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WORLD INTELLECTUAL PROPERTY ORGANIZATION
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**COMMITTEE OF EXPERTS
ON THE DEVELOPMENT OF THE HAGUE AGREEMENT
CONCERNING THE INTERNATIONAL DEPOSIT
OF INDUSTRIAL DESIGNS**

**Seventh Session
Geneva, November 3 to 7, 1997**

REPORT

adopted by the Committee of Experts

I. INTRODUCTION

1. The Committee of Experts on the Development of the Hague Agreement Concerning the International Deposit of Industrial Designs (hereinafter referred to as “the Committee of Experts”) held its seventh session in Geneva from November 3 to 7, 1997.
2. The following States members of the Hague Union were represented at the session: Belgium, Egypt, France, Germany, Greece, Hungary, Indonesia, Italy, Luxembourg, Netherlands, Romania, Slovenia, Spain, Switzerland (14).
3. The following States were represented by observers: Brazil, Canada, Croatia, Czech Republic, Denmark, Ecuador, Japan, Norway, Portugal, Republic of Korea, Russian Federation, Slovakia, Sudan, Sweden, United Kingdom, United States of America (16).
4. Representatives of the Benelux Designs Office (BBDM) and the European Communities (EC) took part in the session in an observer capacity.

5. Representatives of the following non-governmental organizations took part in the session in an observer capacity: American Bar Association (ABA), American Intellectual Property Law Association (AIPLA), Asian Patent Attorneys Association (APAA), Committee of National Institutes of Patent Agents (CNIPA), European Apparel and Textile Organisation (EURATEX), European Communities Trade Mark Association (ECTA), Federal Chamber of Patent Attorneys (FCPA), International Association for the Protection of Industrial Property (AIPPI), International Council of Societies of Industrial Design (ICSID), International Federation of Industrial Property Attorneys (FICPI), International League for Competition Law (LIDC), International Liaison Committee for Embroideries, Curtains and Laces (CELIBRIDE), Japan Design Protection Association (JDPA), Japan Intellectual Property Association (JIPA), Japan Patent Attorneys Association (JPAA), Max-Planck Institute for Foreign and International Patent, Copyright and Competition Law (MPI), Swiss Textile Federation (TVS), Union of European Practitioners in Industrial Property (UEPIP), Union of Industrial and Employers' Confederations of Europe (UNICE) (19).

6. The list of participants is given in the Annex to this report.

7. On behalf of the Director General of WIPO, Mr. François Curchod, Deputy Director General, opened the session and welcomed the participants.

8. The Committee of Experts unanimously elected Mr. Peter Mühlens (Germany) as Chairman and Mr. Philippe Baechtold (Switzerland) and Mrs. Constanta Moraru (Romania) as Vice-chairmen. Mr. Malcolm Todd (WIPO) acted as Secretary to the Committee of Experts.

9. Discussions were based on the following documents drawn up by the International Bureau of WIPO: "Draft New Act of The Hague Agreement Concerning the International Registration of Industrial Designs" (document H/CE/VII/2), "Notes on the Draft New Act of the Hague Agreement Concerning the International Registration of Industrial Designs" (document H/CE/VII/3), "Draft Regulations Under the Draft New Act of the Hague Agreement Concerning the International Registration of Industrial Designs" (document H/CE/VII/4) and "Notes on the Draft Regulations Under the Draft New Act of the Hague Agreement Concerning the International Registration of Industrial Designs" (document H/CE/VII/5).

10. The International Bureau noted the interventions made and recorded them on tape. This report summarizes the discussions without reflecting all the observations made.

II. GENERAL OBSERVATIONS

11. The Delegation of Luxembourg, speaking on behalf of the European Community and its Member States, said that the draft new Act seemed on the whole to respond adequately to some of the problems that had been mentioned in the past, notably at the fifth session. More specifically, the European Community and its Member States were pleased with the way in which the draft was structured in two different chapters according to whether or not the Contracting Party in question had an examining Office. That made it possible to preserve the

undoubted advantages of the present Hague system while at the same time seeking to broaden its geographical scope. Therefore, apart from one or two points that would be raised in the course of the meeting, and which had a global relevance to the need to devise a balanced system that was as simple and attractive as possible to industry, the European Community and its Member States wished to give their broad support to the new draft Act, and intended to take part in the discussion in such a way as to ensure interoperability between the future Community Design system and the Hague system.

12. The Delegation of the United States of America stated that there was a growing interest in design protection in the United States of America, as evidenced by ever-increasing numbers of design patent applications; for the fiscal year ended in September 1997, this number was around 15,800. There was also increasing interest in the private sector in international and foreign systems for the protection of industrial designs, including that under the Hague Agreement. Given the benefits to the users of the Hague system, the Government of the United States of America planned to continue its active participation in these discussions with the goal of obtaining an agreement to which it could subscribe. The new Act of the Hague Agreement must allow the maintenance of the substantive examination system currently in place. This did not, however, mean that the United States of America was unwilling to make necessary and appropriate changes to its law and regulations. For example, the term provisions of the United States of America design patent law would have to be modified, since they presently provide for a term of 14 years from the date of grant of protection. In addition, effective December 1, 1997, the regulations would change so that shading would no longer be a required element in drawings to show contour and character of surfaces; instead, shading would merely be recommended to illustrate surface features. Also, under the new rules, applicants would be permitted to submit color photographs and color drawings to the United States Patent and Trademark Office. Some of these changes, as well as other changes under consideration, were motivated by the participation of the United States of America in this Committee of Experts. There was a limit, however, to the changes that could be made. At its core, the design patent system of the United States of America is different from the many other systems for the protection of industrial designs. Some of the improvements currently being made brought the design patent system into closer alignment with the Hague system. Nonetheless, the process for the development of a new Act of the Hague Agreement was not an industrial design law harmonization process.

13. The Delegation of Switzerland said that the draft new Act was a successful attempt at reconciling different protection systems under the same roof in such a way that users might make international deposits on conditions that would undoubtedly be easier than at present. The delegation added that the new draft Act was useful to numerous branches of industry, and appealed to all the delegations present to do their utmost to bring about the completion of the work. It pointed out that the Committee of Experts had reached its seventh session, and that compromises had been found which, while perhaps not capable of entirely satisfying everyone, would nevertheless ensure the attainment of a number of important objectives (for instance the primacy of the relevant international treaties, the effects of an international deposit or the limitation of such additional requirements as might be imposed by examining offices). The delegation said that it was broadly supportive of the draft new Act, and wanted the work undertaken to be completed as quickly as possible, without the results achieved being questioned in any way.

14. The Delegation of Romania was pleased that the work on a new treaty on the development of the Hague Agreement was continuing in a very positive spirit and with due account being taken of the discussions of the previous session. It mentioned that it attached great importance to the objective of broadening the Agreement to make it into a more effective instrument for the protection of industrial designs. As for the present draft new Act, the delegation considered that it contained a sufficient number of the necessary elements with which to approximate divergent positions on the international protection of industrial designs, and it welcomed the retention of the two separate Chapters, one on the simple and quick system without substantive examination, and the other on the system with substantive examination.

