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*Draft Regulations laid before Parliament under paragraphs 1(1) and 12(1) of Schedule 7 to the European Union (Withdrawal) Act 2018, for approval by resolution of each House of Parliament.*

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## DRAFT STATUTORY INSTRUMENTS

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# 2020 No. XXX

## EXITING THE EUROPEAN UNION INTELLECTUAL PROPERTY

### The Intellectual Property (Amendment etc.) (EU Exit) Regulations 2020

*Made* - - - - *\*\*\**

*Coming into force in accordance with regulation 1(2)*

The Secretary of State makes these Regulations in exercise of the powers conferred by sections 8(1), 8B(1)(a) and 8B(2)(a)(1) of, and paragraph 1 of Schedule 4 and paragraph 21(b) of Schedule 7 to, the European Union (Withdrawal) Act 2018(2) and by section 36 of the Registered Designs Act 1949(3) and by section 78 of the Trade Marks Act 1994(4) and with the consent of the Treasury.

In accordance with paragraphs 1(1) and 12(1) of Schedule 7 to the European Union (Withdrawal) Act 2018, a draft of this instrument has been laid before Parliament and approved by resolution of each House of Parliament.

## PART 1

### Introduction

#### **Citation, commencement and interpretation**

**1.—(1)** These Regulations may be cited as the Intellectual Property (Amendment etc.) (EU Exit) Regulations 2020.

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(1) Section 8B was inserted by section 18 of the European Union (Withdrawal Agreement) Act 2020 c. 1.  
(2) 2018 c. 16. Section 8 is amended by section 27 of the European Union (Withdrawal Agreement) Act 2020 c. 1.  
(3) 1949 c. 88.  
(4) 1994 c. 26.

(2) These Regulations come into force immediately before IP completion day except Parts 7 and 8 which come into force on IP completion day.

(3) 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<sup>(5)</sup>;

“Design Regulation” means Council Regulation (EC) No 6/2002 of 12th December 2001 on Community Designs<sup>(6)</sup> as amended by Council Regulation (EC) No 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<sup>(7)</sup>; and

“Registered Designs Rules” means the Registered Designs Rules 2006<sup>(8)</sup>.

## PART 2

### Amendments to the Intellectual Property (Copyright and Related Rights) (Amendment) (EU Exit) Regulations 2019

2. The Intellectual Property (Copyright and Related Rights) (Amendment) (EU Exit) Regulations 2019<sup>(9)</sup> are amended in accordance with this Part.

3. For regulation 31(a) substitute—

“(a) in paragraph (3)—

(i) in sub-paragraph (a) omit “and the relevant database maintained by the Office for Harmonization in the Internal Market; and”;

(ii) omit sub-paragraph (b);”.

4. In regulation 38, for “exit day” substitute “IP completion day”.

## PART 3

### Amendments to the Intellectual Property (Exhaustion of Rights) (EU Exit) Regulations 2019

5. The Intellectual Property (Exhaustion of Rights) (EU Exit) Regulations 2019<sup>(10)</sup> are amended in accordance with this Part.

6. In regulation 2(1) for “exit day”, in each place it occurs, substitute “IP completion day”.

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(5) 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.

(6) OJ L3, 5.1.2002, p.1.

(7) OJ L386, 29.12.2006, p.14.

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

(9) S.I. 2019/605.

(10) S.I. 2019/265.

## PART 4

### Amendments to the Trade Marks (Amendment etc.) (EU Exit) Regulations 2019

7. The Trade Marks (Amendment etc.) (EU Exit) Regulations 2019<sup>(11)</sup> are amended in accordance with this Part.

8. In regulation 2, for “exit day”, in both places it occurs, substitute “IP completion day”.

9. Schedule 1 (Amendments to the 1994 Act to make provision for certain trade marks registered as European Union trade marks to be treated as registered trade marks and about certain applications for such marks) is amended as follows—

- (a) in section 52A of the 1994 Act<sup>(12)</sup> (to be inserted by paragraph 2), for “exit day”, in both places it occurs, substitute “IP completion day”;
- (b) in Schedule 2A to the 1994 Act (to be inserted by paragraph 3)—
  - (i) for “exit day”, in each place it occurs, substitute “IP completion day”;
  - (ii) after paragraph 21, insert—

#### “Existing EUTM: effect of invalidity or revocation

**21A.**—(1) This paragraph applies where, on IP completion day, an existing EUTM is the subject of proceedings under Article 58 (Grounds for revocation), 59 (Absolute grounds for invalidity) or 60 (Relative grounds for invalidity) which have been instituted but not finally determined before IP completion day (“cancellation proceedings”).

(2) Subject to sub-paragraph (4), where—

- (a) the existing EUTM is revoked or declared invalid (whether wholly or partially) pursuant to a decision in the cancellation proceedings which is finally determined, and
- (b) the registrar has—
  - (i) received notice of the situation referred to in paragraph (a) (“a cancellation notice”), or
  - (ii) otherwise become aware of the situation referred to in paragraph (a),

the registration of the comparable trade mark (EU) which derives from the existing EUTM must be revoked or declared invalid to the same extent as the existing EUTM.

