
STATUTORY INSTRUMENTS

2006 No.

INTELLECTUAL PROPERTY

The Intellectual Property (Enforcement, etc.) Regulations 2006

Made - - - -

Laid before Parliament

Coming into force - -

6th April 2006

The Secretary of State, being a Minister designated for the purposes of section 2(2) of the European Communities Act 1972(a), in relation to measures relating to patents and to trade marks(b), to copyright and to rights in performances(c), to the legal protection of designs(d) and also in relation to measures relating to the prevention of unauthorised extraction of the contents of a database, and of unauthorised reutilisation of those contents(e), in exercise of the powers conferred on him by that section by section 54 of the Trade Marks Act 1994(f), makes the following Regulations:

Introductory

1. These Regulations may be cited as the Intellectual Property (Enforcement, etc.) Regulations 2006 and shall come into force on 6th April 2006.

Amendments of legislation

- 2.—(1) Schedule 1 (amendments of the Registered Designs Act 1949) shall have effect.
- (2) Schedule 2 (amendments of the Patents Act 1977) shall have effect.
- (3) Schedule 3 (amendments of the Copyright, Designs and Patents Act 1988) shall have effect.
- (4) Schedule 4 (amendments of the Trade Marks Act 1994) shall have effect.
- (5) Schedule 5 (amendments of secondary legislation) shall have effect.

Right of action for passing off

3.—(1) A person may grant to a representative association a right to bring an action under the law of passing off.

- (2) A person may grant such a right of action where they own some or all of—
- (a) the goodwill in a business, or

(a) 1972 c. 68.

(b) SI 1995/2983.

(c) SI 1992/ 707 (matters relating to the protection by copyright of computer programs) and SI 1993/595 (measures relating to copyright (other than those relating to the protection by copyright of computer programs) and to rights in performances).

(d) SI 2000/1813.

(e) SI 1996/3155.

(f) 1994 c. 26.

- (b) the collective goodwill in two or more businesses.
- (3) A grant of a right of action under paragraph (1) must be in writing.
- (4) A representative association may exercise a right of action granted under paragraph (1) only with the leave of the court (which may be granted subject to such conditions as the court thinks fit).
- (5) In such an action, the representative association shall have the same rights and remedies available to it as the person granting the right of action would have had if he had brought the action.
- (6) The rights granted under this regulation are concurrent with those of the person granting the right of action.
- (7) In an action brought by a representative association by virtue of this regulation a defendant or defender may avail himself of any defence which would have been available to him if the action had been brought by the person granting the right of action.
- (8) Where an action for passing off is brought which relates (wholly or partly) to an activity in respect of which the representative association and others have concurrent rights of action—
 - (a) the court shall, in assessing damages, take into account any pecuniary remedy already awarded or available to those others;
 - (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 others in respect of the infringement; and
 - (c) the court shall if an account of profits is directed apportion the profits between the representative association and the others as the court considers just, subject to any agreement between them;
 and these provisions apply whether or not the owner of the goodwill in the business is parties to the action.
- (9) In this regulation—
 - (a) “representative association” means body corporate which has as one of its objects the promotion of the collective interest of its members in relation to the goodwill in their businesses; and
 - (b) “account of profits” means, in Scotland, accounting and payment of profits.

Additional damages in Scotland for passing off

4. In Scotland, the court may in an action for damages under the law of passing off having regard to all the circumstances, and in particular to—

- (a) the flagrancy of the infringement, and
 - (b) any benefit accruing to the defender by reason of the infringement,
- award such additional damages as the justice of the case may require.

Order in Scotland for disclosure of information about infringing articles

5.—(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) the producer, manufacturer, distributor, supplier of the infringing goods;
 - (ii) any person who previously possessed the infringing goods;
 - (iii) the suppliers of infringing services; and
 - (iv) the intended wholesaler and retailer of the infringing goods.
- (b) information relating to—
 - (i) the quantities of infringing goods produced, manufactured, delivered, received or ordered;
 - (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 or rule of law; and
- (b) any other power of the court.

Order in Scotland for publication of judgments

6. 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.

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Department of Trade and Industry

SCHEDULE 1

Amendments of the Registered Designs Act 1949

1. The Registered Designs Act 1949^(a) shall be amended as follows.
2. Section 9 (exemption of innocent infringer from liability for damages) shall be omitted.
3. 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.”.

4. Section 19 (registration of assignment, etc), subsection (4) shall be omitted.
5. Before section 25 there shall be inserted—

^(a) 1949 c. 88.

“24A Action for infringement

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

(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) In Scotland, the court may in an action for infringement of the right in a registered design having regard to all the circumstances, and in particular to—

- (a) the flagrancy of the infringement, and
- (b) any benefit accruing to the defender by reason of the infringement,

award such additional damages as the justice of the case may require.

