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AN BILLE UM DHEARAÍ TIONSCAIL, 2000
INDUSTRIAL DESIGNS BILL, 2000

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As initiated

ARRANGEMENT OF SECTIONS

PART 1

Preliminary and General

Section

1. Short title and commencement.
2. Interpretation.
3. Expenses.
4. Transitional provisions and repeals.
5. Prosecution of offences.
6. Offences by bodies corporate.
7. Offences by members of partnership.
8. Service of notices.
9. Fees.
10. Laying of regulations before Houses of Oireachtas.

PART 2

Design Registration

Chapter 1

Registrable Designs

11. Registrable design.
12. Novelty.
13. Individual character.

Section

14. Protection requirements.
15. Conflict with prior design.
16. Designs dictated by their technical function and designs of interconnections.

Chapter 2

Authorship and Ownership of Designs

17. Ownership of designs.
18. Joint ownership of designs.
19. Treatment of author of design.

Chapter 3

Proceedings for Registration

20. Application in prescribed form.
21. Power of Controller to refuse registration.
22. Application for registration of design as a property right.
23. Deemed abandonment of applications.
24. Classification.
25. Filing date.
26. Priority right.
27. Claiming priority.
28. Effect of priority right.
29. Date of registration.

Chapter 4

Register of Designs

30. Register of designs.
31. Certificate of registration.
32. Publication of registration and deferment of publication.
33. Right to apply to court for rectification of register.
34. Right to apply to Controller for rectification of register.
35. Effect of rectification of register.
36. Adaptation of entries to new classification.

Section

37. Power of Controller to correct errors.
38. Inspection of designs register.
39. Right to information.
40. Information as to existence of right in registered design.
41. Registration and publication of assignments, licences, etc.

Chapter 5

Effect of Registration

42. Design right.
43. Duration of protection.
44. Restoration of design right.
45. Effect of order for restoration of design right.
46. Surrender of design right.
47. Invalidation of registration.

Chapter 6

Exceptions to Design Right Protection

48. Acts permitted.
49. Compulsory licences.
50. Prior use.

Chapter 7

Infringement of Design Right

51. Infringement of design right.
52. Secondary infringement of design right.
53. Secondary infringement: providing means for infringement.
54. Meaning of infringing product and article.

Chapter 8

Remedies

55. Certificate of contested validity of registration.
56. Groundless threats.
57. Infringement actionable by registered proprietor.

Section

58. Innocent infringement.
59. Award of damages in infringement action.
60. Undertakings concerning licences of right.
61. Order for delivery up in civil cases.
62. Application to District Court for seizure of infringing products or articles.

Chapter 9

Rights and Remedies of Exclusive Licensees

63. Rights and remedies of exclusive licensees.
64. Exercise of concurrent rights.

Chapter 10

Rights and Remedies of Licensees

65. Rights and remedies of licensees.

Chapter 11

Offences

66. Offences.
67. Falsification of register.
68. False representation.
69. Order for delivery up in criminal proceedings.
70. Search and seizure in criminal cases.

Chapter 12

Delivery Up and Disposal

71. Period after which remedy of delivery up is not available.
72. Order as to disposal of infringing product or article.

Chapter 13

Provision for Preventing Importation

73. Infringing products or articles may be treated as prohibited goods.
74. Power of Revenue Commissioners to make regulations.

Chapter 14

Exhaustion of Design Right

Section

75. Exhaustion of design right.

Chapter 15

Assignment and Licensing

76. Assignment.
77. Exclusive licences.
78. Licensing of registered designs.

Chapter 16

International Arrangements

79. Geneva Act of the Hague Agreement.

Chapter 17

Proceedings before the Controller or the Courts

80. Exercise of discretionary powers of Controller.
81. Costs and security for costs.
82. Evidence before the Controller.
83. Costs of Controller in proceedings.
84. Appeals.

Chapter 18

Miscellaneous

85. Power of Minister to make regulations.
86. Rights of State in respect of registered designs.
87. Privileged communications.
88. Recognition of agents.
89. Duration of copyright in registered designs.

FIRST SCHEDULE

Transitional Provisions

SECOND SCHEDULE

Repeals

—————

Acts Referred to

Companies Acts, 1963 to 1999	
<i>Copyright and Related Rights Act, 2000</i>	2000, No.
Customs Acts	
Industrial and Commercial Property (Protection) Acts, 1927 to 1958	
Industrial and Commercial Property (Protection) Act, 1927	1927, No. 16
Industrial and Commercial Property (Protection) (Amendment) Act, 1929	1929, No. 13
Industrial and Commercial Property (Protection) (Neuchatel Agreement) Act, 1947	1947, No. 45
Industrial and Commercial Property (Protection) (Amendment) Act, 1949	1949, No. 32
Industrial and Commercial Property (Protection) (Amendment) Act, 1957	1957, No. 13
Industrial and Commercial Property (Protection) (Amendment) Act, 1958	1958, No. 58
Local Government Act, 1941	1941, No. 23
Patents Act, 1992	1992, No. 1
Petty Sessions (Ireland) Act, 1851	1851, c. 93
Public Offices Fees Act, 1879	1879, c. 58
Statute of Limitations, 1957	1957, No. 6
Trade Marks Act, 1996	1996, No. 6



AN BILLE UM DHEARAÍ TIONSAIL, 2000
INDUSTRIAL DESIGNS BILL, 2000

BILL

entitled

5 AN ACT TO MAKE PROVISION FOR THE PROTECTION OF
DESIGNS, TO GIVE EFFECT TO DIRECTIVE 98/71/EC OF
THE EUROPEAN PARLIAMENT AND OF THE COUN-
CIL OF 13 OCTOBER 1998¹ ON THE LEGAL PROTEC-
10 TION OF DESIGNS, TO GIVE EFFECT TO THE GENEVA
ACT OF THE HAGUE AGREEMENT CONCERNING THE
INTERNATIONAL REGISTRATION OF INDUSTRIAL
DESIGNS ADOPTED AT GENEVA ON 2 JULY, 1999, AND
TO PROVIDE FOR RELATED MATTERS.

BE IT ENACTED BY THE OIREACHTAS AS FOLLOWS:

15

PART 1

Preliminary and General

1.—(1) This Act may be cited as the Industrial Designs Act, 2000. Short title and commencement.

(2) This Act shall come into operation on such day or days as the
Minister may by order or orders either generally or with reference
20 to any particular purpose appoint, and different days may be so
appointed for different purposes or different provisions of this Act.

2.—(1) In this Act— Interpretation.

“Agreement establishing the World Trade Organisation” means the
Agreement establishing the World Trade Organisation signed at
25 Marrakesh on the 15th day of April, 1994;

“appropriate court” means—

(a) the District Court, where the damages or the value of the
other relief sought in any action to which the application
relates is not liable to exceed such sum as stands specified
30 by an enactment to be the jurisdiction of the District
Court for actions in contract or tort,

(b) the Circuit Court, where the damages or the value of the
other relief sought in any action to which the application
relates is not liable to exceed such sum as stands specified

¹ O.J. No. L289/28, 28.10.98.

by an enactment to be the jurisdiction of the Circuit Court for actions in contract or tort, and

(c) in any other case, the High Court;

“author” has the meaning assigned to it by *section 17*;

“complex product” means a product which is composed of multiple components which can be replaced permitting disassembly and reassembly of the product; 5

“computer-generated” has the meaning assigned to it by *section 17*;

“Controller” means the Controller of Patents, Designs and Trade Marks; 10

“Convention” means the Paris Convention for the Protection of Industrial Property of March 20th 1883, as amended or supplemented by any protocol to that Convention which is for the time being in force in the State;

“Convention country” means a country, territory, state or area, which is a party to the Convention, other than the State; 15

“Council Directive” means Directive No. 98/71/EC of the European Parliament and of the Council of 13 October 1998¹ on the legal protection of designs;

“design” means the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colour, shape, texture or materials of the product itself or its ornamentation; 20

“design of joint authorship” has the meaning assigned to it by *section 18*; 25

“disability” has the same meaning as in section 48 of the Statute of Limitations, 1957;

“filing date” shall be construed in accordance with *section 25*;

“infringing article” has the meaning assigned to it by *section 54*;

“infringing product” has the meaning assigned to it by *section 54*; 30

“made available to the public” means published following registration or otherwise, or exhibited, used in trade or otherwise disclosed, except where these events could not reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within a Member State of the EEA; 35

“member of the World Trade Organisation” means a party to the Agreement establishing the World Trade Organisation;

“Member State of the EEA” means a state which is a contracting party to the Agreement on the European Economic Area signed at Oporto on 2 May 1992, as adjusted by the Protocol signed at Brussels on 17 March 1993 and as amended from time to time; 40

“Minister” means the Minister for Enterprise, Trade and Employment;

¹ O.J. No. L289/28, 28.10.98.

“prescribed” means prescribed by regulations made by the Minister;

5 “product” means any industrial or handicraft item, including parts intended to be assembled into a complex product, packaging, get-up, graphic symbols and typographical typefaces, but not including computer programs;

“Register” has the meaning assigned to it by *section 30*;

“World Trade Organisation” means the Organisation established under the Agreement establishing the World Trade Organisation signed at Marrakesh on the 15th day of April 1994.

10 (2) In this Act, a reference to a section, Part or Schedule, is a reference to a section or Part of, or Schedule to this Act, unless there is an indication that a reference to any other enactment is intended or otherwise indicated.

15 (3) In this Act, a reference to a subsection, paragraph or subparagraph is a reference to the subsection, paragraph or subparagraph of the provision in which the reference occurs, unless there is an indication that a reference to some other provision is intended.

20 (4) A word or expression that is used in this Act and is also used in the Council Directive has, unless the contrary intention appears, the meaning in this Act that it has in the Council Directive.

(5) In construing a provision of this Act, a court shall give to it a construction that will give effect to the Council Directive, and for this purpose a court shall have regard to the provisions of the Council Directive, including the preambles.

25 (6) In this Act, a reference to any enactment shall be construed as a reference to that enactment as amended or adapted by or under any subsequent enactment.

30 **3.**—The expenses incurred by the Minister in the administration of this Act shall, to such extent as may be sanctioned by the Minister for Finance, be paid out of moneys provided by the Oireachtas. Expenses.

4.—(1) The *First Schedule* shall have effect with respect to transitional matters. Transitional provisions and repeals.

35 (2) Subject to *subsection (1)*, the Acts mentioned in *column (2)* of *Part 1* of the *Second Schedule* are hereby repealed to the extent mentioned in *column (3)* of that Schedule.

5.—Notwithstanding the provisions of section 10(4) of the Petty Sessions (Ireland) Act, 1851, summary proceedings for an offence under this Act may be commenced at any time within 12 months from the date on which the offence was committed. Prosecution of offences.

40 **6.**—Where an offence under this Act is committed by a body corporate and is proved to have been so committed with the consent, connivance or approval of or to be attributable to any neglect on the part of a person being a director, manager, secretary or other officer of the body corporate, or any other person who was acting or pur-
45 porting to act in any such capacity, that person as well as the body corporate shall be guilty of an offence and be liable to be proceeded Offences by bodies corporate.

against and punished as if he or she were guilty of the first-mentioned offence.

Offences by members of partnership.

7.—(1) Without prejudice to any liability of a partner under *subsection (3)*, where an offence under this Act is committed by a partnership, any proceedings shall be brought against the partnership in the name of the partnership and not in the name of the individual partner. 5

(2) A fine imposed on a partnership on its conviction in proceedings brought under *subsection (1)* shall be paid out of the assets of the partnership. 10

(3) Where a partnership is guilty of an offence under this Act, every partner, other than a partner who is proved to have been ignorant of or to have attempted to prevent commission of the offence, shall also be guilty of the offence and shall be liable to be proceeded against and punished accordingly. 15

Service of notices.

8.—(1) A notice required to be served or given under this Act shall, subject to *subsection (2)*, be addressed to the person concerned by name, and may be served on or given to the person in one of the following ways—

(a) by delivering it to the person, 20

(b) by leaving it at the address at which the person ordinarily resides or, in a case in which an address for service has been furnished, at that address,

(c) by sending it by post in a prepaid letter to the address at which the person ordinarily resides or, in a case in which an address for service has been furnished, to that address, 25

(d) where the address at which the person ordinarily resides cannot be ascertained by reasonable enquiry and notice is required to be served on, or given to, him or her in respect of any premises, by delivering it to a person over the age of 16 years of age resident in or employed at the premises or by affixing it in a conspicuous position on or near the premises. 30

(2) Where a notice under this Act is to be served on or given to a person who is the owner or occupier of any premises and the name of the person cannot be ascertained by reasonable enquiry, it may be addressed to the person by using the words “the owner” or, as the case may require, “the occupier”. 35

(3) For the purposes of this section, a company within the meaning of the Companies Acts, 1963 to 1999, shall be deemed to be ordinarily resident at its registered office, and every other body corporate, unincorporated body or person, including a partnership, shall be deemed to be ordinarily resident at its principal office or place of business. 40

(4) A person shall not at any time during the period of 3 months after a notice is affixed under *subsection (1)(d)* remove, alter, damage or deface the notice without lawful authority. 45

(5) A person who contravenes *subsection (4)* shall be guilty of an offence and shall be liable on summary conviction to a fine not exceeding £1,500.

