

## SCHEDULE 3

Regulations 5

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—

### **“12A. Application of the Act to certain registered Community designs**

**12A.** Schedule 1A makes provision—

- (a) for registered Community designs (including certain designs whose registration has expired or which have been removed from the register) to be treated as registered under this Act with effect from exit day, and
- (b) about certain applications for registered Community designs made before exit day.

### **12B. Application of the Act to certain international designs**

**12B.** Schedule 1B makes provision—

- (a) for certain designs which are registered in the international register maintained by the International Bureau of the World Intellectual Property Organization in respect of which the European Union is designated (including certain designs whose registration has expired) to be treated as registered under this Act with effect from exit day, and
- (b) about certain applications made before exit day to register in the international register maintained by the International Bureau of the World Intellectual Property Organization a design in respect of which the European Union is designated.”

3. After Schedule 1, insert—

“SCHEDULE 1A

Section 12A

## EUROPEAN COMMUNITY REGISTERED DESIGNS

### PART 1

#### Existing registered Community designs

##### **Designs registered as Community designs to be treated as registered under the Act**

(1) A design which, immediately before exit day, is entered in the RCD register and has been published in the Community Designs Bulletin as mentioned in Article 73(1) (an “existing registered Community design”) is to be treated on and after exit day as if an application for its registration had been made, and it had been registered, under this Act.

(2) A registered design which comes into being by virtue of sub-paragraph (1) is referred to in this Schedule as a “re-registered design”.

(3) This Act applies to a re-registered design as it applies to other registered designs except as otherwise provided in this Schedule.

- (4) For the purposes of this Act—
- (a) the date of registration of a re-registered design is the date on which the existing registered Community design from which the re-registered design derives was treated as registered under the Community Design Regulation, and
  - (b) the date of the application of a re-registered design is the date treated, under Article 38, as the date of filing of the application for the registration of the existing registered Community design from which the re-registered design derives.
- (5) Nothing in this Act authorises the imposition of a fee, or the making of provision by rules or regulations which authorises the imposition of a fee, in respect of any matter relating to a re-registered design (see instead provision made by regulations under Schedule 4 to the European Union (Withdrawal) Act 2018).
- (6) The following provisions of this Act do not apply to a re-registered design—
- (a) section 7A(6);
  - (b) section 18.
- (7) In this Schedule—
- (a) “the RCD register” means the register of registered Community designs maintained under Article 72;
  - (b) “the Community Design Regulation” means Council Regulation (EC) No 6/2002 of 12th December 2001 on Community Designs as it had effect immediately before exit day.

#### **Entries to be made in the register in relation to designs treated as registered under this Act**

- (1) The registrar must as soon as reasonably practicable on or after exit day enter a re-registered design in the register of designs.
- (2) The obligation under section 22(1) (inspection of registered designs) applies to a re-registered design on and after the day on which the re-registered design is entered in the register (notwithstanding that no certificate of registration has been granted).

#### **Opt out**

- (1) Subject to sub-paragraph (2), the proprietor of an existing registered Community design may at any time on or after exit day serve a notice on the registrar that the design is not to be treated as if it had been registered under this Act.
- (2) A notice under sub-paragraph (1) may not be served where on or after exit day—
- (a) the re-registered design which derives from the existing registered Community design (or any interest in it)—
    - (i) has been assigned or otherwise transferred except by an assent by personal representatives, or
    - (ii) has had an interest created in it by a mortgage, licence or other instrument; or
  - (b) proceedings based on the re-registered design have been initiated by the proprietor or with the proprietor’s consent.
- (3) A notice served under sub-paragraph (1) must—
- (a) identify the existing registered Community design; and

- (b) include the name and address of any person having an interest in the existing registered Community design which had effect before exit day in the United Kingdom and in respect of which an entry was recorded in the RCD register.
- (4) A notice under sub-paragraph (1) is of no effect unless the proprietor in that notice certifies that any such person—
  - (a) has been given not less than three months’ notice of the proprietor’s intention to serve such a notice; or
  - (b) is not affected by, or if affected consents to, the notice.
- (5) Where a notice has been served under sub-paragraph (1)—
  - (a) the design ceases with effect from exit day to be treated as if it had been registered under this Act,
  - (b) the obligation imposed on the registrar under paragraph 2 (entries to be made in the register in relation to designs treated as registered under this Act) ceases to have effect, and
  - (c) the registrar must make any necessary amendments to the register.

