiveness
Department for Trade and Industry

Amendments to the Registered Designs Act 1949

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

2. After section 15 there shall be inserted—

“Property in and dealing with registered designs and applications

15A The nature of registered designs

A registered design or an application for a registered design is personal property (in Scotland, incorporeal moveable property).

15B Assignment, &c of registered designs and applications for registered designs

(1) A registered design or an application for a registered design is transmissible by assignment, testamentary disposition or operation of law in the same way as other personal or moveable property, subject to the following provisions of this section.

(2) Any transmission of a registered design or an application for a registered design is subject to any rights vested in any other person of which notice is entered in the register of designs, or in the case of applications, notice is given to the registrar.

(3) An assignment of, or an assent relating to, a registered design or application for a registered design is not effective unless it is in writing signed by or on behalf of the assignor or, as the case may be, a personal representative.

(4) Except in Scotland, the requirement in subsection (3) may be satisfied in a case where the assignor or personal representative is a body corporate by the affixing of its seal.

(5) Subsections (3) and (4) apply to assignment by way of security as in relation to any other assignment.

(6) A registered design or application for a registered design may be the subject of a charge (in Scotland, security) in the same way as other personal or moveable property.

(7) The proprietor of a registered design may grant a licence to use that registered design.

(8) Any equities (in Scotland, rights) in respect of a registered design or an application for a registered design may be enforced in like manner as in respect of any other personal or moveable property.

15C Exclusive licences

(1) In this Act an “exclusive licence” means a licence in writing signed by or on behalf of the proprietor of the registered design authorising the licensee to the exclusion of all other persons, including the person granting the licence, to exercise a right which would otherwise be exercisable exclusively by the proprietor of the registered design.

(2) The licensee under an exclusive licence has the same rights against any successor in title who is bound by the licence as he has against the person granting the licence.”.

3. Before section 25 there shall be inserted—

“24A Action for infringement

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

(a) 1949 c. 88; section 26(2) was amended by section 272 of, and paragraph 15 of Schedule 3 to, the Copyright, Designs and Patents Act 1988; there are other amending but none is relevant.

(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).

24B Exemption of innocent infringer from liability

(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.

24C Order for delivery up

(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.).

(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.

24D Order as to disposal of infringing articles, &c

(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).

24E Jurisdiction of county court and sheriff court

(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.

24F Rights and remedies of exclusive licensee

(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
- (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.

24G Meaning of “infringing article”

(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.”.

4. In section 26 (remedy for groundless threats of infringement proceedings), in subsection (2), for the word “plaintiff”, in both places it occurs, there shall be substituted “claimant”.

5. For section 45 there shall be substituted—

“45 Application to Scotland

(1) In the application of this Act to Scotland—

“account of profits” means accounting and payment of profits;

“accounts” means count, reckoning and payment;

“arbitrator” means arbiter;

“assignment” means assignation;

“claimant” means pursuer;

“costs” means expenses;

“defendant” means defender;

“delivery up” means delivery;

“injunction” means interdict;

“interlocutory relief” means interim remedy.

(2) References to the Crown shall be construed as including references to the Crown in right of the Scottish Administration.”.

6. In section 46 (application to Northern Ireland), after subsection (4) there shall be inserted—

“(4A) Any reference to a claimant includes a reference to a plaintiff.”.

Amendments to other primary legislation

Amendment of the Patents Act 1977

1. The Patents Act 1977(a) shall be amended as follows.

2. In section 62 (restrictions on recovery of damages for infringement), in subsection (3) for the words from “no damages” to the end of the subsection there shall be substituted—

“the court or the comptroller shall, when awarding damages or making an order for an account of profits in proceedings for an infringement of the patent committed before the decision to allow the amendment, take into account the following—

- (a) whether at the date of infringement the defendant or defender knew, or had reasonable grounds to know, that he was infringing the patent;
- (b) whether the specification of the patent as published was framed in good faith and with reasonable skill and knowledge;
- (c) whether the proceedings are brought in good faith.”

3. In section 63 (relief for infringement of partially valid patent), in subsection (2) for the words from “not grant relief” to the end of the subsection there shall be substituted—

“, when awarding damages, costs or expenses or making an order for an account of profits, take into account the following—

- (a) whether at the date of the infringement the defendant or defender knew, or had reasonable grounds to know, that he was infringing the patent;
- (b) whether the specification of the patent was framed in good faith and with reasonable skill and knowledge;
- (c) whether the proceedings are brought in good faith;

and any relief granted shall be subject to the discretion of the court or the comptroller as to costs or expenses and as to the date from which damages or an account should be reckoned.”