(3) Where (by virtue of sub-paragraph (2)) the registration of a comparable trade mark (EU) is revoked or declared invalid to any extent, the registrar must—

- (a) remove the comparable trade mark (EU) from the register (where the revocation or declaration of invalidity relates to all the goods or services for which the existing EUTM was registered); or
- (b) amend the entry in the register listing the goods or services for which the comparable trade mark (EU) is registered (where the revocation or declaration of invalidity relates to only some of the goods or services for which the existing EUTM was registered).

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<sup>(11)</sup> S.I. 2019/269.

<sup>(12)</sup> 1994 c. 26.

(4) The registration of a comparable trade mark (EU) must not be revoked or declared invalid under sub-paragraph (2) where the grounds on which the existing EUTM was revoked or declared invalid (whether wholly or partially) would not apply or would not have been satisfied in relation to the comparable trade mark (EU)—

- (a) if the comparable trade mark (EU) had existed as at the date the cancellation proceedings were instituted, and
- (b) an application for the revocation or a declaration of invalidity of the comparable trade mark (EU) based on those grounds had been made on that date under section 46 or 47 (as the case may be).

(5) Where a comparable trade mark (EU) is revoked or declared invalid to any extent pursuant to this paragraph—

- (a) the rights of the proprietor are deemed to have ceased to that extent as from the date on which the rights of the proprietor of the existing EUTM are deemed to have ceased under the EUTM Regulation;
- (b) subject to any claim for compensation for damage caused by negligence or lack of good faith on the part of the proprietor or a claim for restitution based upon the unjust enrichment of the proprietor, the revocation or invalidity of the comparable trade mark (EU) does not affect—
  - (i) a decision arising from infringement proceedings which has been finally determined and which has been enforced prior to the date on which the entry in the register of the comparable trade mark (EU) has been removed or amended pursuant to sub-paragraph (3) (“the decision date”);
  - (ii) any contract entered into prior to the decision date to the extent that it has been performed prior to the decision date, subject to the right of a party to the contract to claim the repayment of any consideration paid under the contract where, having regard to the circumstances, it is fair and equitable for such repayment to be made.

(6) A cancellation notice may be submitted to the registrar by any person.

(7) For the purposes of this paragraph—

- (a) proceedings are instituted if an application or counterclaim for revocation or for a declaration of invalidity—
  - (i) has been filed (and not subsequently withdrawn) with the European Union Intellectual Property Office or a court designated for the purposes of Article 123, and
  - (ii) meets the requirements for being accorded a filing date under the European Union Trade Mark Regulation and Commission Delegated Regulation (EU) 2018/625 of 5th March 2018;
- (b) a decision is finally determined when—
  - (i) it has been determined, and
  - (ii) there is no further possibility of the determination being varied or set aside (disregarding any power to grant permission to appeal out of time).”.

**10.** Schedule 3 (Other amendments to the 1994 Act) is amended as follows—

- (a) for paragraph 2(4) substitute—
  - “(4) In subsection (4B)—
    - (a) in paragraph (a) for “provision of EU law” substitute “enactment or rule of law”;
    - (b) in paragraph (b) for “EU” substitute “United Kingdom”.
- (b) in paragraph 4(5)(a), for “exit day” substitute “IP completion day”;
- (c) in paragraph 10, for “exit day” substitute “IP completion day”.

**11.** Schedule 4 (Amendments to the Rules) is amended as follows—

- (a) for paragraph 6 substitute—
  - “**6.**—(1) Rule 11 is amended as follows.
    - (2) At the end of paragraph (1)(d), omit “.” and substitute “;”.
    - (3) After paragraph (1)(d) insert—
      - “(e) a proprietor of a comparable trade mark (EU) who sends a derogation notice to the registrar under rule 43A.”.
    - (4) In paragraph (4), for “another EEA state” substitute “an EEA state”.
- (b) after paragraph 6 insert—

- “**6A.**—(1) Rule 12 is amended as follows.
  - (2) At the end of paragraph (4)(d), omit “.” and substitute “;”.
  - (3) After paragraph (4)(d), insert—
    - “(e) in the case of the proprietor who sends a derogation notice to the registrar, the registrar must proceed as if the proprietor had not sent a derogation notice.”.

- (c) after paragraph 10 insert—

- “**10A.**—(1) Rule 43 is amended as follows.
  - (2) At the end of paragraph (1)(b), omit “, or” and substitute “;”.
  - (3) At the end of paragraph (1)(c), omit “,” and substitute “; or”.
  - (4) After paragraph (1)(c), insert—
    - “(d) the registration of a comparable trade mark (EU) is revoked or declared invalid to any extent under rule 43A(6),”.
  - (5) In paragraph (2), after “application and shall” insert “, in the cases referred to in paragraph (1)(a) to (c),”.
  - (6) In paragraph (3)—
    - (a) after “TM8” insert “or the derogation notice”;
    - (b) after “TM26(O)” omit “or” and substitute “;”;
    - (c) after “TM 26(I)” insert “or notification from the registrar under rule 43(4)(b) that the comparable trade mark (EU) will be revoked or declared invalid to the same extent as the corresponding EUTM”.