#### **Effect of claim of priority**

- (1) This paragraph applies where a right of priority has been claimed in accordance with Article 42 in respect of an existing registered Community design.
- (2) The proprietor of the re-registered design which derives from the existing registered Community design is to be treated on and after exit day as having the same claim of priority.
- (3) Accordingly, the relevant date for the purposes of establishing whether (or to what extent) the re-registered design is new or has individual character is the date of filing of the application for registration of a design in a convention country which formed the basis for the claim of priority.

#### **Unregistered pre-exit transfers**

- (1) This paragraph applies where immediately before exit day there is a transfer of an existing registered Community design that has not been entered in the RCD register (a “relevant transfer”).
- (2) Section 19 (registration of assignments, etc.) applies in relation to a relevant transfer as if it were an assignment of the re-registered design which derives from the existing registered Community design which has been transferred.

#### **Pre-exit licences to continue to have effect in the United Kingdom**

- (1) This paragraph applies where immediately before exit day an existing registered Community design is the subject of a licence which—
  - (a) authorises the doing of acts in the United Kingdom which would otherwise infringe an existing registered Community design, and
  - (b) does not expire on exit day (a “relevant licence”).
- (2) Subject to any agreement to the contrary between the licensee and the licensor, a relevant licence continues to authorise the doing of acts which would otherwise infringe the right in the re-registered design which derives from the existing registered Community design.
- (3) Sub-paragraph (2) is subject to the terms on which the relevant licence was granted, subject to such modifications as are necessary for their application in the United Kingdom.

(4) Section 19 (registration of assignments, etc.) applies in relation to a relevant licence as if it were a licence of the re-registered design deriving from the existing registered Community design which is subject to the relevant licence, subject to the following modification.

(5) Where immediately before exit day there is an entry in the RCD register relating to the relevant licence, section 19(5) does not apply to the licence until after the expiry of the period of 12 months beginning with the day after that on which exit day falls.

#### **Security interests in existing registered Community designs**

(1) This paragraph applies where immediately before exit day an existing registered Community design is the subject of an interest which has been granted as security and does not expire on exit day (a “relevant security interest”).

(2) References to the existing registered Community design in any document which grants or refers to the relevant security interest are to be read as including references to the re-registered design which derives from the existing registered Community design.

(3) Section 19 (registration of assignments, etc.) applies in relation to a relevant security interest as if it were a security interest granted in respect of the re-registered design deriving from the existing registered Community design which is subject to the relevant security interest, subject to the following modification.

(4) Where immediately before exit day there is an entry in the RCD register relating to the relevant security interest, section 19(5) does not apply to the document granting the interest until after the expiry of the period of 12 months beginning with the day after that on which exit day falls.

#### **Continuity of rights in relation to an existing registered Community design**

(1) References to an existing registered Community design or the registration of an existing registered Community design in any document entered into before exit day shall, unless there is evidence that the document was not intended to have effect in the United Kingdom, be read on and after exit day as including references to the re-registered design or the registration of the re-registered design which derives from the existing registered Community design.

(2) Subject to any agreement to the contrary, a consent granted before exit day by the proprietor of an existing registered Community design to the doing on or after exit day of an act in the United Kingdom which would otherwise infringe the right in the re-registered design which derives from the existing registered Community design is to be treated for the purposes of section 7A as a consent to the doing of that act granted by the registered proprietor of the re-registered design.

#### **Pending proceedings concerning an existing registered Community design**

(1) This paragraph applies where on exit day an existing registered 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 (“a Community design court”).

(2) Subject to sub-paragraphs (3) and (4), the provisions contained or referred to in Title IX of the Community Design Regulation (with the exception of Articles 86(2), (4), (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 an existing registered Community design, without prejudice to any other relief by way of damages, accounts or otherwise available to the proprietor of the existing registered Community design, the Community design court may grant an injunction to prohibit unauthorised use of the re-registered design which derives from the existing registered Community design.

