



WIPO | HAGUE

The International
Design System

The Role of the International Bureau and the Office of the Designated Contracting Party

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Contents:

- *The Hague System: a Simple but Timeless Concept*

- *The Hague System Procedures I:*
 - *Role of the International Bureau*

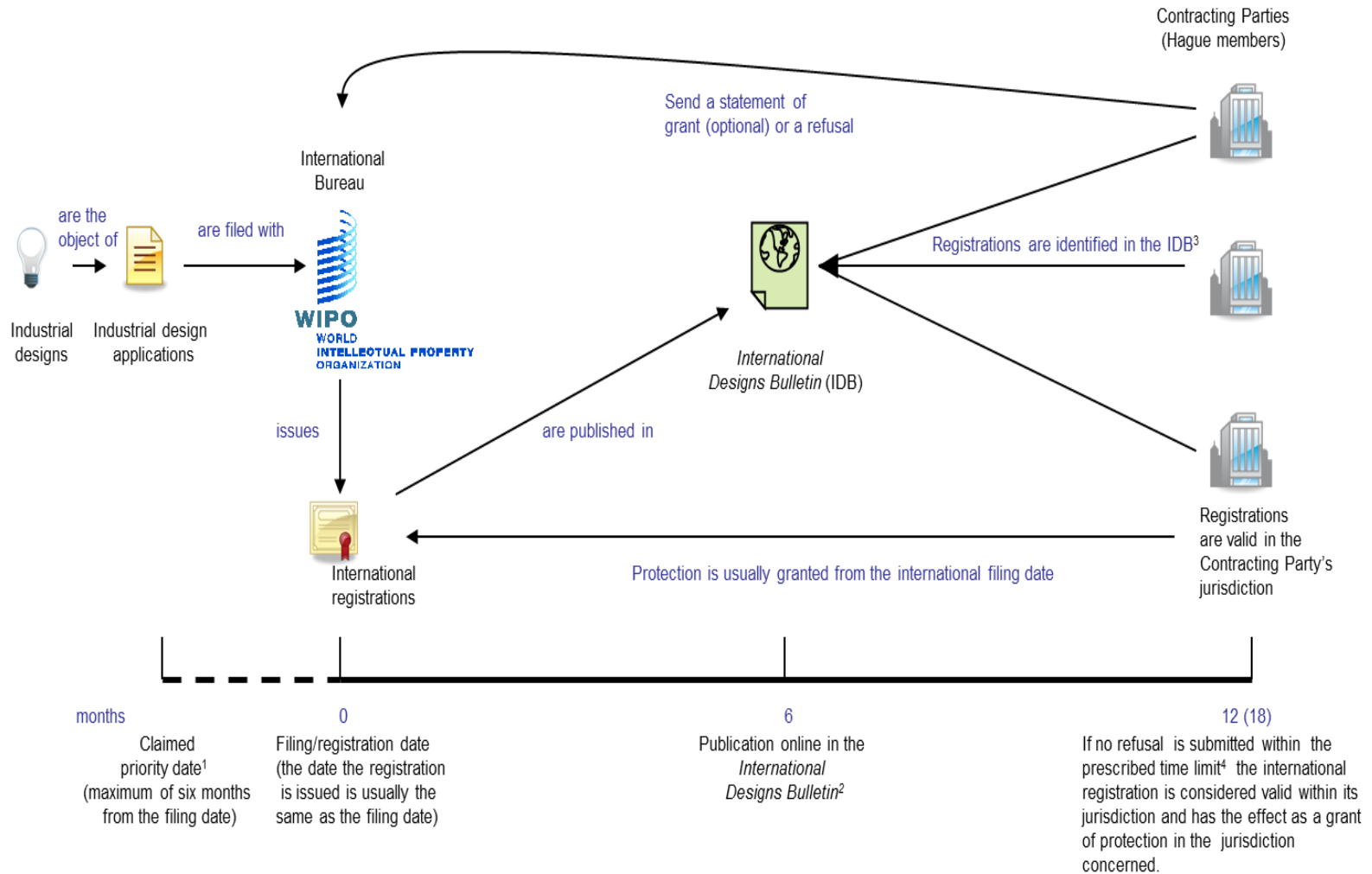
- *The Hague System Procedures II:*
 - *Role of the Office of a Designated CP*

- *Subsequent management of the IR*
 - *Post-registration Procedures*

Hague System: a simple but timeless concept

The centralized acquisition and maintenance of industrial design rights by filing a single international application for a single international registration with effect in one or more designated Contracting Parties.

