

## **Hague Agreement Concerning the International Registration of Industrial Designs**

### **Amendments to the Common Regulations and to the Administrative Instructions**

1. At its thirty-second (19th ordinary) session, which took place in Geneva from September 23 to October 2, 2013, the Assembly of the Hague Union adopted amendments to the Common Regulations under the 1999 Act and the 1960 Act of the Hague Agreement.
2. Furthermore, the Assembly was invited to comment on proposed amendments to the Administrative Instructions for the Application of the Hague Agreement, with a view to proceeding to the consultation required pursuant to Rule 34(1)(a) of the Common Regulations. No comments were made on this occasion by the Assembly.
3. In addition, further proposed amendments to the Administrative Instructions were submitted to the third session of the Working Group on the Legal Development of the Hague System for the International Registration of Industrial Designs, which convened from October 28 to 30, 2013, similarly with a view to proceeding to the required consultation. The Working Group favorably considered the addition of the proposed amendments to the Administrative Instructions.
4. As a result of the said consultations, the Administrative Instructions have been amended by the Director General of the World Intellectual Property Organization (WIPO).
5. The purpose of the amendments to Rule 1(1)(vi) of the Common Regulations and to Section 202 of the Administrative Instructions and the introduction of new Section 205 to the Administrative Instructions is to align the legal framework of the Hague system with the foreseen information technology-based developments in the administration of the Hague system.
6. Furthermore, the amendments to Rules 16(3) to (5) and 26(1) relate to the publication of international registrations, namely, to the period for the belated payment of the publication fee in case of a deferment of publication and the completion of the list of relevant data concerning international registrations to be published in the *International Designs Bulletin*.

7. In addition, the amendments to Rules 7(4) and 8 will allow a Contracting Party bound by the Geneva (1999) Act of the Hague Agreement, where the law of that Contracting Party requires the furnishing of an oath or declaration of the creator, to make a declaration to that effect. Where a Contracting Party that has made the said declaration is designated in an international application, the identity of the creator would also need to be contained in the application.

8. Finally, the addition of new Part 9, entitled “Confidential copies”, to the Administrative Instructions establishes the practical mechanism for transmission of confidential copies under Article 10(5)(a) of the 1999 Act and their updates.

9. All the aforementioned amendments will come into effect on January 1, 2014, and are further described below. It is important to note that, with the exception of the amendment to Rule 16(3) which applies but in rare circumstances, none of the amendments entail immediate practical changes for users.

### **ALIGNMENT OF THE LEGAL FRAMEWORK OF THE HAGUE SYSTEM WITH THE FORESEEN INFORMATION TECHNOLOGY-BASED DEVELOPMENTS IN ITS ADMINISTRATION**

10. Upon recommendation by the second session of the Working Group, which convened from November 5 to 7, 2012, the Assembly adopted amendments to Rule 1(1)(vi) of the Common Regulations concerning the definition of “official form” to also include electronic interfaces made available either on the WIPO web site or on the web site of an Office of a Contracting Party. The amendments to the said Rule reflect the fact that most international applications are filed through an electronic filing (E-filing) interface available on the WIPO web site and that, in line with Article 4(1) of the 1999 Act, a Contracting Party allowing the indirect filing may make an E-filing interface available on the web site of its Office.

11. It is reminded that an improved E-filing interface with user accounts was made available on the WIPO web site as of June 3, 2013. Users filing international applications through the new E-filing interface have access through their user accounts to a personalized environment referred to as the “E-Filing Portfolio Manager”, where an application may be saved, edited and from which data from a stored application may be used as a template. However, the International Bureau of WIPO intends to introduce a further tool, the Hague Portfolio Manager (HPM), which will expand the features of the current E-Filing Portfolio Manager to allow, in particular, the submission of requests for the recording of modifications. The amended wording of Rule 1(1)(vi) also takes into account the future introduction of the HPM, which will allow the electronic submission of requests for modifications.