(4) This section has effect subject to section 24B (exemption of innocent infringer from liability for damages).

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 (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 is not made, retain it pending the making of an order, or the decision not to make an order, under that section.

(7) 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 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; or
- (c) under section 114, 204 or 231 of the Copyright, Designs and Patents Act 1988.

24E Jurisdiction of county court and sheriff court

(1) In Northern Ireland a county court may entertain proceedings under—

- 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 (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 Rights and remedies of representative associations

(1) The registered proprietor of a registered design, or an exclusive licensee, may grant to a representative association a right to bring an action in relation to any infringement or infringements of the right in the design.

(2) A grant of a right of action under subsection (1) must be in writing.

(3) A representative association may exercise a right of action granted under subsection (1) only with the leave of the court (which may be granted subject to such conditions as the court thinks fit).

(4) In such an action, the representative association shall have the same rights and remedies available to it as the person granting the right of action would have had if he had brought the action.

(5) The rights granted under this section are concurrent with those of the person granting the right of action; and references to the registered proprietor in the provisions of this Act relating to infringement shall be construed accordingly.

(6) In an action brought by a representative association 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 person granting the right of action.

(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 representative association and the registered proprietor or an exclusive licensee (or both) have concurrent rights of action—

- (a) the court shall, in assessing damages, take into account—
 - (i) the terms of any licence, and
 - (ii) any pecuniary remedy already awarded or available to the registered proprietor or exclusive licensee 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 registered proprietor or the exclusive licensee in respect of the infringement; and
- (c) the court shall if an account of profits is directed apportion the profits between the representative association, the registered proprietor and the exclusive licensee as the court considers just, subject to any agreement between them;

and these provisions apply whether or not the proprietor or the exclusive licensee are parties to the action.

(8) The representative association shall notify the registered proprietor and any exclusive licensee having concurrent rights before applying for an order under section 24C (order for delivery up of infringing article, &c).

(9) In this section, “representative association” means a body corporate which has as one of its objects the promotion of the collective interest of its members in relation to registered designs.

24H 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 a 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.”.

6. 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”.

7. 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.”

8. 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.”.

SCHEDULE 2

Amendments of the Patents Act 1977

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

2. In section 61 (proceedings for infringement of patent), after subsection (1) there shall be inserted—

“(1A) In Scotland, when considering a claim for damages under subsection (1)(c), the court may have regard to all the circumstances, and in particular to—

- (a) the flagrancy of the infringement, and
- (b) any benefit accruing to the defender by reason of the infringement,

award such additional damages as the justice of the case may require.”.

3. After section 67 there shall be inserted—

“67A Rights and remedies of representative associations

(1) The proprietor of a patent, or the holder of an exclusive licence, may grant to a representative association a right to bring an action in relation to any infringement or infringements of the patent.

(2) A grant of a right of action under subsection (1) must be in writing.

(3) A representative association may exercise a right of action granted under subsection (1) only with the leave of the court (which may be granted subject to such conditions as the court thinks fit).

(4) In such an action, the representative association shall have the same rights and remedies available to it as the person granting the right of action would have had if he had brought the action.

(5) The rights granted under this section are concurrent with those of the person granting the right of action; and references to the proprietor of the patent in the provisions of this Act relating to infringement shall be construed accordingly.

(6) In an action brought by a representative association by virtue of this section a defendant or defender may avail himself of any defence which would have been available to him if the action had been brought by the person granting the right of action.

(7) Where an action for infringement of a patent is brought which relates (wholly or partly) to an infringement in respect of which the representative association and the proprietor of the patent or the holder of an exclusive licensee (or both) have concurrent rights of action—

- (a) the court shall, in assessing damages, take into account—
 - (i) the terms of any licence, and
 - (ii) any pecuniary remedy already awarded or available to the proprietor of the patent or the holder of an exclusive licence 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 proprietor of the patent or the holder of the exclusive licensee in respect of the infringement; and
- (c) the court shall if an account of profits is directed apportion the profits between the representative association, the proprietor of the patent and the holder of the

^(a) 1977 c. 37.

exclusive licence as the court considers just, subject to any agreement between them;

and these provisions apply whether or not the proprietor of the patent or the holder of the exclusive licensee are parties to the action.

(8) In this section, “representative association” means a body corporate which has as one of its objects the promotion of the collective interest of its members in relation to patents.”.

4.—(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^(a) applies.

^(a) SI 2004/2357.

SCHEDULE 3

Amendments of the Copyright, Designs and Patents Act 1988

1. The Copyright, Designs and Patents Act 1988(a) is amended as follows.
2. After section 102 there shall be inserted—

“102A Rights and remedies of representative associations

(1) The copyright owner, or an exclusive licensee, may grant to a representative association a right to bring an action in relation to any infringement or infringements of copyright.

