

# WIPO



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**SPECIAL UNION FOR THE INTERNATIONAL DEPOSIT OF INDUSTRIAL DESIGNS  
(HAGUE UNION)**

## **ASSEMBLY**

**Seventeenth (6th Extraordinary) Session  
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**ELECTRONIC PUBLICATION OF INTERNATIONAL DESIGNS: REDUCTION IN  
PUBLICATION FEES AND AMENDMENT OF THE REGULATIONS**

*Document prepared by the International Bureau*

### Introduction

1. In September 1997, the Director General submitted to the fifteenth session of the Hague Union Assembly (hereinafter referred to as “the Assembly”) a proposal to undertake the electronic publication of international designs (see document H/A/XV/2).

2. Pursuant to that proposal, to which the Assembly gave its agreement (see document H/A/XV/3, paragraphs 8 to 10), the current publication (on paper) of the *International Designs Bulletin* is to be replaced by:

(i) a monthly publication on CD-ROM including all the bibliographic data and reproductions of the designs contained in new deposits registered under the 1960 Act, on a cumulative basis; and

(ii) a monthly publication on paper including all the data contained in the present publication, with the exception of the reproductions of the designs registered under the 1960 Act, i.e., the bibliographic data of deposits registered under the 1960 and 1934 Acts and the information on renewals, prolongations, changes of ownership, changes of owner's name or address, appointments of representatives, renunciations of such appointments, renunciations of deposits, refusals and termination of protection, and corrections made to the International Register.

3. As pointed out in document H/A/XV/2, the new mode of publication for international designs will result in substantial savings which could be passed on to the depositors as a corresponding reduction in the publication fee, thus requiring modification of the schedule of fees. Additionally, the discontinuation of publication in paper form of the reproductions of designs will make it necessary to amend various of the provisions in the Regulations under the Agreement. The present document:

(i) describes the progress of the project for CD-ROM publication of international designs;

(ii) proposes a reduction in the publication fees referred to in the schedule of fees; and

(iii) proposes amendment of Rules 1, 3, 5, 9, 12, 14, 16, 17 and 22 of the Regulations under the Agreement;

#### Progress of the Project

4. On the basis of the proposal submitted to the Assembly in document H/A/XV/2, the Secretariat completed the technical specification for the new electronic publication in November 1997 and, in January 1998, called for tenders for writing the necessary software, identifying and installing the required hardware and training the corresponding staff. The project development phase began on April 14, 1998. At the same time, a new module of the computerized system for administering the international registrations of marks (MAPS) (Madrid Agreement and Protocol System)) was developed in order to store in a relational database the bibliographic data of international deposits to be used not only for the new publication but also for updating the Register of International Deposits and for the issuing of registration certificates and various items of correspondence (receipts, irregularity notices, notices of expiry, etc.). The entering of the bibliographic data of international deposits in this new MAPS module started on June 1, 1998. A demonstration version of the new CD-ROM publication should be available at the beginning of September 1998.

5. To enable the Offices of the States party to the 1960 Act of the Hague Agreement and other users of the publication to familiarize themselves with the use of the new CD-ROM (as proposed by one of the delegations at the fifteenth session of the Assembly (see document H/A/XV/3, paragraph 9), the Secretariat intends to publish at the end of November 1998 and the end of January 1999 the designs registered in September 1998 and in November 1998, respectively, both on paper and on CD-ROM. Thus from March 1999, i.e. with the publication of the first designs registered in 1999, publication of the reproductions of designs registered under the 1960 Act will be made exclusively on CD-ROM.