- 10B.** After rule 43 insert—

**“Invalidation or revocation of Existing EUTM: Cancellation notice and procedure on application for derogation; Schedule 2A paragraph 21A**

**43A.**—(1) A cancellation notice under paragraph 21A of Schedule 2A must—

- (a) identify the existing EUTM by the number under which the existing EUTM was registered in the EUTM Register immediately before IP completion day, together with a representation of the mark,
- (b) include the following details with regard to the decision pursuant to which the existing EUTM was revoked or declared invalid (whether wholly or partially)—
  - (i) the date of the decision (including any decision determined on appeal),
  - (ii) whether the revocation or declaration of invalidity related to all or part of the goods or services for which the existing EUTM was registered,
  - (iii) where the existing EUTM was revoked (whether wholly or partially) the date on which the revocation took effect,
- (c) be accompanied by a copy of the decision (including any decision determined on appeal) pursuant to which the existing EUTM was revoked or declared to be invalid, and
- (d) include a statement confirming that the decision pursuant to which the existing EUTM was revoked or declared invalid (whether wholly or partially) has been finally determined.

(2) Where a cancellation notice is submitted to the registrar by the proprietor of the comparable trade mark (EU) which derives from the existing EUTM, the cancellation notice must be accompanied by—

- (a) a notice (a “derogation notice”) in writing to the registrar that, based upon the provisions in paragraph 21A(4) of Schedule 2A, the comparable trade mark (EU) should not be revoked or declared invalid (whether wholly or partially), and
- (b) a statement of the reasons why paragraph 21A(4) of Schedule 2A applies (a “statement”) together with relevant supporting evidence (“supporting evidence”).

(3) Where the proprietor of a comparable trade mark (EU) submits a cancellation notice to the registrar but fails to send a derogation notice, a statement or supporting evidence, the registration of the comparable trade mark (EU) which derives from the existing EUTM identified in the cancellation notice must be revoked or declared invalid to the same extent as the existing EUTM, unless the registrar directs otherwise.

(4) Where the registrar receives a cancellation notice submitted by a person other than the proprietor of the comparable trade mark (EU) which derives from the existing EUTM, the registrar must as soon as reasonably practicable after receipt of the cancellation notice—

- (a) send a copy of the cancellation notice to the proprietor of the comparable trade mark (EU) which derives from the existing EUTM identified in the cancellation notice, and

(b) notify the proprietor of the comparable trade mark (EU) which derives from the existing EUTM that based upon the revocation or declaration of invalidity of the existing EUTM, the comparable trade mark (EU) will be revoked or declared invalid to the same extent as the corresponding EUTM.

(5) Where the registrar has become aware of the situation referred to in paragraph 21A(2)(a) of Schedule 2A otherwise than by a cancellation notice, the registrar must as soon as reasonably practicable after becoming aware of that situation, notify the proprietor of the comparable trade mark (EU) which derives from the existing EUTM in the terms provided in paragraph (4)(b).

(6) The proprietor of a comparable trade mark (EU) referred to in paragraph (4) and (5) must, within such period of not less than one month as may be specified in the notice referred to in paragraph (4)(b) and (5), send to the registrar a derogation notice accompanied by a statement and supporting evidence as referred to in paragraph (2), failing which the registration of the comparable trade mark (EU) must be revoked or declared invalid to the same extent as the corresponding EUTM, unless the registrar directs otherwise.

(7) The registrar must, in reaching a decision as to whether paragraph 21A(4) of Schedule 2A applies to a comparable trade mark (EU), have regard to the statement and supporting evidence filed by the proprietor of the comparable trade mark (EU) and must send written notice of the decision to the proprietor, stating the reasons for that decision.

(8) For the purposes of any appeal against a decision referred to in subparagraph (7), the date on which the notice is sent must be taken to be the date of the decision.””.

(d) in rule 47(n) (to be inserted by paragraph 11(6)), after “corresponding EUTM” insert “, and where the corresponding EUTM is subject to cancellation proceedings, that cancellation is pending”.

**12.** In Schedule 5 (Consequential amendments, repeals, revocations, transitional and saving provisions), in paragraph 6, in column 2 of the first entry in the Table, for “Schedule 12” substitute “Schedule 21”.

## PART 5

### Amendments to the Designs and International Trade Marks (Amendment etc.) (EU Exit) Regulations 2019

**13.** The Designs and International Trade Marks (Amendment etc.) (EU Exit) Regulations 2019(**13**) are amended in accordance with this Part.

**14.** In the heading to regulation 4 and in regulation 4(1), for “exit day”, in each place it occurs, substitute “IP completion day”.

**15.** In regulation 5, for “exit day”, in each place it occurs, substitute “IP completion day”.

**16.** In regulation 6, for “exit day”, in both places it occurs, substitute “IP completion day”.

**17.** Schedule 1, Part 1 (Design Regulation and supplementary unregistered designs) is amended as follows—

- (a) in Article 1(3) of the Design Regulation (as substituted by paragraph 2), for “exit day” substitute “IP completion day”;
- (b) in Article 7 of the Design Regulation (as substituted by paragraph 8), for “exit day”, in both places it occurs, substitute “IP completion day”;
- (c) for paragraph 19(b) substitute—
  - “(b) for “Community”, in the third place it appears, substitute “United Kingdom or the European Economic Area”.”;
- (d) in paragraph 27(b), for “placee” substitute “place”;
- (e) in Article 81(2)(d) (as substituted by paragraph 29), omit “a continuing”.