Hague System



What is the Hague System?

■ One to Many Relationship

File a single international application for a single international registration (IR) in which one or more Contracting Parties (CP) are designated

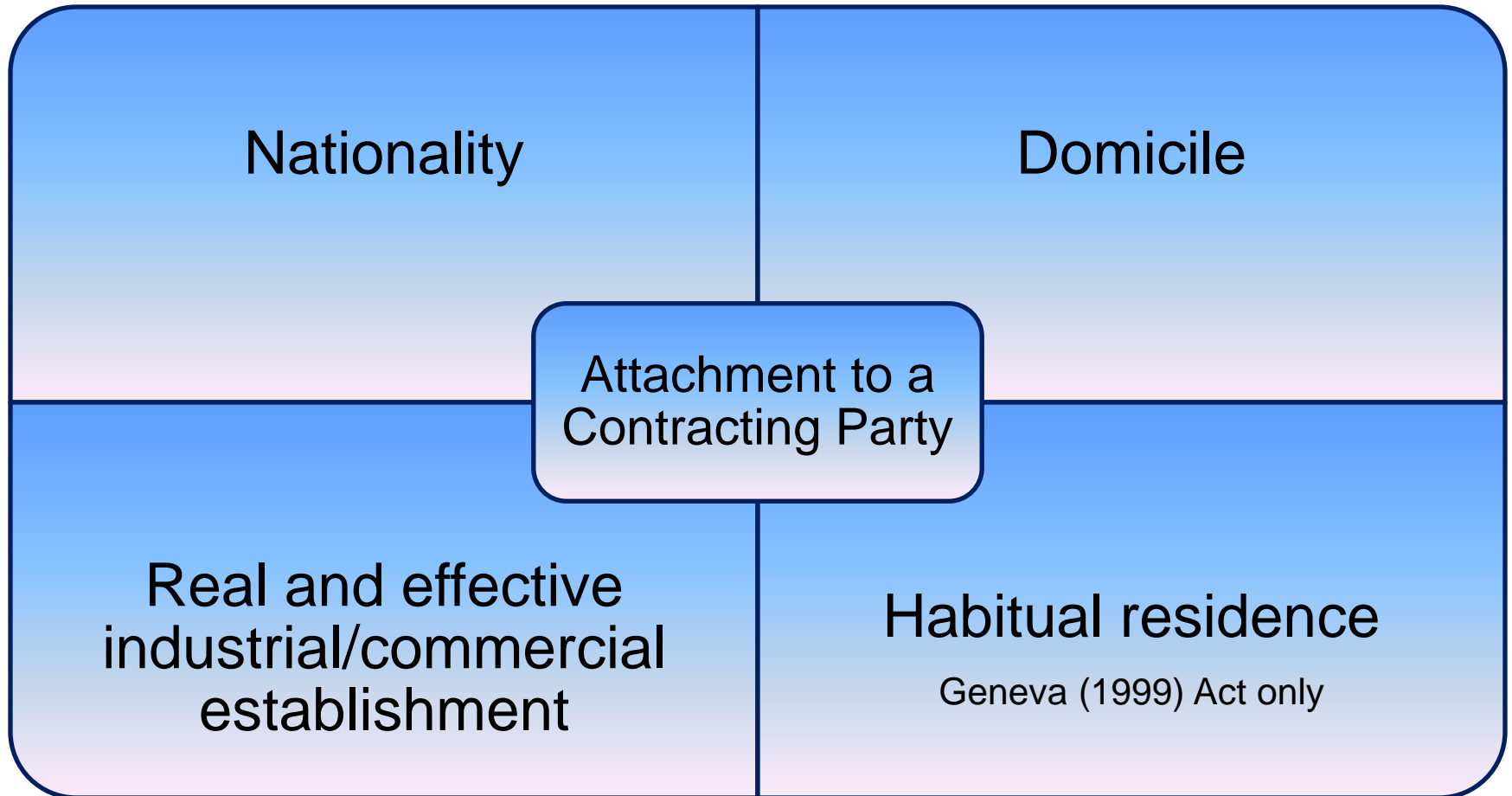
■ “Bundle of Rights”

If no refusal is issued, the resulting international registration has the effect of a grant of protection in each designated Contracting Party

The Hague System is

- “Bundle of Rights” - not determined by the Hague Agreement but governed by the law of each Contracting Party:
 - the conditions for protection;
 - the refusal procedure to be applied when deciding whether a design may be protected or not
 - the rights which result from protection.

