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DRAFT STATUTORY INSTRUMENTS

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**2020 No.**

**The Intellectual Property (Amendment  
etc.) (EU Exit) Regulations 2020**

**PART 5**

**Amendments to the Designs and International Trade  
Marks (Amendment etc.) (EU Exit) Regulations 2019**

**13.** The Designs and International Trade Marks (Amendment etc.) (EU Exit) Regulations 2019<sup>(1)</sup> are amended in accordance with this Part.

**14.** In the heading to regulation 4 and in regulation 4(1), for “exit day”, in each place it occurs, substitute “IP completion day”.

**15.** In regulation 5, for “exit day”, in each place it occurs, substitute “IP completion day”.

**16.** In regulation 6, for “exit day”, in both places it occurs, substitute “IP completion day”.

**17.** Schedule 1, Part 1 (Design Regulation and supplementary unregistered designs) is amended as follows—

- (a) in Article 1(3) of the Design Regulation (as substituted by paragraph 2), for “exit day” substitute “IP completion day”;
- (b) in Article 7 of the Design Regulation (as substituted by paragraph 8), for “exit day”, in both places it occurs, substitute “IP completion day”;
- (c) for paragraph 19(b) substitute—
  - “(b) for “Community”, in the third place it appears, substitute “United Kingdom or the European Economic Area”.”;
- (d) in paragraph 27(b), for “placee” substitute “place”;
- (e) in Article 81(2)(d) (as substituted by paragraph 29), omit “a continuing”.

**18.** In Schedule 1, Part 2 (2005 Regulations and the supplementary unregistered design right), in regulation 4(3) of the 2005 Regulations (as substituted by paragraph 63(b)), for “exit day” substitute “IP completion day”.

**19.** Schedule 2, Part 1 (Design Regulation and continuing unregistered Community designs) is amended as follows—

- (a) in paragraph 5, for “exit day” substitute “IP completion day”;
- (b) in Article 81(2) of the Design Regulation (as substituted by paragraph 29)—
  - (i) in sub-paragraphs (a) to (c)—
    - (aa) for “supplementary”, in each place it occurs, substitute “continuing”;
    - (bb) after “unregistered”, insert “Community”;

- (ii) in sub-paragraph (d)—
  - (aa) omit “a supplementary”;
  - (bb) after “unregistered”, insert “Community”;
- (c) in Articles 82 and 83 of the Design Regulation (as substituted by paragraph 30), for “exit day”, in each place it occurs, substitute “IP completion day”.

**20.** In Schedule 2, Part 2 (2005 Regulations and continuing unregistered Community designs), in regulation 4(3)(a) of the 2005 Regulations (as substituted by paragraph 58(b)), for “exit day” substitute “IP completion day”.

**21.** Schedule 3 (Amendments to the 1949 Act to make provision for certain registered Community designs and International designs to be treated as registered under the 1949 Act from exit day and about certain applications for registered Community designs made before exit day) is amended as follows—

- (a) in the heading, for “exit day”, in both places it occurs, substitute “IP completion day”;
- (b) in sections 12A and 12B of the 1949 Act (as prospectively inserted by paragraph 2), for “exit day”, in each place it occurs, substitute “IP completion day”;
- (c) in Schedule 1A to the 1949 Act (as prospectively inserted by paragraph 3)—
  - (i) for “exit day”, in each place it occurs, substitute “IP completion day”;
  - (ii) after paragraph 9 insert—

**“Existing registered Community design: effect of invalidity**

**9A.**—(1) This paragraph applies where, on IP completion day, an existing registered Community design is the subject of proceedings under Article 25 (Grounds for invalidity) which have been instituted but not finally determined before IP completion day (“invalidation proceedings”).

(2) Subject to sub-paragraph (4) where—

- (a) the existing registered Community design is declared invalid (whether wholly or partly) pursuant to a decision which is finally determined, and
- (b) the registrar has either—
  - (i) received notice of the situation referred to in paragraph (a) (“an invalidation notice”), or
  - (ii) otherwise become aware of the situation referred to in paragraph (a),

the registration of the re-registered design which derives from the existing registered Community design must be declared invalid to the same extent as the existing registered Community design.

