

STATUTORY INSTRUMENTS

2019 No. 638

The Designs and International Trade Marks (Amendment etc.) (EU Exit) Regulations 2019

Citation and commencement

1. These Regulations may be cited as the Designs and International Trade Marks (Amendment etc.) (EU Exit) Regulations 2019 and come into force on exit day.

Commencement Information

I1 Reg. 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

Interpretation

2. In these Regulations—

“1949 Act” means the Registered Designs Act 1949;

“1994 Act” means the Trade Marks Act 1994;

“2005 Regulations” means the Community Design Regulations 2005 ^{M1};

“continuing unregistered Community design” has the meaning given by regulation 4(2);

“Design Regulation” means Council Regulation ([EC](#)) No 6/2002 of 12th December 2001 on Community Designs as amended by Council Regulation ([EC](#)) 1891/2006 of 18th December 2006 to give effect to the accession of the European Community to the Geneva Act of the Hague Agreement concerning the international registration of industrial designs and by the Decision of the European Union of 5th December 2011 on the admission of the Republic of Croatia to the European Union;

“Registered Designs Rules” means the Registered Designs Rules 2006 ^{M2}; and

“Trade Marks Rules” means the Trade Marks Rules 2008 ^{M3}.

Commencement Information

I2 Reg. 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

Marginal Citations

M1 [S.I. 2005/2339](#), amended by [S.I. 2006/1028](#), 2007/3378, 2011/1043 and 2014/2400 and the Intellectual Property (Unjustified Threats) Act 2017, c.14.

M2 [S.I. 2006/1975](#), as amended by [S.I. 2008/2683](#), 2009/546, 2013/444 and 2014/2405.

M3 [S.I. 2008/1797](#), as amended by [S.I. 2009/546](#), [S.I. 2009/2089](#), [S.I. 2012/1003](#), [S.I. 2013/2235](#), [S.I. 2018/825](#); there are other amending instruments but none are relevant.

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

3.—(1) The Design Regulation is amended by Part 1 of Schedule 1 to create the supplementary unregistered design.

(2) The 2005 Regulations are amended by Part 2 of Schedule 1 to apply them to the supplementary unregistered design.

Commencement Information

I3 Reg. 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

Unregistered Community designs existing immediately before [^{F1}IP completion day]

4.—(1) The amendments to the Design Regulation and the 2005 Regulations made by regulation 3 do not apply to an unregistered Community design which is protected under the Design Regulation immediately prior to [^{F2}IP completion day] and remains protected on [^{F2}IP completion day].

(2) That design is referred to as a “continuing unregistered Community design”.

(3) The Design Regulation and the 2005 Regulations apply to a continuing unregistered Community design subject to—

- (a) as regards the Design Regulation, the modifications set out in Part 1 of Schedule 2; and
- (b) as regards the 2005 Regulations, the modifications set out in Part 2 of Schedule 2.

- F1** Words in [reg. 4](#) heading 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\(2\)](#), [14](#)
- F2** Words in [reg. 4\(1\)](#) 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\(2\)](#), [14](#)

Commencement Information

I4 Reg. 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

Certain registered Community designs and international designs to have effect under the 1949 Act

5. Schedule 3 contains amendments to the 1949 Act to make provision:

- (a) for certain registered Community designs to be treated as registered under the 1949 Act from [^{F3}IP completion day] and about certain applications for registered Community designs made before [^{F3}IP completion day]; and
- (b) for certain international registered designs designating the European Union to be treated as registered under the 1949 Act from [^{F3}IP completion day] and about certain applications for international designs designating the European Union made before [^{F3}IP completion day].

F3 Words in [reg. 5](#) 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\(2\)](#), [15](#)

Commencement Information

- I5** Reg. 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

International trade marks

6. Schedule 4 contains 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 under the 1994 Act from [^{F4}IP completion day] and about certain applications for the protection of an international trade mark in the European Union and transformation applications made before [^{F4}IP completion day].

- F4** Words in [reg. 6](#) 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), **16**

Commencement Information

- I6** Reg. 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

Fees payable in respect of re-registered designs, international re-registered designs, and comparable trade marks (IR)

- 7.** Schedule 5 makes provision for the payment of fees in respect of—
- a re-registered design (as that term is defined for the purposes of Schedule 1A to the 1949 Act as inserted by Schedule 3);
 - an international re-registered design (as that term is defined for the purposes of Schedule 1B to the 1949 Act as inserted by Schedule 3);
 - a comparable trade mark (IR) (as that term is defined for the purposes of Schedule 2B to the 1994 Act as inserted by Schedule 4).