Reduction in Publication Fees

6. The total cost of printing (including the paper) for 24 issues of the International Designs Bulletin in its present version and of the two annual tables of owners is estimated at 1,800,000 Swiss francs. The introduction of the new publication mode in March 1999 will save the cost of ten issues of the current publication and of one table of owners for the current biennium, that is to say savings estimated at 800,000 Swiss francs. From those savings must be deducted 25,000 Swiss francs for the pressing of ten monthly issues of the new CD-ROM version (450 copies), 50,000 Swiss francs for printing the paper publication of deposits governed by the 1934 Act of the Agreement and of the other bibliographic data mentioned in paragraph 2 above and 215,000 Swiss francs, for the whole of 1999, for work involved in the digitization of the reproductions of the deposited designs, that is to say a net saving for 1999 of  $[800,000 - 25,000 - 50,000 - 215,000 =]$  510,000 Swiss francs.

7. As stated to the Assembly at its fifteenth session (see document H/A/XV/2, paragraph 14) and in the program and budget submitted to the thirty-second series of meetings of the Assemblies of the Member States of WIPO in March 1998 (see document A/32/2, sub-program 15.2, expected results), it is proposed that the depositors should be given the benefit of the savings by a corresponding reduction in the publication fees.

8. On the basis of the publication fees received for the first five months of 1988 and taking into account the forecast growth in the number of deposits of designs during 1999 (i.e. five per cent; see document AB/32/2, sub-program 15.1, expected results), the amount of the publication fees that would be paid for 1999 may be estimated at 2,157,750 Swiss francs. Savings of 510,000 Swiss francs represent 24 per cent of this total of 2,157,750 Swiss francs and therefore enable a reduction to be proposed (whilst maintaining a small margin of security) of approximately 20 per cent of publication fees as from January 1, 1999.

9. As suggested in document H/A/XV/2 (paragraph 17), the possibility has been envisaged of taking the opportunity of a reduction in the overall amount of publication fees in order to modify the method of calculating those fees. The amount of the fees is currently based on the surface area taken up in the International Designs Bulletin by the reproduction of the designs and on their nature (black and white or color) whereas, under the new publication system, the cost of electronic publication will be more directly linked to the number of reproductions (the digitization being largely independent of the size of the image to be digitized) than to their surface area or their nature (which will nevertheless remain relevant in so far as the volume taken up by a registration on the CD-ROM and the cost of printing the registration certificate will depend on the size of the reproductions and on them being in black and white or in color).

10. However, a complete remodelling of the system for calculating publication fees which would aim to reflect more accurately the true cost of publication of the reproductions of international designs would lead to an increase in the fees for certain types of deposit that benefit the most from the present system of calculation and which generally originate from small depositors or from branches that make large numbers of deposits (as, for example, textile designs). Such depositors would be hard put to understand that an overall reduction in the amounts of the publication fees would mean an increase in fees for them. In addition, a significant adjustment of the system for calculating publication fees would of necessity be accompanied by a high degree of uncertainty as to the revenue derived under the new system

since depositors would naturally tend to adapt to the new system in order to pay the lowest publication fee.

11. It is therefore felt that changes in the present manner of calculating the publication fee could only be introduced in stages and would have to be based on experience gained with the real costs of the new publication mode. In addition, any redistribution of the overall burden of publication on the basis of new criteria would have to be the subject of consultation, if it is to be well accepted by the users of the Hague system, with the professional organizations that represent those users.

12. It is therefore proposed, at this juncture, and with effect from January 1, 1999, that an across-the-board reduction of 20 per cent be applied to the publication fees shown in the schedule of fees contained in the Regulations under the Hague Agreement, i.e.:

– 33 Swiss francs instead of 41 Swiss francs for each set of four standard spaces for publication in black and white and

– 264 Swiss francs instead of 330 Swiss francs for each set of four standard spaces for publication in color.

13. The schedule of fees annexed to the Regulations under the Hague Agreement would be modified accordingly.

*14. The Assembly is invited to approve the new amounts for the publication fees referred to in paragraph 12 above and the corresponding amendment to the schedule of fees annexed to the Regulations under the Hague Agreement, with effect from January 1, 1999.*

#### Amendments to the Regulations

15. The new publication mode for deposits of international designs governed by the 1960 Act of the Agreement implies certain amendments to the Regulations under the Agreement, which are shown in the Annex to this document and are explained below. Those amendments would take effect on January 1, 1999.