15. The Delegation of Japan declared that, in the current situation in which the globalization of economic activities is rapidly progressing, it was important for each country to build and facilitate access to an easy route to protect design rights internationally through unified procedures, as would be made possible under the revised Hague Agreement. From this standpoint, Japan supported the basic purpose of the revised Agreement. The new system should be established as soon as possible through an Act in which as many countries as possible could participate. To realize this, the Act needed to be flexible enough to accommodate the diverse design systems used by individual countries. The proposed Act was not designed directly to harmonize different design systems; nevertheless, it should not be considered on the assumption that different systems and their operations should be left as they are. In order to accommodate the revised Act, the Government of Japan intended to review its design system. At the previous session, Japan had proposed, as a compromise, setting the maximum period for the notification of a refusal at 18 months. Japan was also planning to incorporate various styles of drawings into its design law, which was due to be revised shortly. The draft of the new Act included elements which made it easier for countries with examination systems to join. However, the draft still needed to have some points clarified and to incorporate further elements in order to make the system flexible enough to allow as many countries as possible to join. In particular, the new system needed to be flexible enough to allow equal protection to be provided with respect to rights acquired on the basis of the national registration system and rights acquired under the new international registration system, in particular by collaboration between a complementary International Register and domestic register, and international publication and domestic publication. The Delegation of Japan also stated that all parties to the new system would have an equal concern for the provisions of the new Act; it would therefore be preferable not to limit the voting right of some parties, as prescribed in paragraph (3) of Article 10. Finally, Japan stressed the necessity of the early establishment of a new system which would facilitate and efficiently secure the protection of design rights throughout the world.

16. The Delegation of the Russian Federation said that it had observed, on attending the Committee of Experts for the third time, that from session to session considerable progress was being made in the work on the improvement of the industrial design protection system. The delegation said that, because they took into account the discussions of the previous sessions and sought to reconcile the different requirements of national industrial design laws, the documents presented were a reasonable solution that was compatible on the whole with the industrial design provisions of the patent law of the Russian Federation, and that as a result the Russian Federation would be able to contemplate becoming party to the new Act.

17. The Delegation of the United Kingdom considered that the scheme now proposed was a significant improvement on earlier proposals. United Kingdom designers were not as well served as either inventors or those wanting to protect their trademarks (both of which had access to national, European and international routes); United Kingdom designers on the other hand only have access to national routes in order to protect their designs. The United Kingdom was determined to raise the profile of design protection. To this end, its Office had begun to classify designs using the system of international classification under the Locarno Agreement, and it was presently giving serious consideration to accession to that Agreement. Moreover, the Office had recently begun to publish a journal illustrating designs registered by the United Kingdom Designs Registry. In addition, the United Kingdom was looking at modernizing its legislation for the protection of designs. The adoption of an EC proposal for harmonizing the laws within the European Union would be an important factor in this process. Designers in the United Kingdom were showing increasing interest in the Hague Agreement. The present draft Act could however cause some practical difficulties, for example, where a design which was the subject of deferred publication, and which must therefore remain confidential, was found in the course of a novelty examination. However, such difficulties did not seriously undermine the overall attractiveness of the draft new Act, which the United Kingdom viewed positively.

18. The Delegation of the Republic of Korea recalled that the purposes of the new Act were to facilitate the protection of industrial designs at the international level by way of a harmonized system that would make it possible for countries not yet party to the Hague Agreement to join the new Act, and to provide appropriate application procedures for the industrial sectors that produce design products with a short life-cycle. In line with these objectives, the Delegation of the Republic of Korea expressed its keen interest in the flexibilities contained in the draft new Act (for example, the filing of specimens, deferment of publication and prolongation of the period for the notification of refusal) and indicated that, given that the present draft Act was more elaborate than previous texts, it was confident that a successful conclusion could be reached. The Republic of Korea was not a member of the Hague Union; it was studying the prospects of joining the new Act. To this effect, it was introducing certain provisions (e.g., multiple-design applications, partial non-substantive examination system) in order to provide applicants with rapid and appropriate protection.

19. The Delegation of Norway considered that the draft new Act had a basic structure that was sound; it would be an adequate and efficient instrument for international design protection, and yet be flexible enough to accommodate different national design laws. Nonetheless, there were still some problems, and a non-paper from Norway concerning the interpretation of Articles 10 and 12 would be distributed. Regarding latest developments in Norway, the Norwegian Designs Law was now based on a post-registration opposition system and the average time for granting protection had been reduced from approximately 12 months to about eight months from the filing date. Similarly, Norway wished to contribute to making the new Act a customer-friendly instrument for international design protection. With a view to reaching agreement, Norway was willing to consider changes in its Designs Law, particularly where such changes would benefit users.

20. The Representative of the American Bar Association (ABA) stated that the Chairman of its Section of Intellectual Property Law had recently written to the United States Commissioner of Patents and Trademarks urging prompt completion of this treaty work. He also stated that, in October 1997, the Section Committee on this treaty revision work had

unanimously approved a draft resolution favoring in principle revision of the Hague Agreement, and specifically favoring United States adherence to the revised treaty to the extent it did not mean a significant change in United States design patent law. The Representative considered that the draft Act should be submitted promptly to a Diplomatic Conference, where the remaining major issues could be addressed. He believed that the Regulations should be completed on points where there was general agreement, with compromises that allowed wide acceptance, and that work should continue on improving the Regulations after the revised treaty was in operation. In his opinion, the Regulations should not be used as a basis for forcing compliance with a new approach where it was apparent that considerably more time would be needed to develop general acceptance.

21. The Representative of the Japan Patent Attorneys Association (JPAA) expressed the hope that the International Design Registration System would be compatible with the various design systems, namely, non-examination systems, substantive examination systems and opposition systems, thus enabling many parties to join the new Act of the Hague Agreement. He also expressed the hope that the International Register would contain all relevant information concerning the status of the internationally registered designs in respect of all designated Contracting Parties so as to make it easier for users to conduct searches. Finally, he hoped that a designated Office would be allowed to require a translation in certain situations, for example, when a holder responds to a refusal issued by that Office.

22. The Representative of the International Association for the Protection of Industrial Property (AIPPI) recalled that, from its start a hundred years ago, her Association had worked on the creation of an international design protection system, and had participated in the work aiming at improving the existing Hague system in order to simplify procedures and attract more member countries. Although the Representative believed that the documents presented by the International Bureau showed a step in the right direction, she expressed the hope that the fees should be as low as possible, so as to make the system workable also in practice.

23. The Representative of the Asian Patent Attorneys Association (APAA) welcomed the fact that Article 5(2) of the previous draft of the new Act had been withdrawn, since it would have made it unattractive for countries with substantive examination to join the new Act. He also hoped that the International Bureau would take into consideration the fact that French and English were not commonly used in the majority of Asian countries. The Asian Patent Attorneys Association had members in 18 Asian countries, who conducted their practice in their own languages. Indonesia, the Democratic People's Republic of Korea and Mongolia were at present members of the Hague Agreement. If the language problem were somehow solved, more Asian countries would join the Agreement. Many Asian countries which produced articles such as textiles and toys were developing countries. When such a country, where neither French nor English is commonly spoken, was designated in an international design registration, submission of the documents and publication of the details of the registered design should be made in the language of the designated country, whether the country had a substantive examination system or not, so that its people and examiners might understand the registered design correctly.

24. The Representative of the Swiss Textile Federation (TVS) said that the draft new Act was an interesting base for obtaining satisfactory results. He pointed out that the aim of the new Act was not only to enlarge the number of participating countries, but also to make the

system more attractive for the users. He added that his organization would participate in a positive manner in the debate, hoping that a final result would be reached.

25. The Representative of the American Intellectual Property Law Association (AIPLA) stated that the discussions in previous sessions had had the beneficial effect of causing the United States to review its design patent practice and make a number of changes, particularly to its drawing and photograph requirements. He expressed his continuing support for the work of the Committee of Experts and looked forward to a successful resolution of the remaining issues.