(4) Where the pending proceedings involve a counterclaim for a declaration of invalidity in relation to an existing registered Community design, the Community design court may declare the registration of the re-registered design which derives from the existing registered Community design to be invalid (wholly or in part).

(5) Where the registration of a re-registered design is declared invalid to any extent, the registration shall to that extent be treated as having been invalid from the date of registration or from such other date as the court may direct.

(6) 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.

#### **Effect of injunction protecting an existing registered 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 an existing registered Community design (a “relevant injunction”).

(2) Subject to any order of the court to the contrary, a relevant injunction will have effect and be enforceable to prohibit the performance of acts which infringe or would infringe the right in a re-registered design to the same extent as in relation to the existing registered Community design from which the re-registered design derives as if it were an injunction granted by the court.

## **PART 2**

### **Applications for registered Community designs which are pending at exit day**

#### **Applications for registration pending immediately before exit day**

(1) In this Part references to an existing EU application are to an application for registration of a design under the Community Design Regulation in respect of which the conditions in sub-paragraph (2) are satisfied.

(2) The conditions referred to in sub-paragraph (1) are that immediately before exit day—

- (a) the application has been accorded a filing date pursuant to Article 38; and
- (b) the application has been neither granted nor refused by the European Union Intellectual Property Office.

(1) Where a person who has filed an existing EU application or a successor in title of that person applies for registration of the same design under this Act within a period beginning with exit day and ending with the end of the relevant period, the relevant date for the purposes of establishing whether (or to what extent) the design which is the subject of the application under this Act is new or has individual character is the earliest of—

- (a) the filing date accorded pursuant to Article 38 to the existing EU application;
- (b) the date of priority (if any) claimed under Article 42 in respect of the existing EU application.

(2) In sub-paragraph (1), the “relevant period” means the period of nine months beginning with the day after that on which exit day falls.

(3) For the purposes of this Act—

- (a) where an application is made of the type referred to in sub-paragraph (1) within the period referred to in that sub-paragraph, the date of the application is the filing date accorded pursuant to Article 38 to the existing EU application, and

- (b) where the registrar registers a design which is the subject of an application of the type referred to in sub-paragraph (1) which is made within the period referred to in that sub-paragraph, the date of registration of the design is the filing date accorded pursuant to Article 38 to the existing EU application.
- (4) Accordingly section 3C does not apply in relation to the design.

## PART 3

### Registered Community designs where publication is deferred at exit day

#### **Designs registered at the EUIPO immediately before exit day where publication is deferred**

- (1) In this Part references to a deferred design are to a design registered under the Community Design Regulation in respect of which the conditions in sub-paragraph (2) are satisfied.
- (2) The conditions referred to in sub-paragraph (1) are that immediately before exit day—
  - (a) the design is entered in the RCD register, and
  - (b) publication of the design is deferred under Article 50.
- (1) This paragraph applies where the proprietor of a deferred design or a successor in title of that person applies for registration of the same design under this Act within a period beginning with exit day and ending with the end of the relevant period.
- (2) Sections 3A(4) and 3B do not apply in relation to the application.
- (3) The relevant date for the purposes of establishing whether (or to what extent) the design which is the same as the deferred design is new or has individual character is the earliest of—
  - (a) the filing date accorded pursuant to Article 38 to the application for the deferred design;
  - (b) the date of priority (if any) claimed under Article 42 in respect of the application for the deferred design.
- (4) If the registrar registers a design which is the subject of an application of the type referred to in sub-paragraph (1) which is made within the period referred to in that sub-paragraph, the date of registration of the design is the date on which the deferred design which is the same as that design was treated as registered under the Community Design Regulation.
- (5) Accordingly section 3C does not apply in relation to the design.
- (6) In sub-paragraph (1), the “relevant period” means, the period of nine months beginning with the day after that on which exit day falls.

