



WIPO | HAGUE

The International
Design System

Legal Considerations Based on the National Law and the Hague Agreement

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Legal Framework

Declarations under the 1999 Act and the Common Regulations

- Contracting Parties may make certain declarations in order to comply with their national laws concerning industrial design protection (Art. 30 of the 1999 Act, Rule 35(1) of the Common Regulations)
- Declarations may be made either simultaneously with the deposit of the instrument of accession, or after the deposit (for example, following amendments to the national law).
- Before submission of the declarations to the Director General of WIPO, it is advised that the Legal Section of the Hague Registry be consulted to make sure that the requirements under the 1999 Act, the Common Regulations or the national law for making any declarations, respectively, are satisfied.

Declarations under the 1999 Act and the Common Regulations

■ Effective date of the declaration

- If the declaration is submitted together with the instrument of ratification/accession, it becomes effective on the date on which the Contracting Party becomes bound by the 1999 Act (Art. 30(1), Rule 35(1)).
- If the declaration is submitted afterwards, it becomes effective three months after the date of receipt of the declaration by the Director General of WIPO, or at any later date indicated in the declaration (Art. 30(2), Rule 35(1)).
- Any declaration made after the deposit of the instrument of accession or ratification will apply only in respect of IRs whose date of registration is the same as, or later than, the effective date of the declaration.

Declarations under the 1999 Act and the Common Regulations

- Mandatory declaration: Maximum Duration of Protection (Art. 17(3)(c) of the 1999 Act)
- Mandatory declarations (under certain circumstances)
- Optional declarations

MANDATORY DECLARATION

- Duration of Protection – Maximum Duration of Protection (Art. 17(3)(c) of the 1999 Act)
 - The minimum term of protection that the national law must provide is 15 years, subject to renewal;
 - Where the national law provides for a protection of more than 15 years, the duration of protection of an IR shall be the same as under the national law, subject to renewal.

MANDATORY DECLARATIONS (under certain circumstances)

■ General principle

- Each CP is assumed to permit the period of deferment of 30 months from the filing date, or where priority is claimed, from the priority date (Rule 16(1)(a))

■ Deferment of publication

- Where the law of a CP provides for a deferment period of less than 30 months, that CP must make a declaration of the allowable period of deferment (Art. 11(1)(a))

■ No deferment of publication

- Where the law of a CP does not provide at all for the deferment of publication, that CP must make a declaration notifying that fact

OPTIONAL DECLARATIONS

- Some optional declarations may only be made by a CP with an «Examining Office», namely
 - Declarations under Articles 5(2), 7(2), 14(3) and 18(1)(b)
- «Examining Office»
 - An Office which *ex officio* examines applications filed with it for the protection of industrial designs, at least to determine whether the industrial designs satisfy the condition of novelty (Art. 1(xvii))

OPTIONAL DECLARATIONS

(may be made by a CP with an Examining Office)

The national law of the CP must provide that in order that a national industrial design application be granted a filing date, the following element(s) is/are mandatory content(s) of the application, namely:

- Identity of the Creator (Art. 5(2)(b)(i))
- Brief Description (Art. 5(2)(b)(ii))
 - a brief description of the reproduction or of the characteristic features of the industrial design
 - (NOTE: a product indication is mandatory element in an international application (Art. 5(1)(iv)), therefore it cannot be the subject of a declaration under Art. 5(2)(b)(ii))
- Claim (Art. 5(2)(b)(iii))
 - Exact wording of the claim must be indicated.

OPTIONAL DECLARATIONS

(may be made by a CP with an Examining Office)

■ Prohibition of Self-Designation (Art. 14(3))

- A CP may make declaration that where it is the applicants CP, the designation of that CP in an international application has no effect, i.e., it is prohibited to self-designate

■ Extension of Period for Notification of Refusal (Rule 18(1)(b))

- In principle, the period within which an Office must notify a refusal is six months. However, this period may be extended to 12 months if the Office is an “Examining Office”, or the national law provides for a procedure for opposition to the registration of an industrial design.
- The declaration under Rule 18(1)(b) may contain further declarations under Rule 18(1)(c)(i) and/or (ii)

OPTIONAL DECLARATIONS

(may be made by a CP with an Examining Office)

■ Date of effect of IR (Rule 18(1)(c)(i))

- The IR may produce the effect as a grant of protection under the national law after the expiry date of the refusal period, but within six months from that expiry date.