26. The Representative of the Japan Intellectual Property Association (JIPA) welcomed the omission of the former Article 5(2) from the present text of the draft new Act. However, JIPA still had some problems with certain provisions of the current draft, as already stated by the Delegation of Japan.

27. The Representative of the International Council of Societies of Industrial Designs (ICSID) referred to the declarations made by the Delegations of Japan, the United States of America and the United Kingdom concerning the increasing importance of, and interest in, adequate international protection for designs. He expressed the hope that the Committee of Experts would respond to such increasing interest by delivering a new agreement which would be as simple as possible. He recalled that compromise would be necessary, since no international agreement is ever completely satisfactory to all interests. He also supported the view of the Swiss Delegation as regards the necessity to press ahead with discussion of new material, rather than to re-open matters previously agreed. The Representative hoped that the work would be completed at this session, for which the new draft Act seemed to provide a reasonable prospect, so that a Diplomatic Conference could be held in 1998.

28. The Representative of the Japan Design Protection Association (JDPA) stated that his organization supported the current draft of the new Act. He said that an international design application system such as the Hague system would be very useful for the Japanese users, and stressed the importance of establishing an international system for design application as soon as possible. While recognizing that problems might remain, he hoped that convenience to the users and potential users would be borne in mind.

29. The Representative of the International League for Competition Law (LIDC) said that his Organization was in favor of any progress towards improving the protection of industrial and artistic property with a deposit procedure that brought national systems closer together and thereby allowed the geographical scope of protection to be substantially enlarged. In addition, he supported the wish expressed by the Delegation of Switzerland to the effect that the work of the Committee of Experts should be completed rapidly, and endorsed the statements made by the Representative of AIPPI according to which the documents and projects submitted were a great step forward.

III. PROVISIONS OF THE DRAFT NEW ACT

Article 1: Abbreviated Expressions

30. The International Bureau stated that the definition of “Gazette” in paragraph (vii) arose from paragraph 73 of the Report of the sixth session, which contemplated a term which would cover an electronic publication, such as a CD-ROM. It was also recalled that, in September 1997, the Assembly of the Hague Union had approved a proposal to publish the current International Designs Bulletin on CD-ROM.

Article 2: Applicability of Other Protection Accorded by Laws of Contracting Parties and of Certain International Treaties

31. The Delegation of Romania proposed to reverse the wording of paragraph (2)(ii) in order to provide for the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement) to have no effect on the provisions of the present Act. The International Bureau recalled that the aim of this provision, included at the request of several delegations, was to ensure that a Contracting Party could not, as a result of its accession to the new Act, be relieved of its obligations ensuing from the TRIPS Agreement. It was noted that the question of what was the most adequate formulation to reach this goal could be discussed during the Diplomatic Conference.

32. The International Bureau proposed to replace “relatives aux” by “qui concernent les” in the French version of paragraph (3) in order to follow the corresponding English version of this provision. It explained that the latter wording was preferable because the former wording could be understood as referring only to provisions of the Paris Convention that were specific to industrial designs.

Article 3: Entitlement to File an International Application

33. There were no comments on this article.

Article 4: Procedure for Filing of the International Application

34. The Delegation of the Russian Federation proposed that paragraph (1) provide not only for a Contracting Party to notify the Director General that international applications may not be filed through the intermediary of its Office, but also the reverse alternative, i.e., the possibility to require that international applications be filed through its Office. The International Bureau explained that indirect filing burdened the international procedure and that it appeared more favorable to allow an applicant to file an international application direct with the International Bureau.

35. The Delegation of Switzerland asked the International Bureau to confirm that, in the case of indirect filing, the filing date could be the date of sending of the international application by the applicant to the Office of his Contracting Party. It explained that this could

be the case since, on the one hand, paragraph (2)(c) provided that the filing date must be the date on which the Office of the applicant's Contracting Party received the international application and, on the other hand, according to Note 4.05, the date of receipt of the international application by that Office was determined by the law of that Contracting Party. The International Bureau said that this question needed further thought and could be dealt with either in the Regulations or by means of an agreed statement adopted by the Diplomatic Conference.

Article 5: Contents of the International Application

36. Responding to the Delegation of the United States of America, which regretted that no provision was made for electronic filing, the International Bureau said that the technology concerned was evolving so rapidly that it seemed preferable to leave this subject for a later version of the Regulations. It was, however, definitely intended that electronic filing should be allowed.

37. The Delegation of the United States of America asked whether the requirement in paragraph (1)(a)(ii) to indicate the name of the applicant's Contracting Party was necessary, given the omission of the former paragraph (2). The International Bureau drew attention to the definition of "applicant's Contracting Party" in Article 1(xiii), and commented that this not only related to entitlement to file, but could also have other consequences, for example, in the case of indirect filing.

38. In connection with paragraph (1)(a)(iii), the Delegation of the United States of America recalled that deferment of publication was not possible under its law, nor was the filing of specimens allowed. It then referred to the case where an international application designating its country was accompanied by specimens instead of reproductions and, for the reason set out in Article 9(3), the request for deferment of publication was disregarded; the holder would subsequently submit reproductions, in accordance with Article 9(6)(b). Examination could only be performed on the basis of the reproductions; this would not be satisfactory, because no comparison could be made between the specimen which accompanied the international application initially, and the reproductions supplied subsequently.

39. The Delegation of Norway indicated that, in accordance with its national legislation, where reproductions did not correspond to the specimen accompanying the application, the applicant was allowed to submit other reproductions identical to the specimen.

40. The International Bureau said that, in so far as examination should limit itself to what appeared in the reproductions, such a comparison could be regarded as being outside the scope of the procedure which Offices must perform; if the reproduction subsequently proved to be different from the specimen, this was a matter which could be raised before a court.

41. The Delegation of the United States of America then suggested that, where the international application was accompanied by specimens, the designation of a Contracting Party which did not allow deferment should be disregarded. The Representative of TVS declared that this solution would make it pointless for textile designers to designate the United States of America.

42. The International Bureau said that the suggestion of the Delegation of the United States of America had been noted and would be examined.

43. The Representative of FICPI, supported by the Representative of AIPPI, was of the opinion that Article 5(1), by referring in its title to “all” international applications, could be misinterpreted in view of the additional mandatory contents of an international application designating a Contracting Party having made a declaration under Article 17, and that a reference to Chapter II would be useful. The International Bureau replied that any reference to the provisions of Chapter II would have to be made in a number of provisions of Chapter I and that such references might unduly burden the text.

Article 6: Priority

44. The Delegation of the Netherlands expressed the concern that paragraph (1) would have a narrower scope than Article 2.1 of the TRIPS Agreement, which was generally interpreted in the sense that a claim of priority could be based on one or more earlier applications filed in or for any Member of the World Trade Organization (WTO). Paragraph (1), however, was limited to priority claimed on the basis of one or more earlier applications filed in or for a country party to the Paris Convention. The International Bureau replied that paragraph (1) had been drafted before the conclusion of the TRIPS Agreement. It recognized, however, that it could be appropriate to expand it to include Members of WTO. It was noted in that respect that Article 6 addressed only the question of priority claims that could be included in the international application and did not prejudice the effects of a given priority claim in a given designated Contracting Party.

45. The Delegation of the United States of America noted that the draft new Act did not provide for the possibility of a belated claiming of priority, as had been mentioned in paragraph 66 of the Report of the sixth session.

Article 7: International Registration, Correction of Irregularities and Publication

46. *Paragraphs (1) and (2).* There were no comments on these paragraphs.

