

SCHEDULE 2

Article 3(g)

PART 1

MODIFICATIONS TO PROVISIONS OF THE ACT APPLIED TO PROTECTED INTERNATIONAL REGISTRATIONS (UK) AND REQUESTS FOR INTERNATIONAL REGISTRATION (UK)

1. The Act is modified as follows.
2. Section 1B (requirement of novelty and individual character) applies with the omission in subsection (7) of “3B(2), (3) or (5) or”.
3. Section 3A (determination of applications for registration) applies—
 - (a) with the substitution for subsection (3) of—

“(3) If it appears to the registrar that the holder of an international registration making a request for international registration (UK) of a design in respect of which protection has been applied for in a convention country is not the person who applied for protection in that country (or that person’s personal representative), he shall refuse the request”;
 - (b) with the substitution in subsection (4) for “register that thing or that design” of “confer protection for that design or thing so that it becomes a protected international registration (UK).”;
 - (c) with the insertion after subsection (4) of—

“(5) Where the registrar—

 - (a) refuses a request for international registration (UK); or
 - (b) proceeds with the grant of a request for international registration (UK) on consideration of the applicant’s observations or representations or successful appeal of a decision to refuse a request for international registration (UK),

the registrar must notify the International Bureau in accordance with Article 12 of the Geneva Act and Rule 18 of the Common Regulations.”.
4. Section 3C (date of registrations of designs) applies with the substitution for subsection (1) of—

“(1) A design which is the subject of a request for international registration (UK) shall be protected from and including the date on which the international registration produces the effect as a grant of protection under this Act notified in the statement of grant of protection under Rule 18bis of the Common Regulations.”.
5. Section 3D (appeals in relation to applications for registration) applies with the reference to section 3A as modified under paragraph 3 and the omission of the reference to section 3B.
6. Section 7A (infringement of rights in registered design) applies with the substitution for subsection (6) of—

“(6) No proceedings shall be taken in respect of an infringement of the right in a design which is the subject of a protected international registration (UK) committed before the date of issue of the statement of grant of protection under Rule 18bis of the Common Regulations.”.
7. Subsection (2) of section 7B (right of prior use) applies—
 - (a) with the omission in paragraph (a) of “under section 3”;
 - (b) with the substitution for paragraph (b) of—

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“(b) where a request was made for international registration (UK) for a design in respect of which protection has been applied for in a convention country, the date on which it was treated as having been so made.”.

8. Section 8 (duration of right in registered design) applies with the substitution for subsections (2) and (3) of—

“(2) The period for which the right subsists may be extended for a second, third, fourth and fifth period of five years, by applying to the International Bureau, in accordance with Article 17 of the Geneva Act and subject to the payment of the fees specified under the Common Regulations.

(3) If the first, second, third or fourth period expires without such application and payment being made, the protected international registration (UK) shall cease to have effect.”.

9. Section 11ZA(1B) (grounds for invalidity of registration) applies, with the omission of “3B(2), (3) or (5) or”.

10. Section 11ZB (applications for declarations of invalidity) applies—

- (a) with the insertion in subsection (2) of “or the court” after “registrar”;
- (b) with the insertion in subsection (3) of “or the court” after “registrar”;
- (c) with the insertion in subsection (5) of “or the court” after “registrar”.

11. Section 11ZE (effect of cancellation or invalidation of registration) applies—

- (a) with the omission of subsection (1);
- (b) with the insertion in subsection (2) of “or the court” after “registrar”.

12. Section 11ZF (appeals in relation to cancellation or invalidation) applies with substitution for “11 to 11ZE” of “11ZA, 11ZB, 11ZC and 11ZE”.

13. Section 14 (registration of design where application for protection in convention country has been made) applies with the reference in subsection (2) to an application for registration of a design made by virtue of section 14 being read as a request for international registration (UK) for a design in respect of which protection has been applied for in a convention country.

14. Section 15B (assignment, &c. of registered designs and applications for registered designs), applies, with the substitution for subsection (1) of—

“(1) A protected international registration (UK) is transmissible by assignment, testamentary disposition or operation of law in the same way as other personal or moveable property.”.

15. Section 40 (fees) applies with the omission of the words “the registration of designs and applications therefore, and in respect of other”.

16. Section 44 (interpretation) applies with the insertion after paragraph (4) of—

“(5) Any expression defined for the purposes of the Designs (International Registration of Industrial Designs) Order 2018(1) which is used in this Act as modified by that Order has the same meaning as in that Order.”.

(1) S.I. 2018/23.

PART 2

MODIFICATION OF RULES APPLIED TO PROTECTED INTERNATIONAL REGISTRATIONS (UK) AND REQUESTS FOR INTERNATIONAL REGISTRATION (UK)

17. The 2006 Rules are modified as follows.
18. Rule 2 applies with the insertion after paragraph (2) of—
 - “(3) Any expression defined for the purposes of the Designs (International Registration of Industrial Designs) Order 2018 which is used in the Rules as modified by that Order has the same meaning as in that Order.”
19. Rule 7 applies—
 - (a) with the substitution for paragraph (1) of—
 - “(1) Where a request was made for international registration (UK) of a design in respect of which protection has been applied for in a convention country, the applicant shall comply with the following provisions.”;
 - (b) with the substitution for paragraph (3) of—
 - “(3) At the request of the registrar the applicant must file at the Patent Office a copy of the representation of the design that was the subject of each convention application within such period as the registrar may specify in that request.”.
20. Rule 8 applies with the substitution for paragraph (1) of—
 - “(1) Where it appears to the registrar that the requirements for conferral of protection for a design so that it becomes a protected international registration (UK) are not met—
 - (a) by reason of the request for international registration (UK) not being made in accordance with the rules applicable to international registration (UK); or
 - (b) by reason of section 3A(3) or (4),the registrar must give notice of refusal to the International Bureau in accordance with article 12 of the Geneva Act and rule 18 of the Common Regulations.”.
21. Rule 17 applies with the insertion after paragraph (2) of—
 - “(3) The registrar must notify the International Bureau of the decision on the application for a declaration of invalidity under section 11ZB in accordance with article 15 of the Geneva Act and rule 20 of the Common Regulations.
 - (4) The decision mentioned in paragraph (3) means a decision from which no appeal may be brought on whether the finding of invalidation should be upheld.”.
22. Rule 36(2)(a) applies with the omission at the end of paragraph (iii) of “or” and the insertion after the final “or” of—
 - “(iv) making an application for a protected international registration (UK); or”.