## PART 4

### Treatment of registered Community designs whose registrations expire during the period of six months ending on exit day

#### **Application of Part**

- (1) This Part applies to a design in respect of which the conditions in sub-paragraph (2) are satisfied (an “expired Community design”).
- (2) The conditions referred to in sub-paragraph (1) are that—

- (a) immediately before the transitional period, the design was the subject of a registration under the Community Design Regulation,
  - (b) the registration of the design expired during the transitional period (such that the design did not fall within paragraph 1(1)), and
  - (c) the registration of the design would have been capable of being renewed under Article 13 for at least one further period of five years had a request for renewal been made under Article 13 prior to that expiry.
- (3) An expired Community design is to be treated as if it were an existing registered Community design.
- (4) The provisions of Part 1 of this Schedule apply to an expired Community design as they apply to an existing Community design subject to the provisions of this Part of the Schedule.
- (5) Notwithstanding the entry in the register of designs (under paragraph 2, as applied by sub-paragraph (4)) of a re-registered design which derives from an expired Community design, the right in the re-registered design is expired until the period for which it subsists is extended in accordance with paragraph 16 (or the re-registered design is removed from the register in accordance with paragraph 16(3)).
- (6) In this paragraph, “transitional period” means the period of six months ending with exit day.

#### **Renewal of registration of an expired Community design**

- (1) Where the registration of an expired Community design is renewed in accordance with Article 13(3) of the Continuing Community Design Regulation the registrar must, as soon as reasonably practicable after the date of such renewal, record in the register of designs the extension of the period for which subsists the right in the re-registered design which derives from the expired Community design.
- (2) Where the period for which the right in a re-registered design subsists is extended under sub-paragraph (1), the right is to be treated as if it had never expired, with the result that—
- (a) anything done under or in relation to the right in the period beginning with exit day and ending with the extension under sub-paragraph (1) is to be treated as valid,
  - (b) an act which would have constituted an infringement of the right if it had not expired is to be treated as an infringement, and
  - (c) an act which would have constituted use of the design for the services of the Crown if the right had not expired is to be treated as such use.
- (3) If the registration of an expired Community design is not renewed within the time period permitted by Article 13(3) of the Continuing Community Design Regulation—
- (a) the registrar must remove from the register of designs the re-registered design which derives from the expired Community design; and
  - (b) the re-registered design ceases with effect from exit day to be treated as if it had been registered under this Act.
- (4) In this Schedule “the Continuing Community Design Regulation” means the Council Regulation (EC) No 6/2002 of 12th December 2001 on Community Designs as it has effect in EU law.

## PART 5

### Restoration of registered Community design registrations and applications

#### **Restoration of registered Community design to the RCD register**

- (1) This paragraph applies where:
  - (a) before exit day a registered Community design is removed from the RCD register pursuant to the Community Design Regulation, and
  - (b) on or after exit day the registration of the said design is restored pursuant to Article 67 of the Continuing Community Design Regulation.
- (2) Where the proprietor of the design files a request with the registrar within the period of six months beginning with the date of such restoration—
  - (a) the design will be treated as if it were an existing registered Community design on exit day;
  - (b) the provisions of Part 1 apply to the re-registered design which derives from the existing registered Community design.

#### **Restoration of application for registered Community design**

- (1) This paragraph applies where—
  - (a) before exit day an application for a registered Community design is refused pursuant to the Community Design Regulation; and
  - (b) on or after exit day the application is restored pursuant to Article 67 of the Continuing Community Design Regulation (a “relevant application”).
- (2) Where a person who has filed a relevant application or a successor in title of that person applies for registration of the same design under this Act within a period beginning with exit day and ending with the end of the relevant period, the relevant date for the purposes of establishing whether the design which is the subject of the application under this Act is new or has individual character is the earliest of—
  - (a) the filing date accorded pursuant to Article 38 to the relevant application;
  - (b) the date of priority (if any) claimed under Article 42 in respect of the relevant application.
- (3) In sub-paragraph (2), the “relevant period” means the period of nine months beginning with the day on which the application is restored as referred to in sub-paragraph (1)(b).

