

SCHEDULE 1

Regulation 3

Amendments to the Design Regulation and 2005 Regulations relating to the creation and application of the supplementary unregistered design right etc.

PART 1

Design Regulation and supplementary unregistered designs

Introductory

- 1.—(1) The Design Regulation is amended as set out in this Part.
- (2) A reference in this Part to an Article is to an Article of the Design Regulation.

Substitution of Article 1 – supplementary unregistered designs

2. For Article 1, substitute—

“Article 1

Supplementary unregistered design

1. A design which complies with the conditions contained in this Regulation is referred to as a “supplementary unregistered design”.
2. A design shall be protected as a supplementary unregistered design, if made available to the public in the manner provided for in this Regulation.
3. But a design that is made available to the public before exit day is not protected under this Regulation.”.

Omission of Article 2 (European Union Intellectual Property Office)

3. Omit Article 2.

Amendments to Article 3 (definitions)

4. In Article 3, after point (c), insert—
 - “(d) ‘qualifying country’ and ‘qualifying territory’ mean a country or territory designated by regulations made under Article 7.”.

Amendments to Article 4 (requirements for protection)

5. In Article 4(1), for “Community”, substitute “supplementary unregistered”.

Amendments to Article 5 (novelty)

6. In Article 5(1)—
 - (a) in point (a)—
 - (i) for “an”, substitute “a supplementary”;
 - (ii) omit “Community”;
 - (b) omit point (b).

Amendments to Article 6 (individual character)

7. In Article 6(1)—
- (a) in point (a)—
 - (i) for “an”, substitute “a supplementary”;
 - (ii) omit “Community”;
 - (b) omit point (b).

Substitution of Article 7 (disclosure)

8. For Article 7, substitute—

“Article 7

Disclosure

1. Subject to paragraph 4, for the purposes of applying Articles 5 and 6, a supplementary unregistered design shall be deemed to have been made available to the public where paragraph 2 or 3 applies.

2. This paragraph applies where before exit day, the design was published or exhibited, used in trade or otherwise disclosed except where those events could not have become known in the normal course of business to the circles specialised in the sector operating within the European Union.

3. This paragraph applies where on or after exit day but before the date mentioned in Articles 5(1)(a) or 6(1)(a), the design was published or exhibited, used in trade or otherwise disclosed except where those events could not have become known in the normal course of business to the circles specialised in the sector operating within the United Kingdom, a qualifying country or a qualifying territory.

4. A design shall not, however, be deemed to have been made available to the public for the sole reason that it has been disclosed to a third person under explicit or implicit conditions of confidentiality.

5. For the purposes of this Regulation, a “qualifying country” is a country designated as such, and a “qualifying territory” is a territory designated as such, in Regulations made by the Secretary of State.

6. Regulations under paragraph 5 are to be made by statutory instrument and are subject to annulment in pursuance of a resolution of either House.”

Amendments to Articles 8 to 10 (technical function, interconnections, public policy and morality)

9. In Articles 8, 9 and 10(1), for “Community”, in each place it appears, substitute “supplementary unregistered”.

Amendments to Article 11 (commencement and term of protection of the unregistered Community design)

10. In Article 11—
- (a) in the heading—
 - (i) before “unregistered”, insert “supplementary”;

- (ii) omit “Community”;
- (b) in point 1—
 - (i) for “an”, substitute “a supplementary”;
 - (ii) omit “Community”, the in the first place it appears;
 - (iii) for “Community”, in the second place it appears, substitute “United Kingdom, a qualifying country or a qualifying territory”;
- (c) in paragraph 2, for “Community”, in both places it appears, substitute “United Kingdom, a qualifying country or a qualifying territory”.