#### *Rule 1: Abbreviated Expressions*

16. The new definition proposed for the word “Bulletin” for the purposes of the Regulations specifies that the periodical publication of the relevant data of international deposits may take on more than one form. In fact, the “Bulletin” will be a combination of the new CD-ROM and the paper publication reduced to bibliographic data.

*Rule 12: Reproduction, Samples and Models of the Designs or Articles*

17. With the new publication mode for reproductions of international designs deposited under the 1960 Act, the International Bureau will no longer require a second set, for the printer, of the photographs or other graphic representations that are filed (in addition to the set of reproductions affixed to the application for registration). Likewise, the transparencies will no longer be of any utility. It is therefore proposed to amend subparagraphs 1(b), (c) and (d) of Rule 12 and to delete any reference to “transparencies” in *Rules 3.1(c), 5.1(c)(ii), 9.2(b) and 16.1(ix)*.

18. At the same time, it is proposed that only one photograph or other graphic representation, or only one sample, should be required of designs deposited under the 1934 Act, since a single copy is sufficient as any subsequent communication with the competent authorities of the Member States referred to in Article 14 of the 1934 Act is made by supplying photographs of the representations or samples kept by the International Bureau. Paragraph 1(a) of Rule 12 would also be amended accordingly.

19. It should be noted that the reduction from two to one in the number of copies of representations required also constitutes a significant saving for depositors.

*Rule 9: Multiple Deposit*

20. Since, as mentioned above, the international deposit will in future contain only one set of photographs or other graphic representations, the numbering of industrial designs contained in a multiple deposit can no longer appear on the representations themselves but will have to be shown alongside those representations, in accordance with what the Administrative Instructions will provide.

*Rule 14: Recording or Declining of the International Deposit*

21. The amendment proposed for paragraph 2(b)(i) of Rule 14 results also from the reduction from two to one of the number of copies required.

*Rule 17: Refusals; Rule 22: Corrections*

22. Since the new CD-ROM will be cumulative, one and the same deposit will be repeated for several months on the same CD-ROM. It therefore would seem useful to specify that the publication to which Rules 17 and 22 refer is the first publication of the deposit or of the correction concerned.

23. The implementation of the new publication mode for representations of designs deposited under the 1960 Act of the Agreement will also imply amendments to Administrative Instructions 101, 302, 303, 401, 402, 601, 602 and 603. Pursuant to Rule 31 of the Regulations under the Agreement, these amendments will be the subject of consultations with the Offices concerned as soon as the new mode of publication has been decided in full detail.

*24. The Assembly is invited to adopt, with effect from January 1, 1999, the amendments to the Regulations under the Agreement set out in paragraphs 15 to 22 above and in the Annex to this document.*

[Annex follows]

ANNEX

PROPOSED AMENDMENTS TO THE REGULATIONS

**Rule 1**

**Abbreviated Expressions**

CURRENT WORDING	PROPOSED WORDING
1.1 <i>Abbreviated Expressions</i>	[No change]
For the purposes of these Regulations:	[No change]
[...]	[...]
(xxi) “Bulletin” means the <i>International Designs Bulletin/Bulletin des dessins et modèles internationaux</i> .	(xxi) “Bulletin” means the periodical publication containing the data relating to international deposits whatever the medium used for that publication.

**Rule 3**

**The International Register**

CURRENT WORDING	PROPOSED WORDING
3.1 <i>Contents of the International Register; Keeping of the International Register</i>	[No change]
[...]	[...]
(c) In the case of international deposits which are governed exclusively or partly by the 1960 Act, the International Register shall contain, in addition to the indications referred to in paragraph (a), the reproduction of photographs, other graphic representations or photographic transparencies filed.	(c) In the case of international deposits which are governed exclusively or partly by the 1960 Act, the International Register shall contain, in addition to the indications referred to in paragraph (a), the reproduction of photographs or other graphic representations filed.
[...]	[...]