## PART 6

### Interpretation

#### **Interpretation**

#### **19.** In this Schedule—

- “the Community Design Regulation” has the meaning given by paragraph 1(7);
- “the Continuing Community Design Regulation” has the meaning given by paragraph 16(4);
- “existing registered Community design” has the meaning given by paragraph 1(1);
- “expired Community design” has the meaning given by paragraph 15(1);



“RCD register” has the meaning given by paragraph 1(7);

“re-registered design” has the meaning given by paragraph 1(2).

**20.** References in this Schedule to an “Article” are to an Article of the Community Design Regulation.

## SCHEDULE 1B

Section 12B

### INTERNATIONAL DESIGNS

#### PART 1

##### Existing international designs

###### **International designs in respect of which the European Union is designated to be treated as registered under the Act**

(1) A design which, immediately before exit day, meets the requirements of sub-paragraph (2) (a “protected international registered design (EU)”) is to be treated on and after exit day as if an application for its registration had been made, and it had been registered, under this Act.

(2) The requirements referred to in sub-paragraph (1) are—

- (a) the design is the subject of an international registration which designates the European Union;
- (b) the international registration has been published by the International Bureau pursuant to Article 10(3) of the Geneva Act;
- (c) the European Union Intellectual Property Office has sent to the International Bureau a statement under Rule 18*bis* of the Common Regulations under the 1999 Act and the 1960 Act of the Hague Agreement to the effect that protection is granted in relation to the design, or the period under Article 106e(1) of the Community Design Regulation for communicating to the International Bureau a notification of refusal in respect of the international registration has expired; and
- (d) the effects of the international registration so far as they relate to the design have neither been—
  - (i) refused by the European Union Intellectual Property Office pursuant to Article 106e(1) of the Community Design Regulation; nor
  - (ii) declared wholly invalid pursuant to Article 106f of the Community Design Regulation.

(3) Where prior to exit day the effects of the international registration to which a protected international registered design (EU) is subject are declared partly invalid so far as relating to that design pursuant to Article 106f of the Community Design Regulation, the re-registered international design which derives from the protected international registered design (EU) has effect under this Act to the extent that the effects of the international registration so far as relating to the design have not been declared invalid.

(4) A registered design which comes into being by virtue of sub-paragraph (1) is referred to in this Schedule as a “re-registered international design”.

(5) This Act applies to a re-registered international design as it applies to other registered designs except as otherwise provided in this Schedule.

- (6) For the purposes of this Act—
- (a) the date of registration of a re-registered international design is the date on which the protected international registered design (EU) from which the re-registered international design derives was treated as registered under the Geneva Act, and
  - (b) the date of the application of a re-registered international design is the date treated, under Article 9 of the Geneva Act, as the filing date of the application for the registration of the protected international registered design (EU) from which the re-registered international design derives.

(7) Nothing in this Act authorises the imposition of a fee, or the making of provision by rules or regulations which authorises the imposition of a fee, in respect of any matter relating to a re-registered international design (see instead provision made by regulations under Schedule 4 to the European Union (Withdrawal) Act 2018).

(8) The following provisions of this Act do not apply to a re-registered international design—

- (a) section 7A(6);
- (b) section 18.

(9) In this Schedule—

- (a) “the Community Design Regulation” means Council Regulation (EC) No 6/2002 of 12th December 2001 on Community Designs as it had effect immediately before exit day;
- (b) “the Geneva Act” means the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs adopted by the Diplomatic Conference on 2 July 1999;
- (c) “the International Bureau” means the International Bureau of the World Intellectual Property Organization; and
- (d) “international registration” means the international registration of an industrial design effected according to the Geneva Act.

#### **Entries to be made in the register in relation to designs treated as registered under this Act**

(1) The registrar must as soon as reasonably practicable on or after exit day enter a re-registered international design in the register of designs.

(2) The obligation under section 22(1) (inspection of registered designs) applies to a re-registered international design on and after the day on which the re-registered international design is entered in the register (notwithstanding that no certificate of registration has been granted).

#### **Opt out**

(1) Subject to sub-paragraph (2), the holder of the international registration to which a protected international registered design (EU) is subject (“the proprietor”) may at any time on or after exit day serve a notice on the registrar that the design is not to be treated as if it had been registered under this Act.