12. Once the HPM is launched, communications between the International Bureau and the account holder will mainly take place through the user account. Amended Section 202 of the Administrative Instructions prescribes that a signature may be replaced as regards communications through a user account by a mode of identification. To log into his user account and accede to the E-Filing Portfolio Manager, the applicant uses his user name and password. Following the introduction of the HPM, electronic authentication of any communication through the user account will be carried out by using the said user name and password.

13. New Section 205 of the Administrative Instructions addresses the issue of communications between the International Bureau and the interested party (i.e., applicant/holder/representative) through a user account. Section 205(a) refers to the electronic authentication through the use of the account holder's user name and password. Furthermore, Section 205(b) makes the indication of an email address mandatory when filing an international application or other request through an electronic interface on the WIPO web site. Pursuant to Section 205(c), the International Bureau may transmit communications to the holder of the account through the user account. Although, in the future, communications between the International Bureau and the account holder will take place through the user account, an email alert to the effect that a new communication is available in the account may be programmed. The "Terms and Conditions of Use" will be issued by the International Bureau once the HPM is launched.

## **MATTERS RELATED TO THE PUBLICATION OF INTERNATIONAL REGISTRATIONS**

### **BELETED PAYMENT OF THE PUBLICATION FEE IN CASE OF A DEFERMENT OF PUBLICATION**

14. Upon recommendation by the second session of the Working Group, the Assembly adopted amendments to Rule 16(3) to (5) of the Common Regulations concerning the belated payment of the publication fee. Amended Rule 16(3)(a) aligns the period for the belated payment of the publication fee in case of a deferment of publication with the three-week time limit under Section 601 of the Administrative Instructions, which came into force on January 1, 2012, for the submission of a request for the recording of a limitation or renunciation. Consequently, the time for sending the unofficial reminder by the International Bureau of the payment of the publication fee, as provided for by amended Rule 16(3)(b), is moved to three months before the expiry of the deferment period so as to give enough time for the holder to make the required payment.

15. Furthermore, amended Rule 16(3)(a) also refers to the rare case where specimens have been submitted instead of reproductions. Amended Rule 16(4) further states that the said reproductions shall be submitted not later than three months before the expiry of the period for paying the publication fee.

16. As it is a precondition for the recording and publication of reproductions of industrial designs that they conform to the prescribed requirements concerning quality and format, a reference to Rule 9(1) and (2) is added to amended Rule 16(4).

17. Finally, amended Rule 16(5) stipulates that if the requirements concerning the payment of the publication fee and submission of the reproductions are not complied with, the international registration shall be cancelled. As a consequence of the proposed amendments to paragraphs (3) and (4) of the present Rule, in addition to paragraph (3), a reference to paragraph (4) is added to paragraph (5).

### **RELEVANT DATA CONCERNING INTERNATIONAL REGISTRATIONS PUBLISHED IN THE INTERNATIONAL DESIGNS BULLETIN**

18. Upon recommendation by the second session of the Working Group, the Assembly adopted amendments to Rule 26(1), which adds to the list of relevant data concerning international registrations to be published in the Bulletin. The additions are the following:

## Mergers

19. Where the same person becomes the holder of two or more international registrations resulting from a partial change in ownership, the registrations may be merged at the request of such person. Pursuant to Rule 21(8), the international registration resulting from the merger bears the number of the international registration of which part has been transferred, together, where applicable, with a capital letter. Although as a result of a merger, there is no change with regard to the identity of the owner of the rights deriving from the international registrations in question, it would be in the interest of third parties to have clearer information on the ownership of those rights. Therefore, mergers are added to amended Rule 26(1)(iv).