Who Can Use the System?



Key Principles

- No need for a basic application/registration
- Designation of the Contracting Party of the holder possible
- Most international applications are filed directly with the International Bureau (not via an Office)
- E-filing and E-renewal available
- Subsequent designation is NOT possible

The International Application

In English, French or Spanish

May be filed directly with the International Bureau through the E-filing interface but also on paper

May comprise several different designs up to a maximum of 100 if they belong to the same class of the International Classification (Locarno)

One set of fees (in CHF) is to be paid

The Hague System Procedure I: Role of the International Bureau

Formal examination

Recording in the International Register

Sending the certificate to the holder

Publication in the International Designs Bulletin

Notification to members through the publication in the Bulletin

If the International Bureau finds that the international application does not fulfill the applicable requirements, it invites the applicant to make the required corrections within three months from the date of invitation sent by the International Bureau

International registration has the same effect as a regularly-filed application in all designated Contracting Parties

Formal examination by the IB

■ Mandatory contents (Rule 7(3))

- E-Filing automatically checks that mandatory contents are filled in, such as product indication or data concerning the applicant

■ Additional mandatory contents (Rule 7(4))

- E-Filing «alerts» if additional mandatory content is missing, such as identity of the creator (, where designated CP has made a declaration under Rule 8(1)(a)(i))

■ Optional contents (Rule 7(5))

- If filled in, the IB checks (, such as description)

Requirements concerning reproductions

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

Reproductions: formality examination by the IB

■ Industrial design alone

- Matter that does not form part of the industrial design or the product may be shown in a reproduction if it is indicated in the description and/or by dotted/broken lines or coloring

■ Must be shown against a neutral / plain background

■ No technical drawings, particularly with axes and dimensions

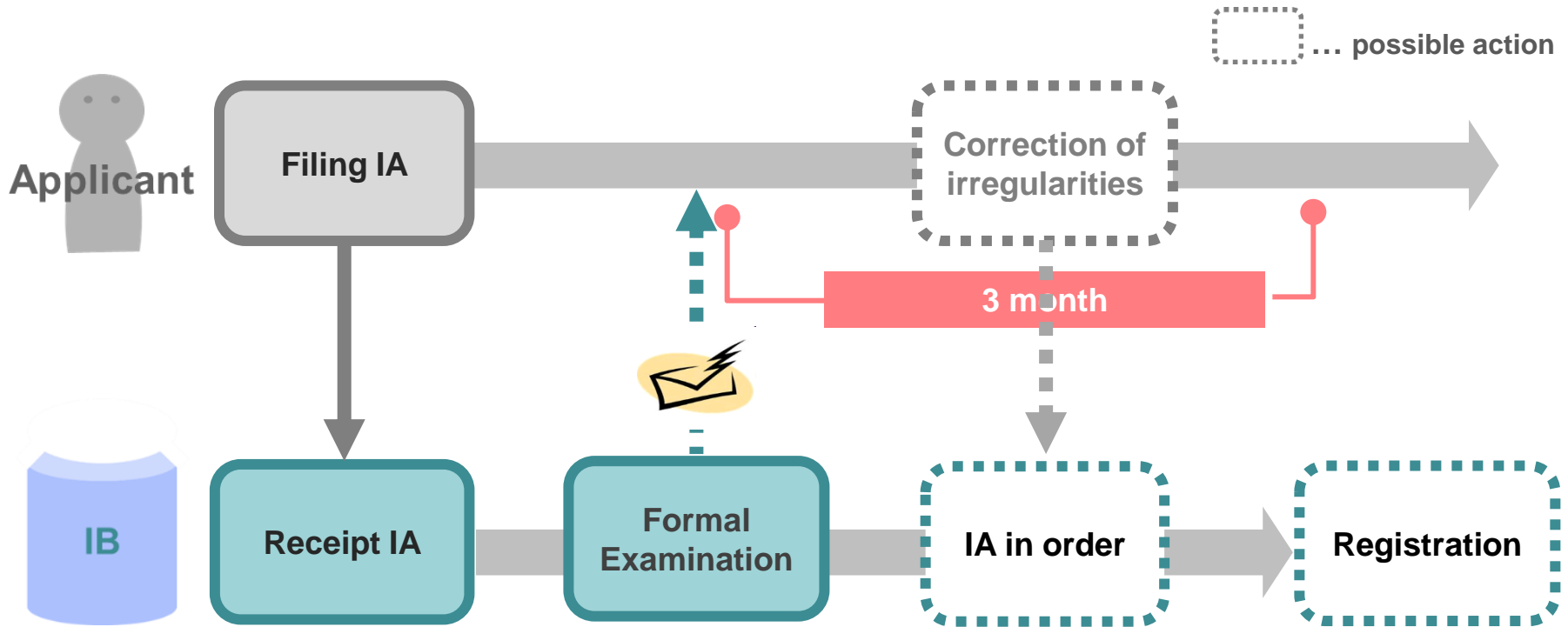
■ No explanatory text or legends in the reproduction