(2) A notice under sub-paragraph (1) may not be served where on or after exit day—

- (a) the re-registered international design which derives from the protected international registered design (EU) (or any interest in it)—
  - (i) has been assigned or otherwise transferred except by an assent by personal representatives, or
  - (ii) has had an interest created in it by a mortgage, licence or other instrument; or

- (b) proceedings based on the re-registered international design have been initiated by the proprietor or with the proprietor's consent.
- (3) A notice served under sub-paragraph (1) must:
  - (a) identify the protected international registered design (EU); and
  - (b) include the name and address of any person who, to the best of the proprietor's knowledge, has an interest in the protected international registered design (EU).
- (4) A notice under sub-paragraph (1) is of no effect unless the proprietor in that notice certifies that any such person—
  - (a) has been given not less than three months' notice of the proprietor's intention to serve such a notice; or
  - (b) is not affected by, or if affected consents to, the notice.
- (5) Where a notice has been served under sub-paragraph (1)—
  - (a) the design ceases with effect from exit day to be treated as if it had been registered under this Act,
  - (b) the obligation imposed on the registrar under paragraph 2 (entries to be made in the register in relation to designs treated as registered under this Act) ceases to have effect, and
  - (c) the registrar must make any necessary amendments to the register.

#### **Effect of claim of priority**

(1) This paragraph applies where a right of priority has been claimed in accordance with Article 6 of the Geneva Act in respect of the international registration to which a protected international registered design (EU) is subject.

(2) The proprietor of the re-registered international design which derives from the protected international registered design (EU) is to be treated on and after exit day as having the same claim of priority.

(3) Accordingly, the relevant date for the purposes of establishing whether (or to what extent) the re-registered international design is new or has individual character is the date of filing of the application for registration of a design in a convention country or a member of the World Trade Organization which formed the basis for the claim of priority.

#### **Unregistered pre-exit transfers**

- (1) This paragraph applies where immediately before exit day—
  - (a) there is a change in ownership of the international registration to which a protected international registered design (EU) is subject,
  - (b) the change in ownership has effect in respect of the European Union and the protected international registered design (EU), and
  - (c) the change in ownership has not been entered in the international register(a "relevant transfer").

(2) Section 19 (registration of assignments, etc.) applies in relation to a relevant transfer as if it were an assignment of the re-registered international design which derives from the protected international registered design (EU) which has been transferred.

### **Pre-exit licences to continue to have effect in the United Kingdom**

(1) This paragraph applies where immediately before exit day a protected international registered design (EU) is the subject of a licence which—

- (a) authorises the doing of acts in the United Kingdom which would otherwise infringe the protected international registered design (EU), and
- (b) does not expire on exit day (a “relevant licence”).

(2) Subject to any agreement to the contrary between the licensee and the licensor, a relevant licence continues to authorise the doing of acts which would otherwise infringe the re-registered international design which derives from the protected international registered design (EU).

(3) Sub-paragraph (2) is subject to the terms on which the relevant licence was granted, subject to such modifications as are necessary for their application in the United Kingdom.

(4) Section 19 (registration of assignments, etc.) applies in relation to a relevant licence as if it were a licence of the re-registered international design deriving from the protected international registered design (EU) which is subject to the relevant licence, subject to the following modification.

(5) Section 19(5) does not apply to the licence until after the expiry of the period of 12 months beginning with the day after that on which exit day falls.

### **Security interests in protected registered international registered designs (EU)**

(1) This paragraph applies where immediately before exit day a protected international registered design (EU) is the subject of an interest which has been granted as security and does not expire on exit day (a “relevant security interest”).

(2) References to the protected international registered design (EU), or the international registration to which the protected international registered design (EU) is subject, in any document which grants or refers to the relevant security interest are to be read as including references to the re-registered international design which derives from the protected international registered design (EU).

(3) Section 19 (registration of assignments, etc.) applies in relation to a relevant security interest as if it were a security interest granted in respect of the re-registered design deriving from the protected international registered design (EU) which is subject to the relevant security interest, subject to the following modification.

(4) Section 19(5) does not apply to the interest until after the expiry of 12 months beginning with the day after that on which exit day falls.

