SCHEDULE 2   Regulation 4

Continuing unregistered Community designs

PART 1

Design Regulation and continuing unregistered Community designs

1.—(1) The Design Regulation applies to a continuing unregistered community design subject to the modifications in this Part.

(2) A reference in this Part to an Article is to an Article of the Design Regulation.

Article 1: continuing unregistered Community design

2. The Design Regulation has effect in relation to a continuing unregistered community design subject to the modifications in this Schedule.

3. In Article 1—

    (a) in the heading, before "Community", insert "Continuing unregistered";

    (b) in point 1, before "Community" and within the inverted commas, insert "continuing unregistered";

    (c) in point 2(a)—

        (i) for "an", substitute "a";

        (ii) before "unregistered" and within the inverted commas, insert "continuing";

    (d) omit points 2(b) and 3.

Article 2: Office

4. Omit Article 2.

Article 3: definitions

5. In Article 3, after the definition of "design", insert "(ab) "European Union" means the countries that were part of the European Union immediately before exit day;".

Article 4: requirements for protection

6. In Article 4(1), before "Community", insert "continuing unregistered".

Article 5: novelty

7. In Article 5(1)—

    (a) before "design" in the first place where it appears, insert "continuing unregistered Community"

    (b) in point (a)—

        (i) omit "in the case of an unregistered Community design,";

        (ii) for "an", substitute "a continuing";

    (c) omit point (b).

Article 6: individual character

8. In Article 6(1)—

    (a) before "design" in the first place where it appears insert "continuing unregistered Community"

    (b) in point (a)—

        (i) omit "in the case of an unregistered Community design,";

        (ii) for "an", substitute "a continuing";

    (c) omit point (b).

Article 7: disclosure

9. In Article 7—

    (a) in point 1—

        (i) after "a", in the first place where it appears, insert "continuing unregistered Community";

        (ii) omit "following registration or otherwise,";

        (iii) omit "or in Articles 5(1)(b) and 6(1)(b), as the case may be,";

        (iv) for "Community", where it appears after "operating within the", substitute "European Union";

    (b) omit points 2 and 3.

Articles 8 to 10: technical function, interconnections, public policy, morality and protection

10. In Articles 8, 9 and 10(1), before "Community", in each place where it appears, substitute "continuing unregistered".

Article 11: commencement and term of protection

11. In Article 11—

    (a) in point 1—

        (i) for "an", substitute "a continuing";

        (ii) for "Community", in the second place where it appears, substitute "European Union";

    (b) in point 2, for "Community", in both places in which it appears, substitute "European Union".

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

12. Omit Articles 12 and 13.

Article 14: right to the Community design

13. In Article 14—

    (a) before "Community", in each place where it appears including in the heading, insert "continuing unregistered";

    (b) in point 3, omit "or specified under national law".

Article 15: claims relating to the entitlement to a Community design

14. In Article 15—

    (a) in the heading, for before "Community", insert "continuing unregistered";

    (b) in point 1—

        (i) for "an", substitute "a continuing";

        (ii) omit ", or a registered Community design has been applied for or registered in the name of,";

        (iii) for "the Community", substitute "that";

    (c) in point 2, before "Community", insert "continuing unregistered";

    (d) in point 3—

        (i) omit "the date of publication of a registered Community design or";

        (ii) for "an", substitute "a continuing";

        (iii) for "the unregistered Community", substitute "that";

        (iv) omit "applied for or";

    (e) omit point 4.

Articles 16 to 18: effects of a judgment on entitlement, presumptions, right to be cited

15. Omit Articles 16 to 18.

Article 19: rights conferred by the Community design

16. In Article 19—

    (a) in the heading, before "Community", insert "continuing unregistered";

    (b) in point 1, for "registered", substitute "continuing unregistered";

    (c) in point 2, for "An", where it first appears, substitute "A continuing";

    (d) omit point 3.