47. *Paragraph (3)(a).* The International Bureau stated that the centralized publication of the international registration in the Gazette was one of the cornerstones of the Hague system. An exception had however been introduced at the request of the United States of America; re-publication by a designated Contracting Party would be allowed, at the applicant's expense, where the reproduction of the industrial design for which protection was granted in a Contracting Party differed from the reproduction published by the International Bureau in the Gazette.

48. The Delegation of Japan expressed its satisfaction with regard to this newly-introduced text. It also expressed its intention to publish the content of the international registrations in Japan.

49. The Delegation of Switzerland was of the opinion that, as drafted, the last part of paragraph (3)(a) was too broad. It therefore suggested that it be narrowed down to reflect the

limitation expressed in Note 7.05. According to that note, the re-publication of an industrial design at the expense of the holder could only be requested by the Office of a designated Contracting Party where that Office carried out a novelty examination and where that examination resulted in the amendment of the industrial design contained in an international registration.

50. The representative of an observer organization asked what should be understood by “amendment of the industrial design” in Note 7.05. The International Bureau stated that this did not mean that new matter could be added to, or that a characteristic feature could be subtracted from, the industrial design contained in the international registration. The term “amendment to the industrial design” was to be understood in the context of a reproduction that did not disclose clearly enough what had been claimed or described in the international registration.

51. The Representative of AIPPI stated that, from her point of view, the only case where re-publication would seem to be needed was that where an application had been divided as a result of a lack of unity of invention.

52. The representatives of observer organizations requested that the requirements leading to re-publication be kept as tight as possible, and that the interest of users be kept in mind.

53. *Paragraph (3)(b).* The International Bureau explained that this provision took account of the *de facto* deferment of publication which took place in examining systems. It further explained that the provisions should be read as meaning that the publication would take place, at the earliest, six months from the date of the international registration, considering the fact that the Gazette was published periodically.

54. The Delegation of Japan asked whether the content of the international registration could be sent to the Offices of the designated Contracting Parties at an earlier stage, so that Examining Offices could be aware of the content of prior international applications when examining subsequent applications. The International Bureau noted that a system of notification to the designated Contracting Parties, additional to the publication, had been expressly discarded because of the extra cost it would entail.

Article 8: Date of International Registration

55. The Delegation of Switzerland asked whether it followed from paragraph (3)(b)(iii) that the date would be affected if the indications enabled the applicant to be contacted but not his representative. The International Bureau stated that it was sufficient that one of these could be contacted.

Article 9: Deferment of Publication

56. The Delegation of the United Kingdom suggested the adoption of a two-stage publication system in case of deferment, whereby the bibliographical data of the international registration would be published at a first stage, and the reproduction of the industrial design

would be published at the end of the deferment period, the extra cost entailed being borne by those requesting deferment.

57. The Delegations of Germany and Greece, as well as the representatives of several observer organizations, supported the proposal as it could be of interest for the users. It was noted, however, that the publication of the bibliographical data would have no legal effect. The Representatives of TVS and UNICE were opposed to the proposal.

58. The International Bureau noted the views expressed, and said that it would investigate the costs that would be entailed by a two-stage publication system.

Article 10: Refusal of Effect; Remedies Against Refusals

59. The International Bureau indicated that the words underlined in paragraph (1) were aimed at clarifying what was meant by formal grounds, using wording from Article 27(1) of the PCT. The intention was unchanged—to restrict the consideration of formal matters to the International Bureau and to remove them from the ambit of refusals.

60. In reply to a question by the Delegation of the United States of America, the International Bureau said that the expression “delegate the examination of the formal contents of an international application to the International Bureau” in paragraph 10.01 of document H/CE/VII/3, meant that the examination of the formal requirements of the international application would be centralized at the International Bureau. This was the essence of the international registration system. This did not mean, however, that there would be a delegation in the legal sense.

61. The Delegation of Japan suggested that paragraph (3) of this article be amended so as to provide that the time-limit to issue a refusal could be modified only by a unanimous decision of all Contracting Parties and not only of those which had not made a notification under Article 20. The Delegation of the United States of America supported this proposal. The International Bureau said that the suggestion of the Delegation of Japan would be taken into account in the next draft and that a similar provision would be inserted in Article 20.

62. Concerning the period for notifying a refusal, the Delegation of Norway referred to its non-paper, distributed earlier in the meeting. The question was whether a post-registration opposition could be notified as an invalidation under Article 12, rather than a refusal under Article 10. Explaining the post-registration opposition system in Norway, the delegation said that, where no grounds for refusal were found by the Norwegian Office, the international registration would be effective in Norway in accordance with Article 11, and would then be published for opposition in the Norwegian Gazette. Where an opposition was filed within the four-month opposition period, the Office would inform the holder of the international registration directly. Where, as a result of the opposition, the Office decided to cancel the effect of the international registration, it proposed to notify the International Bureau in accordance with Article 12(2).

63. The International Bureau stated that it would have no objection to this interpretation. It added that the term “invalidation,” in Article 12, was to be understood in a wide sense. The Delegation of the United States of America observed that it had always been its understanding that the term “competent authorities” in Article 12 included not only courts but also national Offices.

64. The Delegations of Denmark and the United States of America asked for confirmation that the time limit for notifying a refusal constituted only the period of time during which the grounds of refusal (including grounds for opposition) must be notified to the International Bureau, and should not be regarded as a deadline for an effective decision to be taken by the Office. The International Bureau confirmed this interpretation.

Article 11: Effects of International Registration

65. The International Bureau explained that the words underlined in paragraph (2)(a) and (b) had been introduced to take account of the position of the Delegation of Japan.

66. The Delegation of Switzerland, supported by the Representative of TVS, expressed the view that the possibility envisaged in paragraph (2)(b), whereby the effect of the international registration in a Contracting Party was delayed even when a refusal had been withdrawn, could prove to be unfair, and that, in such case, the date of effect should be the date of expiry of the period of refusal. It was agreed that the next draft of the new Act would contain a proposal to that effect.

67. The Delegation of the United States of America referred to the possibility, albeit remote, of loss by its Office of an international application. Since, according to its domestic law, the grant of protection implied a positive action to be taken, the United States of America might find itself, in such a case, in breach of its treaty obligations. However, in many cases, applicants would benefit, since they would receive notice of grant before the period for refusal had expired. The delegation therefore suggested that, in the case of a Contracting Party with an Examining Office, the effect of an international registration should be consequent on such notice.

68. The Delegation of Norway indicated that its legislation also provided for a positive decision on acceptance. However, under its implementation of the Madrid Protocol, it had established more secure procedures in order to avoid breaching its treaty obligations. Norway was willing to do the same under the new Act.

69. The International Bureau considered that the loss of a file would be extremely rare, and should diminish as electronic communication was set up.

Article 12: Invalidation

70. The Delegation of the United States of America sought reassurance that nothing in this article excluded the equitable remedy of declaring that a design patent was unenforceable. The International Bureau commented that Note 12.02 implied that this was so. Such a declaration should not however be notified in accordance with paragraph (2).

71. Observing that, according to Note 12.03, an Office was obliged to notify invalidation only when it was aware of it, the Delegation of the United States of America wondered whether the provision served a useful purpose. The International Bureau commented that even an imperfect system of notifying invalidation was better than nothing.

Article 13: Fees for International Application

72. The International Bureau remarked that, as stated in paragraph 2 of document H/CE/VII/5, it might be appropriate to transfer some details which were at the present contained in the draft new Act to the Regulations at a later stage. This was particularly the case for the present article, especially as regards the fixing of time limits.