**18.** In Schedule 1, Part 2 (2005 Regulations and the supplementary unregistered design right), in regulation 4(3) of the 2005 Regulations (as substituted by paragraph 63(b)), for “exit day” substitute “IP completion day”.

**19.** Schedule 2, Part 1 (Design Regulation and continuing unregistered Community designs) is amended as follows—

- (a) in paragraph 5, for “exit day” substitute “IP completion day”;
- (b) in Article 81(2) of the Design Regulation (as substituted by paragraph 29)—
  - (i) in sub-paragraphs (a) to (c)—
    - (aa) for “supplementary”, in each place it occurs, substitute “continuing”;
    - (bb) after “unregistered”, insert “Community”;
  - (ii) in sub-paragraph (d)—
    - (aa) omit “a supplementary”;
    - (bb) after “unregistered”, insert “Community”;
- (c) in Articles 82 and 83 of the Design Regulation (as substituted by paragraph 30), for “exit day”, in each place it occurs, substitute “IP completion day”.

**20.** In Schedule 2, Part 2 (2005 Regulations and continuing unregistered Community designs), in regulation 4(3)(a) of the 2005 Regulations (as substituted by paragraph 58(b)), for “exit day” substitute “IP completion day”.

**21.** 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) is amended as follows—

- (a) in the heading, for “exit day”, in both places it occurs, substitute “IP completion day”;
- (b) in sections 12A and 12B of the 1949 Act (as prospectively inserted by paragraph 2), for “exit day”, in each place it occurs, substitute “IP completion day”;
- (c) in Schedule 1A to the 1949 Act (as prospectively inserted by paragraph 3)—
  - (i) for “exit day”, in each place it occurs, substitute “IP completion day”;
  - (ii) after paragraph 9 insert—

**“Existing registered Community design: effect of invalidity**

**9A.—**(1) This paragraph applies where, on IP completion day, an existing registered Community design is the subject of proceedings under Article 25 (Grounds for invalidity) which have been instituted but not finally determined before IP completion day (“invalidation proceedings”).

- (2) Subject to sub-paragraph (4) where—
- (a) the existing registered Community design is declared invalid (whether wholly or partly) pursuant to a decision which is finally determined, and
  - (b) the registrar has either—
    - (i) received notice of the situation referred to in paragraph (a) (“an invalidation notice”), or
    - (ii) otherwise become aware of the situation referred to in paragraph (a),

the registration of the re-registered design which derives from the existing registered Community design must be declared invalid to the same extent as the existing registered Community design.

(3) Where (by virtue of sub-paragraph (2)) the registration of a re-registered design is declared invalid, the registrar must—

- (a) where there is a partial declaration of invalidity, amend the entry in the register of designs;
- (b) otherwise, remove the re-registered design from the register.

(4) The registration of a re-registered design must not be declared invalid under sub-paragraph (2) where the grounds on which the existing registered Community design was declared invalid (whether wholly or partly) would not apply or would not have been satisfied in relation to the re-registered Community design if—

- (a) the re-registered design had been the subject of an entry on the register as at the date the invalidation proceedings were instituted, and
- (b) an application for a declaration of invalidity of the re-registered design based on those grounds had been made on that date under section 11ZA.

(5) Where the registration of a re-registered design is declared invalid to any extent pursuant to this paragraph—

- (a) it shall to that extent be treated as having been invalid from the date on which the rights of the proprietor of the existing registered Community design from which it derives are deemed to have ceased under the Community Design Regulation;
- (b) subject to any claim for compensation for damage caused by negligence or lack of good faith on the part of the proprietor or a claim for restitution based upon the unjust enrichment of the proprietor, the invalidity of the registration of the re-registered design does not affect—
  - (i) a decision arising from infringement proceedings which has been finally determined and which has been enforced prior to the date of the declaration of invalidity made pursuant to sub-paragraph (2) (“the invalidity declaration date”);
  - (ii) any contract entered into prior to the invalidity declaration date to the extent that it has been performed prior to that date, subject to the right of a party to the contract to claim the repayment of any consideration paid under the contract where,

having regard to the circumstances, it is fair and equitable for such repayment to be made.

(6) Where a declaration is made under sub-paragraph (2), section 11ZE(2) does not apply.

(7) An invalidation notice may be sent by any person.

(8) For the purposes of this paragraph—

(a) proceedings are instituted if an application or counterclaim for a declaration of invalidity—

(i) has been filed (and not subsequently withdrawn) with the European Union Intellectual Property Office or a court designated for the purposes of Article 80, and

(ii) meets the requirements for being accorded a filing date under the Community Design Regulation and Commission Regulation (EC) No 2245/2002 of 21 October 2002;

(b) a decision is finally determined when—

(i) it has been determined; and

(ii) there is no further possibility of the determination being varied or set aside (disregarding any power to grant permission to appeal out of time).