(3) Where (by virtue of sub-paragraph (2)) the registration of a re-registered design is declared invalid, the registrar must—

- (a) where there is a partial declaration of invalidity, amend the entry in the register of designs;
- (b) otherwise, remove the re-registered design from the register.

(4) The registration of a re-registered design must not be declared invalid under sub-paragraph (2) where the grounds on which the existing registered Community design was declared invalid (whether wholly or partly) would

not apply or would not have been satisfied in relation to the re-registered Community design if—

- (a) the re-registered design had been the subject of an entry on the register as at the date the invalidation proceedings were instituted, and
- (b) an application for a declaration of invalidity of the re-registered design based on those grounds had been made on that date under section 11ZA.

(5) Where the registration of a re-registered design is declared invalid to any extent pursuant to this paragraph—

- (a) it shall to that extent be treated as having been invalid from the date on which the rights of the proprietor of the existing registered Community design from which it derives are deemed to have ceased under the Community Design Regulation;
- (b) subject to any claim for compensation for damage caused by negligence or lack of good faith on the part of the proprietor or a claim for restitution based upon the unjust enrichment of the proprietor, the invalidity of the registration of the re-registered design does not affect—

- (i) a decision arising from infringement proceedings which has been finally determined and which has been enforced prior to the date of the declaration of invalidity made pursuant to sub-paragraph (2) (“the invalidity declaration date”);
- (ii) any contract entered into prior to the invalidity declaration date to the extent that it has been performed prior to that date, subject to the right of a party to the contract to claim the repayment of any consideration paid under the contract where, having regard to the circumstances, it is fair and equitable for such repayment to be made.

(6) Where a declaration is made under sub-paragraph (2), section 11ZE(2) does not apply.

(7) An invalidation notice may be sent by any person.

(8) For the purposes of this paragraph—

- (a) proceedings are instituted if an application or counterclaim for a declaration of invalidity—
  - (i) has been filed (and not subsequently withdrawn) with the European Union Intellectual Property Office or a court designated for the purposes of Article 80, and
  - (ii) meets the requirements for being accorded a filing date under the Community Design Regulation and Commission Regulation (EC) No 2245/2002 of 21 October 2002;
- (b) a decision is finally determined when—
  - (i) it has been determined; and
  - (ii) there is no further possibility of the determination being varied or set aside (disregarding any power to grant permission to appeal out of time).

- (9) An appeal lies from a declaration of invalidity under subparagraph (2).”;
- (d) in Schedule 1B to the 1949 Act (as prospectively inserted by paragraph 3)—
- (i) for “exit day”, in each place it occurs, substitute “IP completion day”;
  - (ii) in the heading to paragraph 7, omit “registered” the first time it occurs.
- 22.** Schedule 4 (Amendments to the 1994 Act to make provision for certain international trade marks protected in the European Union to be treated as registered trade marks and about certain applications for such marks and transformation applications) is amended as follows—
- (a) in section 54A of the 1994 Act (as prospectively inserted by paragraph 2), for “exit day”, in each place it occurs, substitute “IP completion day”;
  - (b) in Schedule 2B to the 1994 Act (as prospectively inserted by paragraph 3), for “exit day”, in each place it occurs, substitute “IP completion day”.
- 23.** Schedule 5, Part 1 (Fees payable in respect of a re-registered design or a re-registered international design) is amended as follows—
- (a) in paragraph 1(2)—
    - (i) omit “of six months”;
    - (ii) for “exit day” substitute “IP completion day”;
  - (b) in paragraph 1(3)—
    - (i) for “ending” substitute “beginning”;
    - (ii) for “exit day” substitute “IP completion day”.
- 24.** Schedule 6 (Amendments to the Registered Designs Rules) is amended as follows—
- (a) in paragraph 3(a), for “exit day”, in both places it occurs, substitute “IP completion day”;
  - (b) after paragraph 3 insert—
- “**3A.** After rule 15 insert—

**“Invalidation of existing registered Community design: invalidation notice and procedure on application for derogation; Schedule 1A paragraph 9A**