Omission of Articles 12 and 13 (registered Community design: commencement, term of protection and renewal)

11. Omit Articles 12 and 13.

Amendment to the heading of section 3 of Title 2 (right to the Community design)

12. In the heading of section 3 of Title 2, for “Community”, substitute “supplementary unregistered”.

Amendments to Article 14 (right to the Community design)

13. In Article 14—
- (a) for “Community”, in each place it appears, including in the heading, substitute “supplementary unregistered”;
 - (b) in point 3, omit “or specified under national law”.

Amendments to Article 15 (claims relating to the entitlement to a Community design)

14. In Article 15—
- (a) in the heading, for “Community”, substitute “supplementary unregistered”;
 - (b) in point 1—
 - (i) for “an”, substitute “a supplementary”;
 - (ii) omit “Community”, in the first place it appears;
 - (iii) omit from “, or a registered” to “name of,”;
 - (iv) for “the Community”, substitute “that”;
 - (c) in point 2, for “Community”, substitute “supplementary unregistered”;
 - (d) in point 3—
 - (i) omit “the date of publication of a registered Community design or”;
 - (ii) for “an”, substitute “a supplementary”;
 - (iii) omit “Community”, in the second place it appears;
 - (iv) for “the unregistered Community”, substitute “that”;
 - (v) omit “applied for or”;
 - (e) omit point 4.

Omission of Articles 16 to 18 (effects of a judgment on entitlement, presumption, right to be cited)

15. Omit Articles 16 to 18.

Amendment to the heading of section 4 of Title 2 (effects of the Community design)

16. In the heading of section 4 of Title 2, for “Community”, substitute “supplementary unregistered”.

Amendments to Article 19 (rights conferred by the Community design)

17. In Article 19—

- (a) in the heading, for “Community”, substitute “supplementary unregistered”;
- (b) in paragraph 1, for “registered Community”, substitute “supplementary unregistered”;
- (c) in point 2—
 - (i) for “An”, substitute “A supplementary”;
 - (ii) omit “Community”;
- (d) omit point 3.

Amendments to Article 20 (limitation of the rights conferred by a Community design)

18. In Article 20—

- (a) in the heading and in point 1, for “Community”, substitute “supplementary unregistered”;
- (b) in point 2—
 - (i) in the words before point (a), for “Community”, substitute “supplementary unregistered”;
 - (ii) in points (a) and (b), for “Community”, substitute “United Kingdom”.

Amendments to Article 21 (exhaustion of rights)

19. In Article 21—

- (a) for “Community”, in the first, second and fourth place it appears, substitute “supplementary unregistered”;
- (b) before “Community”, in the third place it appears, insert “United Kingdom or the European Economic Area”.

Omission of Articles 22 and 23 (prior use and government use)

20. Omit Articles 22 and 23.

Amendments to Article 24 (declaration of invalidity)

21. In Article 24—

- (a) omit point 1;
- (b) in point 2—
 - (i) for “Community”, in the first place it appears, substitute “supplementary unregistered”;
 - (ii) for “the Community design”, substitute “it”;

- (iii) omit “or has been surrendered”;
- (c) in point 3—
 - (i) for “Community”, in the first place it appears, substitute “supplementary unregistered”;
 - (ii) omit “Community”, in the second place it appears.

Amendments to Article 25 (grounds for invalidity)

- 22.** In Article 25—
- (a) in point 1—
 - (i) in the words before subparagraph (a), for “Community”, substitute “supplementary unregistered”;
 - (ii) in point (c), omit “Community”;
 - (iii) omit point (d);
 - (iv) in point (e)—
 - (aa) omit “Community law or”;
 - (bb) omit “of the Member State”;
 - (v) in point (f)—
 - (aa) omit “the”, in the second place it appears;
 - (bb) omit “of a Member State”;
 - (vi) in point (g), for “a Member State”, substitute “the United Kingdom, a qualifying country or a qualifying territory”;
 - (b) in point 2, for “Community”, substitute “supplementary unregistered”;
 - (c) in point 3—
 - (i) omit “(d),”;
 - (ii) omit “the applicant for or”;
 - (d) omit points 5 and 6.