(9) An appeal lies from a declaration of invalidity under sub-paragraph (2).”;

(d) in Schedule 1B to the 1949 Act (as prospectively inserted by paragraph 3)—

(i) for “exit day”, in each place it occurs, substitute “IP completion day”;

(ii) in the heading to paragraph 7, omit “registered” the first time it occurs.

**22.** 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) is amended as follows—

(a) in section 54A of the 1994 Act (as prospectively inserted by paragraph 2), for “exit day”, in each place it occurs, substitute “IP completion day”;

(b) in Schedule 2B to the 1994 Act (as prospectively inserted by paragraph 3), for “exit day”, in each place it occurs, substitute “IP completion day”.

**23.** Schedule 5, Part 1 (Fees payable in respect of a re-registered design or a re-registered international design) is amended as follows—

(a) in paragraph 1(2)—

(i) omit “of six months”;

(ii) for “exit day” substitute “IP completion day”;

(b) in paragraph 1(3)—

(i) for “ending” substitute “beginning”;

(ii) for “exit day” substitute “IP completion day”.

**24.** Schedule 6 (Amendments to the Registered Designs Rules) is amended as follows—

(a) in paragraph 3(a), for “exit day”, in both places it occurs, substitute “IP completion day”;

(b) after paragraph 3 insert—

“**3A.** After rule 15 insert—

**“Invalidation of existing registered Community design: invalidation notice and procedure on application for derogation; Schedule 1A paragraph 9A**

- 15A.**—(1) An invalidation notice under paragraph 9A of Schedule 1A must—
- (a) identify the existing registered Community design by the number under which it was registered in the RCD register immediately before IP completion day, together with a representation of the design,
  - (b) be accompanied by a copy of the decision (including any decision determined on appeal) pursuant to which the existing registered Community design was declared to be invalid, and
  - (c) include a statement confirming that the decision pursuant to which the registered Community design was declared invalid (whether wholly or partly) has been finally determined.
- (2) Where an invalidation notice is sent to the registrar by the proprietor of the re-registered design which derives from the existing registered Community design, the invalidation notice must be accompanied by—
- (a) a notice (a “derogation notice”) in writing to the registrar that, based upon the provisions in paragraph 9A(4) of Schedule 1A, the re-registered design should not be declared invalid (whether wholly or partly), and
  - (b) a statement of the reasons why paragraph 9A of Schedule 1A applies (a “statement”) together with relevant supporting evidence (“supporting evidence”).
- (3) Where the proprietor of a re-registered design submits an invalidation notice to the registrar but fails to send a derogation notice, a statement, or supporting evidence, the registration of the re-registered design which derives from the existing registered Community design identified in the invalidation notice must be declared invalid to the same extent as the existing registered Community design, unless the registrar directs otherwise.
- (4) Where the registrar has received an invalidation notice from a person other than the proprietor of the re-registered design which derives from the existing registered Community design, the registrar must as soon as reasonably practicable after receipt of the invalidation notice—
- (a) send a copy of the invalidation notice to the proprietor of the re-registered design which derives from the existing registered Community design identified in the invalidation notice, and
  - (b) notify the proprietor of the re-registered design which derives from the existing registered Community design that based upon the declaration of invalidity of the existing registered Community design, the re-registered design will be declared invalid to the same extent as the existing registered Community design from which it derives.
- (5) Where the registrar has become aware of the situation referred to in paragraph 9A of Schedule 1A otherwise than by an invalidation notice, the registrar must as soon as reasonably practicable after becoming aware of that situation notify the proprietor of the re-registered design which derives from the existing registered Community design in the terms provided in paragraph (4)(b).
- (6) The proprietor of the re-registered design referred to in paragraphs (4) and (5) must, within such period of not less than one month as may be specified in

the notice referred to in paragraphs (4)(b) and 5, send to the registrar a derogation notice accompanied by a statement and supporting evidence as referred to in paragraph (2), failing which the registration of the re-registered design must be declared invalid to the same extent as the registered Community design from which the re-registered design derives, unless the registrar directs otherwise.

(7) The registrar must, in reaching a decision as to whether paragraph 9A of Schedule 1A applies to a re-registered design, have regard to the statement and supporting evidence filed by the proprietor of the re-registered design and must send written notice of the decision to the proprietor, stating the reasons for that decision.

(8) For the purposes of any appeal against a decision referred to in sub-paragraph (7), the date on which the notice is sent must be taken to be the date of the decision.”.”;

(c) in rule 27(e) of the Registered Designs Rules (as prospectively inserted by paragraph 6(b)), for “exit day” substitute “IP completion day”;

(d) for paragraph 8 substitute—

“8.—(1) Rule 42 (address for service) is amended as follows.

(2) At the end of sub-paragraph (c) omit “, or” and substitute “;”.

(3) After sub-paragraph (1)(c) insert—

“(d) a proprietor of a re-registered design who sends a derogation notice to the registrar under rule 15A.”.

(4) In paragraph (4), for “another EEA state” substitute “an EEA state”.”;

(e) after paragraph 8 insert—

“9.—(1) Rule 43 (failure to furnish an address for service) is amended as follows.

(2) At the end of sub-paragraph 4(c) omit “, or” and substitute “;”.