73. Concerning restrictions on the amount of the individual designation fee, as provided for in paragraph (2) of the present article, it drew attention to the ceilings envisaged in paragraphs 13.10 to 13.12 of document H/CE/VII/3.

74. The Delegation of Switzerland indicated its support for a system whereby the individual fee may not be greater than a fixed proportion of the amount of the fee that the Office concerned would receive for an equivalent domestic registration. However, it thought that individual fees were confusing for the users, and would prefer a system of fixed fees, with a higher fee for Examining Offices.

75. The Delegation of the United States of America, supported by the Delegation of Japan, the Delegation of the United Kingdom and the Representative of the European Communities, favored the system as proposed in the draft new Act. They considered it was necessary to provide for a system flexible enough to enable Offices which examined international designs to cover their costs, and that it was a matter for each Office to assess the savings resulting from the international procedure.

76. The Representative of CELIBRIDE asked that the amount of the fees payable should be as low as possible. The Representative of UNICE considered that the difference in the amount of fees between Offices with or without examination was justified, but should be restricted. The Representative of TVS declared that it was not possible to indicate a precise point of view without concrete proposals of the amounts of individual fees. The Representative of FCPA proposed that the frequency on which the amount of individual fees may be modified should be limited.

77. Taking into account various observations made by the participants, the International Bureau proposed to restrict the possibility of choosing the individual designation fee to Contracting Parties with Examining Offices. The Delegations of Germany, Switzerland and Greece and the Representative of EURATEX supported this proposal. The Representative of the European Communities was against. The Delegation of Luxembourg made a reservation for further thought. In response to a question from the Delegation of the United Kingdom, the International Bureau stated that the terms "Examining Office" was not restricted to an Office of a Contracting Party that had made a notification under Chapter II.

Article 14: Term and Renewal of International Registration

78. There were no comments on this article.

Article 15: Recording of Change in Ownership and Certain Other Matters Concerning International Registration

79. The Delegation of Japan, supported by the Delegation of the United States of America, expressed the view that each Contracting Party should be allowed to maintain its own register for the recording of certain matters affecting international registrations that would not be recorded in the International Register. It indicated that some matters should be recorded in its national register in order to produce effect. The Delegation of the United States of America suggested that a mechanism be put in place to transfer information from the International Register to the Offices of Contracting Parties.

80. The International Bureau stated that it should be made clear that a holder must not be deprived from any of his rights, as a result of the international procedure, where a recording in a national register did not take place. Contracting Parties were free to record in their national register any matters concerning international registrations, provided that recordings in the International Register were given effect as provided for in Article 15(1)(b) and that mandatory recording in the national register at the expense of the holder of the international registration were limited to matters that were not recordable in the International Register.

81. In reply to interventions by the Delegations of Sweden and Japan, the International Bureau indicated that the notes would list other relevant facts that might be recorded in the International Register, such as pledges (security interests) and licenses.

Article 16: Information Concerning Published International Registrations

82. There were no comments on this article.

Article 17: Additional Mandatory Contents of the International Application

83. In response to a question raised by the Delegation of the United Kingdom, the International Bureau said that the declaration of novelty required under the United Kingdom legislation could not fall within the scope of Article 17(2) since it was not regarded as a filing date requirement, but was governed by Article 5(2) and Rule 7(4)(f)(i).

Article 18: Correction of Irregularities Relating to Additional Mandatory Contents of the International Application

84. In reply to a question raised by the Delegation of Sweden, the International Bureau explained that the difference of treatment between Article 18(i) and (ii) was justified by the need to maintain a single filing date of an international application. One could envisage, however, that where the international application designated only Contracting Parties which

had requirements under Article 17(2) and those requirements were fully satisfied in respect of none of those Contracting Parties, then an opportunity to correct the application could be offered to the applicant without his having to file again an international application.

85. The Delegation of Switzerland, supported by the Representative of UPEPI and the Representative of UNICE, suggested that in the case envisaged by Article 18(i), an opportunity should be given to the applicant to choose either that the designation of the Contracting Party in respect of which his international application did not fulfill one or more of the relevant conditions referred to in Article 17(2) be disregarded, or that the filing date of his international application be postponed in respect of all designated Contracting Parties. It was agreed that this possibility would be incorporated in the next draft new Act.

86. The Representative of FICPI suggested to split the filing date of an international application in respect of different designated Contracting Parties. The Representatives of UNICE, UPEPI and TVS were opposed to this suggestion.

Article 19: Confidential Copies of International Applications Containing Requests for Deferment; Publication of Such International Applications

87. The International Bureau said that editorial changes, without any effect on the substance, could be brought to Article 19(1) in the next draft new Act.

Article 20: Refusal of Effect

88. There were no comments on this article (see, however, paragraph 61, above).

Article 21: Common Office of Several States

89. The International Bureau proposed that paragraph (1)(ii) be amended to refer to Articles 1, 3 to 20 and 33, that is, to include the articles of Chapter II. While Article 21 was drafted with the Benelux Office, which was not an Examining Office, in mind, it should not be excluded that an Examining Office might be the subject of a notification under this article. There were no objections to this proposal.

Article 22: Membership of the Hague Union

90. There were no comments on this article.

Article 23: Assembly

91. The Delegation of the United States of America proposed that it should be specified that, in the Assembly, members should be able to vote only on matters which concerned an Act to which they were party. This would follow the pattern of Article 10(3)(a) of the Madrid

Protocol. The International Bureau said that this would be reflected in the next draft or in the Rules of Procedure of the Assembly.

92. That delegation asked whether, under paragraph (2)(a)(viii), the Assembly would give blanket approval for a State or organization to be an observer, or whether this would be done on a meeting-by-meeting basis. The International Bureau, pointing out that this applied only to meetings of the Assembly, replied that it was normal to invite observers to all meetings. The delegation considered that, while the presence of observers from the interested circles would generally be beneficial, there could be occasions on which only Contracting Parties should be present. The International Bureau said that this could be dealt with in the Rules of Procedure of the Assembly.

93. The same delegation also noted that, while paragraph (6)(a) provided for decisions to be taken by a simple majority, under Article 2(3)(d) of the Complementary Act of Stockholm decisions in the present Assembly of the Hague Union were taken by a two-thirds majority; it would be desirable to be consistent on this point. The International Bureau said that this needed not be a problem except where a decision affected both the new Act and the 1934 or 1960 Acts, but agreed to reflect on the question.

Article 24: International Bureau

94. There were no comments on this article.

Article 25: Finances

95. Following a question from the Delegation of Greece concerning the connection between paragraph (3)(i) and the second sentence of paragraph (4), the International Bureau proposed to divide subparagraph (3)(i) into two subparagraphs, dealing respectively with fees and charges; paragraph (4) would then refer to “fees referred to in paragraph (3)(i)” and to “charges referred to in paragraph (3)(ii).”

96. The Delegation of the United States of America requested that it be made clear that the fees referred to in paragraphs (3)(i) and (4)(a) did not include individual designation fees, which were fixed by the Contracting Parties. The International Bureau referred to Note 25.05, but said that it would consider whether a clarification of the text was necessary.

Article 26: Regulations

97. *Paragraph (2)(b).* The Delegation of Switzerland noted that, under this paragraph, amendments to the Regulations required three-quarters of the votes cast whereas the Complementary Act of 1967 required two-thirds of the votes cast. The International Bureau said it would change the text of the draft new Act to refer to two-thirds of the votes cast.