Article 20: limitation of the rights conferred by a Community design

17. In Article 20—

    (a) in the heading and in point 1, before "Community", insert "continuing unregistered";

    (b) in point 2—

        (i) in the words before point (a), before "Community", insert "continuing unregistered";

        (ii) in points (a) and (b), for "Community", substitute "United Kingdom".

Article 21: exhaustion of rights

18. In Article 21—

    (a) before "Community", in the first, second and fourth places where it appears, insert "continuing unregistered";

    (b) before "Community", in the third place where it appears, insert "United Kingdom or the".

Articles 22 and 23: prior use and government use

19. Omit Articles 22 and 23.

Article 24: declaration of invalidity

20. In Article 24—

    (a) omit point 1;

    (b) in point 2—

        (i) before "Community", in both places where it appears, insert "continuing unregistered";

        (ii) omit "or has been surrendered";

    (c) in point 3—

        (i) before "Community", in the first place where it appears, insert "continuing unregistered";

        (ii) omit "Community", in the second place where it appears.

Article 25: grounds for invalidity

21. In Article 25—

    (a) in point 1—

        (i) in the words before subparagraph (a), before "Community", insert "continuing 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 where it appears;

            (bb) omit "of a Member State";

        (vi) in point (g), for "a Member State", substitute "the European Union";

    (b) in point 2, before "Community", insert "continuing unregistered";

    (c) in point 3—

        (i) omit "(d),";

        (ii) omit "applicant for or";

    (d) omit points 5 and 6.

Article 26: consequences of invalidity

22. In Article 26—

    (a) in point 1, before "Community", insert "continuing unregistered";

    (b) in point 2, in the words before subparagraph (a)—

        (i) omit "the national provisions relating either to";

        (ii) before "Community", in both places where it appears, insert "continuing unregistered".

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Article 27: Community design rights as national design rights

23. In Article 27—

(a) for the heading, substitute "Property right";

(b) for points 1 to 4, substitute "A continuing unregistered Community design right is personal property (in Scotland, incorporeal moveable property) which subsists in accordance with this Regulation.".

Articles 28 to 31: transfer, rights in rem, levy and insolvency

24. Omit Articles 28 to 31.

Article 32: licensing

25. In Article 32—

(a) in point 1—

(i) before "Community" in the first place where it appears, insert "continuing unregistered";

(ii) omit "for the whole or part of the Community";

(b) in points 2 to 4, before "Community", in every place where it appears, insert "continuing unregistered";

(c) omit points 5.

Articles 33 to 78: general provisions

26. Omit Articles 33 to 78.

Article 79: Application of the Convention on jurisdiction and enforcement

27. Omit Article 79.

Article 80: Community design courts

28. Omit Article 80.

Article 81: The "design court" – jurisdiction over infringement and validity

29. 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;

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> (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)."

Articles 82 and 83

30. For Articles 82 to 83 substitute—

"Article 82

Pending proceedings concerning a continuing unregistered Community design

1. This paragraph applies where on exit day a continuing unregistered Community design is the subject of proceedings which are pending ("pending proceedings") before a court in the United Kingdom designated for the purposes of Article 80 of the Design Regulation as it had effect immediately before exit day.

2. Subject to sub-paragraphs (3) and (4), the provisions contained or referred to in Title IX of the Design Regulation (with the exception of Articles 86(2), (3), (4) and (5) and 91) shall continue to apply to the pending proceedings as if the United Kingdom were still a Member State with effect from exit day

3. Where the pending proceedings involve a claim for infringement or for threatened infringement of a continuing unregistered Community design, without prejudice to any other relief by way of damages, accounts or otherwise available to the proprietor of the design, the design court may grant an injunction to prohibit unauthorised use of the continuing unregistered Community design.

4. For the purposes of this paragraph proceedings are treated as pending on exit day if they were instituted but not finally determined before exit day.

Article 83

Effect of injunction protecting an unregistered Community design

1. This paragraph applies where immediately before exit day an injunction is in force prohibiting the performance of acts in the United Kingdom which infringe or would infringe a continuing unregistered Community design (a "relevant injunction").