5 **9.—**(1) There shall be charged by the Controller, and paid in Fees.
respect of registration of designs and applications therefor and in
respect of other matters arising under this Act, such fees as may from
time to time be prescribed by the Minister with the consent of the
Minister for Finance.

10 (2) Provision may be made by rules to enable the payment of a
single fee in respect of two or more matters.

(3) All fees charged by the Controller shall be collected and
accounted for in such manner as shall be determined by the Minister
with the consent of the Minister for Finance.

15 (4) The Public Offices Fees Act, 1879, shall not apply in respect
of any fees payable under this section.

20 **10.—**Every regulation made under this Act shall be laid before
each House of the Oireachtas as soon as may be after it is made and,
if a resolution annulling the regulation is passed by either such House
within the next 21 days on which that House has sat after the regu-
lation is laid before it, the regulation shall be annulled accordingly,
but without prejudice to the validity of anything previously done
thereunder. Laying of regulations before Houses of Oireachtas.

PART 2

Design Registration

25 Chapter 1

Registrable Designs

11.—(1) A design that is new and has individual character shall Registrable design.
be registrable under this Act.

30 (2) A design shall not be registrable under this Act if the applicant
for registration of the design is not the proprietor of the design.

12.—(1) A design shall be considered to be new where no design Novelty.
identical to it has been previously made available to the public before
the filing date for registration or, where priority is claimed, the date
of priority.

35 (2) A design shall be deemed to be identical to a design which has
been previously made available to the public where its features differ
only in immaterial details.

(3) A design shall not be deemed to have been made available to
the public—

40 (a) by virtue of its disclosure to another person under explicit
or implicit conditions of confidentiality,

(b) where it is made available less than one year before the
filing date or, where priority is claimed, the date of

priority, by a person as a result of information provided or action taken by the author or his or her successor in title, or

(c) where a design has been made available to the public without the authorisation of the author or his or her successor in title. 5

(4) A design shall not be deemed to have been made available to the public by reason only—

(a) that a representation of the design, or any product to which the design has been applied, has been displayed, with the consent of the proprietor of the design, at an official or international exhibition certified by the Minister for the purposes of this section, 10

(b) that after any display referred to in *paragraph (a)*, and during the period of the exhibition, a representation of the design, or any product to which the design has been applied has been displayed by any person without the consent of the proprietor, or 15

(c) that a representation of the design has been published in consequence of any display referred to in *paragraph (a)*, 20

where the application for registration of the design is made not later than 6 months after the opening of the exhibition.

Individual character.

13.—(1) A design shall be deemed to have individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by a design which has been made available to the public before the filing date of the application for registration or, where priority is claimed, the date of priority. 25

(2) In assessing individual character, the degree of freedom of the author of the design in developing the design shall be taken into consideration. 30

Protection requirements.

14.—(1) A design applied to or incorporated in a product which constitutes a component part of a complex product shall only be considered to be new and to have individual character—

(a) if the component part, once it has been incorporated into the complex product, remains visible during normal use of the complex product, and 35

(b) to the extent that those visible features of the component part fulfil in themselves the requirements as to novelty and individual character under *sections 12 and 13*. 40

(2) In this section “normal use” means use by the end user, excluding maintenance, servicing or repair work.

Conflict with prior design.

15.—(1) A design which is in conflict with a prior design shall not be registrable under this Act.

(2) In this section “prior design” means a design which has been made available to the public after the filing date of the application 45

for registration of another design, or where priority is claimed, after the date of priority of that other design, and which is protected from a date prior to the said filing date or, as the case may be, the said priority date by a design right under this Act.

5 **16.—**(1) The features of appearance of a product which are solely dictated by its technical function shall not be registrable under this Act.

Designs dictated by their technical function and designs of interconnections.

10 (2) The features of appearance of a product which are necessarily reproduced in their exact form and dimensions in order to permit the product in which the design is incorporated or to which it is applied to be mechanically connected to or placed in, around or against another product so that either product may perform its function shall not be registrable under this Act.

15 (3) Notwithstanding *subsection (2)*, and subject to compliance with *sections 12 and 13*, a design serving the purpose of allowing multiple assembly or connection of mutually interchangeable products within a modular system shall be registrable under this Act.

Chapter 2

Authorship and Ownership of Designs

20 **17.—**(1) In this Act, the “author” in relation to a design means the person who creates the design.

Ownership of designs.

(2) In the case of a design which is computer-generated, “author” means the person by whom the arrangements necessary for the creation of the design are undertaken.

25 (3) In this Act, “computer-generated”, in relation to a design, means that the design is generated by computer in circumstances where the author of the design is not an individual.

30 **18.—**(1) In this Act, “design of joint authorship” means a design produced by two or more authors in which the contribution of each author is not distinct from that of the other author or authors.

Joint ownership of designs.

(2) References in this Act to the author of a design shall, unless otherwise provided, be construed in relation to a design of joint authorship as references to all the authors of the design.

35 (3) Where a right conferred by this Act (or any aspect of such right) is owned by more than one person jointly, references in this Act to registered proprietor are to all the owners, and any requirement of the licence of the registered proprietor requires the licence of all the owners.

40 **19.—**(1) The author of a design shall be treated as the first proprietor of the design unless the design is created by an employee in the course of employment, in which case the employer is the first proprietor of the design, subject to any agreement to the contrary.

Treatment of author of design.

45 (2) Where a design becomes vested, whether by assignment, transmission or operation of law, in any person other than the first proprietor either alone or jointly with the first proprietor, that other

person, or as the case may be, the first proprietor and that other person shall be treated as the proprietor of the design.

(3) Where the first proprietor of a design is not the author of the design, the author shall have the right to be cited as the author in the application for registration and in the Register. 5

Chapter 3

Proceedings for Registration

Application in prescribed form.

20.—A person claiming to be the proprietor of a registrable design may apply in the prescribed form and manner to the Controller for registration of the design under this Act. 10

Power of Controller to refuse registration.

21.—(1) The Controller may refuse an application for the registration of a design—

- (a) where the design is contrary to public policy or to accepted principles of morality,
- (b) on the application of the copyright owner or on the initiative of the Controller, where the design constitutes an infringement of a copyright work under the *Copyright and Related Rights Act, 2000*, or 15
- (c) on the application of the person concerned by the use or on the initiative of the Controller, where the design consists of or includes any thing which would not be registered by virtue of section 9, 62 or 63 of the Trade Marks Act, 1996. 20

(2) Where an application for the registration of a design has been refused under *subsection (1)*, the Controller may register the design in an amended form, where that form complies with the requirements for registration under this Act and the identity of the design is retained. 25

Application for registration of design as a property right.

22.—(1) An application for the registration of a design shall be personal property.

(2) *Sections 18, 41, 76, 77 and 78* shall apply, with the necessary modifications, in relation to an application for the registration of a design as they apply in relation to a design right. 30

(3) In *section 41* insofar as it applies in relation to a transaction affecting an application for the registration of a design, the references to the entry of particulars in the Register, and to the making of an application to register particulars, shall be construed as references to the giving of notice to the Controller of those particulars. 35

(4) The Minister shall prescribe a procedure to be followed subsequent to the giving of the notice specified in *subsection (3)*.

Deemed abandonment of applications.

23.—An application which, owing to any fault or neglect on the part of the applicant, has not been completed so as to enable registration to be effected within such time as may be prescribed, shall be deemed to be abandoned. 40

24.—(1) A design shall be classified for the purposes of registration according to a prescribed system of classification. Classification.

5 (2) Any question arising as to the class within which a design falls shall be determined by the Controller, whose decision shall be final and not appealable.

25.—The filing date of an application for registration of a design shall be the date on which the applicant pays the prescribed filing fee and files at the Patents Office documents which contain in the prescribed form— Filing date.

- 10 (a) a request for registration of the design,
(b) a representation of the design suitable for reproduction, and
(c) the name and address of the applicant.

26.—(1) A person or his or her successor in title who has filed an application for registration of a design in, or in respect of, a Convention country or a member of the World Trade Organisation shall enjoy, for the purpose of registering the same design under this Act, a right of priority for the period of 6 months after the filing date of the first application, subject to compliance with any conditions as may be prescribed by the Minister. Priority right.

20 (2) Every filing that is equivalent to a regular national filing under the national law of the state, country, territory or area, where it was made (including the State), or under a bilateral or multilateral agreement to which that state, country, territory or area is a party, shall be recognised as giving rise to a right of priority.

25 (3) In this section “regular national filing” means any filing of an application for registration of a design in, or in respect of, a Convention country or a member of the World Trade Organisation that establishes the date on which the application was filed, whatever the outcome of the application may be.

30 (4) An application for the registration of a design that was the subject of a previous application, and that is filed in or in respect of the same Convention country or member of the World Trade Organisation, shall be considered as the first application for the purpose of determining priority where, and only where, on the filing date of the subsequent application, the previous application has been withdrawn, abandoned or refused, without being open to public inspection and without leaving any rights outstanding, and has not served as a basis for claiming a right of priority.

40 (5) Where the first filing has been made in a country, territory, state or area which is not a party to the Convention or is not a member of the World Trade Organisation, *subsections (1) to (4)* shall apply where the Government makes an order to that effect under this subsection consequent upon bilateral or multilateral agreements under which the State grants, on the basis of a first filing made in or for that country, territory, state or area and subject to conditions equivalent to those laid down in the Convention or in the Agreement establishing the World Trade Organisation, a right of priority having equivalent effect.

50 (6) A right of priority arising as a result of an application under the Convention, the Agreement establishing the World Trade Organisation or under a bilateral or multilateral agreement referred

to in *subsection (5)* may be assigned or otherwise transmitted, either with the application or independently and the reference in *subsection (1)* to the successor in title of the applicant shall be construed accordingly.

Claiming priority. **27.**—(1) An applicant shall file a claim for right of priority in the prescribed manner. 5

(2) A right of priority shall only be granted to applicants who apply in accordance with regulations made under *subsection (1)*.

Effect of priority right. **28.**—(1) A right of priority shall have the effect that the filing date of the application claimed under *section 27* shall be regarded as being the filing date of the application for registration under this Act. 10

(2) Where an application for the registration of a design is filed under this Act and the priority of a previous application is claimed under *section 27* then, notwithstanding any other provision of this Act, the application shall not be refused and the registration of the design under this Act shall not be invalidated by reason only of the fact that the previous application has been made available to the public at any time after the filing date of the previous application. 15

Date of registration. **29.**—A design shall be registered with effect from the filing date of the application for registration. 20

Chapter 4

Register of Designs

Register of designs. **30.**—(1) The Controller may register designs in accordance with this Act and shall maintain, in the prescribed form, a register of designs, in this Act referred to as the “Register”. 25

(2) There shall be entered in the Register—

(a) the names and addresses of proprietors of registered designs;

(b) notices of assignments and transmissions of registered designs; and 30

(c) such other matters relating to registered designs as may be prescribed by the Minister or as the Controller may think fit.

(3) The Register shall be *prima facie* evidence of any matters required or authorised by or under this Act to be entered therein. 35

(4) No notice of any trust, whether express, implied or constructive, shall be entered in the Register, and the Controller shall not be affected by any such notice.

(5) A certificate purporting to be signed by the Controller and certifying that an entry which he or she is authorised by or under this Act to make in the Register has or has not been made, or that any other thing which he or she is so authorised to do has or has not been done, shall be *prima facie* evidence of the matters so certified. 40

(6) Nothing in *subsection (3)* shall oblige the Controller to satisfy himself or herself of the matters referred to in that subsection when considering an application for registration under this Act.

5 **31.—**(1) On the registration of a design under this Act, the Controller shall issue to the registered proprietor a certificate of registration in the prescribed form. Certificate of registration.

10 (2) The Controller may, where he or she is satisfied that the certificate of registration has been lost or destroyed, or in any other case in which he or she thinks it expedient, furnish one or more copies of the certificate.