4. In section 68 (effect of non-registration on infringement proceedings)—

- (a) the words from “, the court or comptroller shall” to “occurring” shall be omitted; and
- (b) before the word “unless”, there shall be inserted “, in proceedings for such an infringement, the court or comptroller shall not award him costs or expenses”.

5.—(1) In section 130 (interpretation), in subsection (1), in the definition of “formal requirements” for “section 17” there shall be substituted “section 15A”.

(2) Sub-paragraph (1) does not apply to an application for a patent to which article 20, 21 or 22 of the Regulatory Reform (Patents) Order 2004(b) applies.

Amendment of the Copyright, Designs and Patents Act 1988

6. The Copyright, Designs and Patents Act 1988(c) is amended as follows.

(a) 1977 c. 37; there are amendments but none is relevant.

(b) SI 2004/2357.

(c) 1988 c. 48; sections 114(6), 204(6) and 231(6) were amended by section 106(1) of, and paragraph 8 of Schedule 3 to, the Trade Marks Act 1994; section 172A was inserted by, and sections 179, 211 and 212 were amended by, SI 1995/3297; section 172A and 179 were amended by SI 1996/2967; there are other amendments but none is relevant.

7. In section 114 (order as to disposal of infringing copy or other article), in subsection (6) for the words from “under this section” to the end of the subsection there shall be substituted—

- “(a) under this section or under section 204 or 231 of this Act;
- (b) under section 24D of the Registered Designs Act 1949;
- (c) 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)); or
- (d) under regulation 1C of the Community Design Regulations 2005 (SI 2005/2339).”.

8.—(1) Section 172A (meaning of EEA and related expressions) shall be amended as follows.

(2) For subsection (1) there shall be substituted—

“(1) In this Part—

“the EEA” means the European Economic Area; and

“EEA state” means a member State, Iceland, Liechtenstein or Norway.”.

(3) In subsection (2), for the words “an EEA national” there shall be substituted “a national of an EEA State”.

9. In section 179 (index of defined expressions), for the words “EEA, EEA national and EEA state” there shall be substituted “the EEA, EEA state and national of an EEA state”.

10. After section 197 there shall be inserted—

“197A Presumptions relevant to recordings of performances

(1) In proceedings brought by virtue of this Part with respect to the rights in a performance, where copies of a recording of the performance as issued to the public bear a statement that a named person was the performer, the statement shall be admissible as evidence of the fact stated and shall be presumed to be correct until the contrary is proved.

(2) Subsection (1) does not apply to proceedings for an offence under section 198 (criminal liability for making etc. illicit recordings); but without prejudice to its application in proceedings for an order under section 199 (order for delivery up in criminal proceedings).”.

11. In section 204 (order as to disposal of illicit recording), in subsection (6) for the words from “under this section” to the end of the subsection there shall be substituted—

- “(a) under this section or under section 114 or 231 of this Act;
- (b) under section 24D of the Registered Designs Act 1949;
- (c) 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)); or
- (d) under regulation 1C of the Community Design Regulations 2005 (SI 2005/2339).”.

12. In section 211(1) (expressions having same meaning as in copyright provisions), for the entry “EEA national,” there shall be substituted the entries “the EEA,” and “EEA state,”.

13. In section 212 (index of defined expressions), for the words “EEA national” there shall be substituted “the EEA and EEA state”.

14. In section 231 (orders as to disposal of infringing articles, &c), in subsection (6) for the words from “under this section” to the end of the subsection there shall be substituted—

- “(a) under this section or under section 114 or 204 of this Act;
- (b) under section 24D of the Registered Designs Act 1949;
- (c) 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)); or
- (d) under regulation 1C of the Community Design Regulations 2005 (SI 2005/2339).”.

Amendment of the Trade Marks Act 1994

15. The Trade Marks Act 1994^(a) shall be amended as follows.

16. In section 19 (order as to disposal of infringing goods, materials or articles), in subsection (6) for the words from “under this section” to the end of the subsection there shall be substituted—

- “(a) under this section (including that section as applied by regulation 4 of the Community Trade Mark Regulations 2006 (SI 2006/1027));
- (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 regulation 1C of the Community Design Regulations 2005 (SI 2005/2339).”.

17. In section 25 (registration of transactions affecting registered trade mark), in subsection (4), for the words from “, then unless” to the end of the subsection there shall be substituted—

“and the mark is infringed before the prescribed particulars of the transaction are registered, in proceedings for such an infringement, the court shall not award him costs unless—

- (a) an application for registration of the prescribed particulars of the transaction is made before the end of the period of six months beginning with its date, or
- (b) the court is satisfied that it was not practicable for such an application to be made before the end of that period and that an application was made as soon as practicable thereafter.”.

18. In section 55 (the Paris Convention), in subsection (1)(b) after the words “that Convention” there shall be inserted “or to that Agreement”.