Article 27: Revision of this Act

Article 28: Amendment of Certain Articles by the Assembly

98. In response to a question from the Chairman, the International Bureau confirmed that, where the Act was revised by a conference of the Contracting States, the revised Act would have to be ratified or acceded to in order to have effect.

99. The International Bureau explained that the purpose of paragraph (2) of Article 27 was to make it easier to amend certain provisions of the Act. Such amendments, once adopted in accordance with Article 28(2), would bind all Contracting Parties; this followed from Article 28(3)(b).

100. The Delegation of the United States of America expressed concern that a majority could amend treaty provisions, including those on voting rights. The Delegation of Germany stated that it would have problems with Articles 27(2) and 28. The Representative of the European Communities also had reservations on these articles. The Delegation of the Netherlands considered that, if it was desirable to be able to amend certain provisions relating to the finances of the Union, without the need for a Diplomatic Conference, such provisions could possibly be transferred to the Rules.

101. The International Bureau observed that similar provisions were in the Paris and Berne Conventions, the PCT, the Madrid Agreement and the Madrid Protocol, though not in the recent treaties adopted in December 1996 in the field of copyright and neighboring rights. They could of course be omitted or restricted; this was a matter for the Diplomatic Conference.

Article 29: Becoming Party to This Act

102. The International Bureau explained that this article had been changed so that the pre-requisite to become a party to the new Act was membership of WIPO instead of membership of the Paris Convention. It was recalled that Article 2(3) of the draft new Act nevertheless required Contracting Parties to comply with the provisions of the Paris Convention concerning industrial designs.

Article 30: Effective Date of Ratifications and Accessions

103. The Delegation of the United States of America proposed that only ratifications or accessions by States should count in order to bring the Act into force. The International Bureau stated that the next draft would follow that proposal. The Representative of the European Communities stated that he had to reserve the position of the Communities on this question.

104. Following a remark made by the Delegation of Switzerland, the International Bureau said that the wording of paragraph 2(ii) *in fine* in the French text would be amended to read: “...au moins 200 demandes de cette nature auprès de la même entité.”

Article 31: Prohibition of Reservations

Article 32: Declarations Made by Contracting Parties

105. There were no comments on these articles.

Article 33: Applicability of the 1934 and 1960 Acts

106. The International Bureau explained that the effect of this article was that, where two States were bound by more than one Act, the later Act would prevail.

107. Replying to a question from the Delegation of the Netherlands concerning the possibility of repealing the 1934 and 1960 Act of the Agreement in order to avoid the coexistence of different Acts, the International Bureau said that only the States that were party to a treaty may decide to discontinue its application.

108. The International Bureau confirmed, at the request of the Representative of the European Communities, that accession to the new Act would not create a treaty relationship between parties to the new Act and States party to the 1934 and/or 1960 Acts without being party to the new Act.

Article 34: Denunciation of This Act

109. There were no comments on this article.

Article 35: Languages of This Act; Signature

110. Following two remarks concerning paragraph (1), the International Bureau said that the choice of the authentic languages of the new Act would have to be decided in the preparatory meeting for the Diplomatic Conference.

Article 36: Depositary

111. There were no comments on this article.

IV. DRAFT REGULATIONS

Rule 1: Definitions

112. It was pointed out that the French text of paragraph (1)(a) should refer to “enregistrement international” rather than “dépôt international.”

Rule 2: Communications with the International Bureau: Signature

113. It was pointed out that the words “Subject to paragraph (5)” should be deleted from paragraph (1).

Rule 3: Representation Before the International Bureau

114. The Representative of ABA asked what qualification was required to be a representative. The International Bureau stated that it was sufficient that the representative be appointed by the applicant or holder; there was no requirement as to nationality, residence or professional qualifications. It should be remembered however that (as indicated in the title of Rule 3) the provision concerned only representation *before the International Bureau*. The question of who was entitled to file an application through an Office, or to represent the holder before an Office in the event of a refusal, was a matter for the law of the Contracting Party concerned. The Representative of UPEPI said that it should be possible for the representative who filed the international application to deal with a refusal by the Office of a designated Contracting Party. The International Bureau responded that this was a matter for that Contracting Party to decide.

115. The Representative of UPEPI asked whether there was a conflict between Rule 3(4)(a), which referred to the signature of a representative replacing that of the applicant, and Rule 7(1), which referred to the international application being signed by the applicant. The International Bureau drew attention to Note 7.04 stating that, where a representative was appointed in a separate communication attached to the international application, he may sign the application for the applicant.

116. The Representative of ICSID proposed that the text of the second sentence of paragraph (5)(a) be amended to read “...appointed or where a change in ownership has been recorded and no representative is appointed...”

Rule 4: Calculation of Time Limits

Rule 5: Irregularities in Postal and Delivery Services

Rule 6: Languages

117. There were no comments on these rules.

Rule 7: Requirements Concerning the International Application

118. *Paragraph (1)*. The Delegation of the United States of America asked whether the provision whereby the application had to be signed by the applicant interfered with the requirement under its national law that the application be signed by the inventor as the applicant and contain an oath or declaration also to be signed by the applicant. The International Bureau replied that this latter question would seem to be relevant to Rule 7(4)(f), which might have to be amended in that respect.

119. *Paragraph (2)*. There were no comments on this paragraph.

120. *Paragraph (3)(a)*. The Delegation of the United States of America said that, under its national law, the application had to be made in the name of the creator. The applicant could thus never be a legal entity. It therefore proposed that this paragraph provide that the applicant could be a legal entity only where the law of a designated Contracting Party allowed for this. Furthermore, the delegation said that, whenever the eventual holder of an international registration was going to be a legal entity, its Office would need to receive a deed of assignment showing that the industrial design had been assigned to the legal entity by the applicant (the creator). The International Bureau replied that the recordal of assignment was covered in Article 15 and Rule 19, but that this provided for such recordal only after international registration. The possibility of providing for the recordal of assignment before the international registration could be considered.

121. The representatives of several observer organizations remarked that industrial designs were generally created by teams of creators, and that it was very difficult to identify each creator and to obtain a signature from each one of them.

122. The Representative of UPEPI stated that, in practice, the problem was not so great. It also referred to the European Patent Convention (EPC), which had adopted an intermediate approach whereby the signature of the inventor was not required, but the latter was notified of the application where he was mentioned as an inventor.

123. The Delegation of the United States of America declared that the solution adopted in the EPC would not be acceptable.

124. The International Bureau proposed to include in the Regulations provisions similar to the ones contained in Rules 4.5(d) and 4.15(b) of the PCT Regulations. (Under that first rule, the request may, for different designated States, indicate different applicants. The second rule provides for the possibility of omitting the signature of an applicant who is an inventor under certain circumstances.) The Delegation of the United States of America indicated that it could accept this, which could help to solve the problem referred to in paragraph 118, above.

125. The Delegations of Sweden, Canada and the Russian Federation stated that, since the requirements in their national laws concerning industrial designs did not differ from those concerning patents, the proposal of the International Bureau would be acceptable for them.

126. In reply to a question of the Chairman concerning the protection of textile designs in the United States of America, the delegation of this country said that two-dimensional patterns were protected under copyright law. Copyright registration was not obligatory, but could be requested, in which case the application could be made in the name of the employer as a work made for hire. The name(s) of the designer(s) needed not be mentioned.