32.—(1) The Controller shall, subject to *subsection (2)*, as soon as practicable after a design has been registered, publish in the prescribed form a notice of the registration in the Patents Office Journal. Publication of registration and deferment of publication.

15 (2) When filing an application for registration of a design an applicant may request that the publication of the registered design under *subsection (1)* be deferred for a period of up to 30 months from the filing date of the application or, if priority is claimed, from the date of priority, and the Controller shall comply with such request.

20 **33.—**(1) An aggrieved person may apply to the High Court for an order for the rectification of the Register by the making of an entry in the Register or the variation or deletion of an entry in the Register. Right to apply to court for rectification of register.

(2) For the purposes of this Act “a rectification of the Register” under this section shall include—

25 (a) entering any change in the name or address of a person who is entered on the Register, or

30 (b) entering a disclaimer or memorandum on the Register relating to a registered design which does not in any way extend the rights given by the existing registration of such design.

(3) The High Court may, in proceedings under this section, decide any question that it may be necessary or expedient to decide in connection with the rectification of the Register.

35 (4) Notice of an application under this section shall be given in the prescribed manner to the Controller and the Controller shall be entitled to appear and be heard by the High Court, and shall appear if so directed by the High Court in any hearing held for the purposes of this section.

40 (5) Unless otherwise directed by the High Court, the Controller may, in lieu of appearing and being heard by the High Court, submit to the High Court a statement in writing, signed by him or her, giving particulars of:

(a) the proceedings before him or her in relation to the matter in issue,

45 (b) the grounds of any decision given by him or her,

(c) the practice of the Patents Office in like cases, if any, and

(d) such matters relevant to the issues and within his or her knowledge as Controller as he or she thinks fit,

and that statement shall be deemed to form part of the evidence in the proceedings.

(6) An order made by the High Court for the rectification of the Register shall direct that notice of the order shall be served on the Controller in the prescribed manner, and on receipt of such notice the Controller shall rectify the Register in accordance with the terms of the order to which the notice relates. 5

(7) In this section, “aggrieved person” shall include a person who is entitled to the design right in a registered design where that person would be entitled to apply for the invalidation of the registration of the design under *subsection (3) of section 47*. 10

Right to apply to Controller for rectification of register.

34.—(1) An application for an order for the rectification of the Register under *section 33* may, at the option of the applicant, be made in the first instance to the Controller. 15

(2) In the case to which *subsection (1)* applies, the Controller shall have all the powers of the High Court under *section 33* to decide the matter.

Effect of rectification of register.

35.—A rectification of the Register under *section 33* or *34* shall have effect as follows— 20

(a) an entry made has effect from the date on which it should have been made,

(b) an entry varied has effect as if it had originally been made in its varied form, and 25

(c) an entry deleted shall be deemed never to have had effect,

unless, in any case, the High Court directs otherwise.

Adaptation of entries to new classification.

36.—(1) The Minister may make regulations authorising the Controller to do such things as the Controller considers necessary to implement any amended or substituted classification for the purposes of the registration of designs and, without prejudice to the generality of the aforesaid, the Minister may make regulations in respect of the amendment of existing entries on the Register so as to accord with the new classification. 30

(2) Any power of amendment effected under this section shall not be exercised so as to extend the rights conferred by the registration, except where it appears to the Controller that compliance with this requirement would involve undue complexity and that any extension would not be substantial and would not adversely affect the rights of any person. 35
40

(3) Regulations made under this section may empower the Controller—

(a) to require the registered proprietor of a registered design, within such time as may be prescribed, to file a proposal for the amendment of the Register, and 45

(b) to cancel or refuse to renew the registration of the design in the event of the proprietor failing to do so.

(4) A proposal under *subsection (3)(a)* shall be advertised and may be opposed, in such manner as may be prescribed.

5 **37.**—(1) The Controller may, in accordance with this section, correct an error in an application for the registration or in the representation of a design, or any error in the Register. Power of Controller to correct errors.

10 (2) A correction may be made under this section upon a request in writing made by any person interested and accompanied by the prescribed fee, or on the initiative of the Controller.

(3) Where the Controller is requested under this section to correct an error in the Register, he or she shall determine the matter in the prescribed manner.

15 (4) Where the Controller proposes to make a correction under this section on his or her initiative, he or she shall give notice of the proposal to the registered proprietor or the applicant for registration of the design, as the case may be, and to any other person who appears to him or her to be concerned, and shall give them an opportunity to be heard before making the correction.

20 (5) A correction of the Register under this section shall have effect as if it had originally been made in its corrected form.

38.—(1) Subject to *subsection (2)*, the public shall have a right to inspect the Register at such times and in such manner as may be prescribed by the Minister. Inspection of designs register.

25 (2) Where deferment of publication is granted under *section 32*, the representations of the design shall not be open to public inspection until the expiry of that period of deferment.

30 (3) Where a request is made to the Controller for a certified or uncertified copy of, or extract from, an entry in the Register, the Controller shall issue a copy of the entry or extract to the applicant on payment of the prescribed fee.

(4) In relation to any portion of the Register kept otherwise than in documentary form—

35 (a) the right of inspection conferred by *subsection (1)* is a right to inspect the material on the Register, and

(b) the right to a copy or extract conferred by *subsection (3)* is a right to a copy or extract in a form in which it can be taken away and in which it is visible and legible.

(5) Each of the following—

40 (a) a copy of an entry in the Register or an extract from the Register which is supplied under *subsection (3)*, or

(b) a copy of any representation or document kept in the Patents Office or an extract from any such document,

which purports to be a certified copy or certified extract shall be admitted in evidence in civil or criminal proceedings without further proof and without production of an original.

(6) In this section, “certified copy” and “certified extract” means a copy and an extract certified by the Controller and sealed with the seal of the Controller. 5

Right to information.

39.—(1) Subject to *subsection (2)*, after the registration of a design and upon the filing of a written request by any person in the prescribed manner, the Controller shall, subject to compliance with the prescribed conditions, give the person making the request such information, and permit him or her to inspect such documents, relating to the application for registration of the design concerned as may be specified in the request. 10

(2) Where deferment of publication is granted under *section 32*, no information or documents constituting or relating to the application shall, without the consent of the registered proprietor or the applicant (as the case may be), be published or communicated to any other person by the Controller under *subsection (1)* until the expiry of that period of deferment. 15

(3) *Subsection (2)* shall not prevent the Controller from publishing or communicating to others any prescribed information relating to an application for registration of a design. 20

(4) Where a person is notified that an application for registration of a design has been made and that the applicant shall, if the design is registered, bring proceedings against that person in the event of his or her doing an act specified in the notification, that person may make a request under *subsection (1)*, notwithstanding that the design has not been registered or that deferment of publication has been granted, and that subsection shall apply accordingly. 25

(5) Where an application for the registration of a design has been abandoned or refused, neither the application for registration nor any other material or information filed in pursuance thereof shall at any time be open to inspection at the Patents Office or be published by the Controller. 30

Information as to existence of right in registered design.

40.—On the request of a person furnishing any information to enable the Controller to identify the design, and on payment of the prescribed fee, the Controller shall inform that person— 35

(a) whether the design is registered and, if so, the class in which it is registered, and

(b) whether an extension of the period for which the design right in the design shall subsist has been granted, 40

and shall state the date of registration and name and address of the registered proprietor.

Registration and publication of assignments, licences, etc.

41.—(1) Where a person becomes entitled by assignment, transmission or operation of law to the design right in a design or to a share in that design right, or becomes entitled as mortgagee, licensee or otherwise to any other interest in the design right in a design, he or she shall apply to the Controller in the prescribed manner for the 45

registration of his or her title as proprietor or co-proprietor or, as the case may be, of notice of his or her interest, in the Register.

5 (2) Without prejudice to *subsection (1)*, an application for the registration of the title of a person becoming entitled by assignment to the design right in a design or a share in that design right, or becoming entitled by virtue of a mortgage, licence or other instrument to any other interest in the design right in a design, may be made in the prescribed manner by the assignor, mortgagor, licensor or other party to that instrument, as the case may be.

10 (3) Where an application is made under this section for the registration of the title of any person, the Controller shall, upon proof of title to his or her satisfaction—

15 (a) where that person is entitled to the design right in a design or a share in that design right, register him or her in the Register as proprietor or co-proprietor of the registered design, and enter in the Register particulars of the instrument or event by which he or she derives title, or

20 (b) where that person is entitled to any other interest in the design right, enter in the Register notice of his or her interest, with particulars of the instrument (if any) creating it,

and shall publish the entry in the prescribed manner.

25 (4) Except for the purposes of an application to rectify the Register under *section 33* or *34* of this Act, a document in respect of which no entry has been made in the Register under *subsection (3)* shall not be admitted in court as evidence of the title of a person to the design right in a design or share of or interest in the design right in a design unless the court otherwise directs.

Chapter 5

30 *Effect of Registration*

42.—(1) There shall be a property right to be known and in this Act referred to as “design right”. Design right.

(2) A design right shall not subsist in a design until the date of registration of the design.

35 (3) The registered proprietor of a design shall be the owner of the design right in the design.

40 (4) The design right in a registered design shall also apply to any design which does not produce on the informed user a different overall impression, taking into consideration the degree of freedom the author had in developing the design.

45 (5) The design right shall confer on its owner the exclusive right to use the design and to authorise others to use it, including the right to make, offer, put on the market, import, export or use a product in which the design is incorporated or to which it is applied, or to stock such a product for those purposes.

43.—(1) Subject to *subsection (2)*, the design right in a design shall expire 5 years after the date of registration. Duration of protection.

(2) The period for which the design right subsists may be renewed, for a second, third, fourth and fifth period of 5 years, by applying to the Controller for an extension in the prescribed manner and paying the prescribed renewal fee.

(3) Subject to *subsection (4)*, where a period during which design right subsists expires without an application for renewal and payment of the prescribed fee being made, the design right shall expire, and the Controller shall notify the registered proprietor in the prescribed manner. 5

(4) Where during the period of 6 months immediately following the end of a period of subsistence of the design right the renewal fee and any prescribed additional fee are paid, the design right shall be deemed not to have expired, and accordingly— 10

(a) anything undertaken under or in relation to the design right by or with the consent of the registered proprietor during that period shall be treated as valid, 15

(b) an act which would have constituted an infringement of the design right if it had not expired shall be treated as an infringement, and

(c) an act which would have constituted use for the service of the State under *section 86* if the design right had remained in force during the period between expiry and restoration shall be deemed to constitute use for the service of the State. 20

Restoration of design right.

44.—(1) Where the design right has expired by reason of a failure to extend, in accordance with *subsection (2)* or *subsection (4)* of *section 43*, the period for which the right subsists, an application for the restoration of the right may be made in the prescribed manner to the Controller within the prescribed period. 25

(2) The application under *subsection (1)* may be made by the person who was the registered proprietor of the design or by any other person who would have been entitled to the design right if it had not expired and where the design right was held by two or more persons jointly, the application may, with the leave of the Controller, be made by one or more of them without joining the others. 30 35

(3) Where the Controller is satisfied that the proprietor took reasonable care to see that the period for which the design right subsisted was extended in accordance with *subsection (2)* or *subsection (4)* of *section 43*, the Controller shall, on payment of any unpaid renewal fee and any prescribed additional fee, order the restoration of the design right. 40 45

(4) An order made under *subsection (3)* may be made subject to such conditions as the Controller thinks fit, and if the proprietor of the design does not comply with any condition the Controller may revoke the order and give such consequential directions as he or she thinks fit. 45

(5) Notice of the restoration of a design right shall be published by the Controller in the prescribed manner.

(6) The Minister may prescribe that the period prescribed for the purposes of *subsection (1)* may be altered, subject to any transitional 50

provisions and savings as appear to the Minister to be necessary or expedient.

45.—(1) An act undertaken or authorisation given under or in relation to the design right in a design during the period between expiry and restoration of the design right shall be treated as valid.

Effect of order for restoration of design right.

(2) An act undertaken during the period between expiry and restoration of the design right which would have constituted an infringement if the design right had not expired shall be treated as an infringement—

(a) if undertaken at a time when it was possible for an application for extension to be made under *subsection (4) of section 44*, or

(b) if it was a continuation or repetition of an earlier infringing act.

(3) Where it is no longer possible for an application for extension to be made under *subsection (4) of section 44*, and before publication of notice of the application for restoration, a person—

(a) began in good faith to undertake an act which would have constituted an infringement of the design right if it had not expired, or

(b) made in good faith effective and serious preparations to undertake such an act,

he or she has the right to continue to undertake the act, or, as the case may be, to undertake the act, notwithstanding the restoration of the design right.

(4) *Subsection (3)* does not extend to granting a licence to another person to undertake the act.