## Declarations under Rule 21 bis and their withdrawals

20. Rule 21 bis came into force on January 1, 2012. The said Rule established a mechanism to allow the Offices of designated Contracting Parties to refuse the effects of the recording of a change in ownership, where such recording under their national/regional laws is not allowed. Pursuant to Rule 21 bis(4), the International Bureau records in the International Register a declaration by the Office of a designated Contracting Party that a change in ownership has no effect in the said Contracting Party and modifies the International Register accordingly. The International Bureau notifies both the previous holder (transferor) and the new holder (transferee) of the recording. Furthermore, in accordance with Rule 21 bis(5), the declaration may be withdrawn, in part or whole. In such a case, the International Bureau records the withdrawal of declaration in the International Register, modifies the International Register and notifies both the previous holder (transferor) and the new holder (transferee) of the recording. It is in the interest of third parties that declarations and their withdrawals under Rule 21 bis be published. To this end, new subparagraph (ix) is added to Rule 26(1) referring to declarations under Rule 21 bis and their withdrawals.

## Cancellations under Rule 12(3)(d)

21. Rule 12(3) provides that where a Contracting Party has made a declaration under Article 7(2) of the 1999 Act or under Rule 36(1) of the Common Regulations, that declaration may further specify that the individual designation fee to be paid in respect of the Contracting Party comprises two parts, the first part to be paid at the time of filing the international application and the second part to be paid at a later date, which is determined in accordance with the law of the Contracting Party concerned. In the situation where a declaration under Rule 12(3) has been made, Rule 12(3)(d) further provides that, where the second part of the individual designation fee is neither paid to the Office of the designated Contracting Party concerned nor to the International Bureau within the applicable period, the International Bureau shall cancel the international registration with respect to the designated Contracting Party concerned following a request to that effect received from the Office. In accordance with Rule 12(3)(d), such a cancellation shall be notified to the holder of the international registration. However, this cancellation would happen unbeknownst to third parties if it was not published. Thus, in the interest of third parties' information, new subparagraph (viii) is added to Rule 26(1) referring to cancellations recorded under Rule 12(3)(d), as a result of which this particular type of cancellation will also be published<sup>1</sup>.

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<sup>1</sup> It is to be noted that, although they are of a different nature, any other type of recorded events negatively affecting partially or totally an international registration is published in accordance with Rule 26(1), namely, "refusals", "invalidations", "renunciations", "limitations", and "international registrations which have not been renewed".

## **SPECIAL REQUIREMENTS CONCERNING INDICATIONS OF THE IDENTITY OF THE CREATOR AND AN OATH OR A DECLARATION OF THE CREATOR**

22. The Assembly further adopted amendments to Rule 7(4), (Additional Mandatory Contents of an International Application) and to Rule 8 (Special Requirements Concerning the Applicant and the Creator). At the time of the Diplomatic Conference in 1999, the wording of Rule 8 allowing a Contracting Party to require an oath or declaration according to its domestic law and that this be further supported by the indication of the creator, corresponded, notably, to the situation under the law of the United States of America<sup>2</sup>. However, since then, the new law of the United States of America, the Leahy-Smith America Invents Act (AIA), signed on September 16, 2011, moved the United States of America from a “first to invent” system to a “first inventor to file” system. As a result of the AIA, assignees or other persons to whom the inventor is under obligation to assign the invention or who have a proprietary interest in the matter may now be applicants in patent applications.

23. While the United States of America has relaxed its requirement regarding who may be an applicant in a patent application, it has retained its longstanding statutory requirement that the patent application include the name of the inventor of the invention and that the inventor execute an oath or declaration in connection with the application attesting that he or she is in fact the inventor of the claimed invention<sup>3</sup>.

24. New subparagraph (ii) is added to Rule 8(1)(a) to allow a Contracting Party bound by the 1999 Act to make a declaration whereby its national law requires the furnishing of an oath or declaration of the creator, and that this continue to be completed by a provision, in this instance new paragraph (3), to the effect that in such circumstances the international application would contain the indication of the creator. Following the addition of subparagraph (ii) to Rule 8(1)(a), Rule 8(1)(a) became Rule 8(1)(a)(i).