Amendments to Article 26 (consequences of invalidity)

- 23.** In Article 26—
- (a) in point 1, for “Community”, substitute “supplementary unregistered”;
 - (b) in point 2—
 - (i) omit “the national provisions relating either to”;
 - (ii) for “Community”, in both places it appears, substitute “supplementary unregistered”.

Amendment to the heading of Title 3: supplementary unregistered designs as objects of property

- 24.** In the heading of Title 3, for “Community”, substitute “Supplementary Unregistered”.

Amendments to Article 27: supplementary unregistered design rights as national design rights

- 25.** In Article 27—

Status: This is the original version (as it was originally made).

- (a) for the heading, substitute “Property right”;
- (b) for points 1 to 4, substitute “A supplementary unregistered design is personal property (in Scotland, incorporeal moveable property) which subsists in accordance with this Regulation.”.

Omission to Articles 28 to 31 (transfer, rights in rem, levy and insolvency)

26. Omit Articles 28 to 31.

Article 32 (licensing)

27. In Article 32—

- (a) in point 1—
 - (i) for “Community”, in the first place it appears, substitute “supplementary unregistered”;
 - (ii) omit “for the whole or part of the Community”;
- (b) in points 2 to 4, for “Community”, in each place it appears, substitute “supplementary unregistered”;
- (c) omit point 5.

Omission of Articles 33 to 78 (general provisions)

28. Omit Articles 33 to 78.

Amendment to the heading of Title 9 (jurisdiction and procedure in legal actions relating to Community designs)

29. In the heading of Title 9, for “Community”, substitute “Supplementary Unregistered”.

Omission of Article 79 (application of the Convention on jurisdiction and enforcement)

30. Omit Article 79.

Amendment to the heading of section 2 (disputes concerning infringement and validity of designs) of Title 9

31. In the heading of section 2 of Title 9, for “Community”, substitute “supplementary unregistered”.

Omission of Article 80 (Community design courts)

32. Omit Article 80.

Substitution of Article 81 (The “design court” – jurisdiction over infringement and validity)

33. For Article 81, substitute—

“Article 81

The “design court” – Jurisdiction over infringement and validity

1. In this Regulation, “design court” means—

- (a) in England and Wales, the High Court;
 - (b) in Scotland, the sheriff court and the Court of Session; and
 - (c) in Northern Ireland, the county court and the High Court.
2. The design court has exclusive jurisdiction—
- (a) for infringement actions and actions in respect of threatened infringement of supplementary unregistered designs;
 - (b) for actions for declaration of non-infringement of supplementary unregistered designs;
 - (c) for actions for a declaration of invalidity of a supplementary unregistered design;
 - (d) for counterclaims for a declaration of invalidity of a continuing a supplementary unregistered design raised in connection with actions under (a).”

Omission of Articles 82 and 83: jurisdiction

34. Omit Articles 82 and 83.

Amendments to Article 84 (action or counterclaim for a declaration of invalidity of a supplementary unregistered design)

35. In Article 84—
- (a) in the heading and in paragraph 1, for “Community”, substitute “supplementary unregistered”;
 - (b) in point 2—
 - (i) before “(4)”, insert “and”;
 - (ii) omit “and (5)”;
 - (c) in point 3—
 - (i) for “Community”, substitute “supplementary unregistered”;
 - (ii) for “conditions” to “situated”, substitute “laws applying to the design courts”;
 - (d) in point 4, for “Community”, substitute “supplementary unregistered”.

Amendments to Article 85 (presumption of validity – defence as to the merits)

36. In Article 85—
- (a) omit point 1;
 - (b) in point 2—
 - (i) for “an”, in the third place it appears, substitute “a supplementary”;
 - (ii) omit “Community”, in the first and second places it appears;
 - (iii) for “Community”, in the third and fourth places it appears, substitute “supplementary unregistered”.