(2) A grant of a right of action under subsection (1) must be in writing.

(3) A representative association may exercise a right of action granted under subsection (1) only with the leave of the court (which may be granted subject to such conditions as the court thinks fit).

(4) In such an action, the representative association shall have the same rights and remedies available to it as the person granting the right of action would have had if he had brought the action.

(5) The rights granted under this section are concurrent with those of the person granting the right of action; and references in the relevant provisions of this Part to the copyright owner shall be construed accordingly.

(6) In an action brought by a representative association 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 person granting the right of action.

(7) Where an action for infringement of copyright is brought which relates (wholly or partly) to an infringement in respect of which the representative association and the copyright owner or an exclusive licensee (or both) have concurrent rights of action—

- (a) the court shall, in assessing damages, take into account—
 - (i) the terms of any licence, and
 - (ii) any pecuniary remedy already awarded or available to the copyright owner or exclusive licensee 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 copyright owner or the exclusive licensee in respect of the infringement; and
- (c) the court shall if an account of profits is directed apportion the profits between the representative association, the copyright owner and the exclusive licensee as the court considers just, subject to any agreement between them;

and these provisions apply whether or not the copyright owner or the exclusive licensee are parties to the action.

(8) The representative association shall notify the copyright owner and any exclusive licensee having concurrent rights before applying for an order under section 99 (order for delivery up of infringing article, &c) or exercising the right conferred by section 100 (right of seizure).

(9) In this section, “representative association” means a body corporate which has as one of its objects the promotion of the collective interest of its members in relation to copyright.
”.

3. In section 114 (order as to disposal of infringing copy or other article), in subsection (6)—

(a) 1988 c. 48.

- (a) after the words “of this Act” there shall be inserted “, section 24D of the Registered Design Act 1949”; and
- (b) after the words “design right” there shall be inserted “, registered designs”.

4. After section 191M there shall be inserted—

“191N Rights and remedies of representative associations

(1) The owner of performer’s property rights, or an exclusive licensee, may grant to a representative association a right to bring an action in relation to any infringement or infringements of those rights.

(2) A grant of a right of action under subsection (1) must be in writing.

(3) A representative association may exercise a right of action granted under subsection (1) only with the leave of the court (which may be granted subject to such conditions as the court thinks fit).

(4) In such an action, the representative association shall have the same rights and remedies available to it as the person granting the right of action would have had if he had brought the action.

(5) The rights granted under this section are concurrent with those of the person granting the right of action; and references in this Part to the rights owner shall be construed accordingly.

(6) In an action brought by a representative association 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 person granting the right of action.

(7) Where an action for infringement of a performer’s property rights is brought which relates (wholly or partly) to an infringement in respect of which the representative association and the rights owner or an exclusive licensee (or both) have concurrent rights of action—

- (a) the court shall, in assessing damages, take into account—
 - (i) the terms of any licence, and
 - (ii) any pecuniary remedy already awarded or available to the right owner or exclusive licensee 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 right owner or the exclusive licensee in respect of the infringement; and
- (c) the court shall if an account of profits is directed apportion the profits between the representative association, the right owner and the exclusive licensee as the court considers just, subject to any agreement between them;

and these provisions apply whether or not the right owner or the exclusive licensee are parties to the action.

(8) The representative association shall notify the owner of the performer’s property rights and any exclusive licensee having concurrent rights before applying for an order under section 195 (order for delivery up of infringing article, &c) or exercising the right conferred by section 196 (right of seizure).

(9) In this section, “representative association” means a body corporate which has as one of its objects the promotion of the collective interest of its members in relation to performers’ rights.”.

5. 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).”.

6.In section 204 (order as to disposal of illicit recording), in subsection (6)—

(a) after the words “of this Act” there shall be inserted “, section 24D of the Registered Design Act 1949”; and

(b) after the words “design right” there shall be inserted “, registered designs”.

7.—(1) Section 231 (orders as to disposal of infringing articles, &c) shall be amended as follows.

(2) In subsection (5) the words “or seized” shall be omitted.

(3) In subsection (6)—

(a) after the words “of this Act” there shall be inserted “, section 24D of the Registered Design Act 1949”;

(4) after the words “rights in performances” there shall be inserted “, registered designs”.

8.After section 235 there shall be inserted—

“235A Rights and remedies of representative associations

(1) The design right owner, or an exclusive licensee, may grant to a representative association a right to bring an action in relation to any infringement or infringements of design right.

(2) A grant of a right of action under subsection (1) must be in writing.

(3) A representative association may exercise a right of action granted under subsection (1) only with the leave of the court (which may be granted subject to such conditions as the court thinks fit).