(5) If the act referred to in *subsection (3)* was undertaken, or preparations were made, in the course of a business, trade or profession, the person entitled to the right conferred by *subsection (3)* may—

(a) authorise the undertaking of that act by any of his or her partners for the time being in that business, trade or profession, and

(b) (i) assign that right, or

(ii) transmit that right by testamentary disposition (or in the case of a body corporate on its dissolution),

to any person who acquired that part of the business, trade or profession during the time when the act was being undertaken or the preparations were being made.

(6) Where a product is disposed of to another person in exercise of the rights conferred by *subsection (3)* or *subsection (5)*, that other person and any person claiming under him or her may use the product in the same way as if it had been disposed of by the registered proprietor of the design.

(7) An act referred to in this section which would have constituted use for service of the State of the design if the design right remained

in force during the period between expiry and restoration shall be deemed to constitute use for the service of the State.

Surrender of design right.

46.—(1) The design right in a design may be surrendered by the registered proprietor.

(2) The Minister may make regulations: 5

(a) as to the manner and effect of the surrender of a design right; and

(b) for protecting the interests of other persons having an interest in that design right.

Invalidation of registration.

47.—(1) At any time after a design has been registered, any person with an interest may apply to the Controller for the invalidation of the registration of the design— 10

(a) on the ground that the design was not, at the filing date of the application for registration or, where priority is claimed, at the date of priority, registrable in accordance with *sections 11 to 14*, 15

(b) on the ground that the design was not registrable in accordance with *section 16*, or

(c) on any ground on which the Controller could have refused to register the design under *section 21(1)(b)*, 20

and the Controller may make such order on the application as he or she thinks fit.

(2) At any time after a design has been registered, any person may apply to the Controller for invalidation of the registration on the ground that the making available or use of the design would be contrary to public policy or morality, and the Controller may make such order on the application as he or she thinks fit. 25

(3) The Controller may, on the application by a person so entitled for invalidation of the registration of a design on the ground that the person whose name is entered in the Register as the proprietor of the design is not entitled to be so registered, make such order as he or she thinks fit. 30

(4) The Controller may, on the application by a person so entitled, or on the initiative of the Controller, invalidate the registration of a design on the ground that the design is in conflict with a prior design. 35

(5) In this section, “prior design” has the meaning assigned to it by *section 15(2)*.

(6) The Controller may, on the application of any person so entitled for invalidation of the registration of a design on the ground that a distinctive sign which is registrable under the Trade Marks Act, 1996, has been subsequently used in the design, make such order as he or she thinks fit. 40

(7) The Controller may, on the application of the person concerned by the use for the invalidation of the registration of a design or on the initiative of the Controller, where the design consists of or includes anything which would not be registered by virtue of section 45

9, 62 or 63 of the Trade Marks Act, 1996, make such order as he or she thinks fit.

(8) For the purposes of this section, “a person so entitled” means—

5 (a) in respect of *subsection (3)*, the person entitled to the design right;

(b) in respect of *subsections (4) and (6)*, the holder of the conflicting right.

10 (9) A registration may be declared invalid after it has lapsed or after it has been surrendered in proceedings under *section 46*.

(10) An invalidation under this section shall take effect from the date of registration or from such later date as the Controller may direct.

15 (11) Where a design has been invalidated under the provisions of *subsections (1), (2), (6) or (7)*, the Controller may register the design in an amended form, where that form complies with the requirements for registration under this Act and the identity of the design is retained.

20 (12) A registration under *subsection (11)* may be accompanied by a partial disclaimer by the registered proprietor or by entry in the Register of a court decision declaring the partial invalidity of the design right.

Chapter 6

Exceptions to Design Right Protection

25 **48.**—(1) The design right is not infringed by— Acts permitted.

(a) acts done privately and for non-commercial purposes,

(b) acts done for experimental purposes, or

30 (c) acts of reproduction for the purposes of making citations or of teaching, provided that such acts are compatible with fair trade practice and do not unduly prejudice the normal exploitation of the design, and that mention is made of the source.

(2) The design right is not infringed by—

35 (a) use of equipment on ships and aircraft registered outside the State where these temporarily enter the State,

(b) the importation into the State of spare parts and accessories for the purpose of repairing such craft, or

(c) the execution of repairs on such craft.

40 **49.**—(1) At any time after a design has been registered, any person may apply to the Controller for the grant of a compulsory licence in respect of the design on the ground that the design is not being applied to a product to such an extent as to meet demand for that product in the State, or in such a manner that such demand is not Compulsory licences.

being met on reasonable terms, or that such demand is being met by importation, other than from a member of the World Trade Organisation, and the Controller may make an order on the application as he or she thinks fit.

(2) An order for the grant of a licence shall, without prejudice to any other method of enforcement, have effect as if it were a deed executed by the registered proprietor and all other necessary parties granting a licence in accordance with the order. 5

(3) Where an order granting a compulsory licence has been made under *subsection (1)*, any person may apply to the Controller for an order amending or cancelling that order on the grounds that the circumstances which led to that order have changed or have ceased to exist and are unlikely to recur, and the Controller may make an order on such application upon such terms as he or she thinks fit, including terms which provide for the protection of the interests of the licensee concerned. 10 15

(4) *Subsection (3)* shall also apply to an order made under that subsection.

Prior use.

50.—(1) Subject to *subsection (2)*, where a person has commenced use within a Member State of the EEA, or has made serious preparations to that end, of a design which has not been copied from a registered design, the continued use of that design by that person for that purpose shall not infringe the design right in the registered design. 20

(2) The design referred to in *subsection (1)* is a design which has not been made available to the public before the filing date of the application for registration of the registered design or, where priority is claimed, the date of priority of the registered design, and the use of which commenced before the said filing date or, as the case may be, the said date of priority. 25 30

(3) The right conferred by this section may not be transmitted.

Chapter 7

Infringement of Design Right

Infringement of design right.

51.—(1) The design right is infringed by a person who, without the licence of the registered proprietor of the design and while the design right is in force, undertakes or authorises another to undertake any act which is the exclusive right of the registered proprietor of the design. 35

(2) The design right is not infringed by the reproduction of a feature of the design which is not taken into account in determining whether the design is registrable. 40

Secondary infringement of design right.

52.—A person infringes the design right where he or she without the licence of the registered proprietor of the design and while the design right is in force—

(a) sells, rents or offers or exposes for sale or rent, 45

(b) imports into the State, otherwise than for his or her private and domestic use, or

(c) in the course of a business, trade or profession, has in his or her possession, custody or control,

a product which is, and which he or she knows or has reason to believe is, an infringing product.

5 **53.**—A person infringes the design right where he or she without the licence of the registered proprietor of the design—

Secondary infringement: providing means for infringement.

(a) makes,

(b) sells, rents or offers or exposes for sale or rent,

(c) imports into the State, or

10 (d) has in his or her possession, custody or control,

an article specifically designed or adapted for applying to or incorporating in a product the design, knowing or having reason to believe that it has been or is to be used to make infringing products.

15 **54.**—(1) In this Act, a product shall be an “infringing product” in relation to a registered design where—

Meaning of infringing product and article.

(a) the application of the design to or the incorporation of the design in the product is an infringement of the design right in the design,

20 (b) the product has been or is proposed to be imported into the State and the application of the design to or incorporation of the design in the product in the State would constitute an infringement of the design right in the design, or

25 (c) the use of the product in any other way infringes the design right.

(2) Nothing in *subsection (1)(b)* shall be construed as applying to products which have been put on the market in a Member State of the EEA by or with the consent of the registered proprietor of the design.

30 (3) An article shall be an “infringing article” in relation to a registered design where it is specifically designed or adapted for applying the design to products and a person makes, sells or rents, or offers or exposes for sale or rent, or imports into the State, such an article, or has it in his or her possession, custody or control knowing or
35 having reason to believe that it has been or is to be used to make infringing products.

Chapter 8

Remedies

40 **55.**—(1) Where in proceedings before the appropriate court the validity of the registration of a design is contested and it is found by that court that the design is validly registered, the court may certify that finding and the fact that the validity of the registration of the design was contested in those proceedings.

Certificate of contested validity of registration.

(2) Where a certificate has been granted under *subsection (1)*, and in any subsequent proceedings before the appropriate court for infringement of the design right or for invalidation of the registration of the design, a final order or judgement is made or given in favour of the party relying on the validity of the registration, that party shall, unless the court otherwise directs, be entitled to his or her costs as between solicitor and client. 5

(3) *Subsection (2)* shall not extend to the costs of an appeal in any proceedings.

Groundless threats.

56.—(1) Where a person (whether or not the registered proprietor of, or entitled to any design right in, or any other interest in a design) by circulars, advertisements or otherwise threatens another person with proceedings for infringement of design right, a person aggrieved by the threats (whether or not he or she is the person to whom the threats are made) may bring proceedings in the appropriate court against the person making the threats for any such relief as is mentioned in *subsection (3)*. 10 15

(2) In any proceedings under *subsection (1)*, the plaintiff shall, where he or she proves that the threats were so made and satisfies the court that he or she is a person aggrieved by them, be entitled to the relief claimed unless— 20

(a) the defendant proves that the acts in respect of which the proceedings were threatened constitute or, if undertaken, would constitute an infringement of the design right, and

(b) the plaintiff fails to show that the registration of the design concerned is invalid. 25

(3) The relief referred to in *subsections (1)* and *(2)* shall be—

(a) a declaration to the effect that the threats complained of are unjustifiable,

(b) an injunction against the continuance of the threats, and 30

(c) such damages, if any, as have been sustained by the plaintiff by reason of the threats.

(4) For the purposes of this section, a notification of the existence of a registered design does not of itself constitute a threat of proceedings within the meaning of this section. 35

(5) In this section, “a person aggrieved” shall not include a person making or importing any object.

Infringement actionable by registered proprietor.

57.—(1) An infringement of the design right is actionable by the registered proprietor of the design.

(2) No proceedings shall be taken in respect of an infringement committed before the date on which the certificate of registration of the design under this Act is granted. 40

(3) In an action for infringement of the design right under this section, all relief by way of damages, injunction, account of profits or otherwise is available to the plaintiff as it is available in respect of the infringement of any other property right. 45

58.—(1) Where in an action for the infringement of the design right in a registered design, it is shown that at the time of the infringement the defendant did not know and had no reason to believe that the design was registered, the plaintiff shall not be entitled to damages against the defendant and no order shall be made for an account of profits.

Innocent infringement.

(2) For the purposes of *subsection (1)*, a person shall not be regarded as knowing or having reason to believe that the design was registered by reason only of the application to a product, or to any printed matter accompanying a product, of the word “registered”, or any word or words or abbreviation expressing or implying that a design has been registered, unless the registration number of the design accompanied the word or words or abbreviation concerned.

(3) Nothing in this section shall affect the power of the appropriate court to grant an injunction in any proceedings for the infringement of the design right in a registered design.

(4) In an action for infringement of design right, the appropriate court may, if it thinks fit, refuse to award any damages or make an order for an account of profits in respect of an infringement committed at any time during the period referred to in *subsection (4) of section 43* but before the fees referred to in that subsection are paid.

59.—In addition to or as an alternative to awarding compensation to a plaintiff for financial loss, the appropriate court may award aggravated or exemplary damages or both aggravated and exemplary damages.

Award of damages in infringement action.

60.—(1) Where, in proceedings for infringement of the design right in a design in respect of which a licence is available as of right, the defendant undertakes to take a licence on such terms as may be agreed or, in default of agreement, settled by the Controller—

Undertakings concerning licences of right.

(a) no injunction shall be granted against the defendant,

(b) no order for delivery up shall be made under *section 61*, and

(c) the amount recoverable against the defendant by way of damages or on an account of profits shall not exceed 3 times the amount which would have been payable by the defendant as licensee where a licence on those terms had been granted before the earliest infringement.

(2) An undertaking under *subsection (1)* may be given at any time before the final order in the proceedings without any admission of liability.

(3) Nothing in this section shall affect the remedies available in respect of an infringement committed before a licence was available as of right.

61.—(1) Where a person in the course of a business, trade or profession has in his or her possession, custody or control infringing products or articles the registered proprietor of the design may apply to the appropriate court for an order that the infringing products or articles be delivered up to him or her or to such other person as the court may direct.

Order for delivery up in civil cases.

(2) An application under *subsection (1)* shall not be made after the expiration of the period specified in *subsection (1) of section 71* as being the limit of the period for delivery up and no order shall be made unless the appropriate court also makes, or it appears to the appropriate court that there are grounds for making, an order as to the disposal of an infringing product or article. 5

(3) A person to whom an infringing product or article is delivered up pursuant to an order made under this section shall, where an order under *section 72* as to the disposal of the infringing product or article is not made, retain it pending the making of an order, or the decision not to make an order, under that section. 10

Application to District Court for seizure of infringing products or articles.