Commencement Information

- I7** Reg. 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

Amendments to the Registered Designs Rules

- 8.** Schedule 6, which contains amendments to the Registered Designs Rules, has effect.

Commencement Information

- I8** Reg. 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

Amendments to the Trade Marks Rules

- 9.** Schedule 7, which contains amendments to the Trade Marks Rules, has effect.

Commencement Information

- I9** Reg. 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

Other amendments to legislation

10.—(1) Schedule 8, which contains other amendments to legislation, has effect.

(2) [^{F5}Subject to regulation 10A,] any application or proceeding under the 1994 Act which was made or commenced before the coming into force of these Regulations shall be dealt with under the 1994 Act as it had effect before paragraph (1) comes into force.

- F5** Words in [reg. 10\(2\)](#) inserted (26.11.2021) by [The Trade Marks and International Trade Marks \(Amendment\) \(EU Exit\) Regulations 2021 \(S.I. 2021/1235\)](#), regs. 1, 6

Commencement Information

- I10** Reg. 10 in force at 31.12.2020 on IP completion day (in accordance with [2020 c. 1, Sch. 5 para. 1\(1\)](#)), see reg. 1

[^{F6}Qualification to Transitional Provision

10A.—(1) Opposition or invalidation proceedings other than excluded proceedings (“relevant proceedings”) shall be dealt with under the 1994 Act as it had effect before regulation 10(1) came into force subject to the provisions set out in this regulation.

(2) The provisions in paragraphs (5) and (6) apply to relevant proceedings where the conditions in paragraph (4) are met.

(3) The provisions in paragraph (8) apply to relevant proceedings in the circumstances mentioned in that paragraph.

(4) The conditions mentioned in paragraph (2) are that—

- (a) the relevant proceedings are based, whether wholly or partially, on the ground that there exists an earlier trade mark (“a relevant earlier mark”) which is—
- (i) an existing EUTM,
 - (ii) an existing EUTM application,
 - (iii) an existing IR(EU), or
 - (iv) an existing ITM application or existing request for EU extension;
- (b) in the case of proceedings referred to in sub-paragraphs (a)(i) and (iii), the comparable trade mark (EU) or comparable trade mark (IR) which derives from the existing EUTM or the existing IR(EU) (as the case may be) is the subject of—
- (i) a declaration of invalidity under section 47 of the 1994 Act,
 - (ii) a revocation decision under section 46 of the 1994 Act based on grounds other than those contained in section 46(1)(a) or (b) of the 1994 Act with effect from a date prior to the date of filing of the application for registration of the trade mark the subject of the relevant proceedings or (where applicable) the date of the priority claimed in respect of that application, or
 - (iii) an application for a declaration of invalidity or revocation as referred to in sub-paragraphs (i) and (ii);

- (c) in the case of proceedings referred to in sub-paragraphs (a)(ii) and (iv), an application for registration of a trade mark based upon the existing EUTM application pursuant to paragraph 25 of Schedule 2A to the 1994 Act or an application for registration of a trade mark based upon the existing ITM application or the existing request for EU extension pursuant to paragraph 28 or 29 of schedule 2B to the 1994 Act (as the case may be)—
 - (i) has been made and the application has neither resulted in the registration of the trade mark nor the registration being refused (“a pending TM application”),
 - (ii) has resulted in the registration of the trade mark in part only,
 - (iii) has resulted in the registration of the trade mark, which registration is the subject of a revocation decision or an application for the same under section 46 of the 1994 Act based on grounds other than those contained in section 46(1)(a) or (b) of the 1994 Act with effect from a date prior to the date of filing of the application for registration of the trade mark the subject of the relevant proceedings or (where applicable) the date of the priority claimed in respect of that application, or
 - (iv) has resulted in the registration of the trade mark which registration is the subject of a declaration of invalidity or an application for the same under section 47 of the 1994 Act.
 - (5) In the case of an application for a declaration of invalidity or revocation as referred to in paragraphs (4)(b)(iii) and (4)(c)(iii) and (iv) (“pending proceedings”) or a pending TM application, the registrar may decide that the relevant proceedings be determined only after—
 - (a) a final decision has been made in the pending proceedings;
 - (b) the trade mark the subject of the pending TM application has been registered whether in whole or in part or the trade mark has not proceeded to registration for any reason, including as a result of the application not being accepted or it being successfully opposed, withdrawn or abandoned.
 - (6) Where—
 - (a) the comparable trade mark (EU) or comparable trade mark (IR) referred to in paragraph (4)(b) is the subject of a final decision which declares the registration invalid to any extent or revokes the registration to any extent on grounds other than those contained in section 46(1)(a) or (b) of the 1994 Act with effect from a date prior to the date of filing of the application for registration of the trade mark the subject of the relevant proceedings or (where applicable) the date of the priority claimed in respect of that application,
 - (b) the application for registration of a trade mark referred to in paragraph (4)(c) has resulted in the registration of the trade mark in part only, or
 - (c) the trade mark referred to in paragraph (4)(c)(iii) or (iv) is the subject of a final decision which revokes the registration to any extent on grounds other than those contained in section 46(1)(a) or (b) of the 1994 Act with effect from a date prior to the date of filing of the application for registration of the trade mark the subject of the relevant proceedings or (where applicable) the date of the priority claimed in respect of that application, or which declares the registration invalid to any extent,
- the registrar may decide that the relevant proceedings shall be dealt with under the 1994 Act as it had effect before regulation 10(1) came into force taking account of the provisions in paragraph (7).
- (7) A relevant earlier mark on which the relevant proceedings were based may be relied on if or to the same extent that—
 - (a) the registration of the comparable trade mark (EU) or comparable trade mark (IR) referred to in paragraph (6)(a) is not declared invalid or the registration is not revoked,
 - (b) the application for registration of a trade mark referred to in paragraph (6)(b) is registered, or