(3) After sub-paragraph (4)(c) insert—

“(d) in the case of a proprietor who sends a derogation notice to the registrar, the registrar must proceed as if the proprietor had not sent a derogation notice.”.”.

25. In Schedule 8, Part 1 (Further amendments to the 1949 Act), omit paragraph 7.

## PART 6

### Amendments to the Patents (Amendment) (EU Exit) Regulations 2019

26. The Patents (Amendment) (EU Exit) Regulations 2019(14) are amended in accordance with this Part.

27. For regulation 3(a) and (b), substitute—

“(a) in the heading for “EU compulsory”, substitute “Compulsory pharmaceutical”;

(b) in subsection (1), for “an “EU compulsory”, substitute “a “compulsory pharmaceutical”.”.

28. Omit regulation 4.

29. For the definition of “plant breeders’ right” substituted by regulation 7(2)(c), substitute—

““plant breeders’ right” means—

- (a) any right granted under, or having effect as if granted under, section 3 of the 1997 Act (including existing rights as defined by section 40(4) of that Act); and
- (b) any right which by virtue of regulation 3 of the Plant Breeders’ Rights (Amendment etc.) (EU Exit) Regulations 2019(15) is treated as if it were a plant breeders’ right granted in accordance with the 1997 Act and as if the variety were registered in accordance with regulations under section 18(1)(c) of the 1997 Act;”.

30. Omit regulation 17.

31. In the insertion after paragraph 10 of Regulation (EC) No 1610/96 made by regulation 20(3), for paragraph 12 substitute—

“12. ‘court’ means—

- (a) as respects England and Wales, the High Court;
- (b) as respects Scotland, the Court of Session;
- (c) as respects Northern Ireland, the High Court in Northern Ireland.”.

32. Omit regulation 21.

33. In regulation 24(3), in the insertion of paragraph 8(1)(b), for “Part A section 1, points 1 to 7 or Part B, Section 1 points 1 to 5”, substitute “Part A section 1, points 1.1 to 1.7 or Part B, Section 1 points 1.1 to 1.4.3”.

34. In Regulation 52(3) in the insertion after Article 1(e) of Regulation (EC) No 469/2009—

(a) for paragraph (g), substitute—

“(g) ‘court’ means—

- (i) as respects England and Wales, the High Court;
- (ii) as respects Scotland, the Court of Session;
- (iii) as respects Northern Ireland, the High Court in Northern Ireland;” and

(b) in paragraph (j), after “granted” insert “or having effect as if granted”.

35. Omit regulation 53.

36. In regulation 62, omit “before”.

37. In regulation 69, for “exit day” in each place it occurs, substitute “IP completion day”.

## PART 7

### Amendments to the Patents Act 1977

38. The Patents Act 1977(16) is amended as follows.

39. In Schedule A1—

- (a) in paragraph 1, omit the definition of “Council Regulation”;
- (b) in paragraph 3(3), for “Article 14(3) fourth indent of the Council Regulation”, substitute “regulation 20A of the Plant Breeders’ Rights Regulations 1998(17)”;

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(15) S.I. 2019/204.

(16) 1977 c. 37.

(17) S.I. 1998/1027. Regulation 20A is prospectively inserted into the 1998 Regulations by S.I. 2019/204, reg 17(5).

- (c) in paragraph 4, for “Article 14(3) third indent of the Council Regulation”, substitute “section 9(10) of the Plant Varieties Act 1997(18)”.

## PART 8

### Amendments to Regulation (EC) No 469/2009 and related amendments

#### Amendments to Regulation (EC) No 469/2009

**40.** Regulation (EC) No 469/2009(19) of the European Parliament and of the Council of 6th May 2009 concerning the supplementary protection certificate for medicinal products is amended as set out in the Schedule.

#### Amendment to Regulation (EU) No 2019/933

**41.**—(1) Regulation (EU) 2019/933 of the European Parliament and of the Council of 20th May 2019 amending Regulation (EC) No 469/2009 concerning the supplementary protection certificate for medicinal products is amended as follows.

(2) After Article 2 (entry into force), omit “This Regulation shall be binding in its entirety and directly applicable in all Member States.”.

#### Amendment to the Patents Rules 2007

**42.** In the Patents Rules 2007(20), after rule 116, insert—

##### “Notifications relating to supplementary protection certificates

**116A.** Notifications under Article 5(2)(b) and (c) of the Medicinal Products Regulation must be made on Patents Form SP5.”.

#### Transitional provisions

**43.**—(1) Paragraph (2) applies where, before IP completion day, a product or a medicinal product containing that product, as defined in Article 1 of Regulation EC (No) 469/2009, is marked in accordance with that Regulation with the logo set out in Annex -I of that Regulation.

(2) That product or medicinal product containing that product so marked is not required, after these Regulations come into force, to have the words “UK export” affixed to it.

(3) Paragraph (4) applies where, before IP completion day, a notification is made to the Comptroller-General of Patents, Designs and Trade Marks in the form set out in Annex -Ia of Regulation (EC) No 469/2009.

(4) That notification is to be treated, on and after IP completion day, as a notification made—

(a) on Patents Form SP5; and

(b) on the same date as the notification made on the form set out in that Annex -Ia.

