
DRAFT STATUTORY INSTRUMENTS

2019 No. XXXX

**EXITING THE EUROPEAN UNION
DESIGNS
TRADE MARKS**

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

*Made - - - - - ***
Coming into force into force in accordance with
regulation 1*

**THE DESIGNS AND INTERNATIONAL TRADE MARKS
(AMENDMENT ETC.) (EU EXIT) REGULATIONS 2019**

1. Citation and commencement
2. Interpretation
3. Amendments to the Design Regulation and the 2005 Regulations relating to the creation and application of the supplementary unregistered design etc.
4. Unregistered Community designs existing immediately before exit day
5. Certain registered Community designs and international designs to have effect under the 1949 Act
6. International trade marks
7. Fees payable in respect of re-registered designs, international re-registered designs, and comparable trade marks (IR)
8. Amendments to the Registered Designs Rules
9. Amendments to the Trade Marks Rules
10. Other amendments to legislation
11. Revocation
Signature

SCHEDULE 1 — 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

1. Introductory

2. Substitution of Article 1 – supplementary unregistered designs
3. Omission of Article 2 (European Union Intellectual Property Office)
4. Amendments to Article 3 (definitions)
5. Amendments to Article 4 (requirements for protection)
6. Amendments to Article 5 (novelty)
7. Amendments to Article 6 (individual character)
8. Substitution of Article 7 (disclosure)
9. Amendments to Articles 8 to 10 (technical function, interconnections, public policy and morality)
10. Amendments to Article 11 (commencement and term of protection of the unregistered Community design)
11. Omission of Articles 12 and 13 (registered Community design: commencement, term of protection and renewal)
12. Amendment to the heading of section 3 of Title 2 (right to the Community design)
13. Amendments to Article 14 (right to the Community design)
14. Amendments to Article 15 (claims relating to the entitlement to a Community design)
15. Omission of Articles 16 to 18 (effects of a judgment on entitlement, presumption, right to be cited)
16. Amendment to the heading of section 4 of Title 2 (effects of the Community design)
17. Amendments to Article 19 (rights conferred by the Community design)
18. Amendments to Article 20 (limitation of the rights conferred by a Community design)
19. Amendments to Article 21 (exhaustion of rights)
20. Omission of Articles 22 and 23 (prior use and government use)
21. Amendments to Article 24 (declaration of invalidity)
22. Amendments to Article 25 (grounds for invalidity)
23. Amendments to Article 26 (consequences of invalidity)
24. Amendment to the heading of Title 3: supplementary unregistered designs as objects of property
25. Amendments to Article 27: supplementary unregistered design rights as national design rights
26. Omission to Articles 28 to 31 (transfer, rights in rem, levy and insolvency)
27. Article 32 (licensing)
28. Omission of Articles 33 to 78 (general provisions)
29. Amendment to the heading of Title 9 (jurisdiction and procedure in legal actions relating to Community designs)
30. Omission of Article 79 (application of the Convention on jurisdiction and enforcement)
31. Amendment to the heading of section 2 (disputes concerning infringement and validity of designs) of Title 9
32. Omission of Article 80 (Community design courts)
33. Substitution of Article 81 (The “design court” – jurisdiction over infringement and validity)
34. Omission of Articles 82 and 83: jurisdiction
35. Amendments to Article 84 (action or counterclaim for a declaration of invalidity of a supplementary unregistered design)
36. Amendments to Article 85 (presumption of validity – defence as to the merits)
37. Amendments to Article 86 (judgments of invalidity)