127. The Delegation of the Netherlands asked whether the provision under the law of the United States of America whereby a legal entity could not file an application without a previous assignment from the inventor did not contradict Article 3 of the new Act. The International Bureau replied that Article 3 established a general principle concerning the entitlement to file an international application and that it did not interfere with the specific provisions in the Contracting Parties.

128. *Paragraph (3)(b) and (c).* There were no comments on these provisions.

129. *Paragraph (3)(d).* The Delegation of Norway explained that, under its national law, protection could be sought for a motif itself, in which case it was required to submit a reproduction showing the motif alone. This reproduction requirement arose from the definition of design protection in Norwegian law and was thus a substantive matter. Norway would however be willing to change its practice regarding the reproduction of motifs and did not propose an amendment to the Act.

130. *Paragraph (3)(e), (f) and (g).* There were no comments on these provisions.

131. *Paragraph (4)(a) and (b).* There were no comments on these provisions.

132. *Paragraph (4)(c).* In reply to a remark made by the Delegation of the Russian Federation, the International Bureau said that the reason why the draft new Act did not require that a copy of the previous application be submitted where priority was claimed was to make the system more user-friendly. It added that such a copy was not required under either the current Hague system or the Madrid system. The Delegation of the Russian Federation, supported by the Delegation of Japan and the Delegation of the United States of America, said that the priority documents could be needed in order to determine novelty. The Representative of FICPI considered that such cases would be very rare. The International Bureau suggested that, in a particular case, an Office could ask the holder to furnish the priority document to it in the context of a refusal, and that this would be reflected in the notes. The Delegation of the Russian Federation said that a holder should be able to file the priority document with the Office of a designated Contracting Party without being required to go through a local representative.

133. *Paragraph (4)(f).* The Delegation of the United Kingdom requested that a statement of novelty be included as an additional content of the international application. It suggested that the statement could be pre-drafted by the International Bureau and included in the application form.

134. *Paragraph (4)(g).* The Delegation of the United States of America suggested the following modification: “The international application may be accompanied by a statement *that identifies information known to be material to the patentability of a design for which protection is sought.*”

135. *Paragraph (5).* The representative of an observer organization suggested that the applicant be notified of any non-required or non-permitted matter deleted *ex officio* by the International Bureau. The International Bureau observed that a similar text had recently been approved by the Assembly of the Hague Union for Rule 8.3(b) of the current Regulations.

Rule 8: Reproductions of the Industrial Design

136. *Paragraph (1).* Referring to a previous intervention made by the Delegation of the United States of America concerning the non-protectability of a motif itself under its national law, the International Bureau stated that, where a reproduction showing an industrial design itself were submitted, the United States Patent and Trademark Office should be allowed to

refuse the international registration on the ground that a motif itself was not protectable under its law. This was considered as a substantive issue and not as a question of form.

137. *Paragraph (1)(b)*. In the French text, the word “établi” was replaced by the word “prescrit.”

138. *Paragraph (2)*. There were no comments on this paragraph.

139. *Paragraph (3)*. Responding to the intervention of the representative of an observer organization, the International Bureau said that the notification made by the Contracting Parties would be a general one and that it would not be made on a case-by-case basis.

140. Following a debate on the requirement of cross-section views by the Japanese Patent Office, it was agreed that the last sentence of Note 8.03 in document H/CE/VII/5 would be amended to say that a national Office would not be allowed systematically to require a cross-section view or an internal view, but it should be allowed to accept it if the applicant wished to submit it for a better understanding of the design or to require it if this were indispensable for the understanding of the design, and the International Bureau would not refuse it.

141. *Paragraph (4)*. Following a request for clarification made by the Delegation of the United States of America, the International Bureau said that it would examine whether the first sentence of this paragraph should also refer to the other requirements contained in the same rule.

142. Following the suggestion of the Delegation of the United States of America, the International Bureau agreed that the term “views” in the last sentence of this paragraph should be replaced by the term “reproductions.”

143. The International Bureau concurred with the interpretation of the Delegation of the United States of America that an Office could refuse an international registration on the ground that the reproductions did not contain surface shading, if this was the only way to sufficiently disclose the industrial design. It was agreed that Note 8.09 would be further developed.

Rule 9: Specimens of the Industrial Design Where Deferment of Publication Is Requested

144. There were no comments on this rule.

Rule 10: Identity of Creator; Description; Claim

145. The Delegation of the United States of America explained that, according to its legislation, the description was divided into two parts (a mandatory description concerning the ornamental features and an optional description concerning characteristics which are not shown). It proposed therefore to delete the first sentence of paragraph (2), which restricted a description to 100 words.

146. The Representative of UPEPI, supported by the Representative of FICPI, expressed its understanding for the concerns of the Delegation of the United States of America and expressed his doubts as to whether 100 words would be sufficient to cover the description of the numerous designs which could be included in an international application.

147. The Representative of TVS stressed that several national legislations imposed a maximum of 100 words for a description and that, if such a limit was not provided for in the draft Regulations, one should be very careful as to the effects of an international registration containing a description exceeding this limit.

148. The International Bureau said that lengthy descriptions would increase the costs of translation. One could nevertheless envisage to provide for exceptions to the principle whereby the description should not exceed 100 words and to introduce an additional fee payable where this limit was exceeded.

149. The Delegation of the United Kingdom considered that printing the wording of a claim in the international application form, as was suggested in Note 10.03, seemed too restrictive for the applicant and that more freedom should be given when drafting a claim. The Delegation of the United States of America confirmed that the example given in Note 10.03 reflected accurately the formal requirement to meet under its legislation in order to obtain a filing date but that amendments might be needed later on, depending on the cases. The International Bureau was of the opinion that a standard wording printed in an international application would help the applicant.

Rule 11: International Application Filed Through an Office

Rule 12: Examination by the International Bureau

150. There were no comments on these rules.

Rule 13: Registration of the Industrial Design in the International Register

151. The Delegation of Croatia observed that paragraph (2)(iv) referred to “class or classes” which seemed contrary to the principle laid down by Article 5(3) whereby several designs may only be the subject of the same international application if they related to the same class.

152. The International Bureau said that the words “or classes” would be deleted.

153. The Representative of JPAA expressed his hopes that a searcher would have easy access via the national register and publication to the information recorded in the International Register, including comprehensive information not only on refusals but also on subsequent decisions affecting the refusals. The International Bureau explained that the scope of Rule 13 was confined to the recording of the international registration as such and that the subsequent recording of information relating to that international registration was dealt with in Rules 17, 18, 19, 20 and 23.

Rule 14: Reproduction of the Industrial Design Where Publication Is Deferred

Rule 15: Contents of the Publication of the International Registration

154. There were no comments on these rules.

Rule 16: Notification of Refusal

155. The Delegation of the United States of America raised the question of which were the notifications of refusal which had to be transmitted through the International Bureau and those which could be addressed directly to the holder. It explained that, under its legislation, examination could take place in several steps (for example, where an international registration was divided following a notification of refusal based on lack of unity and where, once divided, it turned out that a given industrial design did not meet the requirement of novelty). In such a case, this delegation wondered whether the second notification of refusal could be sent directly to the holder.

156. The Delegation of Japan indicated that it shared the concerns of the Delegation of the United States of America.

157. The Representative of UPEPI expressed the wish that the holder be informed in the applicable time limit of all the grounds of refusal which could be raised against an international registration, in order to be in a position to decide whether or not it was worth securing protection for a given industrial design. He pointed out that, where fees were payable for each individual design, the applicant had in fact paid for the examination of the designs filed at the time of filing, whether or not the application met the requirements of unity.