62.—(1) Where the registered proprietor of a design applies to the District Court, it may, where satisfied that there are reasonable grounds for believing that there are being hawked, carried about or marketed infringing products or articles, authorise by order a member of the Garda Síochána to seize without warrant the products or articles and to bring them before the District Court. 15

(2) On being satisfied that any product or article referred to in *subsection (1)* is an infringing product or article the District Court may order the product or article to be destroyed or to be delivered up to the registered proprietor or otherwise dealt with as the Court may think fit. 20

(3) In an application to the District Court under *subsection (1)* or, in any *ex parte* application or interlocutory motion to a court of competent jurisdiction for an order which would permit the applicant to enter and search a premises or place specified in that order and take possession of material found in those premises or that place on terms set out in such order, the court hearing such an application may receive hearsay evidence to the effect that the witness or deponent believes that the material may be found in a particular location. 25 30

(4) A witness or deponent shall not be obliged to indicate the source of the information upon which that witness formed the belief that material may be found in a particular location.

(5) After the implementation of an order made under this section, the appropriate court may, on the application of a person aggrieved by it, award damages against the applicant for the order as it considers just, on being satisfied that— 35

- (a) no infringement of design right has been established, and
- (b) the information on which the registered proprietor applied for the order was given maliciously. 40

Chapter 9

Rights and Remedies of Exclusive Licensees

Rights and remedies of exclusive licensees.

63.—(1) An exclusive licensee has, except as 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, from the date on which an application is made for registration of his or her interest under *subsection (2) of section 41*. 45

(2) The rights and remedies of an exclusive licensee shall be 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.

5 (3) In an action brought by an exclusive licensee under this section, a defendant may avail himself or herself of any defence which would have been available to him or her if the action had been brought by the registered proprietor.

10 (4) In awarding damages in any proceedings taken by an exclusive licensee by virtue of this section, the appropriate court may take into consideration only the losses suffered or likely to be suffered by the exclusive licensee as a result of the infringement.

64.—(1) Where proceedings for infringement of design right brought by the registered proprietor or an exclusive licensee relate (wholly or partly) to an infringement in respect of which they have concurrent rights of action, the registered proprietor or, as the case may be, the exclusive licensee may not, without the leave of the appropriate court, proceed with the action unless the other is either joined as a plaintiff or added as a defendant. Exercise of concurrent rights.

20 (2) *Subsection (1)* shall not affect the granting of interlocutory relief on an application by a registered proprietor or exclusive licensee alone.

25 (3) A person who is added as a defendant as mentioned in *subsection (1)* shall not be liable for any costs in the action unless he or she takes part in the proceedings.

(4) Where an action for infringement of design right is brought which relates (wholly or partly) to an infringement in respect of which the registered proprietor and an exclusive licensee have or had concurrent right of action—

30 (a) the appropriate 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,

35 (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

40 (c) the appropriate 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.

45 (5) The registered proprietor shall notify any exclusive licensee who has a concurrent right of action before applying for an order under *section 61* and the appropriate 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.

(6) This section shall have effect subject to any agreement to the contrary between the exclusive licensee and the registered proprietor.

Chapter 10

Rights and Remedies of Licensees

Rights and remedies of licensees.

65.—(1) A licensee is entitled to invite the registered proprietor of a design to take infringement proceedings in respect of any matter which affects the licensee's interests, from the date on which application is made for registration of his or her interest under *subsection (2) of section 41*. 5

(2) Where the registered proprietor—

(a) refuses to take proceedings when called upon under *subsection (1)*, or 10

(b) fails to do so within 2 months after being so called upon,

the licensee may bring the proceedings in his or her own name as if he or she were the registered proprietor.

(3) Where infringement proceedings are brought by a licensee under this section, the licensee may not, without the leave of the appropriate court, proceed with the action unless the registered proprietor is either joined as a plaintiff or added as a defendant. 15

(4) *Subsection (3)* shall not affect the granting of interlocutory relief on an application by a licensee alone.

(5) A registered proprietor who is added as a defendant under *subsection (3)* shall not be liable for any costs in the action unless he or she takes part in the proceedings. 20

Chapter 11

Offences

Offences.

66.—(1) A person who without the licence of the registered proprietor of a design and while the design right is in force— 25

(a) uses, otherwise than for his or her private and domestic use,

(b) makes for sale or rent,

(c) sells or rents, or offers or exposes for sale or rent,

(d) imports into the State, otherwise than for his or her private and domestic use, 30

(e) exports, or

(f) in the course of a business, trade or profession, has in his or her possession, custody or control,

a product which is, and which he or she knows or has reason to believe is, an infringing product, shall be guilty of an offence. 35

(2) A person who—

(a) makes,

(b) sells or rents, or offers or exposes for sale or rent,

(c) imports into the State, or

(d) has in his or her possession, custody or control,

an article specifically designed or adapted for applying to or incorporating in a product a design, knowing or having reason to believe that it has been or is to be used to make infringing products, shall be guilty of an offence.

(3) An offence shall not be committed under *subsection (1)* by the undertaking of an act which under this Act may be undertaken without infringing the design right.

(4) A person guilty of an offence under this section shall be liable—

(a) on summary conviction, to a fine not exceeding £1,500 in respect of each infringing product or article, or to imprisonment for a term not exceeding 12 months, or both, or

(b) on conviction on indictment, to a fine not exceeding £100,000, or to imprisonment for a term not exceeding 5 years, or both.

67.—A person who makes or causes to be made a false entry in the Register, or falsely claims, in writing or otherwise, something to be a copy or reproduction of an entry in the Register, or produces or tenders or causes to be produced or tendered in evidence any such thing, knowing or having reason to believe the entry or thing to be false, shall be guilty of an offence and shall be liable—

Falsification of register.

(a) on summary conviction, to a fine not exceeding £1,500 or to imprisonment for a term not exceeding 12 months, or both, or

(b) on conviction on indictment, to a fine, or to imprisonment, or both.

68.—(1) Where a person falsely represents that a design applied to a product disposed of by him or her in the State for valuable consideration is registered, knowing or having reason to believe that the representation is false, he or she shall be guilty of an offence.

False representation.

(2) For the purposes of this section, a person who in the State disposes of a product for valuable consideration having stamped, engraved or impressed thereon or otherwise applied to it the word “registered” or anything expressing or implying that a design applied to the product is a registered design, shall be deemed to have made a representation as to registration under this Act unless it is shown that the reference is to registration elsewhere than in the State and that the design is so registered.

(3) Where any person, after the design right in a design has expired, marks any product to which the design has been applied with the word “registered”, or any word or words implying that there is a subsisting right in the design under this Act, or causes any such product to be so marked, he or she shall be guilty of an offence.

(4) A person guilty of an offence under *subsection (1)* or *(3)* shall be liable on summary conviction to a fine not exceeding £1,500.

Order for delivery up in criminal proceedings.

69.—(1) The court may, on conviction of a person or being satisfied that there is a *prima facie* case to answer, where the court is satisfied that at the time of the arrest or charge the person had in his or her possession, custody or control in the course of a business, trade or profession a product or article, knowing or having reason to believe it to be an infringing product or article, order that the infringing product or article be delivered up to the registered proprietor of the design or to such other person as the court may direct. 5

(2) An order under this section may be made by the court of its own motion, or on the application of the person bringing a prosecution, and may be made whether or not the person accused is convicted of the offence, but shall not be made— 10

(a) after the expiration of the period specified in *subsection (3) of section 71* as being the limit of the period for delivery up, or 15

(b) where it appears to the court unlikely that any order will be made as to the disposal of the infringing products or articles.

(3) A person to whom an infringing product or article is delivered up pursuant to an order made under this section shall retain it pending the making of a final order or decision not to make an order, as the case may be. 20

Search and seizure in criminal cases.

70.—(1) Where a judge of the District Court is satisfied by information on oath that there are reasonable grounds for suspecting—

(a) that an offence under *section 66* has been, or is about to be, committed in, on or at any premises or place, and 25

(b) that evidence that such an offence has been, or is about to be, committed is in, on or at those premises or that place,

the District Court may issue a warrant authorising a member of the Garda Síochána, accompanied by such other members of the Garda Síochána or other person or persons as that member thinks proper, at any time or times within 28 days from the date of the issue of the warrant on production where requested of that warrant to enter and search the premises or place specified in the warrant using reasonable force where necessary, and to do all or any of the following acts: 30 35

(i) to seize any products or articles in respect of which he or she has reasonable ground for suspecting that an offence under *section 66* has been or is about to be committed;

(ii) to make an inventory or prepare other evidence of infringement of design right or potential infringement of design right; 40

(iii) to seize anything found there which he or she believes on reasonable grounds may be required to be used in evidence in any proceedings brought in respect of an offence under this Act; 45

(iv) to require any person found there to give his or her name and address.

(2) A warrant issued under this section may authorise persons, including the registered proprietor or his or her designated representative, to accompany and assist any member of the Garda Síochána in executing the warrant or in collating any inventory or other evidence.

5 (3) A person who—

(a) obstructs or interferes with a person acting under the authority of a warrant issued under this section,

10 (b) is found in, on or at the premises or place specified in the warrant by a member of the Garda Síochána acting as aforesaid and who fails or refuses to give the member his or her name and address when required to do so or gives a name or address that is false or misleading,

(c) obstructs the exercise of an authority conferred by a warrant under this section, or

15 (d) fails or refuses to give information to a member of the Garda Síochána when requested to do so under this section,

20 shall be guilty of an offence and shall be liable on summary conviction to a fine not exceeding £1,500, or to imprisonment for a term not exceeding 12 months, or both.

Chapter 12

Delivery Up and Disposal

25 **71.**—(1) Subject to *subsection (2)*, an application for an order under *section 61* may not be made after the expiration of 6 years from the date on which the infringing product or article was made. Period after which remedy of delivery up is not available.

(2) Where, during the whole or any part of the period referred to in *subsection (1)*, the registered proprietor—

(a) is under a disability, or

30 (b) is prevented by fraud or concealment from discovering the facts entitling him or her to apply for an order,

an application under *section 61* may be made at any time before the expiration of 6 years from the date on which the applicant ceased to be under a disability or, as the case may be, could, with reasonable diligence, have discovered those facts.

35 (3) An order for delivery up in criminal proceedings under *section 69* shall not, in any case, be made after the expiration of 6 years from the date on which the proceedings under that section were initiated.

40 (4) Where in any proceedings for an order for delivery up under *section 61* or *69* the date of the making of the infringing product or article is put into question by the defendant, the onus of proof shall be on the defendant that the infringing product or article was made more than 6 years before the date on which an application for an order under *section 61* was made or proceedings under *section 69* were initiated.

Order as to disposal of infringing product or article.

72.—(1) An application may be made to the court for an order that an infringing product or article—

(a) delivered up under *section 61* or *69*, or

(b) seized and detained under *section 62* or *70*,

shall be—

5

(i) forfeited to the registered proprietor, or

(ii) destroyed or otherwise dealt with as the court may direct,

and the court may make such an order or such other order as it thinks fit.

(2) In considering what order, if any, should be made under *sub-section (1)* the court shall consider whether other remedies available in an action for infringement of the design right would be adequate to compensate the registered proprietor and to protect his or her interests.

10

(3) Provision shall be made by rules of the court as to the service of notice on persons having an interest in the products or articles concerned, and any such person may—

15

(a) appear in proceedings for an order under this section whether or not he or she was served with notice, or

(b) appeal against any order made, whether or not he or she appeared in the proceedings concerned.

20

(4) An order made under this section shall not take effect until the expiration of the period within which notice of an appeal may be given, or, where before the expiration of that period notice of appeal is duly given, until the final determination or abandonment of the proceedings on the appeal.

25

(5) Where there is more than one person interested in a product or article, the court shall make such order as it thinks fit and may direct the product or article to be sold or otherwise dealt with and any proceeds divided in accordance with the direction of the court.

30

(6) Where the court decides that no order shall be made under this section, the person who had the product or article in his or her possession, custody or control immediately before it was delivered up or seized shall be entitled to its return.

(7) References in this section to a person having an interest in a product or article include any person in whose favour an order may be made under this section in respect of the product or article or under section 145 or 264 of the *Copyright and Related Rights Act, 2000*, or under section 23 of the *Trade Marks Act, 1996*.

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Chapter 13

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Provision for Preventing Importation

Infringing products or articles may be treated as prohibited goods.