■ Maximum and minimum size

Disclaimer (Section 403(a))

- "Disclaimer" of protection for part of the industrial design may be indicated:
 - in the description (by text), and/or
 - by means of dotted or broken lines or coloring

Irregularity notice by the IB (Rule 14(1))



Irregularity 1 (ex. Lang.) Filing Date affected

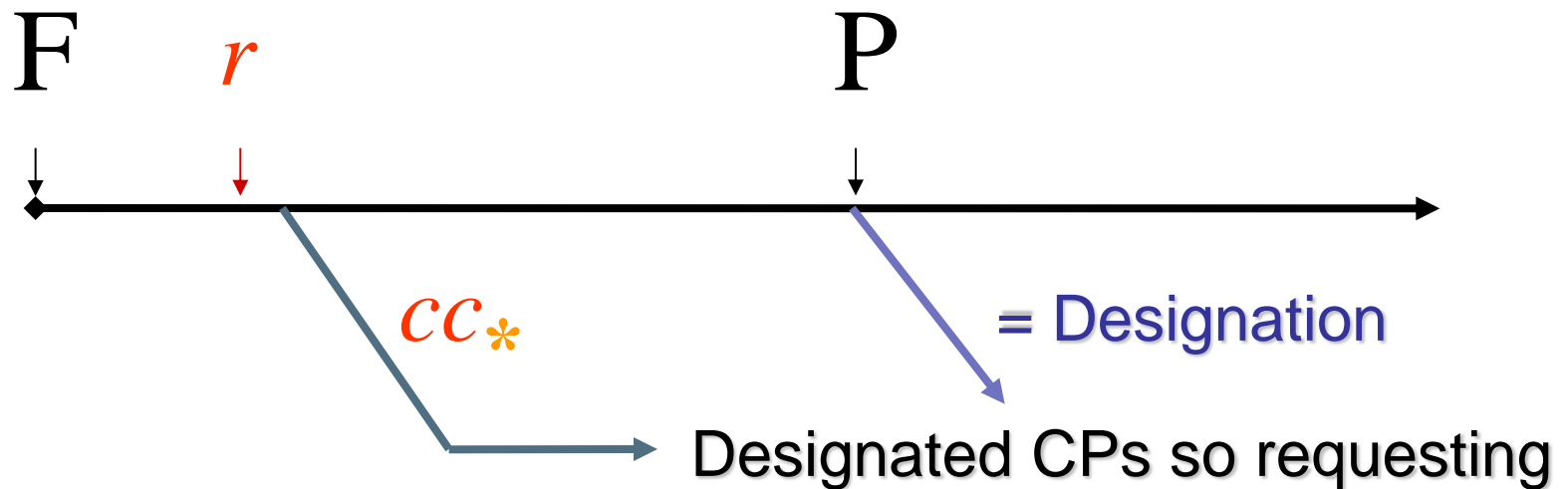
Irregularity 2 (ex. Claim) Date of IR affected

Irregularity 3 (ex. Repro.) No effect on Filing date or date of IR

Confidential Copies – 1999 Act

- Office simply notifies the IB of its wish to receive confidential copies of any IR designating that CP.
- Can only be used for examination purposes.
- Must be kept in confidence until its publication by the IB.

