

# Considerations on Substantive Examination by the Office of a Designated Contracting Party

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# Substantive Examination by the Office of a Designated CP

- Substantive examination, if any, is undertaken by the Office of a designated CP as provided by its national law
- Refusal must be sent to the IB within the set time limits from the date of publication of the IR
- Holder has same remedies as would have been available if filed as a national application
- If not refused, or if refusal withdrawn, the IR produces the same effect as a grant of protection under the national law

# Typical Substantive Grounds for Refusal

- Definition of an industrial design
  - Type of design not protected (ex. “logo”)
  - Disclosure insufficient to figure out the design
  
- Public order and morality
  
- Conflict with prior applications / registrations
  
- Lack of Novelty
  
- Lack of Creativity / Non-obviousness

# WORKING GROUP ON THE LEGAL DEVELOPMENT OF THE HAGUE SYSTEM FOR THE INTERNATIONAL REGISTRATION OF INDUSTRIAL DESIGNS

5TH SESSION, DECEMBER 14 TO 16, 2015



# Discussions

## in the 5th Session of the Working Group

- Discussions were based on document H/LD/WG/5/4, «Proposal for Recommendations Relating to the Disclosure of an Industrial Design in an International Application»
- All the delegations and representatives of user groups were in favor of establishing the Guidance for users
- The final Guidance, prepared in consultation with the Examining Offices, will be published on the WIPO website

# Requirements concerning reproductions under the Hague System

## Legal Framework

- Article 5(1)(iii) of the 1999 Act
- Rule 9(1) and (2) of the Common Regulations
- Sections 401 to 405 of the Administrative Instructions  
*which govern formality examination by the IB*
  
- Article 12(1) of the 1999 Act
- Rule 9(3) and (4) of the Common Regulations  
*which govern examination by a designated Office*

# Rule 9(4) of the Common Regulations

- No refusal on formal grounds.
- Refusal possible on the ground «*that the reproductions contained in the international registration are not sufficient to disclose fully the industrial design*»

# Basic Proposal for the Regulations \*

R9.09: «: “A Contracting Party may however refuse on the ground that a reproduction does not sufficiently disclose the appearance of the industrial design. Thus, for example, although it may not refuse protection on the sole ground that a reproduction is not provided with surface shading, *it may refuse if the only way to sufficiently disclose the industrial design is to provide surface shading, and that this has not been done.*

In such a case, *the reason for refusal would be the substantive ground* that the industrial design is not sufficiently disclosed, *not* the formal ground that the reproduction does not contain surface shading.”

\* Records of the Diplomatic Conference for the Adoption of a New Act of the Hague Agreement Concerning the International Deposit of Industrial Designs (Geneva Act)



# Draft Recommendations discussed in the Working Group

- The proposal for recommendations as contained in the Annex to document H/LD/WG/5/4 were discussed in the WG
- Several comments and proposals were made by the delegations
- The Guidance will be finalized in consultation with the Examining Offices of Contracting Parties to the Hague Agreement
- The list of Examining Offices will be updated as further Contracting Parties join the Hague System («Which recommendations shall be taken into account when designating that CP»)

# Draft Recommendation 1.1

## ■ Provide a sufficient number of views

- Six views of a three-dimensional product from different angles (front, back, top, bottom, right side, left side), or two views showing the front surface and rear surface of a two-dimensional physical product (e.g. postcard, textile, etc.) should be submitted.
- Instead of six views, perspective views may be accepted if the views show the entire configuration of the product.
- Each view should be of the same scale as the others.
- Appropriate legend or description indicating an angle of each view should be provided.

# Draft Recommendation 1.2.

## ■ Provide Explanations on the Omitted Views

- Where the applicant wishes to omit a certain view(s) which is/are an identical or mirror image of another view or which only shows a flat and non-ornamental surface of the product, it should be clearly explained in the description which view(s) is(are) omitted and why that(those) view(s) is(are) omitted.

# Draft Recommendation 1.3

## ■ Provide Views Showing Disclaimed Part of the Product

Where an applicant seeks protection of a certain part of the product:

- the entire configuration of the product should be represented in six views or perspective views, even though protection is sought only for a certain part of it. In those views, the disclaimed part of the product must be indicated by means of dotted or broken lines or coloring, according to Section 403 of the Administrative Instructions for the Application of the Hague Agreement;
- an explanation on how the disclaimed part is indicated should be given in the description; if no explanation is given on how to identify the disclaimed part of the design, it could create an ambiguity in the sense that the dotted or broken lines may be considered part of an ornamentation on the surface of a product. Additionally, if the disclaimed part is indicated with coloring and no explanation is provided, the color would be considered as an integral element of the claimed design.

# Draft Recommendation 2

## ■ Provide Supplemental Views

- Depending on the necessity of the clear disclosure of configuration of a certain part of the product, supplemental views such as (partially-) enlarged view, exploded view, cross-sectional view, view showing a state where the product has transformed, etc., in addition to standard views showing the appearance of the whole product (see Draft Recommendation 1.1), should be submitted.
- An appropriate legend or description of the supplemental view should be provided to avoid any ambiguity. For example, the representations may be considered inconsistent with one another if a certain part of the product is represented largely in a view without an indication of “enlarged view” because the view is deemed to be different in scale from the other views.
- When an enlarged view or cross-sectional view is submitted, an indication of which portion of the product is shown in those views should be given in the description or in the corresponding legend.

# Draft Recommendation 3

- Provide Shading, Hatching, Dots, or Lines that May Be Used to Indicate Relief or Contours of Surfaces of a Three-Dimensional Product
  - Shading, hatching, dots, or lines should be provided in the representations only where it is difficult to represent relief or contours of surfaces of a three-dimensional product without them.
  - The purpose of the shading, hatching or lines provided in the representations should be clearly stated in the description in order to avoid any confusion with patterns on the surfaces.

# Draft Recommendation 4

- No Mixing of the Reproductions in Different Forms / No Mixing of the Representations in Black and White and in Color
  - All reproductions should be in the same form.
  - Representations should be all in either black and white or color.

# Final Guidance to be published on the WIPO website

- These recommendations are not legally binding on Offices. In other words, even if the applicants were to follow the recommendations, the Office could still refuse protection pursuant to Rule 9(4) of the Common Regulations, on the basis of a substantive ground in accordance with its applicable law.
- These recommendations are not intended to be exhaustive.





**Thank You!**

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