

Hague Agreement Concerning the International Registration of Industrial Designs

Amendments to the Common Regulations

1. At its thirty-fourth (15th extraordinary) session, which took place in Geneva from September 22 to 30, 2014, 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. The general purpose of the amendments to Rules 18(4) and 18*bis*(1) and (2) of the Common Regulations is to enhance transparency concerning the scope of protection of the industrial design that is the subject of the international registration as amended in the procedure before the Office, where applicable, and improve the information on the status of the international registration in a designated Contracting Party. These amendments have to be read in line with the International Bureau's intention to start making the copies of notifications of refusal and withdrawal of refusal, as well as statements of grant of protection, publicly available alongside the publication in the *International Designs Bulletin* of the recording of any refusal, withdrawal of refusal or statement of grant of protection.
3. Amendments were also made with respect to the Schedule of Fees to authorize the International Bureau to collect a fee for the provision of additional services that may be offered in the future.
4. The amended text of the Common Regulations is reproduced in the Annex to this Information Notice.
5. The purpose of this Information Notice is to explain the operation of the amendments to Rules 18(4) and 18*bis*(1) and (2). A more detailed presentation of all the amendments and their rationale can be found in the Hague Union Assembly document H/A/34/2, which is available on the WIPO web site at the following address:
http://www.wipo.int/meetings/en/doc_details.jsp?doc_id=281046, and in the Working Group documents H/LD/WG/4/2 and H/LD/WG/4/3, available on the WIPO web site at the following address: http://www.wipo.int/meetings/en/details.jsp?meeting_id=32042.

INTRODUCTION OF A “FEEDBACK MECHANISM”

6. It is recalled that Article 14(2)(c) of the 1999 Act provides that the effect given to the international registration under Article 14(2)(a) and (b) shall apply to the industrial design as received from the International Bureau by the Office of a designated Contracting Party or, where applicable, “as amended in a procedure before that Office”.

7. New subparagraphs (c) of Rule 18(4) and Rule 18*bis*(1) and (2) prescribe that, where the international registration was amended in a procedure before the Office, the ensuing statement of grant of protection or the notification of withdrawal of refusal issued by that Office shall now contain or indicate all such amendments. Understandably, however, the information on amendments could be provided in the language in which the Office detains it, even if it is a language other than the working language used for the statement or notification concerned.

8. As indicated in paragraph 2, above, and in order for the “Feedback Mechanism” to fulfill its public information function, information relating to the amendments will be made publicly available through the *International Designs Bulletin* by reproducing a copy of the notification of withdrawal of refusal or statement of grant of protection received.

INDICATION OF THE DATE OF EFFECT OF THE INTERNATIONAL REGISTRATION

9. New Rule 18(4)(b)(iv) and Rule 18*bis*(1)(b)(iv) and (2)(b)(iv) make it compulsory for Offices to indicate in their statements of grant of protection and notifications of withdrawal of refusal the date on which the international registration produced or will produce the effect as a grant of protection under the applicable law. Depending on the applicable law, the said date may be different from the date of the statement or notification. The International Bureau will include that date as part of the publication of the recording of any statement of grant of protection or withdrawal of refusal.

STATEMENT OF GRANT OF PROTECTION MADE COMPULSORY IN CERTAIN CIRCUMSTANCES

10. To enhance the transparency of the status of the international registration in a designated Contracting Party, new subparagraph (d) of Rule 18*bis*(1) makes the communication of a statement of grant of protection mandatory in two circumstances where no notification of refusal was first communicated.

11. The first circumstance is where a Contracting Party has made a declaration under Rule 18(1)(b) that covers the situations envisaged under Rule 18(1)(c)(i) or (ii)¹. It is recalled that Rule 18(1)(c)(i) reads as follows “(c) The declaration referred to in subparagraph (b) may also state that the international registration shall produce the effect referred to in Article 14(2)(a) of the 1999 Act at the latest (i) at a time specified in the declaration which may be later than the date referred to in that Article but which shall not be more than six months after the said date”². Where Rule 18(1)(c)(i) applies, the Office has not found any grounds for refusal and, consequently, not issued any notification of refusal.

¹ At the time of release of this Information Notice, Turkey and Spain have made a declaration under Rule 18(1)(c)(i) of the Common Regulations and the Republic of Korea has made a declaration under Rule 18(1)(c)(ii).

² Depending on the national/regional law, such a date could be, for instance, the date of the scheduled republication of the international registration at the national level.

12. In addition, pursuant to Rule 18(1)(c)(ii), where a decision regarding the grant of protection was unintentionally not communicated within the period applicable to communicate a refusal, the Office of the Contracting Party concerned shall notify the International Bureau accordingly and endeavor to communicate such a decision to the holder of the international registration concerned promptly thereafter. Where Rule 18(1)(c)(ii) applies, new subparagraphs (d) and (e) of Rule 18*bis*(1) make mandatory the communication of a statement of grant of protection indicating the date of effect as a grant of protection under the applicable law to the International Bureau.

13. The second circumstance caters for the possibility before the Offices of certain Contracting Parties that the holder initiate amendments to an industrial design. Thus, where protection is granted to an industrial design following amendments resulting from a procedure initiated by the holder without any prior refusal being issued by the Office concerned, new subparagraph (d) of Rule 18*bis*(1) makes the communication of a statement of grant of protection mandatory.