- (c) the trade mark referred to in paragraph (6)(c) is not revoked or declared invalid.
- (8) Where the relevant proceedings are based whether wholly or partially on the ground that there exists a relevant earlier mark which is—
- (a) an existing EUTM or an existing IR(EU) which is the subject of an opt out notice,
 - (b) an existing EUTM application, an existing ITM application or an existing request for EU extension in respect of which—
 - (i) no application has been made for registration of the same trade mark pursuant to paragraph 25 of Schedule 2A to the 1994 Act or paragraph 28 or 29 of Schedule 2B to the 1994 Act (as the case may be) and the period within which such application must be made, as provided in those paragraphs, has expired, or
 - (ii) an application for registration of the same trade mark has been made pursuant to the provisions referred to in sub-paragraph (i) and the trade mark has not proceeded to registration whether in whole or in part for any reason, including as a result of the application not being accepted, or it being successfully opposed, withdrawn or abandoned,

the relevant proceedings shall be dealt with under the 1994 Act as it had effect before regulation 10(1) came into force except the registrar may decide that the existing EUTM, existing IR(EU), existing EUTM application, existing ITM application or existing request for EU extension (as the case may be) may not be relied upon as an earlier trade mark for the purposes of the relevant proceedings.

- (9) In this regulation—
- (a) “excluded proceedings” means opposition or invalidation proceedings which have been the subject of a decision on the substantive issues raised in the proceedings prior to the coming into force of this regulation;
 - (b) “final decision” means a decision which has been determined and there is no possibility of the determination being varied or set aside (disregarding any power to grant permission to appeal out of time);
 - (c) the terms “existing EUTM”, “comparable trade mark (EU)” and “existing EUTM application” have the meanings given respectively by paragraphs 1(1), 1(2) and 24(1) of Schedule 2A to the 1994 Act;
 - (d) the term “opt out notice”, in relation to an existing EUTM, has the meaning given by paragraph 2(1) of Schedule 2A to the 1994 Act and in relation to an existing IR(EU) has the meaning given by paragraph 2(1) of Schedule 2B to the 1994 Act;
 - (e) the terms “existing IR(EU)” and “comparable trade mark (IR)” have the meanings given respectively by paragraphs 1(1) and 1(4) of Schedule 2B to the 1994 Act;
 - (f) the terms “existing ITM application” and “existing request for EU extension” have the meanings given by paragraph 33(7) of Schedule 2B to the 1994 Act.]

<p>F6 Reg. 10A inserted (26.11.2021) by The Trade Marks and International Trade Marks (Amendment) (EU Exit) Regulations 2021 (S.I. 2021/1235), regs. 1, 7</p>
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Revocation

11. The Community Designs (Designation of Community Design Courts) Regulations 2005 ^{M4} are revoked.

Commencement Information

I11 Reg. 11 in force at 31.12.2020 on IP completion day (in accordance with [2020 c. 1, Sch. 5 para. 1\(1\)](#)), see reg. 1

Marginal Citations

M4 [S.I. 2005/696](#).

Department for Business, Energy and Industrial
Strategy

Chris Skidmore
Minister of State for Universities, Science,
Research and Innovation

We consent to the making of these regulations

Rebecca Harris
Jeremy Quin
Two of the Lords Commissioners of Her
Majesty's Treasury

Changes to legislation:

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