Amendments to Article 86 (judgments of invalidity)

37. In Article 86—
- (a) in point 1—
 - (i) in the words before point (a)—
 - (aa) omit “Community”, in the first place it appears;

Status: This is the original version (as it was originally made).

- (bb) for “Community”, in the second place it appears, substitute “supplementary unregistered”;
- (ii) in points (a) and (b), for “the Community”, in each place it appears, substitute “that”;
- (b) omit points 2 to 5.

Omission of Articles 87 and 88 (effect of judgment on invalidity and applicable law)

38. Omit Articles 87 and 88.

Amendments to Article 89 (sanctions in actions for infringement)

39. In Article 89—

- (a) in point 1—
 - (i) in the words before point (a)—
 - (aa) omit “Community”, in the first place it appears;
 - (bb) for “Community”, in the second place it appears, substitute “supplementary unregistered”;
 - (ii) in point (a), for “the Community”, substitute “that”;
 - (iii) in point (d), omit from “the law” to “international”;
- (b) omit point 2.

Amendments to Article 90 (provisional measures, including protective measures)

40. In Article 90—

- (a) in point 1—
 - (i) omit “of a Member State”;
 - (ii) omit “Community”, in the first place it appears;
 - (iii) for “Community”, in the second place it appears, substitute “supplementary unregistered”;
 - (iv) omit from “under” to the end of the sentence;
- (b) in point 2, for “Community”, substitute “supplementary unregistered”;
- (c) in point 3—
 - (i) omit “Community”;
 - (ii) omit from “whose” to “(4)”;
 - (iii) omit from “, which” to “jurisdiction”.

Omission of Articles 91 and 92 (specific rules on related actions and appeals)

41. Omit Articles 91 and 92.

Amendment to the heading of section 3 (other disputes concerning Community designs) of Title 9

42. In the heading of section 3 of Title 9, for “Community”, substitute “supplementary unregistered”.

Omission of Articles 93 (supplementary provisions on the jurisdiction of national courts)

43. Omit Article 93.

Amendments to Article 94 (obligation of the national court)

44. In Article 94—

- (a) for “national”, substitute “design”, in the heading and the other place it appears;
- (b) for “Community”, substitute “supplementary unregistered”.

Omission of Title 10 (effects on the laws of the Member States)

45. Omit Title 10.

Omission of Title 11 (supplementary provisions regarding the Office)

46. Omit Title 11.

Omission of Title 11A (international registration)

47. Omit Title 11A.

Omission of Articles 107 to 109 (implementing regulation, procedure of Boards of Appeal and Committee)

48. Omit Articles 107 to 109.

Omission of Article 110 (transitional provision)

49. In Article 110—

- (a) in point 1—
 - (i) omit from “Until” to “subject,”;
 - (ii) for “Community”, substitute “supplementary unregistered”;
- (b) omit point 2.

Omission of Article 110a (provisions relating to the enlargement of the Community)

50. Omit Article 110a.

Omission of Article 111 (entry into force)

51. Omit paragraphs 2 and 3.

Omission of text after Title 12

52. After Title 12, omit “This Regulation shall be binding in its entirety and directly applicable in all Member States.”.

PART 2

2005 Regulations and the supplementary unregistered design right

53. The 2005 Regulations are amended as follows.

Regulation 1: interpretation

54. In regulation 1—

(a) for the definitions in paragraph (2), substitute—

““design court” has the meaning given by Article 81 of the Design Regulation;

“Design Regulation” means Council Regulation (EC) No 6/2002 of 12th December 2001 on Community Designs as amended by regulation 4(1) of, and Part 1 of Schedule 1 to, the Designs and International Trade Marks (Amendment etc.) (EU Exit) Regulations 2018; and

“supplementary unregistered design” has the meaning given by Article 1 of the Design Regulation.”;

(b) omit paragraph (3).