Confidential Copies – 1999 Act



- * Confidential Copies to be sent immediately after registration (Article 10(5))

Publication

- International registrations are published in the *International Designs Bulletin* on WIPO's website:

<http://www.wipo.int/hague/en/bulletin/>

- International publication takes the place of national publication (Article 10(3)(a) of the 1999 Act).
- Refusal period starts from the date of publication (Rules 18(1)(a) and 26(3)).

International Designs Bulletin

The Bulletin is the official publication of the Hague System. It contains data regarding new international registrations, renewals, and modifications affecting existing international registrations.

Publication

Year

2016 ▼

Bulletin No. - Publication date

05 - 05.02.2016 ▼

Recording Type

Registrations (1960 and 1999 Acts) ▼

Query

Registration Number ▼ =

AND ▼

International Registration Date ▼ =

AND ▼

Priority Data ▼ =

AND ▼

Locarno Classification ▼ =

AND ▼

Indication of Products ▼ =

AND ▼

Holder ▼ =

AND ▼

Designated Contracting Parties ▼ =

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[INID Codes \(ST.80\) !\[\]\(5a18afe524e3f27c8e87b83f91993700_img.jpg\)](#)

[Locarno classification](#)

To Sum Up

■ Role of the International Bureau

- Formal examination (are the formal requirements met?)
- Registration and recording in the International Register
- Translation and Publication in the ***International Designs Bulletin***
- “Notification” to Designated Contracting Parties
(through the publication of the Bulletin on WIPO website)

■ Effects of the international registration at this stage

- Same effect as a regularly filed national application in all Designated Contracting Parties

The Hague System Procedure II: Role of the Office of a designated CP

Refusal by a designated Contracting Party

on same substantive grounds as for national/regional filings

must be communicated within time limit

effect limited to territory of the member that has refused

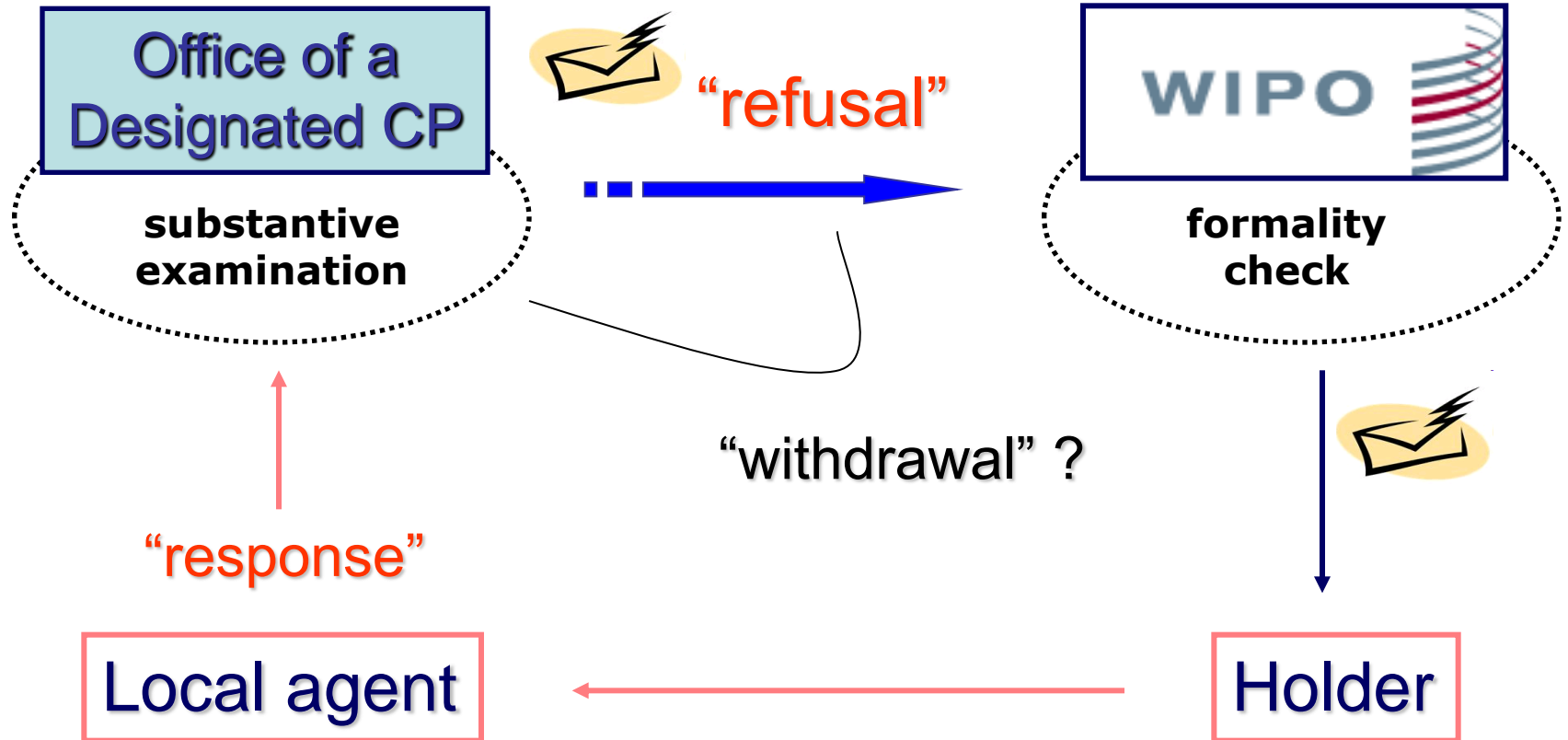
International registration (where not refused)