■ Date of effect of IR (Rule 18(1)(c)(ii))

- The IR may produce the effect as a grant of protection according to the law of the CP where a decision regarding the grant of protection was unintentionally not communicated within the applicable refusal period.
- The application of this declaration should therefore be limited to exceptional cases, and on an individual case basis, as opposed to a declaration under Rule 18(1)(c)(1).

- (Where the Office of the CP that made the said declarations has not found any grounds for refusal, it is obliged to issue a statement of grant of protection provided for in Rule 18*bis*(1).)

OPTIONAL DECLARATIONS

(may be made by a CP with an Examining Office)

■ Individual Designation Fee (Art. 7(2))

- A CP with an Examining Office and an intergovernmental organization may make a declaration that, in connection with each IR, in respect of which it is designated, and in connection with the renewal of such IR, it wishes to receive an “individual designation fee”, instead of a share of the standard fees.
- The amount of the individual designation fee must not be higher than the fees that would be payable for registering a design by filing at the national level, also reflecting the savings resulting from the international procedure.

OPTIONAL DECLARATIONS

■ Standard designation fee (Rule 12(1))

- There are three different levels of standard designation fee, reflecting the scope of examination carried out by an Office.
- For level two or three to apply it is necessary to make a declaration to that effect.
- A CP with an Examining Office may, instead of a declaration concerning individual designation fee, make a declaration requiring the level two or three standard designation fee.

Levels of the Standard Designation Fee

- level one, for CPs whose Office does not carry out examination on substantive grounds – this level will apply *automatically* in the absence of any declaration;
- level two, for CPs whose Office carries out examination on substantive grounds other than novelty (for example, on issues such as the definition of a “design”, public order and morality, or the protection of State emblems);
- level three, for CPs whose Office carries out examination on substantive grounds, including a limited examination as to novelty (for example, an examination as to local novelty only even if the criterion for the validity of the design right is worldwide novelty), or examination as to novelty following opposition by third parties.

OPTIONAL DECLARATIONS

■ Security Clearance (Rule 13(4))

- Any CP whose law requires security clearance, may make a declaration that the period of one month allowed for its Office to transmit an international application to the IB shall be replaced by a period of six months.

OPTIONAL DECLARATIONS

- Prohibition of filing through National Office (Art. 4(1)(b))
 - In general, international application may be filed, at the option of the applicant, either directly with the IB or through the Office of the applicant's Contracting Party.
 - However, a CP may make a declaration that international applications may not be filed through its Office

OPTIONAL DECLARATIONS

■ Filing in Name of the Creator (Rule 8(1)(a)(i))

- The national law of a CP contains a requirement that a national application for the protection of an industrial design must be filed in the name of the creator.

■ Oath or Declaration of the Creator (Rule 8(1)(a)(iii))

- The national law of a CP contains a requirement that an oath or declaration of the creator must be furnished. The declaration must specify the form and content of any statement or document required.
- The international application containing the designation of the CP which has made the declaration must also contain indications concerning the identity of the creator of the industrial design.

OPTIONAL DECLARATIONS

■ Unity of Design (Art. 13(1))

- The national law of a CP contains a requirement that designs which are the subject of the same application should conform to a requirement of unity of design, unity of production or unity of use, or that the designs should belong to the same set or composition of items, or that only one independent and distinct design be claimed in a single application.
- The declaration should be comprehensive, detailed and specific as to the requirements in question.

OPTIONAL DECLARATIONS

■ Requirements Concerning Views (Rule 9(3))

- Specify certain views of the product or products which constitute the industrial design or in relation to which the industrial design is to be used.
- However, the declaration may not require more than one view where the industrial design or product is two-dimensional, or more than six views where the product is three-dimensional.
- (The Office of the CP that made the declaration can refuse the effects of the IR pending compliance with the specified requirement of views.)

OPTIONAL DECLARATIONS

■ Effect of Change in Ownership (Art. 16(2))

- Any CP may make a declaration that the recording in the International Register of a change in ownership of an IR shall not have effect in that CP until its Office has received the statements or documents specified in that declaration.

Thank You!