(a) 1994 c. 26; section 55 was amended by SI 1999/1899; there are other amendments but none is relevant.

Amendments to secondary legislation

Amendment of the Duration of Copyright and Rights in Performances Regulations 1995

1. In regulation 2 of the Duration of Copyright and Rights in Performances Regulations 1995(a) for the definition of “EEA state” there is substituted—

““EEA state” means a member State, Iceland, Liechtenstein or Norway.”.

Amendment of the Copyright and Related Rights Regulations 1996

2. The Copyright and Related Rights Regulations 1996(b) shall be amended as follows.

3. In regulation 2, for the definition of “EEA state” there shall be substituted—

““EEA state” means a member State, Iceland, Liechtenstein or Norway.”.

4. In regulation 16(7) after the word “regulation” there shall be inserted “and regulation 17A”.

5. After regulation 17 there shall be inserted—

“Presumptions relevant to works subject to publication right

17A. In proceedings brought by virtue of Chapter 6 of Part 1 of the Copyright, Designs and Patents Act 1988, as applied to publication right by regulation 17, with respect to a work, where copies of the work as issued to the public bear a statement that a named person was the owner of publication right in the work at the date of issue of the copies, the statement shall be admissible as evidence of the fact stated and shall be presumed to be correct until the contrary is proved.

Application of presumptions in relation to an order for delivery up in criminal proceedings

17B. Regulation 17A does not apply to proceedings for an offence under section 107 of the Copyright, Designs and Patents Act 1988 as applied and modified by regulation 17 in relation to publication right; but without prejudice to its application in proceedings for an order under section 108 of the Copyright, Designs and Patents Act 1988 as that section applies to publication right by virtue of regulation 17.”.

Amendment of the Copyright and Rights in Databases Regulations 1997

6. For regulation 23 of the Copyright and Rights in Databases Regulations 1997(c) there shall be substituted—

“Application of copyright provisions to database right

23. The following provisions of the 1988 Act apply in relation to database right and databases in which that right subsists as they apply in relation to copyright and copyright works—

(a) SI 1995/3297.
(b) SI 1996/2967.
(c) SI 1997/3032.

sections 90 to 93 (dealing with rights in copyright works)
sections 96 to 102 (rights and remedies of copyright owner and exclusive licensee)
sections 113 and 114 (supplementary provisions relating to delivery up)
section 115 (jurisdiction of county court and sheriff court).”.

Amendment of the Community Design Regulations 2005

7. The Community Design Regulations 2005(a) shall be amended as follows.
8. In regulation 1(2) (interpretation), at the appropriate place, there shall be inserted—
““Community design court” means a court designated as such by the Community Designs (Designation of Community Design Courts) Regulations 2005(b);”.
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.

(a) SI 2005/2339.
(b) SI 2005/696.

(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.

(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.

(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.”.

10. After regulation 5 there shall be inserted—

“Application to Scotland and Northern Ireland

5A.—(1) In the application of these Regulations to Scotland—

“accounts” means count, reckoning and payment;

“claimant” means pursuer;

“defendant” means defender;

“delivery up” means delivery;

“injunction” means interdict.

(2) In the application of these Regulations to Northern Ireland, “claimant” includes plaintiff.”.

SCHEDULE 4

Regulation 2(4)

Repeals

<i>Title</i>	<i>Extent of repeal or revocation</i>
Registered Designs Act 1949 (c. 88)	Section 9. Section 19(4). In section 28(5), in both places where they occur, the words “or expenses”.
Patents Act 1977 (c. 37)	In section 68, the words from “, the court or comptroller shall” to “occurring”.
Copyright, Designs and Patents Act 1988 (c. 48)	In section 144A(1), the word “member”. Section 172A(3). In section 231(5), the words “or seized”.
Patents Act 2004 (c. 16)	Section 2(3) and (4).
Community Design Regulations 2005 (SI 2005/2339)	Regulation 2(7).

EXPLANATORY NOTE

(This note is not part of the Regulations)

This Instrument implements or further implements the following Community instruments—

- (a) Directive of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights (2004/48/EC) (OJ L157, 30.4. 2004 p.45, a corrigendum was published in OJ L195, 2.6.2004 p.16) (“the Enforcement Directive”);
- (b) Agreement establishing the World Trade Organisation (including the Agreement on Trade-Related Aspects of Intellectual Property Rights (Cm. 3044-6, 3080, 3263-4, 3268-9, 3271, 3275-7 and 3282) (“TRIPS”) which was specified as a Community treaty by SI 1995/265;
- (c) Directive of the European Parliament and of the Council of 13 October 1998 on the legal protection of designs (98/71/EC) (OJ L289, 28.10.98 p. 28) (“the Designs Directive”);
- (d) Council Regulation of 12 December 2001 on Community designs (EC) Regulation No. 6 of 2002 (OJ. L3, 5. 1. 2002 p.1) (“the Community Design Regulation”); and
- (e) European Economic Area Agreement (“EEA Agreement”).