## Rule 5

### Mandatory Contents of the Application

CURRENT WORDING	PROPOSED WORDING
5.1 <i>Mandatory Contents of the Application</i>	[No change]
[...]	[...]
(c) In the case of international deposits governed exclusively or partly by the 1960 Act, the application shall contain, in addition to the indications referred to in paragraph (a):	[No change]
[...]	[...]
(ii) an indication of the documents, photographs, transparencies or other graphic representations accompanying the application;	(ii) an indication of the documents, photographs or other graphic representations accompanying the application;
[...]	[...]

## Rule 9

### Multiple deposit

CURRENT WORDING	PROPOSED WORDING
[...]	[...]
9.2 <i>Other Rules Applicable to Multiple Deposits</i>	[No change]
[...]	[...]
(b) Each design included in a multiple deposit shall be identified by a different number, which shall appear on the photographs, other graphic representations or photographic transparencies and on the samples or models which may accompany the application. Numbering shall be in accordance with the Administrative Instructions.	(b) Each design included in a multiple deposit shall be identified by a different number, which shall appear on the photographs or other graphic representations and on the samples or models which may accompany the application. Numbering shall be in accordance with the Administrative Instructions.
[...]	[...]



## Rule 12

### Reproduction, Samples and Models of the Designs or Articles

#### CURRENT WORDING

#### PROPOSED WORDING

##### 12.1 *Reproduction, Samples and Models*

[No change]

(a) In the case of international deposits governed exclusively by the 1934 Act, the application shall be accompanied by two photographs or other graphic representations, or two samples, of each design or of each article in which it is intended to incorporate the designs.

(b) In the case of international deposits which are governed exclusively or partly by the 1960 Act, the application shall be accompanied, for each design or for each article in which it is intended to incorporate the designs,

(a) In the case of international deposits governed exclusively by the 1934 Act, the application shall be accompanied by one photograph or other graphic representation or one sample of each design or of each article in which it is intended to incorporate the designs.

(b) In the case of international deposits which are governed exclusively or partly by the 1960 Act, the application shall be accompanied, for each design or for each article in which it is intended to incorporate the designs, by one photograph or other graphic representation, in color if the depositor requests publication in color or, failing that, in black and white, presented in accordance with the provisions of the Administrative Instructions. Additionally, the application may be accompanied by samples or models of the article or articles. The dimensions of the representation of each design or article shown in the photographs or other graphic representations accompanying the application shall be those in which the depositor wishes the design to be published, provided that one of those dimensions shall be not less than 3cm. The dimensions of the representations of the articles shall not be more than 16cm x 16cm.

(i) if the depositor does not request that the designs be published in color: by two photographs or other graphic representations in black and white;

(ii) if the depositor requests that the designs be published in color: by either two photographs or other graphic representations in color, or one color transparency and two photographs in color produced from the transparency.

Additionally, the application may be accompanied by samples or models of the article or articles. The dimensions of the representation of each design or article shown in the photographs or other graphic representations accompanying the application shall be those in which the depositor wishes the design to be published, provided that one of those dimensions shall be not less than 3cm. The dimensions of the representations of the articles shall not be more than 16cm x 16cm.

(c) Photographs, graphic representations or photographic transparencies shall be of a quality permitting all the details of the articles shown in them to be clearly distinguished and admitting of reproduction in accordance with the provisions of the Administrative Instructions.

(d) The same article may be represented from different angles; reproductions of the article viewed from different angles may be shown on the same photograph, graphic representation or transparency or on separate photographs, graphic representations or transparencies.

(e) The photographs or other graphic representations, the transparencies or the samples or models relating to one and the same deposit shall be contained in a single envelope or packet. None of the dimensions of any envelope or packet, including packing, shall exceed 30cm and the weight of any such envelope or packet and its packing shall not exceed 4kg. Perishable articles or articles which are dangerous to store shall not be accepted for deposit.