### **Continuity of rights in relation to a protected international registered design (EU)**

(1) References to a protected international registered design (EU), or the international registration to which a protected international registered design (EU) is subject, in any document entered into before exit day shall, unless there is evidence that the document was not intended to have effect in the United Kingdom, be read on and after exit day as including references to the re-registered international design or the registration of the re-registered international design which derives from the protected international registered design (EU) .

(2) Subject to any agreement to the contrary, a consent granted before exit day by the holder of the international registration to which a protected international registered design (EU) is subject to the doing on or after exit day of an act in the United Kingdom which would otherwise infringe the re-registered international design which derives from the protected international registered design (EU) is to be treated for the purposes of section 7A as a consent to the doing of that act granted by the registered proprietor of the re-registered international design.

### **Pending proceedings concerning a protected international registered design (EU)**

(1) This paragraph applies where on exit day a protected international registered design (EU) is the subject of proceedings which are pending (“pending proceedings”) before a court in the United Kingdom designated for the purposes of Article 80 (“a Community design court”).

(2) Subject to sub-paragraphs (3) and (4), the provisions contained or referred to in Title IX of the Community Design Regulation (with the exceptions of Articles 86(2), (4), (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 protected international registered design (EU), without prejudice to any other relief by way of damages, accounts or otherwise available to the holder of the international registration to which the protected international registered design (EU) is subject, the Community design court may grant an injunction to prohibit unauthorised use of the re-registered international design which derives from the protected international registered design (EU).

(4) Where the pending proceedings involve a counterclaim for a declaration of invalidity in relation to a protected international registered design (EU), the Community design court may declare the registration of the re-registered international design which derives from the protected international registered design (EU) to be invalid (wholly or in part).

(5) Where the registration of a re-registered international design is declared invalid to any extent, the registration shall to that extent be treated as having been invalid from the date of registration or from such other date as the court may direct.

(6) 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.

### **Effect of injunction protecting a protected international registered design (EU)**

(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 protected international registered design (EU) (a “relevant injunction”).

(2) Subject to any order of the court to the contrary, a relevant injunction will have effect and be enforceable to prohibit the performance of acts which infringe or would infringe the right in a re-registered international design to the same extent as in relation to the protected international registered design (EU) from which the re-registered international design derives as if it were an injunction granted by the court.

## **PART 2**

### **International registrations in respect of which the period for refusal has not expired before exit day etc.**

(1) In this Part references to a “pending international design (EU)” are to a design which, immediately before exit day, meets the requirements of sub-paragraph (2).

(2) The requirements referred to in sub-paragraph (1) are—

(a) the design is the subject of an international registration which designates the European Union;

(b) the design is not the subject of—

(i) a refusal by the European Union Intellectual Property Office pursuant to Article 106e(1) of the Community Design Regulation; or

- (ii) a statement by the European Union Intellectual Property Office under Rule 18*bis* of the Common Regulations under the 1999 Act and the 1960 Act of the Hague Agreement to the effect that protection is granted in relation to it;
  - (c) the international registration to which the design is subject—
    - (i) has not been published by the International Bureau pursuant to Article 10(3) of the Geneva Act; or
    - (ii) has been published by the International Bureau but the period under Article 106e(1) of the Community Design Regulation for communicating to the International Bureau a notification of refusal in respect of the international registration has not expired.
- (1) Where the holder of the international registration to which a pending international design (EU) is subject, or a successor in title of that person, makes an application for registration of the same design under this Act within a period beginning with exit day and ending with the end of the relevant period, the relevant date for the purposes of establishing whether (or to what extent) the design which is the subject of the application under this Act is new or has individual character is the earliest of—
- (a) the date on which the international registration was treated as registered pursuant to Article 10(2) of the Geneva Act;
  - (b) the date of priority (if any) claimed under Article 41 of the Community Design Regulation as applied by Article 106a of that Regulation in respect of the pending international design (EU).
- (2) In sub-paragraph (1), the “relevant period” means the period of nine months beginning with the day after that on which exit day falls.
- (3) For the purposes of this Act—
- (a) where an application is made of the type referred to in sub-paragraph (1) within the period referred to in that sub-paragraph, the date of the application is the date on which the international registration to which the pending international design (EU) is subject was treated as registered pursuant to Article 10(2) of the Geneva Act, and
  - (b) where the registrar registers a design which is the subject of an application of the type referred to in sub-paragraph (1) which is made within the period referred to in that sub-paragraph, the date of registration of the design is the date on which the international registration to which the pending international design (EU) is subject was treated as registered pursuant to Article 10(2) of the Geneva Act.
- (4) Accordingly section 3C does not apply in relation to the design.