Regulation 1A: infringement proceedings

55. In regulation 1A—

(a) in paragraph (1) omit “Community”, in both places it appears;

(b) in paragraph (2)—

(i) for “paragraphs (3) to”, substitute “paragraph”;

(ii) for “Community”, in both places where it appears, substitute “supplementary unregistered”;

(c) omit paragraphs (3) and (4);

(d) in paragraph (5)—

(i) for “an”, in both places where it appears before “unregistered”, substitute “a supplementary”;

(ii) omit “Community”, in both places where it appears.

Regulation 1B: order for delivery up

56. In regulation 1B—

(a) in paragraph (1)(b)—

(i) for “Community”, in the first and second places where it appears, substitute “supplementary unregistered”;

(ii) omit “Community”, in the third place where it appears;

(iii) before “court”, in the second place where it appears, insert “design”;

(b) in paragraph (2), before “court”, in both places where it appears, insert “design”;

(c) in paragraph (4), for “Community”, substitute “supplementary unregistered”;

(d) in paragraph (8), before “court”, insert “design”.

Regulation 1C: order for disposal

57. In regulation 1C—

(a) in paragraph (1)—

(i) in the words before sub-paragraph (a), omit “Community”;

(ii) in sub-paragraph (a), for “Community”, substitute “supplementary unregistered”;

(iii) in sub-paragraph (b), before “court”, insert “design”;

(b) in paragraph (2)—

(i) before “court”, insert “design”;

(ii) for “Community”, substitute “supplementary unregistered”;

(c) in paragraphs (3) and (4), before “court”, insert “design”.

Regulation 1D: meaning of “infringing article”

58. In regulation 1D—

(a) in paragraphs (2), (3)(b) and (4), for “Community”, in each place where it appears, substitute “supplementary unregistered”;

(b) in paragraph (5), for the words from “an enforceable” to the end substitute “anything which forms part of retained EU law as a result of section 3 or 4 of the European Union (Withdrawal) Act 2018(1)”.

Regulation 2: unjustified threats: threats of infringement proceedings

59. In regulation 2(1), for “Community”, in both places where it appears, substitute “supplementary unregistered”.

Regulation 2B: unjustified threats: permitted communications

60. In regulation 2B—

(a) in paragraph (2), for “Community”, in each place where it appears, substitute “supplementary unregistered”;

(b) in paragraph (3), before “court”, insert “design”;

(c) in paragraph (5)—

(i) omit sub-paragraphs (a)(i) and (ii);

(ii) in sub-paragraph (a)(iii)—

(aa) for “an”, substitute “a supplementary”;

(bb) omit “Community”;

(iii) in sub-paragraph (b), for “Community”, in both places where it appears, substitute “supplementary unregistered”.

Regulation 2C, 2E and 2F: unjustified threats: general

61.—(1) In regulation 2C(2), for “Community”, substitute “supplementary unregistered”.

(2) Omit regulation 2E.

(3) In regulation 2F, for “Community”, substitute “supplementary unregistered”.

(1) 2018 c.16.

Regulation 3: false representation

62. Omit regulation 3.

Regulation 4: privileged communications

63. In regulation 4—

(a) in paragraph (1), for “any”, in the second place where it appears, substitute “a supplementary unregistered”;

(b) for paragraph (3), substitute—

“(3) In paragraph (2) “professional designs representative” means a person whose name appears on the special list of professional representatives for design matters maintained by the European Union Intellectual Property Office referred to in Article 78(4) of Council Regulation (EC) 6/2002 of 12th December 2001 on Community designs as it had effect immediately before exit day.”.

Regulation 5 and the Schedule: services of the Crown

64.—(1) In regulation 5—

(a) in the heading, for “Community”, substitute “supplementary unregistered”;

(b) omit “registered Community designs and”;

(c) before “unregistered”, insert “supplementary”;

(d) omit “Community”, in the second place where it appears.

(2) In the Schedule—

(a) for “Community”, in each place where it appears, substitute “supplementary unregistered”;

(b) before “court”, in each place where it appears, insert “design”;

(c) omit paragraph 5(6).