no refusal = same rights as a local design registration

a bundle of independent national/regional rights

advantages of central management

Refusal Mechanism



Substantive Examination by the Office

- Substantive examination, if any, 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

Possible Office Actions

- Refusal
- Withdrawal of Refusal
- Statement of Grant of Protection

Refusal: Basic Principles

- Refusal period: starting from the **date of publication**
- **Provisional objection**: which may become a **final decision**, without further notification
- Languages: English, French or Spanish
- Total or partial refusal

Refusal: Time Frame

- Principle: 6 months (Art. 12(2) of the 1999 Act, Rule 18(1)(a))
- Exception (Rule 18(1)(b)):
(which may be opted for by a CP whose Office is an “Examining Office” or whose law provides for an opposition procedure)

The period may be extended up to 12 months

Refusal Ground: No formal ground

- Principle (Article 12(1) of the 1999 Act):
substantive grounds only (incl. opposition)
 - Exceptions:
 - requirement as to unity of design (Article 13) *
 - specific views of the design not furnished (Rule 9(3)(a)) *
- * Declaration required

Refusal Ground: Typical substantive grounds

- 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

Withdrawal of Refusal / SGP

- Refusal may be withdrawn, totally or partially:
Withdrawal of refusal (Rule 18(4))
- Withdrawal of refusal may take the form of:
Statement of grant of protection (Rule 18bis (2))
- Statement of grant of protection may be issued even where no refusal (Rule 18bis (1)).
 - *optional but recommended*

Effects of an IR in a designated CP

- After publication (Article 14(1))
= effects *as application* from the date of IR, *at least*
- If no refusal is notified (Article 14(2)(a))
= effects *as a grant of protection*, in principle, *at the latest from the expiry date of the applicable refusal period (6 or 12 months)*
- If the refusal is withdrawn (Article 14(2)(b))
= effects *as a grant of protection at the latest from the date on which the refusal was withdrawn*

Effects of an IR in a designated CP (cont.)

- “Two exceptions” to Article 14(2)(a)

applicable through an additional declaration by a CP (whose Office is an “Examining Office” or whose law provides for an opposition procedure) opting for 12-month refusal period

- Option 1 (Rule 18(1)(c)(i))

The latest time at which protection must be granted may be extended up to 6 months after the expiry date of the 12-month refusal period

Effects of an IR in a designated CP (cont.)

■ “Two exceptions” to Article 14(2)(a) - *continued*

■ Option 2 (Rule 18(1)(c)(ii))

Protection will be granted according to the law of the Contracting Party where a decision regarding the grant of protection was unintentionally not communicated within the applicable refusal period.