PARTIAL STATEMENT OF GRANT OF PROTECTION

14. It may be the case that before an Office, the examination of some designs contained in one and the same international registration is performed relatively quickly whereas the examination of other designs take more time. As it is in the holder's and third parties' interest that the statement of grant of protection for an industrial design be issued as quickly as possible, amended Rule 18*bis*(1)(a) now provides that the Office may send a statement of grant of protection related only to some of the industrial designs that are the subject of the international registration, even where no notification of refusal related to the same designs has first been communicated by the Office³. In accordance with new Rule 18*bis*(1)(b)(iii), each such statement of grant of protection communicated by the Office shall indicate those industrial designs to which it relates.

15. It may also be the case, that the date of effect as a grant of protection under the applicable law is different in respect of different industrial designs that are the subject of the international registration. As explained in paragraph 9, it is compulsory to indicate the date of effect in any statement of grant of protection.

ENTRY INTO EFFECT

All the aforementioned amendments will come into effect on January 1, 2015, on which date the International Bureau will stand ready to process statements of grant of protection and notifications of withdrawal of refusal presented in accordance with amended Rules 18(4) and 18*bis*(1) and (2). However, no Office of a Contracting Party is obliged to apply the said Rules to international registrations published before January 1, 2015.

December 4, 2014

³ It is recalled that either a notification of withdrawal of refusal under Rule 18(4) or a statement of grant of protection under Rule 18*bis*(2) must be sent where a notification of refusal for the same design has been communicated. The notification under Rule 18(4) or the statement under Rule 18*bis*(2) may not concern any other designs than those to which the refusal relates.

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

(as in force on January 1, 2015)

*Rule 18
Notification of Refusal*

[...]

(4) [*Notification of Withdrawal of Refusal*] (a) The notification of any withdrawal of refusal shall relate to one international registration, shall be dated and shall be signed by the Office making the notification.

- (b) The notification shall contain or indicate
- (i) the Office making the notification,
 - (ii) the number of the international registration,
 - (iii) where the withdrawal does not relate to all the industrial designs to which the refusal applied, those to which it relates or does not relate,
 - (iv) the date on which the international registration produced the effect as a grant of protection under the applicable law, and
 - (v) the date on which the refusal was withdrawn.
- (c) Where the international registration was amended in a procedure before the Office, the notification shall also contain or indicate all amendments.

[...]

*Rule 18bis
Statement of Grant of Protection*

(1) [*Statement of Grant of Protection Where No Notification of Refusal Has Been Communicated*] (a) An Office which has not communicated a notification of refusal may, within the period applicable under Rule 18(1)(a) or (b), send to the International Bureau a statement to the effect that protection is granted to the industrial designs, or some of the industrial designs, as the case may be, that are the subject of the international registration in the Contracting Party concerned, it being understood that, where Rule 12(3) applies, the grant of protection will be subject to the payment of the second part of the individual designation fee.

- (b) The statement shall indicate
- (i) the Office making the statement,
 - (ii) the number of the international registration,
 - (iii) where the statement does not relate to all the industrial designs that are the subject of the international registration, those to which it relates,
 - (iv) the date on which the international registration produced or shall produce the effect as a grant of protection under the applicable law, and
 - (v) the date of the statement.
- (c) Where the international registration was amended in a procedure before the Office, the statement shall also contain or indicate all amendments.
- (d) Notwithstanding subparagraph (a), where Rule 18(1)(c)(i) or (ii) applies, as the case may be, or where protection is granted to the industrial designs following amendments in a procedure before the Office, the said Office must send to the International Bureau the statement referred to in subparagraph (a).

(e) The applicable period referred to in subparagraph (a) shall be the period allowed pursuant to Rule 18(1)(c)(i) or (ii), as the case may be, to produce the effect as a grant of protection under the applicable law, with respect to a designation of a Contracting Party having made a declaration under either of the aforementioned Rules.

(2) [*Statement of Grant of Protection Following a Refusal*] (a) An Office which has communicated a notification of refusal and which has decided to either partially or totally withdraw such refusal, may, instead of notifying a withdrawal of refusal in accordance with Rule 18(4)(a), send to the International Bureau a statement to the effect that protection is granted to the industrial designs, or some of the industrial designs, as the case may be, that are the subject of the international registration in the Contracting Party concerned, it being understood that, where Rule 12(3) applies, the grant of protection will be subject to the payment of the second part of the individual designation fee.

- (b) The statement shall indicate
- (i) the Office making the notification,
 - (ii) the number of the international registration,
 - (iii) where the statement does not relate to all the industrial designs that are the subject of the international registration, those to which it relates or does not relate,
 - (iv) the date on which the international registration produced the effect as a grant of protection under the applicable law, and
 - (v) the date of the statement.
- (c) Where the international registration was amended in a procedure before the Office, the statement shall also contain or indicate all amendments.

[...]

[...]

SCHEDULE OF FEES

(as in force on January 1, 2015)

[...]

VII. *Services Provided by the International Bureau*

24. The International Bureau is authorized to collect a fee, whose amount it shall itself fix, for services not covered by this Schedule of Fees.

[End of Annex]