2. Subject to any order of the court to the contrary, a relevant injunction will continue to have effect and be enforceable to prohibit the performance of acts which infringe or would infringe the right in a continuing unregistered Community design to the same extent as before exit day.".

Article 84: action or counterclaim for a declaration of invalidity of a Community design

31. In Article 84—

(a) in the heading and in point 1, before "Community", insert "continuing unregistered";

(b) in point 2—

    (i) before "(4)", insert "and";

    (ii) omit "and (5)";

(c) in point 3—

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(i) before "Community", insert "continuing unregistered";

(ii) for "conditions" to "situated", substitute "laws applying to the design courts";

(d) in point 4, before "Community", insert "continuing unregistered".

Article 85: presumption of validity – defence as to the merits

32. In Article 85—

(a) omit point 1;

(b) in point 2—

(i) for "an", in the second place where it appears, substitute "a continuing unregistered";

(ii) omit "Community", in the second place where it appears;

(iii) before "Community", in the third and fourth places where it appears, insert "continuing unregistered".

Article 86: judgments of invalidity

33. In Article 86—

(a) in point 1—

(i) in the words before point (a)—

(aa) omit "Community", in the first place it appears;

(bb) before "Community", in the second place it appears, insert "continuing unregistered";

(b) in points (a) and (b), for "Community", in each place where it appears, substitute "that";

(c) omit points 2 to 5.

Articles 87 and 88: sanctions in actions for infringement

34. Omit Articles 87 and 88.

Article 89: sanctions in actions for infringement

35. In Article 89—

(a) in point 1—

(i) in the words before subparagraph (a)—

(aa) omit "Community", in the first place it appears;

(bb) before "Community", in the second place it appears, insert "continuing unregistered";

(ii) in point (a), for "the Community", substitute "that";

(iii) in point (d), omit from "the law" to "international";

(b) omit point 2.

Article 90: provisional measures, including protective measures

36. In Article 90—

(a) in point 1—

(i) omit "of a Member State";

    (ii) omit "Community", in the first place it appears;

    (iii) before "Community", in the second place it appears, insert "continuing unregistered";

    (iv) omit from "under the law" to the end of the sentence;

  (b) in point 2, before "Community", insert "continuing unregistered";

  (c) in point 3—

    (i) omit "Community";

    (ii) omit from "whose" to "(4)";

    (iii) omit from ", which" to "jurisdiction".

Articles 91 and 92: specific rules on related actions and further appeals

37. Omit Articles 91 and 92.

Article 93: supplementary provisions on the jurisdiction of national courts

38. Omit Article 93.

Article 94: obligation of the national court

39. In Article 94—

  (a) for "national", in the heading and the other time it appears, substitute "design";

  (b) after "a", the second times it appears, substitute "continuing unregistered Community".

Title 10

40. Omit Title 10.

Title 11: supplementary provisions concerning the Office

41. Omit Title 11.

Title 11A: international registration

42. Omit Title 11A.

Articles 107 to 109: implementing regulation, procedure of Boards of Appeal and Committee

43. Omit Articles 107 to 109.

Article 110: transitional provision

44. In Article 110—

  (a) in point 1—

    (i) omit from "Until" to "subject,";

    (ii) before "Community", insert "continuing unregistered";

  (b) omit point 2.

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Article 110a: provisions relating to the enlargement of the Community

45. In Article 110a—

    (a) in point 1—

        (i) for ""new Member States(s)"" substitute ""specified countries"";

       (ii) before "Community", the first time it appears, insert "continuing unregistered";

      (iii) omit "or applied for";

      (iv) for "Member States", the second time it appears, substitute "specified countries";

       (v) omit from "in order" to the end of the sentence;

    (b) omit point 2;

    (c) in point 3—

       (i) before "Community", insert "continuing unregistered";

      (ii) for "a new Member State", substitute "one or more specified countries";

    (d) in point 4—

       (i) omit "the applicant or";

      (ii) for "a new Member State", substitute "one or more specified countries";

      (iii) before "Community", insert "continuing unregistered";

      (iv) after "Article 25(1) omit "(d)".