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(18) 1997 c. 66. Section 9(10) is prospectively inserted into the 1997 Act by S.I. 2019/204, reg 15(2)(c).

(19) OJ L152, 16.6.2009, p.1 amended by Regulation (EU) 2019/933, OJ L153, 11.6.2019, p.1.

(20) S.I. 2007/3291, as amended by 2011/2052L; there are other amending instruments but none are relevant.

Date

*Name*  
*Title*  
Department for Business, Energy and Industrial  
Strategy

We consent to the making of these Regulations

Date

*Name*  
*Name*  
Two of the Lords Commissioners of Her  
Majesty's Treasury

## SCHEDULE

Regulation 40

## Amendments to Regulation (EC) No 469/2009

**Interpretation of Schedule**

1. In this Schedule, a reference to an Article, paragraph, point or Annex is to that of Regulation (EC) No 469/2009.

**Article 1: definitions**

2. In Article 1, in relation to the definition of “maker”—
- (a) for “Union”, substitute “United Kingdom”;
  - (b) omit “third”;
  - (c) after “countries”, insert “outside the United Kingdom, the Isle of Man and the Member States of the European Union”; and
  - (d) renumber that definition as paragraph (k) and insert after the definition of “UK authorisation(21)”.

**Article 5: effects of the certificate**

3. In Article 5—
- (a) in paragraph 2(a)—
    - (i) in point (i)—
      - (aa) omit “third”; and
      - (bb) after “countries”, insert “outside the United Kingdom, the Isle of Man and the Member States of the European Union”;
    - (ii) in point (ii), for “Union”, substitute “United Kingdom”;
    - (iii) in point (iii)—
      - (aa) for “Member State of making”, substitute “United Kingdom”;
      - (bb) for “Member States”, substitute “the United Kingdom, the Isle of Man or one or more Member States of the European Union”;
    - (iv) in point (iv), for “Union”, substitute “United Kingdom”;
  - (b) in paragraph 2(b)—
    - (i) for “authority” to “take place”, substitute “comptroller”;
    - (ii) for “that Member State”, substitute “the United Kingdom”;
    - (iii) for “a”, where it appears before the last occurrence of “certificate”, substitute “that”;
  - (c) in paragraph 2(c), for “authority referred to in Article 9(1)”, substitute “comptroller”;
  - (d) in paragraph 2(d)—
    - (i) omit “third”;
    - (ii) after “countries”, insert “outside the United Kingdom, the Isle of Man and the Member States of the European Union”;
    - (iii) for “a logo, in the form set out in Annex -I, is affixed”, substitute “the words ‘UK export’ are affixed so as to be sufficiently clear and visible to the naked eye”;

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(21) The definition of “UK authorisation” is inserted by [S.I. 2019/801](#).

- (e) in paragraph 2(e), omit from “and” to the end of the sentence;
- (f) in paragraph 3, for “Union”, substitute “United Kingdom”;
- (g) in paragraph 5—
  - (i) omit point (c);
  - (ii) in point (d), omit from “granted” the first time it appears to “making” the second time it appears;
  - (iii) in point (e)—
    - (aa) omit “third”, both times it appears;
    - (bb) after “countries”, insert “outside the United Kingdom, the Isle of Man and the Member States of the European Union”;
- (h) in paragraph 6—
  - (i) for “authority”, substitute “comptroller”;
  - (ii) for “contained in Annex -Ia”, substitute “prescribed by rules made under section 123 of the Patents Act 1977”;
- (i) in paragraph 7—
  - (i) omit “third”;
  - (ii) after “country”, the first time it appears, insert “outside the United Kingdom, the Isle of Man and the Member States of the European Union”;
- (j) omit paragraph 8, including its footnote;
- (k) after paragraph 10, insert—

“11. The Secretary of State may by regulations make further provision as to the manner and form (including design and colour) of affixing the words “UK export” to the outer packaging of the product, or the medicinal product containing that product, referred to in paragraph 2(a)(i) of this Article, and, where feasible, to its immediate packaging.

12. Those regulations are to be made by statutory instrument which is subject to annulment pursuant to a resolution of either House of Parliament.”.

#### **Article 11: publication**

- 4. In Article 11(4)—
  - (a) for “authority referred to in Article 9(1)”, substitute “comptroller”;
  - (b) for “It”, substitute “The comptroller”.

#### **Article 21a: evaluation**

- 5. Omit Article 21a.

#### **Annex -I and Annex -I: logo and standard form**

- 6. Omit Annex -I and Annex -Ia.

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## EXPLANATORY NOTE

*(This note is not part of the Regulations)*

These Regulations amend the following statutory instruments (the “existing regulations”) which were made as a consequence of the United Kingdom exiting the European Union:

- The Intellectual Property (Exhaustion of Rights) (EU Exit) Regulations 2019 ([S.I. 2019/265](#));
- The Trade Marks (Amendment etc.) (EU Exit) Regulations 2019 ([S.I. 2019/269](#)) (“the Trade Marks Regulations”);
- The Intellectual Property (Copyright and Related Rights) (Amendment) (EU Exit) Regulations 2019 ([S.I. 2019/605](#)) (“the Copyright Regulations”);
- The Designs and International Trade Marks (Amendment etc.) (EU Exit) Regulations 2019 ([S.I. 2019/638](#)) (“the Designs Regulations”); and
- The Patents (Amendment) (EU Exit) Regulations 2019 ([S.I. 2019/801](#)) (“the Patents Regulations”).