73.—(1) The registered proprietor of a design may give notice in writing to the Revenue Commissioners—

(a) that he or she is the registered proprietor, and

(b) that he or she requests the Revenue Commissioners for a period specified in the notice to treat infringing products or infringing articles as prohibited goods.

5 (2) The period specified in a notice given under *subsection (1)* shall not exceed 5 years and shall not extend beyond the period for which design right is to subsist.

(3) The registered proprietor may give notice in writing to the Revenue Commissioners—

(a) that he or she is the registered proprietor,

10 (b) that infringing products or articles referred to in *subsection (1)(b)* are expected to arrive in the State at a time and a place specified in the notice, and

(c) that he or she requests the Revenue Commissioners to treat those products or articles as prohibited goods.

15 (4) When a notice given under *subsection (1)* is in force, the importation of goods to which the notice relates, other than products imported by a person for his or her private and domestic use, is prohibited.

20 (5) Notwithstanding *subsection (4)* or anything contained in the Customs Acts, a person is not, by reason of the prohibition, liable to any penalty under the Customs Acts other than forfeiture of the prohibited goods.

25 (6) In this section, “prohibited goods” means counterfeit or pirated goods within the meaning of the European Communities (Counterfeit and Pirated Goods) Regulations, 1996 (S.I. No. 48 of 1996).

74.—(1) The Revenue Commissioners may prescribe the form in which notice is to be given under *section 73* and require a person giving notice— Power of Revenue Commissioners to make regulations.

30 (a) to furnish the Revenue Commissioners with such evidence as may be prescribed, either on giving notice or when the goods are imported, or at both these times, and

(b) to comply with such other conditions as may be prescribed.

35 (2) Regulations made under this section may require a person giving a notice under *section 73*—

(a) to pay such fees in respect of the notice as may be specified by the Revenue Commissioners from time to time,

40 (b) to give such security as may be so specified by the Revenue Commissioners in respect of any liability or expense which the Revenue Commissioners may incur in consequence of the notice given by reason of the detention of any infringing product or article or anything done to any infringing product or article detained, and

45 (c) to indemnify the Revenue Commissioners against any such liability or expense whether security has been given or not.

(3) Regulations made under this section may make different provisions in respect of different classes of case to which they apply and may include such incidental and supplementary provisions as the Revenue Commissioners consider expedient from time to time.

(4) A fee paid pursuant to regulations made under this section shall be accounted for in such manner as shall be prescribed by the Minister for Finance. 5

Chapter 14

Exhaustion of Design Right

Exhaustion of design right.

75.—The design right shall not be infringed by the doing of anything in relation to products to which the design has been applied or is incorporated where such products have been put on the market in a Member State of the EEA by or with the consent of the registered proprietor. 10

Chapter 15

15

Assignment and Licensing

Assignment.

76.—(1) The design right is transmissible by assignment, testamentary disposition or operation of law, as personal or moveable property.

(2) Any equities in respect of the design right may be enforced in like manner as in respect of any other personal property. 20

(3) An assignment or mortgage of a design right, or a vesting assent relating to it, shall not be effective unless it is in writing signed by or on behalf of the assignor, mortgagor or party granting such assent or, as the case may be, a personal representative and this requirement may be satisfied in a case where the assignor, mortgagor or party granting the assent or personal representative is a body corporate by the affixing of its seal. 25

(4) Until an application has been made for registration of a transaction referred to in this section under *section 41*— 30

(a) the transaction shall be ineffective as against a person acquiring a conflicting interest in or under the design right in ignorance of it; and

(b) a person claiming to be a licensee by virtue of the transaction shall not be entitled to the rights and remedies conferred by *sections 63* and *65*. 35

(5) Where there is more than one registered proprietor of a design, no registered proprietor shall, without the consent of each of the others, grant a licence under the design right or assign or mortgage a share in it. 40

(6) An assignment may be partial so as to apply to—

(a) one or more but not all of the acts the registered proprietor has the exclusive right to undertake or authorise, or

(b) part but not the whole of the period for which the design right is to subsist. 45

5 **77.**—(1) In this Act, an “exclusive licence” means a licence authorising the licensee, to the exclusion of all other persons including the person granting the licence, to use a registered design in the manner authorised by the licence and references in this Act to “exclusive licensee” shall be construed accordingly. Exclusive licences.

(2) An exclusive licensee has the same rights against a successor in title who is bound by the licence as the exclusive licensee has against the person granting the licence.

10 **78.**—(1) Until an application has been made for registration of a transaction referred to in this section under *section 41*— Licensing of registered designs.

(a) the transaction shall be ineffective as against a person acquiring a conflicting interest in or under the registered design in ignorance of it, and

15 (b) a person claiming to be a licensee by virtue of the transaction shall not be entitled to the rights and remedies conferred by *sections 63* and *65*.

(2) A licence may be partial so as to apply to—

20 (a) one or more but not all of the acts that the registered proprietor has the exclusive right to undertake or authorise, or

(b) part but not the whole of the period for which the design right is to subsist.

25 (3) A licence, including an exclusive licence, granted in respect of a design right shall not be effective unless it is in writing and signed by or on behalf of the grantor and this requirement may be satisfied in a case where the grantor is a body corporate by the affixing of its seal.

30 (4) Unless the licence provides otherwise, it shall be binding on a successor in title to the grantor’s interest in the design, except a purchaser in good faith for valuable consideration and without notice of the licence or a person deriving title from such a purchaser, and references in this Act to undertaking any act with or without the consent of the registered proprietor shall be construed accordingly.

35 (5) References in this Act to a licence or licensee include a sub-licence or sub-licensee.

Chapter 16

International Arrangements

79.—(1) In this Act—

Geneva Act of the Hague Agreement.

40 “Hague Agreement” means the Geneva Act of the Hague Agreement concerning the International Registration of Industrial Designs, adopted at Geneva on 2 July, 1999;

“International Bureau” has the meaning given by Article 1 of the Hague Agreement;

45 “international design” means a design which is entitled to protection in the State under the Hague Agreement.

(2) The Minister may prescribe such matters as he or she considers appropriate for giving effect in the State to the provisions of the Hague Agreement.

(3) The proprietor of an international design designating the State shall, as respects the State, have the same rights and remedies and be subject to the same conditions as an applicant for registration under this Act or, as the case may be, the registered proprietor of a design registered under this Act. 5

Chapter 17

Proceedings before the Controller or the Courts 10

Exercise of discretionary powers of Controller.

80.—Where any discretionary power is, by or under this Act, given to the Controller, that power shall not be exercised adversely to an applicant for registration of a design or a registered proprietor of a design or to a party in proceedings before the Controller without that applicant, proprietor or party being given an opportunity of being heard as regards the exercise of that power. 15

Costs and security for costs.

81.—(1) The Controller may, in any proceedings before him or her under this Act, order the payment to any party of such costs (if any) as the Controller may consider reasonable and direct how and by what party they are to be paid, and any such order may, by leave of the High Court, be enforced in the same manner as a judgement or order of the High Court to the same effect. 20

(2) Where, under this Act, a party who neither resides nor carries on business in the State or in any other state which may be prescribed is a party to any proceedings before the Controller, the Controller or, in the case of any appeal, the High Court, may require that party to give security for the costs of the proceedings. 25

(3) Where a requirement under *subsection (2)* is not complied with, the Controller or, as the case may be, the High Court may treat the proceedings as abandoned. 30

Evidence before the Controller.

82.—In subsection (1) of section 92 (as amended by section 73 of the Trade Marks Act, 1996) of the Patents Act, 1992 (which relates to evidence in proceedings before the Controller under that Act or any other enactment), after “before the Controller (including proceedings under the Trade Marks Act, 1996”, there shall be inserted “, and the *Industrial Designs Act, 2000*” and the section as so amended is set out in the Table to this section. 35

TABLE

In any proceeding under this or any other enactment before the Controller (including proceedings under the Trade Marks Act, 1996, and the *Industrial Designs Act, 2000*), evidence shall be given by statutory declaration in the absence of directions to the contrary; but in any case in which the Controller thinks it right so to do he may take evidence *viva voce* in lieu of or in addition to evidence by such declaration. 40

Costs of Controller in proceedings.

83.—In proceedings before the courts under this Act, the Controller shall not be awarded costs and shall not be ordered to pay the costs of any other party. 45

84.—(1) Except as otherwise provided by this Act, an appeal lies to the High Court from any decision or order of the Controller under this Act within the period of 3 months from the date of the decision or order of the Controller. Appeals.

5 (2) An appeal from a decision of the High Court under this section shall lie to the Supreme Court on a specified point of law by leave of the High Court.

Chapter 18

Miscellaneous

10 85.—(1) The Minister may make regulations for the purpose of enabling this Act to have full effect. Power of Minister to make regulations.

(2) Regulations made under this section may contain such incidental, supplementary or consequential provisions as appear to the Minister to be necessary or expedient for the purposes of this Act.

15 (3) The Minister may make regulations for prescribing any matter referred to in this Act as prescribed.

(4) The Government or the Minister, as the case may be, may by order amend or revoke an order made by the Government or the Minister under this Act including an order made under this subsection (other than a commencement order).
20

86.—(1) Subject to this section, the registration of a design shall have the same effect as against the State as it has against an individual. Rights of State in respect of registered designs.

25 (2) A Minister of the Government may, by himself or herself or by such of his or her officers, servants or agents as may be authorised in writing by him or her or by any other person acting on his or her behalf, at any time after the application for registration of a design under this Act, use the design for the service of the State—

30 (a) on such terms as may, either before or after the use thereof, be agreed on with the consent of the Minister for Finance between that Minister of the Government and the applicant or, as the case may be, the registered proprietor, or

(b) in default of agreement, on such terms as may be settled in the manner provided under this section,

35 and the terms of any agreement or licence concluded between the applicant or, as the case may be, the registered proprietor and any person other than a Minister of the Government shall be inoperative so far as it concerns the use of the design for the service of the State.

40 (3) Where a registered design has, before the date of registration or, where priority is claimed, the date of priority, been duly recorded in a document or embodied in a model by a Minister of the Government (such design not having been communicated directly or indirectly by the applicant for the registration or, as the case may be, the registered proprietor) any Minister of the Government or such
45 of his or her officers, servants or agents as may be authorised in writing by him or her, may use the design so recorded for the service of the State free of royalty or any other payment to the applicant or,

as the case may be, the registered proprietor, notwithstanding the existence of the design right.

(4) For the purposes of *subsection (3)*, where, in the opinion of that Minister of the Government, the disclosure to the applicant or, as the case may be, the registered proprietor of the document recording the design or the model embodying the design would be detrimental to the public interest, such disclosure may be made confidentially to counsel on behalf of the applicant or registered proprietor or to any independent expert mutually agreed upon. 5

(5) In case of a dispute as to the use of a design under this section, the terms therefor or as to the existence or scope of any record referred to in *subsection (3)*, the matter shall be referred to the High Court for decision, and the High Court shall have the power to refer the whole matter or any question or issue of fact thereon to be heard by an arbitrator upon such terms as it may direct. 10 15

(6) The High Court or arbitrator, in settling a dispute referred to in *subsection (5)*, shall be entitled to take into consideration any benefit or consideration which the applicant or registered proprietor or any other person interested in the design may have received directly or indirectly from the State in respect of such use of the design. 20

(7) Notwithstanding *subsection (5)*, an arbitrator appointed under that subsection shall make his or her finding within 3 months of the reference from the High Court, or within such further period of time as may be agreed with the High Court. 25

(8) In any proceedings under this section, the Minister of the Government who is a party to the proceedings may—

- (a) put in question the validity of the relevant registration without applying for its invalidation, or
- (b) if the registered proprietor of the design is party to the proceedings, apply for the invalidation of the registration on any ground upon which a registration may be invalidated under this Act. 30

(9) The right to use a design for the service of the State under this section shall include the power to sell or rent, or offer for sale or rent, any products made in pursuance of such right which are no longer required for the service of the State. 35

(10) Nothing in this section shall affect the right of the State or of any person deriving title directly or indirectly from the State to sell, rent or use any articles forfeited under the Customs Acts. 40

(11) Any person who acquires products disposed of, sold or rented in the exercise of powers conferred by this section and any person claiming under him or her shall have the power to deal with the products in the same manner as if they had been made pursuant to a design right held on behalf of the State. 45

(12) In this Act, “service of the State” means a service financed out of moneys charged on or advanced out of the Central Fund or moneys provided by the Oireachtas or by a local authority for the purposes of the Local Government Act, 1941.