25. Furthermore, a minor addition to Rule 8(1)(b) creates an equivalent requirement in respect of a declaration under new Rule 8(1)(a)(ii) as already provided in respect of a declaration under new Rule 8(1)(a)(i), namely, the declaration must specify the form and mandatory contents of the oath or declaration of the creator. Finally, since Rule 7(4)(c) reflects the special requirements under Rule 8, consequential amendments to Rule 7(4)(c) were made.

## **ESTABLISHMENT OF A MECHANISM FOR THE TRANSMISSION OF CONFIDENTIAL COPIES UNDER ARTICLE 10(5)(A) OF THE 1999 ACT AND THEIR UPDATES**

26. New Part Nine, entitled “Confidential Copies”, consisting of new Sections 901: “Transmission of Confidential Copies” and 902: “Updating of Data Concerning the International Registration” is added to the Administrative Instructions. Section 901 establishes a practical mechanism for the transmission of confidential copies to the Offices that have requested to receive such confidential copies under Article 10(5)(a). At present, none of the Contracting Parties to the 1999 Act has made this request. It is, however, likely that the Offices of a few prospective Contracting Parties whose accessions appear imminent will do so. Furthermore,

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<sup>2</sup> Records of the Diplomatic Conference for the Adoption of the New Act of the Hague Agreement Concerning the International Deposit of Industrial Designs, p. 273.

<sup>3</sup> See Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, § 4, 125 Stat. 284, 293-94 (September 16, 2011); 35 U.S.C. § 115(a) (as amended on September 15, 2012), “NAMING THE INVENTOR; INVENTOR’S OATH OR DECLARATION. – An application for patent shall include, or be amended to include, the name of the inventor for any invention claimed in the application. Except as otherwise provided in this section, each individual who is the inventor or a joint inventor of a claimed invention in an application for patent shall execute an oath or declaration in connection with the application”.

updated data of recordings, for example, relating to changes, cancellations and corrections, may be relevant to the Offices that have received a confidential copy. Therefore, pursuant to Section 902 any relevant data relating to the international registration recorded in the International Register before its publication shall be communicated to the Offices that have received a confidential copy of the international registration concerned.

27. Section 901(a) provides that a confidential copy shall be transmitted to each Office by electronic means established *vis-à-vis* each Office, in accordance with Section 204(a)(ii). The only exception shall be the transmission of a specimen submitted to the International Bureau by the applicant (paragraph (b) of Section 901). The transmission of such a specimen to each Office must take place in an appropriate manner.

28. Section 902(d) provides that updated data concerning an international registration shall be communicated to each Office that has received a confidential copy of the international registration in the same manner as established for confidential copies. The purpose of Section 902(a) is to inform the Offices of all the designated Contracting Parties that have received a confidential copy of the international registration of its cancellation under Rule 16(5), in the case where the publication fee is not paid or proper reproductions of the industrial design are not submitted. Furthermore, the purpose of Section 902(b) is to inform the Office of a designated Contracting Party that has received a confidential copy of the international registration of any change relevant to that Contracting Party upon its recording in the International Register. Finally, the purpose of Section 902(c) is to inform the Offices of designated Contracting Parties that have received a confidential copy of the international registration of any correction effected before the publication of the international registration, unless the correction only concerns the designations of other Contracting Parties.

29. The amended text of the Common Regulations and the Administrative Instructions is reproduced in Annexes I and II.

30. A more detailed presentation of the amendments referred to above can be found in the Hague Union Assembly document H/A/32/2, which is available on the WIPO web site at the following address: [http://www.wipo.int/meetings/en/details.jsp?meeting\\_id=29895](http://www.wipo.int/meetings/en/details.jsp?meeting_id=29895), and in the Working Group document H/LD/WG/3/6., available on the WIPO web site at the following address: [http://www.wipo.int/meetings/en/details.jsp?meeting\\_id=29704](http://www.wipo.int/meetings/en/details.jsp?meeting_id=29704).