These Regulations substitute “IP completion day” for the various references to “exit day” in the existing regulations (“IP completion day” is defined in the European Union (Withdrawal Agreement) Act [2020 \(c.1\)](#) (“the 2020 Act”) as 11pm on 31st December 2020). This will ensure that the provisions in the existing regulations will take effect by reference to IP completion day rather than exit day. The existing regulations will come into force on IP completion day by operation of paragraph 1 of Schedule 5 to the 2020 Act. These Regulations also amend certain errors contained in the existing regulations. For example, Part 2 corrects an error where a reference to Schedule ZA1 to the Copyright, Designs & Patents Act 1988 had been inadvertently retained in regulation 31(a) of the Copyright Regulations despite its deletion from that Act by another provision of the Copyright Regulations.

Part 4 amends the Trade Marks Regulations to make further changes to the Trade Marks Act 1994 (“the 1994 Act”) and the Trade Marks Rules 2008 to implement Article 54(3) of the Agreement on the withdrawal of the United Kingdom of Great Britain and Northern Ireland from the European Union and the European Atomic Energy Community signed on 24th January 2020 (“the Withdrawal Agreement”), insofar as it relates to European Union trade marks. The Trade Marks Regulations provide that a European Union trade mark (“an existing EUTM”) which is registered immediately before exit day (now amended to “IP completion day”) is to be treated on and after that day as if it were a trade mark registered under the 1994 Act (“a comparable trade mark (EU)”).

New paragraph 21A of Schedule 2A to the 1994 Act applies where on IP completion day an existing EUTM is the subject of revocation or invalidity proceedings, which after IP completion day results in the revocation of or a declaration of invalidity in respect of the existing EUTM. Where the registrar (as defined in the 1994 Act) receives notice or otherwise becomes aware of such revocation or declaration of invalidity, the comparable trade mark (EU) which derives from the existing EUTM must be revoked or declared invalid to the same extent as the existing EUTM and with effect from the same date except where the grounds on which the existing EUTM was revoked or declared invalid would not have applied had the proceedings been brought against the comparable trade mark (EU) under the 1994 Act.

New rule 43A of the Trade Marks Rules 2008 ([S.I. 2008/1797](#)) sets out the procedural matters which apply where the registrar receives notice or otherwise becomes aware of the revocation of or declaration of invalidity in respect of an existing EUTM.

Part 5 amends the Designs Regulations to make further changes to the Registered Designs Act 1949 (“the 1949 Act”) and the Registered Designs Rules 2006 to implement Article 54(3) of the Withdrawal Agreement insofar as it relates to registered Community designs. The Designs Regulations provide that a registered Community design (“an existing registered Community design”) which is registered immediately before exit day (now amended to “IP completion day”) is to be treated on and after that day as if it were a design registered under the 1949 Act (“a re-registered design”).

New paragraph 9A of Schedule 1A to the 1949 Act applies where on IP completion day an existing registered Community design is the subject of invalidity proceedings, which after IP completion day results in a declaration of invalidity. Where the registrar (as defined in the 1949 Act) receives notice or otherwise becomes aware of such declaration of invalidity, the re-registered design which derives from the existing registered Community design must be declared invalid to the same extent as the existing registered Community design and with effect from the same date, except where the grounds on which the existing registered Community design was declared invalid would not have applied had the proceedings been brought against the re-registered design under the 1949 Act.

New rule 15A of the Registered Designs Rules 2006 ([S.I. 2006/1975](#)) sets out the procedural matters which apply where the registrar receives notice or otherwise becomes aware of the declaration of invalidity in respect of an existing registered Community design.

Part 6 amends the Patents Regulations to correct minor errors, to acknowledge the treatment of Community plant variety rights as plant breeders’ rights by virtue of the Plant Breeders’ Rights (Amendment etc.) (EU Exit) Regulations 2019 ([S.I. 2019/204](#)) (“the Plant Breeders’ Regulations”), and to update transitional provisions to refer to IP completion day.

Part 7 amends the Patents Act 1977 to replace references to EU law with equivalent domestic legislation, aligning with amendments made by the Plant Breeders’ Regulations.

Part 8 and the Schedule relate to supplementary protection certificates for medicinal products and arise out of changes made by Regulation (EU) 2019/933 of the European Parliament and of the Council of 20th May 2019 amending Regulation (EC) No 469/2009 concerning the supplementary protection certificate for medicinal products. Part 8 amends Regulation 2019/933 and the Patents Rules 2007 ([S.I. 2007/3291](#)) and contains transitional provisions. The Schedule amends Regulation (EC) No 469/2009 to address inoperabilities occurring as a result of the aforementioned changes.

An impact assessment has not been produced for this instrument as no, or no significant, impact on the private, public and voluntary sectors is foreseen.

An explanatory memorandum is available alongside this instrument on the Legislation UK website at [www.legislation.gov.uk](http://www.legislation.gov.uk).