- 15A.**—(1) An invalidation notice under paragraph 9A of Schedule 1A must—
- (a) identify the existing registered Community design by the number under which it was registered in the RCD register immediately before IP completion day, together with a representation of the design,
  - (b) be accompanied by a copy of the decision (including any decision determined on appeal) pursuant to which the existing registered Community design was declared to be invalid, and
  - (c) include a statement confirming that the decision pursuant to which the registered Community design was declared invalid (whether wholly or partly) has been finally determined.
- (2) Where an invalidation notice is sent to the registrar by the proprietor of the re-registered design which derives from the existing registered Community design, the invalidation notice must be accompanied by—
- (a) a notice (a “derogation notice”) in writing to the registrar that, based upon the provisions in paragraph 9A(4) of Schedule 1A, the re-registered design should not be declared invalid (whether wholly or partly), and

- (b) a statement of the reasons why paragraph 9A of Schedule 1A applies (a “statement”) together with relevant supporting evidence (“supporting evidence”).
- (3) Where the proprietor of a re-registered design submits an invalidation notice to the registrar but fails to send a derogation notice, a statement, or supporting evidence, the registration of the re-registered design which derives from the existing registered Community design identified in the invalidation notice must be declared invalid to the same extent as the existing registered Community design, unless the registrar directs otherwise.
- (4) Where the registrar has received an invalidation notice from a person other than the proprietor of the re-registered design which derives from the existing registered Community design, the registrar must as soon as reasonably practicable after receipt of the invalidation notice—
  - (a) send a copy of the invalidation notice to the proprietor of the re-registered design which derives from the existing registered Community design identified in the invalidation notice, and
  - (b) notify the proprietor of the re-registered design which derives from the existing registered Community design that based upon the declaration of invalidity of the existing registered Community design, the re-registered design will be declared invalid to the same extent as the existing registered Community design from which it derives.
- (5) Where the registrar has become aware of the situation referred to in paragraph 9A of Schedule 1A otherwise than by an invalidation notice, the registrar must as soon as reasonably practicable after becoming aware of that situation notify the proprietor of the re-registered design which derives from the existing registered Community design in the terms provided in paragraph (4)(b).
- (6) The proprietor of the re-registered design referred to in paragraphs (4) and (5) must, within such period of not less than one month as may be specified in the notice referred to in paragraphs (4)(b) and 5, send to the registrar a derogation notice accompanied by a statement and supporting evidence as referred to in paragraph (2), failing which the registration of the re-registered design must be declared invalid to the same extent as the registered Community design from which the re-registered design derives, unless the registrar directs otherwise.
- (7) The registrar must, in reaching a decision as to whether paragraph 9A of Schedule 1A applies to a re-registered design, have regard to the statement and supporting evidence filed by the proprietor of the re-registered design and must send written notice of the decision to the proprietor, stating the reasons for that decision.
- (8) For the purposes of any appeal against a decision referred to in sub-paragraph (7), the date on which the notice is sent must be taken to be the date of the decision.”.”;
- (c) in rule 27(e) of the Registered Designs Rules (as prospectively inserted by paragraph 6(b)), for “exit day” substitute “IP completion day”;
- (d) for paragraph 8 substitute—
  - “8.—(1) Rule 42 (address for service) is amended as follows.
  - (2) At the end of sub-paragraph (c) omit “, or” and substitute “;”.
  - (3) After sub-paragraph (1)(c) insert—

“(d) a proprietor of a re-registered design who sends a derogation notice to the registrar under rule 15A.”.

(4) In paragraph (4), for “another EEA state” substitute “an EEA state”. ”;

(e) after paragraph 8 insert—

“9.—(1) Rule 43 (failure to furnish an address for service) is amended as follows.

(2) At the end of sub-paragraph 4(c) omit “, or” and substitute “;”.

(3) After sub-paragraph (4)(c) insert—

“(d) in the case of a proprietor who sends a derogation notice to the registrar, the registrar must proceed as if the proprietor had not sent a derogation notice.”.”.

**25.** In Schedule 8, Part 1 (Further amendments to the 1949 Act), omit paragraph 7.