December 23, 2013

**Common Regulations  
Under the 1999 Act and the 1960 Act  
of the Hague Agreement**

(as in force on January 1, 2014)

[...]

*Rule 1  
Definitions*

(1) [*Abbreviated Expressions*] For the purposes of these Regulations,

[...]

(vi) “official form” means a form established by the International Bureau or an electronic interface made available by the International Bureau on the web site of the Organization, or any form or electronic interface having the same contents and format;

[...]

*Rule 7  
Requirements Concerning the International Application*

[...]

(4) [*Additional Mandatory Contents of an International Application*] (a) With respect to Contracting Parties designated under the 1999 Act in an international application, that application shall contain, in addition to the indications referred to in paragraph (3)(iii), the indication of the applicant’s Contracting Party.

(b) Where a Contracting Party designated under the 1999 Act has notified the Director General, in accordance with Article 5(2)(a) of the 1999 Act, that its law requires one or more of the elements referred to in Article 5(2)(b) of the 1999 Act, the international application shall contain such element or elements, as prescribed in Rule 11.

(c) Where Rule 8 applies, the international application shall, as applicable, contain the indications referred to in paragraphs (2) or (3) thereof and be accompanied by any relevant statement, document, oath or declaration referred to in that Rule.

[...]

*Rule 8  
Special Requirements Concerning the Applicant and the Creator*

(1) [*Notification of Special Requirements Concerning the Applicant and the Creator*] (a)(i) Where the law of a Contracting Party bound by the 1999 Act requires that an application for the protection of an industrial design be filed in the name of the creator of the industrial design, that Contracting Party may, in a declaration, notify the Director General of that fact;

(ii) Where the law of a Contracting Party bound by the 1999 Act requires the furnishing of an oath or declaration of the creator, that Contracting Party may, in a declaration, notify the Director General of that fact.

(b) The declaration referred to in subparagraph (a)(i) shall specify the form and mandatory contents of any statement or document required for the purposes of paragraph (2). The declaration referred to in subparagraph (a)(ii) shall specify the form and mandatory contents of the oath or declaration required.

(2) [*Identity of the Creator and Assignment of International Application*] Where an international application contains the designation of a Contracting Party that has made the declaration referred to in paragraph (1)(a)(i),

(i) it shall also contain indications concerning the identity of the creator of the industrial design, together with a statement, complying with the requirements specified in accordance with paragraph (1)(b), that the latter believes himself to be the creator of the industrial design; the person so identified as the creator shall be deemed to be the applicant for the purposes of the designation of that Contracting Party, irrespective of the person named as the applicant in accordance with Rule 7(3)(i);

(ii) where the person identified as the creator is a person other than the person named as the applicant in accordance with Rule 7(3)(i), the international application shall be accompanied by a statement or document, complying with the requirements specified in accordance with paragraph (1)(b), to the effect that it has been assigned by the person identified as the creator to the person named as the applicant. The latter person shall be recorded as the holder of the international registration.

(3) [*Identity of the Creator and Oath or Declaration of the Creator*] Where an international application contains the designation of a Contracting Party that has made the declaration referred to in paragraph (1)(a)(ii), it shall also contain indications concerning the identity of the creator of the industrial design.

[...]

#### *Rule 16 Deferment of Publication*

[...]

(3) [*Period for Paying Publication Fee*] (a) The publication fee referred to in Rule 12(1)(a)(iv) shall be paid not later than three weeks before the period of deferment applicable under Article 11(2) of the 1999 Act or under Article 6(4)(a) of the 1960 Act expires or not later than three weeks before the period of deferment is considered to have expired in accordance with Article 11(4)(a) of the 1999 Act or with Article 6(4)(b) of the 1960 Act.

