

Changes to legislation: Registered Designs Act 1949, PART 1 is up to date with all changes known to be in force on or before 21 January 2024. There are changes that may be brought into force at a future date. Changes that have been made appear in the content and are referenced with annotations. (See end of Document for details) View outstanding changes

SCHEDULES

[^{F1}SCHEDULE 1A

EUROPEAN COMMUNITY REGISTERED DESIGNS

Textual Amendments

- F1** Schs. 1A, 1B inserted (31.12.2020) by [The Designs and International Trade Marks \(Amendment etc.\) \(EU Exit\) Regulations 2019 \(S.I. 2019/638\)](#), reg. 1, **Sch. 3 para. 3** (with Sch. 5 Pt. 1) (as amended by [S.I. 2020/1050](#), regs. 1(2), 23); 2020 c. 1, Sch. 5 para. 1(1)

PART 1

EXISTING REGISTERED COMMUNITY DESIGNS

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

- 1 (1) A design which, immediately before [^{F2}IP completion 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 [^{F2}IP completion 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);

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(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 [F²IP completion day].

Textual Amendments

F2 Words in [Sch. 1A](#) substituted in earlier amending provision S.I. 2019/638, Sch. 3 para. 3 (31.12.2020) by [The Intellectual Property \(Amendment etc.\) \(EU Exit\) Regulations 2020 \(S.I. 2020/1050\)](#), regs. 1(2), [21\(c\)\(i\)](#)

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

- 2
- (1) The registrar must as soon as reasonably practicable on or after [F²IP completion 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).

Textual Amendments

F2 Words in [Sch. 1A](#) substituted in earlier amending provision S.I. 2019/638, Sch. 3 para. 3 (31.12.2020) by [The Intellectual Property \(Amendment etc.\) \(EU Exit\) Regulations 2020 \(S.I. 2020/1050\)](#), regs. 1(2), [21\(c\)\(i\)](#)

Opt out

- 3
- (1) Subject to sub-paragraph (2), the proprietor of an existing registered Community design may at any time on or after [F²IP completion 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 [F²IP completion 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

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- (b) include the name and address of any person having an interest in the existing registered Community design which had effect before [F²IP completion 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 [F²IP completion 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.

Textual Amendments

- F2** Words in [Sch. 1A](#) substituted in earlier amending provision S.I. 2019/638, Sch. 3 para. 3 (31.12.2020) by [The Intellectual Property \(Amendment etc.\) \(EU Exit\) Regulations 2020 \(S.I. 2020/1050\)](#), regs. 1(2), [21\(c\)\(i\)](#)

Effect of claim of priority

- 4 (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 [F²IP completion 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.

Textual Amendments

- F2** Words in [Sch. 1A](#) substituted in earlier amending provision S.I. 2019/638, Sch. 3 para. 3 (31.12.2020) by [The Intellectual Property \(Amendment etc.\) \(EU Exit\) Regulations 2020 \(S.I. 2020/1050\)](#), regs. 1(2), [21\(c\)\(i\)](#)

Unregistered pre-exit transfers

- 5 (1) This paragraph applies where immediately before [F²IP completion day] there is a transfer of an existing registered Community design that has not been entered in the RCD register (a “relevant transfer”).

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- (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.

Textual Amendments

- F2** Words in [Sch. 1A](#) substituted in earlier amending provision S.I. 2019/638, Sch. 3 para. 3 (31.12.2020) by [The Intellectual Property \(Amendment etc.\) \(EU Exit\) Regulations 2020 \(S.I. 2020/1050\)](#), regs. 1(2), [21\(c\)\(i\)](#)

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

- 6 (1) This paragraph applies where immediately before [^{F2}IP completion 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 [^{F2}IP completion 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 [^{F2}IP completion 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 [^{F2}IP completion day] falls.

Textual Amendments

- F2** Words in [Sch. 1A](#) substituted in earlier amending provision S.I. 2019/638, Sch. 3 para. 3 (31.12.2020) by [The Intellectual Property \(Amendment etc.\) \(EU Exit\) Regulations 2020 \(S.I. 2020/1050\)](#), regs. 1(2), [21\(c\)\(i\)](#)

Security interests in existing registered Community designs

- 7 (1) This paragraph applies where immediately before [^{F2}IP completion day] an existing registered Community design is the subject of an interest which has been granted as security and does not expire on [^{F2}IP completion 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

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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 [F²IP completion 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 [F²IP completion day] falls.

Textual Amendments

- F2** Words in [Sch. 1A](#) substituted in earlier amending provision S.I. 2019/638, Sch. 3 para. 3 (31.12.2020) by [The Intellectual Property \(Amendment etc.\) \(EU Exit\) Regulations 2020 \(S.I. 2020/1050\)](#), regs. 1(2), [21\(c\)\(i\)](#)

Continuity of rights in relation to an existing registered Community design

- 8
- (1) References to an existing registered Community design or the registration of an existing registered Community design in any document entered into before [F²IP completion day] shall, unless there is evidence that the document was not intended to have effect in the United Kingdom, be read on and after [F²IP completion 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 [F²IP completion day] by the proprietor of an existing registered Community design to the doing on or after [F²IP completion 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.

Textual Amendments

- F2** Words in [Sch. 1A](#) substituted in earlier amending provision S.I. 2019/638, Sch. 3 para. 3 (31.12.2020) by [The Intellectual Property \(Amendment etc.\) \(EU Exit\) Regulations 2020 \(S.I. 2020/1050\)](#), regs. 1(2), [21\(c\)\(i\)](#)

Pending proceedings concerning an existing registered Community design

- 9
- (1) This paragraph applies where on [F²IP completion 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),

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- (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 [F²IP completion 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 [F²IP completion day] if they were instituted but not finally determined before [F²IP completion day].

Textual Amendments

- F2** Words in [Sch. 1A](#) substituted in earlier amending provision S.I. 2019/638, Sch. 3 para. 3 (31.12.2020) by [The Intellectual Property \(Amendment etc.\) \(EU Exit\) Regulations 2020 \(S.I. 2020/1050\)](#), regs. 1(2), [21\(c\)\(i\)](#)

Existing registered Community design: effect of invalidity

- [^{F3}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.

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- (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).]

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Textual Amendments

- F3** Sch. 1A para. 9A inserted in earlier amending provision S.I. 2019/638, Sch. 3 para. 3 (31.12.2020) by The Intellectual Property (Amendment etc.) (EU Exit) Regulations 2020 (S.I. 2020/1050), regs. 1(2), **21(c)(ii)**

Effect of injunction protecting an existing registered Community design

- 10 (1) This paragraph applies where immediately before [F²IP completion 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.]

Textual Amendments

- F2** Words in Sch. 1A substituted in earlier amending provision S.I. 2019/638, Sch. 3 para. 3 (31.12.2020) by The Intellectual Property (Amendment etc.) (EU Exit) Regulations 2020 (S.I. 2020/1050), regs. 1(2), **21(c)(i)**

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Changes and effects yet to be applied to the whole Act associated Parts and Chapters:

Whole provisions yet to be inserted into this Act (including any effects on those provisions):

- s. 22(1)(aa) and word inserted by [2014 c. 18 s. 9\(2\)](#)
- s. 22(5) inserted by [2014 c. 18 s. 9\(4\)](#)
- s. 22(6)(7) inserted by [2014 c. 18 s. 9\(5\)](#)