= *Protection can be granted even after the refusal period, but only in limited circumstances.*

Subsequent Management of IR

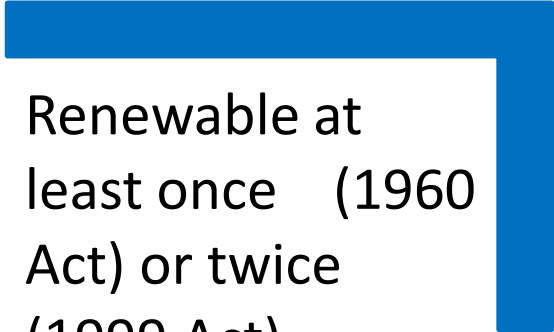

What are the Post-Registration Procedures?

- Renunciation
- Limitation
- Change in ownership
- Renewal
- Change in name and/or address of the holder
- Appointment, change or cancellation of representative

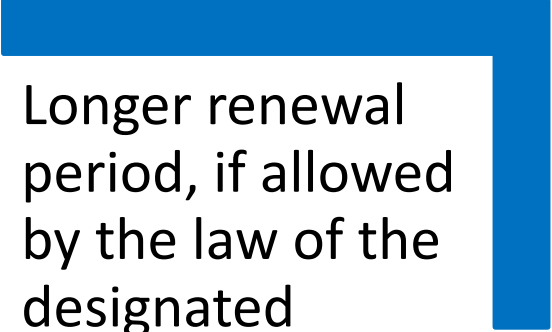

Renewal of IR



Duration of protection: five years



Renewable at least once (1960 Act) or twice (1999 Act)



Longer renewal period, if allowed by the law of the designated Contracting Party

Renewal (Rules 23 – 25)

- Duration of protection under the 1999 Act
 - Initial term: five years
 - Minimum duration:
 - 15 years (5 + 5 + 5)
 - May be further renewed
 - Subject to renewal, protection up to the maximum duration in accordance with the national law
(*refer to declarations of CPs*)

Renewal – Paper Form or Electronic Form

- Paper form: form DM/4
- **E-renewal** interface:
 - Online service (launched in December 2010)
 - https://webaccess.wipo.int/erenewal_dm/erenewal.jsp?lang=EN
 - Online payment (current account or credit card)

Renewal – Scope

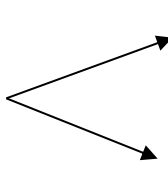
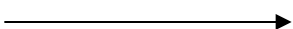
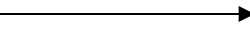
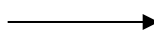
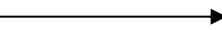
- Renewal **NOT possible** for those CPs and/or for those designs subject to:
 - a renunciation recorded in the International Register
 - a limitation recorded in the International Register
 - an invalidation recorded in the International Register
- Renewal **possible** for a CP in case of refusal recorded in the International Register

Change in Ownership – Rule 21 – Form DM/2

- The Hague Agreement deals only with the recording of the change → the validity of an assignment agreement is outside its scope
- The request can be presented by the holder OR the *new* owner, provided that:
 - the request is signed by the holder, or
 - the request is signed by the *new* owner and accompanied by an attestation from the competent authority of the holder's CP that the new owner appears to be the successor in title of the holder

Summary: Post-Registration Procedures

The holder may request:

- reduction of the scope of the IR 
 - **Renunciation**
 - **Limitation**
- prolongation of the IR 
 - **Renewal**
- transfer IR to new owner 
 - **Change in Ownership**
- update information about the holder 
 - **Change in name and/or address of the holder**
- representation before the International Bureau 
 - **Appointment, change or cancellation of representative**

Change in Ownership – Follow-up Procedure before the Office

- **New Rule 21 *bis*** adopted by the Hague Union Assembly - Entry into force: January 1, 2012.
- Mechanism to allow CP to refuse the effects of the recording of a change in ownership in the International Register, where such a recording is not allowed under their national/regional laws.
- Declaration sent by the Office to the International Bureau will be recorded in the International Register and notified to the previous holder (transferor) and the new holder (transferee) accordingly.
- The part of the international registration which is the subject of the declaration will be recorded as a separate international registration that will “remain” in the name of the previous holder (transferor).

Invalidation in Designated CP

- Office or court decision which is made after producing protection (Rule 20)

- Remarks:
 - Opportunity to defend the right
 - Total or partial invalidation
 - Only the final decision shall be sent to the International Bureau by the Office
 - The International Bureau records and publishes the invalidation



Thank You
www.wipo.int/hague/en