(b) Three months before the expiry of the period of deferment of publication referred to in subparagraph (a), the International Bureau shall, by sending an unofficial notice, remind the holder of the international registration, where applicable, of the date by which the publication fee referred to in subparagraph (a) shall be paid.

(4) [*Period for Submitting Reproductions and Registration of Reproductions*] (a) Where specimens have been submitted instead of reproductions in accordance with Rule 10, those reproductions shall be submitted not later than three months before the expiry of the period for paying the publication fee set under paragraph (3)(a).

(b) The International Bureau shall record in the International Register any reproduction submitted under subparagraph (a), provided that the requirements under Rule 9(1) and (2) are complied with.



(5) [*Requirements Not Complied With*] If the requirements of paragraphs (3) and (4) are not complied with, the international registration shall be canceled and shall not be published.

[...]

*Rule 26*  
*Publication*

(1) [*Information Concerning International Registrations*] The International Bureau shall publish in the Bulletin relevant data concerning

- (i) international registrations, in accordance with Rule 17;
- (ii) refusals, with an indication as to whether there is a possibility of review or appeal, but without the grounds for refusal, and other communications recorded under Rules 18(5) and 18*bis*(3);
- (iii) invalidations recorded under Rule 20(2);
- (iv) changes in ownership and mergers, changes of name or address of the holder, renunciations and limitations recorded under Rule 21;
- (v) corrections effected under Rule 22;
- (vi) renewals recorded under Rule 25(1);
- (vii) international registrations which have not been renewed;
- (viii) cancellations recorded under Rule 12(3)(d);
- (ix) declarations that a change in ownership has no effect and withdrawals of such declarations recorded under Rule 21*bis*.

[...]

[Annex II follows]

## **Administrative Instructions for the Application of the Hague Agreement**

(as in force on January 1, 2014)

[...]

### **Part Two Communications with the International Bureau**

[...]

#### *Section 202: Signature*

A signature shall be hand written, printed or stamped; it may be replaced by the affixing of a seal or, as regards the electronic communication referred to in Section 204(a)(i) or (ii) or communications through a user account referred to in Section 205, by a mode of identification to be determined by the International Bureau or agreed upon between the International Bureau and the Office concerned, as the case may be.

[...]

#### *Section 205: Communications Through User Accounts Available on the Web Site of the Organization*

(a) A user account may be established by an interested party who has agreed to the "Terms and Conditions of Use" issued by the International Bureau. Communications through the user account shall be authenticated through the use of the account holder's user name and password.

(b) An international application or other request as specified in the "Terms and Conditions of Use", may be submitted through an electronic interface made available by the International Bureau on the web site of the Organization and shall indicate an email address.

(c) The International Bureau may transmit communications to the holder of the account through the user account.

[...]

### **Part Nine Confidential Copies**

#### *Section 901: Transmission of Confidential Copies*

(a) The confidential copy of an international registration provided for under Article 10(5) of the 1999 Act shall be transmitted to any Office concerned by electronic means in accordance with Section 204(a)(ii).

(b) Notwithstanding paragraph (a) above, a specimen submitted to the International Bureau pursuant to Rule 10(1)(ii) shall be transmitted in an appropriate manner.

*Section 902: Updating of Data Concerning the International Registration*

(a) Where the international registration referred to in Section 901(a) is cancelled pursuant to Rule 16(5), that cancellation shall be communicated to any Office that has received a confidential copy of the said international registration.

(b) Where, with respect to the international registration referred to in Section 901(a), a change is recorded in the International Register pursuant to Rule 21(1)(a) before the publication of the said international registration, that change shall be communicated to any Office that has received a confidential copy of the international registration, except where the change is specific to the designations of other Contracting Parties.

(c) Paragraph (b) shall apply to any correction effected under Rule 22(1) before the publication of the international registration.

(d) Any cancellation, change or correction referred to in this section shall be communicated in the same manner as provided for in Section 901(a).

[End of Annex II]