(4) In such an action, the representative association shall have the same rights and remedies available to it as the person granting the right of action would have had if he had brought the action.

(5) The rights granted under this section are concurrent with those of the person granting the right of action; and references in the relevant provisions of this Part to the design right owner shall be construed accordingly.

(6) In an action brought by a representative association 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 person granting the right of action.

(7) Where an action for infringement of design right is brought which relates (wholly or partly) to an infringement in respect of which the representative association and the design right owner or an exclusive licensee (or both) have concurrent rights of action—

(a) the court shall, in assessing damages, take into account—

(i) the terms of any licence, and

(ii) any pecuniary remedy already awarded or available to the design right owner or exclusive licensee 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 design right owner or the exclusive licensee in respect of the infringement; and
- (c) the court shall if an account of profits is directed apportion the profits between the representative association, the design right owner and the exclusive licensee as the court considers just, subject to any agreement between them;

and these provisions apply whether or not the design right owner or the exclusive licensee are parties to the action.

(8) The representative association shall notify the design right owner and any exclusive licensee having concurrent rights before applying for an order under section 230 (order for delivery up of infringing article, &c).

(9) In this section, “representative association” means a body corporate which has as one of its objects the promotion of the collective interest of its members in relation to designs.”.

SCHEDULE 4

Amendments of the Trade Marks Act 1994

1. The Trade Marks Act 1994^(a) shall be amended as follows.
2. In section 14 (action for infringement), after subsection (2) there shall be inserted—
 - “(3) In Scotland, the court may in an action for infringement of a registered trade mark having regard to all the circumstances, and in particular to—
 - (a) the flagrancy of the infringement, and
 - (b) any benefit accruing to the defender by reason of the infringement,award such additional damages as the justice of the case may require.”
3. In section 19 (order as to disposal of infringing goods, materials or articles), in subsection (6)—
 - (a) after the words “under this section” there shall be inserted “, under section 24D of the Registered Design Act 1949”;
 - (b) after the words “infringement of” there shall be inserted “registered designs.”.
4. After section 31 there shall be inserted—

“31A Rights and remedies of representative associations

(1) The proprietor of a registered trade mark, or an exclusive licensee, may grant to a representative association a right to bring an action in relation to any infringement or infringements of the registered trade mark.

(2) A grant of a right of action under subsection (1) must be in writing.

(3) A representative association may exercise a right of action granted under subsection (1) only with the leave of the court (which may be granted subject to such conditions as the court thinks fit).

(4) In such an action, the representative association shall have the same rights and remedies available to it as the person granting the right of action would have had if he had brought the action.

(5) The rights granted under this section are concurrent with those of the person granting the right of action; and references to the proprietor of a registered trade mark in the provisions of this Act relating to infringement shall be construed accordingly.

(6) In an action brought by a representative association 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 person granting the right of action.

(7) Where an action for infringement of a registered trade mark is brought which relates (wholly or partly) to an infringement in respect of which the representative association and the proprietor of the registered trade mark or an exclusive licensee (or both) have concurrent rights of action—

- (a) the court shall, in assessing damages, take into account—
 - (i) the terms of any licence, and
 - (ii) any pecuniary remedy already awarded or available to the proprietor or exclusive licensee in respect of the infringement;

^(a) 1994 c. 26.

- (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 proprietor or the exclusive licensee in respect of the infringement; and
- (c) the court shall if an account of profits is directed apportion the profits between the representative association, the proprietor and the exclusive licensee as the court considers just, subject to any agreement between them;

and these provisions apply whether or not the proprietor or the exclusive licensee are parties to the action.

(8) The representative association shall notify any proprietor of the registered trade mark or exclusive licensee having concurrent rights before applying for an order under section 16 (order for delivery up of infringing article, &c).

(9) In this section, “representative association” means a body corporate which has as one of its objects the promotion of the collective interest of its members in relation to trade marks.”.

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

SCHEDULE 5

Amendments of secondary legislation

Amendment of the Trade Marks (International Registration) Order 1996

6. In the Trade Mark (International Registration) Order 1996(a) after article 7 there shall be inserted—

“Representative actions

7A.—(1) Section 31A (rights and remedies of representative associations) applies to any infringement or infringements of a protected international trade mark (UK) as it applies to a registered trade mark.”.

Amendments of the Copyright and Related Rights Regulations 1996

7. The Copyright and Related Rights Regulations 1996(b) shall be amended as follows.
8. In regulation 16(7) after the word “regulation” there shall be inserted “and regulation 17A”.
9. 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

10. 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 1996/714.
(b) SI 1996/2967.
(c) SI 1997/3032.

sections 90 to 93 (dealing with rights in copyright works)

sections 96 to 102A (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).”.

EXPLANATORY NOTE

(This note is not part of the Regulations)