
STATUTORY INSTRUMENTS

2020 No. 1050

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

PART 5

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

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 subparagraph (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.