Regulation 3 implements Article 13 of the Enforcement Directive. It sets out the grounds on which damages should be awarded against a person who knowingly infringes an intellectual property right.

Regulation 4 implements Article 8 of the Enforcement Directive in Scotland. It creates a new type of court order, for disclosure of information about infringing goods and services. By reason of the House of Lords decision in *Norwich Pharmacal v Customs and Excise Commissioners* [1974] AC 133 no provision is necessary to implement this obligation in England and Wales or Northern Ireland.

Regulation 5 implements Article 15 of the Enforcement Directive in Scotland. It creates a new type of court order, for the dissemination and publication of a judgment at the defender’s expense. This Article was implemented in England and Wales by changes made to the Civil Procedure Rules (by SI 2005/3515 (L. 32)).

Schedule 1 amends the Registered Designs Act 1949 (c. 88).

Paragraph 2 of that Schedule inserts new sections 15A and 15B (property in and dealing with registered designs and applications) to make further provisions relating to the Community Design Regulation and the Designs Directive. It also inserts a new section 15C which makes provision relating to or arising out of Article 4 of the Enforcement Directive.

Paragraph 3 of that Schedule inserts new section 24A to 24G (actions for infringement, innocent infringement, delivery up and disposal of infringing articles, rights and remedies of exclusive licensees) to implement sections 5 to 7 of the Enforcement Directive.

Paragraph 5 of that Schedule substitutes a new section 45 for that in the Act, which contains definitions for Scotland.

Schedule 2 amends the Patents Act 1977 (c. 37), the Copyright, Designs and Patents Act 1988 (c. 48) and the Trade Marks Act 1994 (c.26).

Paragraphs 1 to 5 of that Schedule amend sections 62, 63 and 68 of the Patents Act 1977 (restriction on recovery of damages, relief for infringement of a partially invalid patent and effect of non-registration) to implement Article 13(1) of the Enforcement Directive. They also make a minor amendment to section 130 of that Act (interpretation) to further implement TRIPS.

Paragraphs 6 to 14 of that Schedule amend the Copyright, Designs and Patents Act 1988. They amend references to the EEA in sections 172A, 179, 211 and 212 in order to re-implement the EEA Agreement and amend sections 114, 204 and 231 to include references to the new section

24D of the Registered Designs Act 1949, the new regulation 1C of the Community Design Regulations 2005 and the application of section 19 of the Trade Marks Act 1994 by the Community Trade Mark Regulations 2006 (SI 2006/1027). They also insert a new section 197A, which creates a new presumption in relation to recordings of performances, in order to implement Article 5 of the Enforcement Directive.

Schedule 3 makes amendments to the Duration of Copyright and Rights in Performances Regulations 1995 (SI 1995/3297), the Copyright and Related Rights Regulations 1996 (SI 1996/2967), the Copyright and Rights in Databases Regulations 1997 (SI 1997/3032) and the Community Design Regulations 2005 (SI 2005/696).

Paragraph 1 of that Schedule amends the reference to the EEA in regulation 2 of the Duration of Copyright and Rights in Performances Regulations 1995.

Paragraphs 2 to 5 of that Schedule amend the Copyright and Related Rights Regulations 1996. They amend the reference to the EEA in regulation 2 and insert new regulations 17A and 17B, which create a new presumption in relation to publication right, in order to implement Article 5 of the Enforcement Directive.

Paragraph 6 of that Schedule amends the Copyright and Rights in Database Regulations 1997 by substituting a new regulation 23, on the application of copyright provisions to database right, in order to implement sections 5 to 7 of the Enforcement Directive.

Paragraphs 7 to 10 of that Schedule amend the Community Design Regulations 2005 by inserting new regulations 1A to 1D (infringement proceedings, orders for delivery up and disposal of infringing articles) and regulation 5A which contains definitions for Scotland. It also makes a consequential amendment to regulation 1(2) of those Regulations.

Schedule 4 contains repeals and revocations.

A regulatory impact assessment and transposition note is available, copies of which have been placed in the libraries of both Houses of Parliament. Copies of the assessment and transposition note are also available from the Intellectual Property and Innovation Directorate, The Patent Office, Concept House, Newport NP10 8QQ and the Patent Office website www.patent.gov.uk.

STATUTORY INSTRUMENTS

2006 No. 1028

INTELLECTUAL PROPERTY

The Intellectual Property (Enforcement, etc.) Regulations 2006

£3.50