(c) Photographs or graphic representations shall be of a quality permitting all the details of the articles shown in them to be clearly distinguished and admitting of reproduction in accordance with the provisions of the Administrative Instructions.

(d) The same article may be represented from different angles; reproductions of the article viewed from different angles may be shown on the same photograph or graphic representation or on separate photographs or graphic representations.

(e) The photographs or other graphic representations or the samples or models relating to one and the same deposit shall be contained in a single envelope or packet. None of the dimensions of any envelope or packet, including packing, shall exceed 30cm and the weight of any such envelope or packet and its packing shall not exceed 4kg. Perishable articles or articles which are dangerous to store shall not be accepted for deposit.

## Rule 14

### Recording or Declining of the International Deposit

CURRENT WORDING	PROPOSED WORDING
[...]	[...]
14.2 <i>Defective International Deposits</i>	[No change]
[...]	[...]
(c) The international deposit shall bear the date on which the correction of the defect was received by the International Bureau where the defect was one of the following:	[No change]
[...]	[...]
(viii) the provisions of Rule 12.1(a) or of Rule 12.1(b), first sentence, were not complied with, except in the case where the photographs, other graphic representations, samples or models were furnished in one copy only;	(viii) the provisions of Rule 12.1(a) or of Rule 12.1(b), first sentence, were not complied with;
[...]	[...]

## Rule 16

### Publication of the International Deposit

CURRENT WORDING	PROPOSED WORDING
16.1 <i>Contents of the Publication of the International Deposit</i>	[No change]
The publication of any international deposit shall contain:	[No change]
[...]	[...]

(ix) where the international deposit is governed exclusively or partly by the 1960 Act, the reproduction of the photographs, other graphic representations or transparencies filed;

[...]

(ix) where the international deposit is governed exclusively or partly by the 1960 Act, the reproduction of the photographs or other graphic representations filed;

[...]

## **Rule 17**

### **Refusals**

#### **CURRENT WORDING**

*17.1 Forms and Contents of Notifications of Refusal and of Withdrawal of Refusal*

[...]

(b) The notification of refusal of protection shall indicate:

[...]

(ix) the date on which the national or regional Office which pronounced the refusal received the issue of the Bulletin in which the international deposit was published;

[...]

*17.2 Recording, Transmittal and Publication of Refusal and Withdrawal of Refusal*

(a) The refusal shall not be recorded in the International Register:

[...]

#### **PROPOSED WORDING**

[No change]

[...]

[No change]

[...]

(ix) the date on which the national or regional Office which pronounced the refusal received the issue of the Bulletin in which the international deposit was published for the first time;

[...]

[No change]

[No change]

[...]

(ii) if the date referred to in Rule 17.1(b)(ix) has not been indicated, unless the notification of refusal was received by the International Bureau within six months after the publication date of the issue of the Bulletin in which the international deposit was published;

[...]

(ii) if the date referred to in Rule 17.1(b)(ix) has not been indicated, unless the notification of refusal was received by the International Bureau within six months after the publication date of the issue of the Bulletin in which the international deposit was published for the first time;

[...]

## Rule 22

### Corrections

#### CURRENT WORDING

##### 22.1 *Corrections*

[...]

(c) Where a refusal pronounced by a national or regional Office relates to a corrected element, Rule 17 shall apply *mutatis mutandis*. The date referred to in Rule 17.1(b)(ix) shall be considered by the International Bureau to be the date of receipt by the national or regional Office of the issue of the Bulletin in which the correction was published.

#### PROPOSED WORDING

[No change]

[...]

(c) Where a refusal pronounced by a national or regional Office relates to a corrected element, Rule 17 shall apply *mutatis mutandis*. The date referred to in Rule 17.1(b)(ix) shall be considered by the International Bureau to be the date of receipt by the national or regional Office of the issue of the Bulletin in which the correction was published for the first time.

[End of annex and of document]