87.—(1) This section applies to communications in respect of any matter relating to the protection of a design. 50

(2) Any communication to which this section applies—

(a) between a person and his or her registered agent, or

(b) for the purposes of obtaining or in response to a request for information which a person is seeking for the purpose of instructing his or her registered agent,

is privileged from disclosure in legal proceedings in the State in the same way as a communication between a person and his or her solicitor or, as the case may be, a communication for the purpose of obtaining or in response to a request for information which a person seeks for the purpose of instructing his or her solicitor.

(3) In *subsection (2)*, “registered agent” means:

(a) a registered trade mark agent;

(b) a registered patent agent.

(4) Section 94(2) of the Patents Act, 1992, is hereby amended by the deletion of “, design” and the said subsection shall be construed and have effect accordingly.

88.—(1) Whenever, under this Act, an act has to be undertaken by or done to a person in connection with the registration of a design or any procedure relating to a registered design or a design right, the act may be undertaken by or done to an agent—

Recognition of agents.

(a) who is authorised by that person orally or in writing; and

(b) who is a registered patent agent or a registered trade mark agent.

(2) A registered patent agent or a registered trade mark agent duly authorised by a person under *subsection (1)* to act as his or her agent may, subject to any agreement to the contrary between the agent and that person, on giving notice to the Controller and that person, cease to act as agent for that person.

(3) In this Act, “registered patent agent” shall have the same meaning as “patent agent” in the Patents Act, 1992.

(4) Part X (Patent Agents) of the Patents Act, 1992, shall apply in respect of registered patent agents under this Act as it applies in respect of patent agents under the Patents Act, 1992.

(5) In this Act, “registered trade mark agent” shall have the same meaning as “registered trade mark agent” in the Trade Marks Act, 1996.

(6) Part V (Trade Mark Agents) of the Trade Marks Act, 1996, shall apply in respect of registered trade mark agents under this Act as it applies in respect of registered trade mark agents under the Trade Marks Act, 1996.

(7) The Minister may prescribe the maximum fees to be charged by a registered patent agent or a registered trade mark agent in respect of services provided in connection with the protection of designs.

Duration of
copyright in
registered designs.

89.—The *Copyright and Related Rights Act, 2000*, is hereby amended by the insertion of the following after section 31—

“Duration of
copyright in
registered designs.

31A. The copyright in a registered design shall expire 25 years after the filing date of the application for registration of the design under the *Industrial Designs Act, 2000*, unless this extends the period of protection under this Act.”. 5

FIRST SCHEDULE

Section 4.

Transitional Provisions

1. A design that stands registered on the day on which this Act comes into operation shall continue to be registered under the Industrial and Commercial Property (Protection) Acts, 1927 to 1958, and those Acts shall apply notwithstanding the coming into operation of this Act. 10

2. For the purposes of this Schedule, an application for the registration of a design under the Industrial and Commercial Property (Protection) Acts, 1927 to 1958, received by the Controller before the day on which this Act comes into operation in respect of which a registration has not been effected (other than an application which has been abandoned or refused) shall, notwithstanding the coming into operation of this Act, be registered under the Industrial and Commercial Property (Protection) Acts, 1927 to 1958, and the provisions of those Acts shall apply to that registered design. 15 20

3. Notwithstanding *paragraph 2*, an application for the registration of a design under the Industrial and Commercial Property (Protection) Acts, 1927 to 1958, received by the Controller before the day on which this Act comes into operation in respect of which a registration has not been effected (other than an application which has been abandoned or refused) may be registered under this Act where the applicant gives notice to the Controller requesting that the registration of the design be determined in accordance with this Act and otherwise satisfies the Controller that the application is a valid application for the purposes of this Act. 25 30

4. Notice given under *paragraph 3* shall be in the prescribed form, shall be accompanied by the prescribed fee and shall not be valid unless it is received by the Controller within 6 months of the coming into operation of this Act and before the Controller registers the design under the Industrial and Commercial Property (Protection) Acts, 1927 to 1958. 35

5. Notice given under *paragraph 3* shall be irrevocable. 40

6. Notice given under *paragraph 3* shall be deemed to be received on the coming into operation of this Act for the purposes of filing dates.

SECOND SCHEDULE

Repeals

Section 4.

(1) Number and Year	(2) Short Title of Act	(3) Extent of Repeal
5	No. 16 of 1927 Industrial and Commercial Property (Protection) Act, 1927	All remaining provisions
	No. 13 of 1929 Industrial and Commercial Property (Protection) (Amendment) Act, 1929	All remaining provisions
10	No. 45 of 1947 Industrial and Commercial Property (Protection) (Neuchatel Agreement) Act, 1947	All remaining provisions
	No. 32 of 1949 Industrial and Commercial Property (Protection) (Amendment) Act, 1949	All remaining provisions
15	No. 13 of 1957 Industrial and Commercial Property (Protection) (Amendment) Act, 1957	All remaining provisions
	No. 21 of 1958 Industrial and Commercial Property (Protection) (Amendment) Act, 1958	All remaining provisions



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AN BILLE UM DHEARAÍ TIONSCAIL, 2000
INDUSTRIAL DESIGNS BILL, 2000

EXPLANATORY MEMORANDUM

PART 1 (Preliminary and General) of this Bill makes provision to underpin the operation of the Act and includes provisions on short title and commencement (*section 1*), interpretation (*section 2*), expenses (*section 3*), transitional provisions and repeals (*section 4*), prosecution of offences (*section 5*), offences by bodies corporate (*section 6*), offences by members of partnerships (*section 7*), service of notices (*section 8*), fees (*section 9*) and laying of regulations before Houses of Oireachtas (*section 10*). Of particular note are the definitions of “complex product”, “design”, “made available to the public” and “product”, which are taken from Directive 98/71/EC of the European Parliament and of the Council of 13 October 1998 on the legal protection of designs (O.J. No. L289/28, 28.10.98) contained in *section 2*. *Section 4* provides for transitional provisions which are constructed (in the *First Schedule*) in such a manner as to provide a cut-off between the old system of protection and the new system of protection under this Act. Provision is made in the transitional provisions to permit an applicant whose application is awaiting a decision on registration at the commencement of the new Act to elect to have it considered under the new Act instead of under the old law, subject to certain conditions. Otherwise, the old law will continue to apply to existing registered designs.

PART 2

(Design Registration)

Chapter 1 (Registrable Designs) of *Part 2* sets out the criteria for registrability of a design and these are based on the relevant Articles of the Directive (i.e. Articles 3 to 7).

Under *section 11* (Registrable design), a design which is new and has individual character will be registrable under this Bill provided that the applicant for registration is the proprietor of the design. *Section 12* (Novelty) provides a definition of novelty and places the onus on the applicant to establish novelty prior to filing the application. The novelty of a design shall not be destroyed if it is disclosed in confidence, if it was made available to the public within one year prior to the filing date as a result of information provided or actions taken by the designer, if it was made available to the public without the authorisation of the author or if it was displayed at a certified official or international exhibition and the application was filed within 6 months of the opening of that exhibition.

A design, by virtue of *section 13* (Individual character), shall be considered to have individual character where it produces a different overall impression on the informed user, taking into consideration the degree of freedom of the designer in developing the design. Under *section 14* (Protection requirements), a design applied to a component part of a complex product can only be considered new and to have individual character if the component part remains visible during normal use and where that component part in itself meets the novelty and individual character requirements of *sections 12* and *13*. *Section 15* (Conflict with prior design) states that a design which conflicts with a design in which design rights existed prior to the filing date of the later design is not registrable. *Section 16* (Designs dictated by their technical function and designs of interconnections) provides that the features of a product which are exclusively dictated by technical function will not be registrable. However, a design serving the purpose of allowing multiple assembly or connection of mutually interchangeable products within a modular system is registrable, provided that it meets the novelty and individual character criteria under this Act.

Chapter 2 (Authorship and Ownership of Designs) makes provision relating to the ownership and authorship of designs.

Section 17 (Ownership of designs) provides that the creator of the design shall be the author. In relation to a computer-generated design the person who makes the arrangements necessary for the creation of the design shall be considered the author. *Section 18* (Joint ownership of designs) provides a definition for design of joint authorship and stipulates that where a right conferred by this Bill is owned by a number of people any requirement of the consent of the registered proprietor shall require the consent of all of the joint owners of the right. The author, by virtue of *section 19* (Treatment of author of design), shall be the first owner of a design, except where it is created during the course of employment. In employee situations, the author shall still be entitled to be cited as the creator of the design in any application for registration and in the register. Where a design is transferred to another person, provision is made to the effect that the other person becomes the proprietor of the design.

Chapter 3 (Proceedings for Registration) sets out various proceedings relating to the registration of a design.

Section 20 (Application in prescribed form) provides for the filing of an application for registration of a design with the Controller by persons claiming to be the owner of the design. The application should comply with the requirements which will be set out in regulations. *Section 21* (Power of Controller to refuse registration) sets out specific grounds for refusal of registration of a design by the Controller. This is a very important provision. If approval for registration is refused, no design right shall subsist in the design and the applicant cannot stop the use of the design by a third party. *Section 22* (Application for registration of design as a property right) provides for applications for registration of a design to be treated as objects of property. Thus, an application for registration may be assigned or inherited or otherwise transferred. *Section 23* (Deemed abandonment of applications) provides that applications which, due to the fault or neglect of the applicant, are not completed within the prescribed time limit will be considered abandoned.

Section 24 (Classification) provides for a design, upon registration, to be classified according to a prescribed system and gives the Controller the power to make final decisions concerning classification matters. *Section 25* (Filing date) establishes the criteria which will

decide the filing date to be applied to an application for registration of a design, that is, the date on which the prescribed information and fees are filed at the Patents Office. The filing date is very important because it establishes the date at which matters such as novelty and individual character will be assessed and it also gives the proprietor of the design precedence over another application which may be filed at a later date.

Section 26 (Priority right) gives a person who has filed an application for protection of a design in or in respect of a Paris Convention country or a member of the World Trade Organisation (WTO), a right of priority during a period of 6 months from the date of filing of the foreign application. *Section 27* (Claiming priority) establishes that an applicant shall not be entitled to claim priority unless the claim is made in the prescribed form. *Section 28* (Effect of priority right) sets out the effect which claiming priority has on the filing date, that is, the right of priority makes the filing date for the application the same as the filing date of the priority application. The making available to the public of the previous application after its filing date shall not destroy the novelty of that design and shall not be reason for refusal to register the design or invalidation of a registered design. *Section 29* (Date of registration) provides that a design shall be registered from the date of filing of the application. This is an important provision because it allows the protection of a design to apply from the date registration is applied for rather than the date on which the design is registered.

Chapter 4 (Register of Designs) enables the establishment of the register of designs and makes provision for the correction and rectification of the register and for access to information on the register.

Section 30 (Register of designs) provides that the Controller may register designs and shall record specific details of registered designs on a designs register which is to be known as the "Register". *Section 31* (Certificate of registration) provides for the issue by the Controller of a certificate of registration to the registered proprietor on registration of the design, and for the replacement of this certificate in specific circumstances. *Section 32* (Publication of registration and deferment of publication) obliges the Controller to publish notice of the registration of a design as soon as practicable after registration. The section also provides for deferment of publication for a period of up to 30 months at the request of the applicant.

Section 33 (Right to apply to court for rectification of register) establishes that any aggrieved person has a right to apply to the High Court for rectification of the register. Notice of any such application shall be given to the Controller. A person who is the rightful owner of a design right shall, by virtue of this section, be entitled to apply to have their name registered in place of a person who should not be so registered and to thereby re-possess his or her rights in the design. *Section 34* (Right to apply to Controller for rectification of register) provides that an application for rectification of the register may, at the option of the applicant, be made first to the Controller rather than to the court and that the Controller has the power of the court to decide the matter. *Section 35* (Effect of rectification of register) sets out the effect of rectification of the register under *sections 33* and *34*.

Section 36 (Adaptation of entries to new classification) deals with situations where an amendment to the Designs Classification system (currently the Locarno Classification) may be made which causes a design registered on the Irish register to be re-classified into another

class or to be classified according to a different system of classification and gives power to the Controller to amend the Irish register to reflect the revised status of the registration in such circumstances.

Section 37 (Power of Controller to correct errors) establishes that the Controller may correct an error in an application for the registration of a design, in the representation of a design supplied with an application or any error in the register, at the written request of any person interested, or on his or her own initiative. This provision is designed to permit correction of clerical errors, as opposed to *sections 33* and *34* which deal with more substantive changes to the register.