38. Omission of Articles 87 and 88 (effect of judgment on invalidity and applicable law)
 39. Amendments to Article 89 (sanctions in actions for infringement)
 40. Amendments to Article 90 (provisional measures, including protective measures)
 41. Omission of Articles 91 and 92 (specific rules on related actions and appeals)
 42. Amendment to the heading of section 3 (other disputes concerning Community designs) of Title 9
 43. Omission of Articles 93 (supplementary provisions on the jurisdiction of national courts)
 44. Amendments to Article 94 (obligation of the national court)
 45. Omission of Title 10 (effects on the laws of the Member States)
 46. Omission of Title 11 (supplementary provisions regarding the Office)
 47. Omission of Title 11A (international registration)
 48. Omission of Articles 107 to 109 (implementing regulation, procedure of Boards of Appeal and Committee)
 49. Omission of Article 110 (transitional provision)
 50. Omission of Article 110a (provisions relating to the enlargement of the Community)
 51. Omission of Article 111 (entry into force)
 52. Omission of text after Title 12
- PART 2 — 2005 Regulations and the supplementary unregistered design right
53. The 2005 Regulations are amended as follows.
 54. Regulation 1: interpretation
 55. Regulation 1A: infringement proceedings
 56. Regulation 1B: order for delivery up
 57. Regulation 1C: order for disposal
 58. Regulation 1D: meaning of “infringing article”
 59. Regulation 2: unjustified threats: threats of infringement proceedings
 60. Regulation 2B: unjustified threats: permitted communications
 61. Regulation 2C, 2E and 2F: unjustified threats: general
 62. Regulation 3: false representation
 63. Regulation 4: privileged communications
 64. Regulation 5 and the Schedule: services of the Crown

SCHEDULE 2 — Continuing unregistered Community designs

PART 1 — Design Regulation and continuing unregistered Community designs

1. (1) The Design Regulation applies to a continuing unregistered community...
2. Article 1: continuing unregistered Community design
3. In Article 1— (a) in the heading, before “Community”, insert...
4. Article 2: Office
5. Article 3: definitions
6. Article 4: requirements for protection
7. Article 5: novelty
8. Article 6: individual character
9. Article 7: disclosure
10. Articles 8 to 10: technical function, interconnections, public policy, morality and protection
11. Article 11: commencement and term of protection
12. Articles 12 and 13: registered Community design: commencement, term of protection and renewal

13. Article 14: right to the Community design
14. Article 15: claims relating to the entitlement to a Community design
15. Articles 16 to 18: effects of a judgment on entitlement, presumptions, right to be cited
16. Article 19: rights conferred by the Community design
17. Article 20: limitation of the rights conferred by a Community design
18. Article 21: exhaustion of rights
19. Articles 22 and 23: prior use and government use
20. Article 24: declaration of invalidity
21. Article 25: grounds for invalidity
22. Article 26: consequences of invalidity
23. Article 27: Community design rights as national design rights
24. Articles 28 to 31: transfer, rights in rem, levy and insolvency
25. Article 32: licensing
26. Articles 33 to 78: general provisions
27. Article 79: Application of the Convention on jurisdiction and enforcement
28. Article 80: Community design courts
29. Article 81: The “design court” – jurisdiction over infringement and validity
30. Articles 82 and 83
31. Article 84: action or counterclaim for a declaration of invalidity of a Community design
32. Article 85: presumption of validity – defence as to the merits
33. Article 86: judgments of invalidity
34. Articles 87 and 88: sanctions in actions for infringement
35. Article 89: sanctions in actions for infringement
36. Article 90: provisional measures, including protective measures
37. Articles 91 and 92: specific rules on related actions and further appeals
38. Article 93: supplementary provisions on the jurisdiction of national courts
39. Article 94: obligation of the national court
40. Title 10
41. Title 11: supplementary provisions concerning the Office
42. Title 11A: international registration
43. Articles 107 to 109: implementing regulation, procedure of Boards of Appeal and Committee
44. Article 110: transitional provision
45. Article 110a: provisions relating to the enlargement of the Community
46. Article 111: entry into force
47. Text after Title 12
48. PART 2 — 2005 Regulations and continuing unregistered Community designs
The 2005 Regulations apply to continuing unregistered community designs subject...
49. Regulation 1: interpretation
50. Regulation 1A: infringement proceedings
51. Regulation 1B: order for delivery up
52. Regulation 1C: order for disposal
53. Regulation 1D: meaning of “infringing article”
54. Regulation 2: unjustified threats: threats of infringement proceedings
55. Regulation 2B: unjustified threats: permitted communications
56. Regulation 2C, 2E and 2F: unjustified threats: general
57. Regulation 3: false representation
58. Regulation 4: privileged communications
59. Regulation 5 and the Schedule: services of the Crown

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

1. The 1949 Act is amended as follows.
2. Before section 13, insert— Application of the Act to certain...
3. After Schedule 1, insert— SCHEDULE1A EUROPEAN COMMUNITY REGISTERED DESIGNS Section...