    (e) in point 5—

       (i) omit the first sentence;

      (ii) for "Community", the second time it appears, substitute "European Union";

      (iii) for "an", substitute "a continuing".

Article 111: entry into force

46. Omit paragraphs 2 and 3.

Text after Title 12

47. After Title 12, omit "This Regulation shall be binding it its entirety and directly applicable in all Member States.".

PART 2

2005 Regulations and continuing unregistered Community designs

48. The 2005 Regulations apply to continuing unregistered community designs subject to the following modification.

Regulation 1: interpretation

49. 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 5 of, and Part 1 of

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Schedule 2 to, the Designs and International Trade Marks (Amendment etc.) (EU Exit) Regulations 2018; and

"continuing unregistered Community design" has the meaning given by Article 1 of the Design Regulation.";

(b) omit paragraph (3).

Regulation 1A: infringement proceedings

50. In regulation 1A—

(a) in paragraph (1) omit "Community", in both places where it appears;

(b) in paragraph (2)—

    (i) for "paragraphs (3) to", substitute "paragraph";

    (ii) before "Community", in both places where it appears, insert "continuing unregistered";

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

(d) in paragraph (5), for "an", in both places where it appears, substitute "a continuing".

Regulation 1B: order for delivery up

51. In regulation 1B—

(a) in paragraph (1)(b)—

    (i) before "Community", in the first and second places where it appears, insert "continuing 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), before "Community", insert "continuing unregistered";

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

Regulation 1C: order for disposal

52. In regulation 1C—

(a) in paragraph (1)—

    (i) in the words before paragraph (a), omit "Community";

    (ii) in paragraph (a), before "Community", insert "continuing unregistered";

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

(b) in paragraph (2)—

    (i) before "court, insert "design";

    (ii) before "Community", insert "continuing unregistered";

(c) in paragraphs (3) and (4), before "court", in each place where it appears, insert "design".

Regulation 1D: meaning of "infringing article"

53. In regulation 1D—

(a) in paragraph (2), before "Community", insert "continuing unregistered";

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    (b) in paragraph (3)(b)—

        (i) before "Community", in the first place where it appears, insert "continuing unregistered";

       (ii) omit "Community", in the second place where it appears;

    (c) in paragraph (4), before "Community, in both places where it appears, insert "continuing unregistered";

    (d) in paragraph (5), for "an enforceable" to the end of the sentence, insert "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

54. In regulation 2(1), before "Community", in both places where it appears, insert "continuing unregistered".

Regulation 2B: unjustified threats: permitted communications

55. In regulation 2B—

    (a) in paragraph (2), before "Community", in each place where it appears, insert "continuing 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 (b), before "Community", in both places where it appears, insert "continuing unregistered".

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

56.—(1) In regulation 2C(2), before "Community", insert "continuing unregistered".

(2) Omit regulation 2E.

(3) In regulation 2F, before "Community", insert "continuing unregistered".

Regulation 3: false representation

57. Omit regulation 3.

Regulation 4: privileged communications

58. In regulation 4—

    (a) in paragraph (1), for "any", in the second place where it appears, substitute "a continuing unregistered Community";

    (b) for paragraph (3), substitute—

       "(3) In paragraph (2) "professional designs representative" means a person whose name appears on—

          (a) the special list of professional representatives for design matters maintained by the European Union Intellectual Property Office referred to in Article 78(4) of

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(**1**) 2018 c.16.

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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

59.—(1) In regulation 5—

    (a) in the heading, before "Community", insert "continuing unregistered";

    (b) for "registered Community designs and" substitute "continuing".

  (2) In the Schedule—

    (a) before "Community", in each place where it appears, insert "continuing unregistered";

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

    (c) omit paragraph 5(6).