Section 38 (Inspection of designs register) provides for the inspection of the Register at such times and in such manner as may be prescribed by the Minister for Enterprise, Trade and Employment, and for the provision by the Controller of copies or extracts from an entry in the Register on request. In cases of deferred publication of a registered design, the representations of that design shall not be open to public inspection until the period of deferment expires. *Section 39* (Right to information) obliges the Controller, in response to a written request, to provide information relating to the application for registration of a registered design and to permit inspection of documents relating to the application, except where publication of a design has been deferred. *Section 40* (Information as to existence of right in registered design) provides that where a person gives sufficient information to enable the Controller to identify a particular design, the Controller shall inform that person whether that design is registered and give other limited information about the design.

Section 41 (Registration and publication of assignments, licences, etc.) provides for the registration at the Patents Office of the title of any person who becomes entitled by assignment, transmission or operation of law to a design right in a registered design or becomes entitled as mortgagee, licensee or otherwise to any other interest in the design right in a registered design. Failure to register does not affect the validity of the assignment as between the assignor and the assignee. However, when an assignment is not registered, the legal title to sue third parties remains vested in the original proprietor on the register, who must be made a party to the action if the assignee is to sue.

Chapter 5 (*Effect of Registration*) sets out the effect of a registration of a design under this Bill and makes provision for such matters as duration of protection, restoration and surrender of design rights and invalidation of design rights.

Section 42 (Design right) establishes the design right in a registered design and that the person recorded as the proprietor of the design on the register shall be the design right owner. The design right gives the registered proprietor the exclusive right to use the design.

Section 43 (Duration of protection) sets out the term of protection afforded by the registration of a design. It establishes that the design right in a design shall last for a maximum period of 25 years, renewable in 5 yearly periods.

Section 44 (Restoration of design right) provides for the restoration of a design right which has expired because of a failure to extend the period of the subsistence of the design right, but only covers cases where the registered proprietor took reasonable care to see that the subsistence of the right was properly renewed. *Section*

45 (Effect of order for restoration of design right) is a technical provision which sets out the effect of an order for restoration of a design right which has lapsed because of a failure to extend the period of protection.

Section 46 (Surrender of design right) permits the registered proprietor of a design to give up the design right in that design at his or her discretion.

Section 47 (Invalidation of registration) provides for the invalidation by the Controller of a registered design on specific grounds which are based on the grounds set out in Article 11 of the Directive. These grounds include the non-registrability of the design, the design being contrary to public policy or morality, non-entitlement of the registered proprietor to be so registered, conflict with prior design or conflict with trade marks or national emblems.

Chapter 6 (Exceptions to Design Right Protection) sets out the exceptions to the protection afforded by the registration of a design.

Section 48 (Acts permitted) provides exceptions to the rights conferred by a registered design for private and non-commercial uses, experimental purposes, teaching and use of designs on ships and aircraft which temporarily enter the State. *Section 49* (Compulsory licences) establishes that the Controller may, on the application of any person, make an order granting a compulsory licence for the use of a registered design on the grounds that the registered proprietor of the design is not producing sufficient products incorporating the design to meet demand in the State. *Section 50* (Prior use) permits the continued use of a design which was in use prior to the registration of the design or in respect of which serious preparations for use were made by a person other than the registered proprietor prior to that date.

Chapter 7 (Infringement of Design Right) details the acts which constitute infringements of the design right in a registered design.

Section 51 (Infringement of design right) sets out the acts which will constitute primary infringement of the design right and which are actionable by the proprietor of the design right. The section also provides that the use of features which do not form part of the registered design shall not constitute an infringement of the design right. *Section 52* (Secondary infringement of design right) provides that it is an infringement of design right to undertake certain secondary acts e.g. to sell, rent, import or possess infringing products in the course of a business. *Section 53* (Secondary infringement: providing means for infringement) provides that a rightsowner can take action against persons who facilitate infringement by providing the means to others to infringe. *Section 54* (Meaning of infringing product and article) provides definitions for the terms “infringing product” and “infringing article”. Such definitions are required to give proper effect to the remedies and offences provisions in the Bill.

Chapter 8 (Remedies) lists the civil remedies available under this Bill to registered proprietors and others in respect of registered designs.

Section 55 (Certificate of contested validity of registration) establishes that where the validity of the registration of a design is contested and the court finds that the design is validly registered, the court may certify that finding and the fact that the validity of the registration of the design was contested in those proceedings. *Section 56* (Groundless threats) permits persons who are threatened with

legal proceedings for the infringement of design right in a registered design to counter-sue in cases where the threats are groundless. It is intended to prevent malicious threats by persons who aim to establish or protect a dominant market position, where they are not actually entitled to the right themselves.

Section 57 (Infringement actionable by registered proprietor) allows the registered proprietor of a design a direct civil remedy for any infringement of his or her design right and provides the same relief as is available in respect of any other property right. *Section 58* (Innocent infringement) establishes that no damages or account of profits shall be ordered against a defendant who innocently infringes a design right. *Section 59* (Award of damages in infringement action) provides that the appropriate court may award aggravated or exemplary damages in addition to compensation for financial loss in respect of infringement of design right.

Section 60 (Undertakings concerning licences of right) is designed to deal with particular situations in which proceedings for infringement of design right are instituted where a licence to use the design is available as of right.

Section 61 (Order for delivery up in civil cases) makes provision for the registered proprietor of a design to apply for a civil remedy of order for delivery up of infringing products or articles. *Section 62* provides a procedure for application by the registered proprietor to the District Court for seizure without warrant by the Gardai of goods which there are reasonable grounds for believing are infringing goods, and to permit the District Court to receive hearsay evidence without the obligation to reveal the source of the information. *Subsection (5)* provides a protection against malicious accusations.

Chapter 9 sets out the rights and remedies of exclusive licensees.

It sets out in *section 63* (Rights and remedies of exclusive licensees) that those rights shall, except as against the registered proprietor, be the same as those available to a registered proprietor. Provision is also made in *section 64* (Exercise of concurrent rights) for procedures in infringement actions where concurrent rights exist between the registered proprietor and an exclusive licensee.

Chapter 10 sets out the rights and remedies of licensees.

Section 65 (Rights and remedies of licensees) entitles an ordinary (non-exclusive) licensee to invite the registered proprietor to take infringement proceedings and, where the registered proprietor refuses or fails to do so, to bring such proceedings himself or herself where the licensee's interests are affected.

Chapter 11 (*Offences*) makes provision for offences and remedies in criminal proceedings.

The acts which constitute offences under this Bill are set out in *section 66* (*Offences*), as are the penalties for summary convictions and indictments. These are set at a level which will permit prosecutions to be taken in the District Court.

Section 67 (Falsification of register) makes it an offence to make false entries in the Register and sets out the penalties for such offences. The maximum level of fine on indictment is not fixed in order to permit the court to set the fine at what it considers to be an appropriate level. Falsely representing that a design used in the

course of trade is a registered design when it is not so registered shall be an offence under *section 68* (False representation).

Sections 69 (Order for delivery up in criminal proceedings) and *70* (Search and seizure in criminal cases) provide for orders for delivery up and for search and seizure powers respectively in cases where suspected or actual offences have occurred concerning registered designs and they are identical to the civil remedies provided in respect of infringing goods.

Chapter 12 deals with matters relating to the delivery up and disposal of infringing products and articles.

The period during which an application for an order for delivery up in civil and criminal cases must be made is set out in *section 71* (Period after which remedy of delivery up is not available). In respect of civil proceedings, the period within which the application must be made is 6 years from the date the infringing product or article was made whereas, in criminal proceedings, the period within which an order must be made is 6 years from the date on which criminal proceedings were initiated. It is also set out clearly that the defendant must prove the dates the goods were made, where he or she claims that the infringing material was made outside those dates. *Section 72* (Order as to disposal of infringing product or article) permits application to be made to the court for forfeiture to the registered proprietor of goods which are seized or delivered up under this Bill or for the destruction or other disposal of such goods. It also makes provision as to the persons who are entitled to receive such goods.

Chapter 13 provides a procedure for registered proprietors to prevent importation of infringing goods.

In *sections 73* (Infringing products or articles may be treated as prohibited goods) and *74* (Power of Revenue Commissioners to make regulations) power is given to the Revenue Commissioners, on application by the registered proprietor of a design, to treat infringing products or articles as counterfeit or pirated goods and to have such goods forfeited under the Customs Acts.

Chapter 14 implements the Directive in respect of exhaustion of rights in registered designs.

Section 75 (Exhaustion of design right) provides for exhaustion of the design right in relation to products which have been made available to the public in the EEA by or with the consent of the registered proprietor. This means that, when a registered proprietor has agreed to the use of his or her design on products which are put for sale, rent etc. on the market in the EEA, the registered proprietor cannot control the downstream sale or other use of those products. This measure is taken from Article 15 of the EU Directive on the legal protection of designs and is intended to give effect to the single market in the EU.

Chapter 15 deals with assignment and licensing of the design right in registered designs.

In *section 76* (Assignment), the transmissibility of the design right is established while, in *subsection (4)*, it is stipulated that such a transfer of design right shall be ineffective against persons acquiring rights in ignorance of the transfer until an application to register the transfer has been made under *section 41* (Registration and publication of assignments, licences, etc.) of this Bill. A licensee is also denied the

rights and remedies otherwise available under this Bill until such application is made. *Section 77* (Exclusive licences) provides that an exclusive licence shall be effective against the grantor and any successor in title to the grantor and provides a definition of “exclusive licence”. Provision is made in *section 78* (Licensing of registered designs) relating to the effect of licenses in general including a stipulation that licenses must be in writing and signed on behalf of the grantor.

Chapter 16 (International Arrangements) permits the Minister for Enterprise, Trade and Employment to introduce legislation which will permit the implementation and ratification in Ireland of the Geneva Act of the Hague Agreement.

Section 79 (Geneva Act of the Hague Agreement) enables the Minister for Enterprise, Trade and Employment to introduce measures by secondary legislation to enable the ratification and implementation in Ireland of the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs. The Hague Agreement, which is administered by the World Intellectual Property Organisation (WIPO), is an international system of design registration which enables applicants from member countries to obtain protection for their design in all other member countries by a single application. This section also places an applicant for registration under the international system in the same position as an applicant under domestic Irish law.

Chapter 17 (Proceedings before the Controller or the Courts) deals with proceedings before the Controller and certain matters relating to the Controller’s appearance before the courts.

Section 80 (Exercise of discretionary power of controller) is a standard technical provision in intellectual property legislation which forbids the Controller from exercising any discretionary power he or she may have under this Bill adversely to an applicant or a registered proprietor without that party being given the opportunity of being heard. The Controller is given the power to decide costs in proceedings before him or her under *section 81* (Costs and security for costs) and to treat proceedings as abandoned where a party does not provide the security for costs which the Controller requires. *Section 82* (Evidence before the Controller) is a technical provision which applies the provisions of section 92 of the Patents Act, 1992 (Regarding the giving of evidence before the Controller and the calling of witnesses) to proceedings before the Controller under this Bill. Finally, in this Chapter, *section 83* (Costs of Controller in proceedings) states that the Controller shall not be awarded costs or ordered to pay costs in relation to any proceedings before the courts under this Bill and *section 84* (Appeals) provides a general right of appeal from all decisions (unless denied under a specific provision of this Bill) of the Controller to the High Court.

Chapter 18 (Miscellaneous) makes provision for matters which are not covered elsewhere in the Bill.

Section 85 (Power of Minister to make regulations) is a technical provision which permits the Minister for Enterprise, Trade and Employment to make the necessary regulations to give effect to this Bill and permits the Government or the Minister to amend orders made under the Bill, except for commencement orders. The State is permitted to use designs for the services of the State under *section 86* (Rights of State in respect of registered designs). This right is subject to the terms agreed between the relevant Minister (with the consent of the Minister for Finance) and the owner of the rights in

the design. Where terms cannot be agreed, the matter is to be referred to the High Court, which shall have the power to appoint an arbitrator to make a finding within 3 months of the appointment.

Section 87 (Privileged communications) is another technical provision which gives communications between an applicant or registered proprietor and his or her registered agent the same status of privilege from disclosure in legal proceedings as communications between a solicitor and his or her client. *Section 88* (Recognition of agents) provides for recognition of Patent and Trade Mark Agents to act for applicants or registered proprietors under this Bill. The relevant provisions of the Patents Act, 1992, and the Trade Marks Act, 1996, which regulate the status and qualifications of such agents have been applied in respect of design matters under this provision.

The final section of this Bill, *section 89* (Duration of copyright in registered designs), provides a term of copyright protection for registered designs which will be the same as the maximum period of protection afforded by registration under this Bill i.e. 25 years from the filing date of the application for registration. This is a change from the current law, whereby a design does not qualify for copyright protection at all once it is used or intended to be used as a model or pattern to be industrially produced.

*An Roinn Fiontar, Trádála agus Fostaíochta,
Iúil, 2000.*