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

1. The 1994 Act is amended as follows.
2. After section 54 (and before the italic heading before section...
3. Before Schedule 3, insert— SCHEDULE2B INTERNATIONAL TRADE MARKS PROTECTED IN...

SCHEDULE 5 — Fees payable in respect of re-registered designs, re-registered international designs and comparable trade marks (IR)

PART 1 — Fees payable in respect of a re-registered design or a re-registered international design

1. (1) The extension of the duration of the right in...
 2. The restoration of the right in a re-registered design or...
 3. A request for a certified copy of an entry in...
 4. The registrar may by rules provide that any person who...
 5. A request made to correct any error in the representation...
 6. A request for information under section 23 of the Act...
 7. The registrar may by regulations make provision about fees in...
 8. The Registered Designs (Fees) Rules 2016 apply to re-registered designs...
- PART 2 — Fees payable in respect of a comparable trade mark (IR)
9. The renewal of the registration of a comparable trade mark...
 10. The renewal of the registration of a comparable trade mark...
 11. The renewal of a comparable trade mark (IR) under paragraph...
 12. If a renewal fee is paid in respect of only...
 13. A request for information or inspection of documents relating to...
 14. The Trade Marks (Fees) Rules 2008 apply to comparable trade...
 15. The Commissioners for Her Majesty's Revenue and Customs may by...
 16. Regulations under paragraph 15 may make different provision as respects...
 17. A statutory instrument containing regulations under paragraph 15 is subject...
 18. The Trade Marks (Customs) Regulations 1994, to the extent that...

SCHEDULE 6 — Amendments to the Registered Designs Rules

1. The Registered Designs Rules are amended as follows.
2. After rule 2A (directions of the registrar), insert— Re-registered designs...
3. In rule 13(2)— (a) at the end of (2) insert—...
4. Omit rule 23.
5. In rule 26 (certificate of registration), after paragraph (3) insert...
6. In rule 27 (registration of interests), in paragraph (1)—
7. In rule 33 (copies of representations and specimens), after paragraph...
8. In rule 42 (address for service), in paragraph (4), for...

SCHEDULE 7 — Amendments to the Trade Marks Rules

1. The Trade Marks Rules are amended as follows.
2. In rule 2, after paragraph (2) insert—
3. Before rule 3 insert— Comparable trade mark (IR) These Rules apply to a comparable trade mark (IR) as...
4. After rule 4 insert— Prescribed comparable trade mark (IR) fees...
5. Before rule 6 insert— Application for registration based upon an...
6. In rule 14, after paragraph (3) insert—
7. Before rule 30 insert— Filing of regulations for International collective...
8. (1) Rule 47 is amended as follows.

SCHEDULE 8 — Other amendments to legislation

PART 1 — Further amendments to the 1949 Act

1. The 1949 Act is further amended as follows.
 2. In section 1B (requirement of novelty and individual character), in...
 3. In section 11ZA (grounds for invalidity of registration), in subsection...
 4. In section 11ZB (applications for declaration of invalidity), in subsection...
 5. In section 20 (rectification of register), in subsection (1B)—
 6. In section 24D (order as to disposal of infringing articles...
 7. In section 24G (meaning of “infringing article”), omit subsection (5)....
 8. After section 25 (certificate of contested validity of registration), insert—...
 9. In section 35ZA (offence of unauthorised copying etc of design...
 10. In section 44 (interpretation), in subsection (1), omit the definitions...
- PART 2 — Amendments to the Copyright, Designs and Patents Act 1988
11. The Copyright, Designs and Patents Act 1988 is amended as...
- PART 3 — Amendments to the Design Right (Proceedings before the Comptroller) Rules 1989
12. The Design Right (Proceedings before the Comptroller) Rules 1989 are...
 13. In rule 22 (costs), in paragraph (2), omit “or another...
 14. In rule 23 (service and translation of documents), in paragraph...
 15. In Schedule 1 (forms) for “another”, each time it appears...
- PART 4 — Further amendments to the 1994 Act
16. The 1994 Act is further amended as follows.
 17. (1) Section 6 is amended as follows.
 18. In section 53 omit ““international trade mark (EC)” means a...
 19. (1) Section 104 is amended as follows.

Explanatory Note