

## SCHEDULE 6

Regulation 8

### Amendments to the Registered Designs Rules

1. The Registered Designs Rules are amended as follows.

#### Commencement Information

- I1** Sch. 6 para. 1 in force at 31.12.2020 on IP completion day (in accordance with 2020 c. 1, Sch. 5 para. 1(1)), see reg. 1

2. After rule 2A (directions of the registrar), insert—

#### “Re-registered designs

**2B.** Except where provided to the contrary, these Rules apply to a re-registered design and a re-registered international design as they apply to other registered designs.”

#### Commencement Information

- I2** Sch. 6 para. 2 in force at 31.12.2020 on IP completion day (in accordance with 2020 c. 1, Sch. 5 para. 1(1)), see reg. 1

3. In rule 13(2)—

- (a) at the end of (2) insert—

“except where the registered design is a re-registered design or a re-registered international design where the duration of the right in the design ends within the period of six months beginning with [<sup>F1</sup>IP completion day] (as defined in section 20(1) of the European Union (Withdrawal) Act 2018) and ending with the end of the period of six months beginning with the day after that on which [<sup>F1</sup>IP completion day] falls (a “relevant re-registered design”).”

- (b) after (2) insert—

“(2A) The period prescribed for the purposes of section 8A(1) in respect of a relevant re-registered design or a re-registered international design shall be the period of 12 months beginning immediately after the date on which the registrar gave notice under section 8(3).”

#### Textual Amendments

- F1** Words in Sch. 6 para. 3(a) substituted (31.12.2020 immediately before IP completion day) by The Intellectual Property (Amendment etc.) (EU Exit) Regulations 2020 (S.I. 2020/1050), regs. 1(2), 24(a)

#### Commencement Information

- I3** Sch. 6 para. 3 in force at 31.12.2020 on IP completion day (in accordance with 2020 c. 1, Sch. 5 para. 1(1)), see reg. 1

- <sup>F2</sup>**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—

**Changes to legislation:** There are currently no known outstanding effects for the The Designs and International Trade Marks (Amendment etc.) (EU Exit) Regulations 2019, SCHEDULE 6. (See end of Document for details)

- (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.

**Textual Amendments**

**F2** Sch. 6 para. 3A inserted (31.12.2020 immediately before IP completion day) by [The Intellectual Property \(Amendment etc.\) \(EU Exit\) Regulations 2020 \(S.I. 2020/1050\)](#), regs. 1(2), **24(b)**

**Commencement Information**

**I4** Sch. 6 para. 3A in force at 31.12.2020 on IP completion day (in accordance with [2020 c. 1](#), [Sch. 5 para. 1\(1\)](#)), see [reg. 1](#)

4. Omit rule 23.

**Commencement Information**

**I5** Sch. 6 para. 4 in force at 31.12.2020 on IP completion day (in accordance with [2020 c. 1](#), [Sch. 5 para. 1\(1\)](#)), see [reg. 1](#)

5. In rule 26 (certificate of registration), after paragraph (3) insert “ (4) This rule shall not apply to re-registered designs or re-registered international designs. ”

**Commencement Information**

**I6** Sch. 6 para. 5 in force at 31.12.2020 on IP completion day (in accordance with [2020 c. 1](#), [Sch. 5 para. 1\(1\)](#)), see [reg. 1](#)

6. In rule 27 (registration of interests), in paragraph (1)—

(a) at the end of sub-paragraph (d), for “.”, substitute “ ; ”;

(b) after sub-paragraph (d) insert—

“(e) where the design to be registered is a re-registered design (within the meaning of “re-registered design” in paragraph 1(2) of Schedule 1A) an indication that the re-registered design was on [<sup>F3</sup>IP completion day] the subject of a registration at the European Union Intellectual Property Office, including the number of the registration of the registered Community design from which the re-registered design derives.”.

**Textual Amendments**

**F3** Words in [Sch. 6 para. 6\(b\)](#) substituted (31.12.2020 immediately before IP completion day) by [The Intellectual Property \(Amendment etc.\) \(EU Exit\) Regulations 2020 \(S.I. 2020/1050\)](#), regs. 1(2), **24(c)**

**Commencement Information**

**I7** Sch. 6 para. 6 in force at 31.12.2020 on IP completion day (in accordance with [2020 c. 1](#), [Sch. 5 para. 1\(1\)](#)), see [reg. 1](#)

7. In rule 33 (copies of representations and specimens), after paragraph (2) insert “ (3) This rule shall not apply to re-registered designs or re-registered international designs. ”

**Changes to legislation:** There are currently no known outstanding effects for the The Designs and International Trade Marks (Amendment etc.) (EU Exit) Regulations 2019, SCHEDULE 6. (See end of Document for details)

**Commencement Information**

**I8** Sch. 6 para. 7 in force at 31.12.2020 on IP completion day (in accordance with 2020 c. 1, **Sch. 5 para. 1(1)**), see reg. 1

[<sup>F48</sup>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”. ]

**Textual Amendments**

**F4** Sch. 6 para. 8 substituted (31.12.2020 immediately before IP completion day) by [The Intellectual Property \(Amendment etc.\) \(EU Exit\) Regulations 2020 \(S.I. 2020/1050\)](#), regs. 1(2), **24(d)**

**Commencement Information**

**I9** Sch. 6 para. 8 in force at 31.12.2020 on IP completion day (in accordance with 2020 c. 1, **Sch. 5 para. 1(1)**), see reg. 1

[<sup>F59</sup>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.”.]

**Textual Amendments**

**F5** Sch. 6 para. 9 inserted (31.12.2020 immediately before IP completion day) by [The Intellectual Property \(Amendment etc.\) \(EU Exit\) Regulations 2020 \(S.I. 2020/1050\)](#), regs. 1(2), **24(e)**

**Commencement Information**

**I10** Sch. 6 para. 9 in force at 31.12.2020 on IP completion day (in accordance with 2020 c. 1, **Sch. 5 para. 1(1)**), see reg. 1

**Changes to legislation:**

There are currently no known outstanding effects for the The Designs and International Trade Marks (Amendment etc.) (EU Exit) Regulations 2019, SCHEDULE 6.