## PART 3

### Treatment of international registered designs whose registrations expire during the period of six months ending on exit day

#### Application of Part

- (1) This Part applies to a design which met the requirements set out in paragraph 1(2)(b) to (d) in respect of which the conditions in sub-paragraph (2) are satisfied (an “expired international design”).
- (2) The conditions referred to in sub-paragraph (1) are that—

- (a) immediately before the transitional period, the design was the subject of an international registration which designated the European Union,
  - (b) the international registration expired during the transitional period (such that the design did not fall within paragraph 1(1)), and
  - (c) the renewal of the international registration would have been capable of being effected for the European Union in accordance with Article 17 of the Geneva Act for at least one further period of five years had a request for renewal been made in accordance with Article 17(2) prior to that expiry.
- (3) An expired international design is to be treated as if it were a protected international registered design (EU).
- (4) The provisions of Part 1 of this Schedule apply to an expired international design as they apply to a protected international registered design (EU) subject to the provisions of this Part of the Schedule.
- (5) Notwithstanding the entry in the register of designs (under paragraph 2, as applied by sub-paragraph (4)) of a re-registered international design which derives from an expired international design, the right in the re-registered international design is expired until it is extended in accordance with paragraph 14 (or the re-registered design is removed from the register in accordance with paragraph 14(3)).
- (6) In this paragraph, “transitional period” means the period of six months ending with exit day.

#### **Renewal of registration of an expired international design**

- (1) Where within the period beginning with exit day and ending with the end of the relevant period—
- (a) the international registration to which an expired international design was subject is renewed in accordance with Article 17(2) of the Geneva Act,
  - (b) the renewal has effect in respect of the European Union and the expired international design, and
  - (c) the holder of that international registration notifies the registrar of such renewal, the registrar must, as soon as reasonably practicable after the date of notification, record in the register of designs the extension of the period for which subsists the right in the re-registered international design which derives from the expired international design.
- (2) Where the period for which the right in a re-registered international design subsists is extended under sub-paragraph (1), the right is to be treated as if it had never expired, with the result that—
- (a) anything done under or in relation to the right in the period beginning with exit day and ending with the extension under sub-paragraph (1) is to be treated as valid,
  - (b) an act which would have constituted an infringement of the right if it had not expired is to be treated as an infringement, and
  - (c) an act which would have constituted use of the design for the services of the Crown if the right had not expired is to be treated as such use.
- (3) If within the period referred to in sub-paragraph (1) the holder fails to notify the registrar in accordance with sub-paragraph (1)(c)—
- (a) the registrar must remove from the register of designs the re-registered international design which derives from the expired international design, and
  - (b) the re-registered international design ceases with effect from exit day to be treated as if it had been registered under this Act.

(4) In sub-paragraph (1), the “relevant period” means the period of nine months beginning with the day after that on which exit day falls.

## PART 4

### Interpretation

#### **Interpretation**

(1) In this Schedule—

“the Community Design Regulation” has the meaning given by paragraph 1(9);

“expired international design” has the meaning given by paragraph 13(1);

“the Geneva Act” has the meaning given by paragraph 1(9);

“the International Bureau” has the meaning given by paragraph 1(9);

“international registration” has the meaning given by paragraph 1(9);

“protected international registered design (EU)” has the meaning given by paragraph 1(1);

“re-registered international design” has the meaning given by paragraph 1(4).

(2) For the purposes of paragraphs 1(2)(b) and 11(2)(c), where the international registration to which a design is subject has not been published in its entirety but the design itself has been by virtue of a request made under Article 11(4)(a) of the Geneva Act, the international registration is to be treated as having been published.”.