158. The Delegation of Canada declared that it was the intention in its country to determine within the prescribed time limit all grounds of refusal, including in the case where it was necessary to object on the ground of lack of unity.

159. The Delegation of Norway stated that according to its legislation a substantive examination could take place in parallel with division to meet the requirement of unity.

160. The International Bureau drew attention to Note 10.04 in document H/CE/VII/3, which might need to be clarified. The Delegation of the United States of America emphasized the importance of the understanding contained in Note 10.04, particularly that a first refusal did not preclude additional grounds being notified later.

161. In the course of the discussion on this rule, the Delegation of the Netherlands stressed that the draft new Act should make it easier to obtain protection than by filing directly with each national Office. It urged delegations to bear in mind that this system should benefit users if it were to reach its goal.

162. The Representative of EURATEX supported the intervention of the Delegation of the Netherlands and added that it would not be possible to fight efficiently against counterfeiting with very complex provisions.

163. The Representative of FICPI expressed the view that Contracting Parties with Examining Offices could also interpret and apply their law and regulations in a more user-friendly manner.

Rule 17: Irregular Refusals

Rule 18: Invalidations in Designated Contracting Parties

Rule 19: Recordal of a Change

Rule 20: Corrections in the International Register

Rule 21: Unofficial Notice of Expiration

164. There were no comments on these rules.

Rule 22: Details Concerning Renewal

165. The Delegation of the United Kingdom asked what was the justification for paragraph (2)(b), which provided for renewal in respect of a Contracting Party where the maximum term of protection had expired. The International Bureau explained that the renewal was effected under the holder's responsibility and that the latter was the best judge to assess the opportunity to renew an international registration in respect of a designated Contracting Party notwithstanding the fact that, according to the information available to the International Bureau, the maximum term of protection in that Contracting Party had expired. Even though Article 14(3)(c) provided for Contracting Parties to notify the International Bureau of the maximum period of protection under their law, the holder may have relevant information not yet available to the International Bureau.

166. The Representative of FICPI suggested that, where the amount of the renewal fee proved to be insufficient, the rules should provide that the amount received should ensure the renewal in respect of certain Contracting Parties or certain industrial designs, instead of entailing a total loss of rights, as was envisaged in paragraph (3)(b). The International Bureau stated that the unofficial notice of expiration would give the holder all the elements required to determine the amount due; moreover, paragraph (3)(b) would take effect only at the end of the grace period and if the holder had undertaken to pay the renewal fees before the date of expiration of the term of protection, he would have had ample time to react to the notification provided for under paragraph (3)(a). Besides, only the holder could determine which were the designs and the Contracting Parties in respect of which the registration was to be renewed.

Rule 23: Recordal of the Renewal; Certificate

167. There were no comments on this rule.

Rule 24: Gazette

168. The International Bureau recalled that the Assembly of the Hague Union had approved a proposal in September 1997, which should become effective by the beginning of 1999, aiming at publishing reproductions of industrial designs in the form of a CD-ROM and at

discontinuing the paper publication of such reproductions. It indicated that publication on paper would remain for bibliographical data concerning the 1934 Act and the 1960 Act.

Rule 25: Payment of Fees

Rule 26: Currency of Payments

169. There were no comments on these rules.

Rule 27: Crediting of Fees to the Accounts of the Contracting Parties Concerned

170. The Delegation of the United States of America asked the International Bureau whether the further fees payable on division of registration referred to in Article 13(4) fell within the scope of this rule. The International Bureau replied that this was not the case; such fees would be paid by the holder direct to the Office concerned.

Rule 28: Administrative Instructions

171. There were no comments on this rule.

V. FUTURE WORK

172. The Chairman invited the delegations and representatives of observer organizations to express their views on the way to continue the discussions. The Delegations of Switzerland, Germany, Greece, Sweden, the Netherlands and the Russian Federation, as well as several representatives of observer organizations considered that, at this stage of the discussions, another session of the Committee of Experts would not lead to further agreement. They therefore proposed to proceed to a Diplomatic Conference. It was noted that, if considered useful, the International Bureau would hold consultations on those pending issues that might be solved outside a Diplomatic Conference as well as, if necessary, regarding the transfer of certain provisions of the draft new Act to the draft Regulations as had been indicated in the course of the discussions. The Delegation of the United States of America, while agreeing generally with these conclusions, suggested that, if necessary, a further session of the Committee of Experts could be convened in order to discuss the said pending issues and, possibly, the said transfer.

173. The International Bureau stated that the timing of a Diplomatic Conference would have to be considered in the context of the approval of the Program and Budget for the 1998-1999 biennium in the Spring of 1998. It was unlikely therefore that a Conference could be convened before 1999. The Conference would, in any case, be preceded by a Preparatory Meeting dealing with the procedural aspects of the Conference.

174. This report was unanimously adopted by the Committee of Experts on November 7, 1997.

[Annex follows]

ANNEXE/ANNEX

LISTE DES PARTICIPANTS/LIST OF PARTICIPANTS

I. MEMBRES/MEMBERS

(dans l'ordre alphabétique des noms français des États/
in the alphabetical order of the names in French of the States)

ALLEMAGNE/GERMANY

Peter MÜHLENS, First Counsellor, Federal Ministry of Justice, Bonn

Britta DIECK-BOGATZKE (Mrs.), Executive Assistant, Patent Law Section, Federal Ministry of Justice, Bonn

Elke WELTER (Mrs.), Counsellor, Design Department, German Patent Office, Berlin

BELGIQUE/BELGIUM

Monique PETIT (Mme), conseiller adjoint, Office de la propriété industrielle, Ministère des affaires économiques, Bruxelles

ÉGYPTE/EGYPT

Alaa YOUSSEF, Third Secretary, Permanent Mission, Geneva

ESPAGNE/SPAIN

Aurora HERNÁNDEZ AGUSTI (Sra.), Técnico Superior Examinador, Oficina Española de Patentes y Marcas, Ministerio de Industria y Energía, Madrid

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Denis CROZE, chef du Service des affaires multilatérales, Institut national de la propriété industrielle, Paris

Marie JAOUEN (Mme), chargé de mission aux affaires juridiques et contentieuses, Institut national de la propriété industrielle, Paris

GRÈCE/GREECE

Myrto LAMBROU (Mrs.), Attorney, Department of Legal and International Affairs, Industrial Property Organization, Athens

HONGRIE/HUNGARY

Gusztáv SZÖLLŐSI, Head, Industrial Design and Utility Model Section, Hungarian Patent Office, Budapest

Zsolt RÁBAI, Legal Assistant, Hungarian Patent Office, Budapest

INDONÉSIE/INDONESIA

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Sophia BONNE (Mme), administrateur, Office de l'harmonisation dans le marché intérieur (marques, dessins et modèles), Alicante

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American Intellectual Property Law Association (AIPLA): Douglas LARSON (Chair, Industrial Designs Committee, Los Angeles)

Association asiatique d'experts juridiques en brevets (APAA)/Asian Patent Attorneys Association (APAA): Yeon-Soo KIM (Member of the Designs Committee, Korea); Riichi USHIKI (Member of the Designs Committee, Tokyo)

Association communautaire du droit des marques (ECTA)/European Communities Trade Mark Association (ECTA): Matthieu van KAAM (Head, Trademarks Department, Philips International B.V., Eindhoven)

Association internationale pour la protection de la propriété industrielle (AIPPI)/International Association for the Protection of Industrial Property (AIPPI): Max HOOL (Fédération de l'industrie horlogère suisse, Bienne); Marianne LEVIN (Mrs.) (Faculty of Law, Stockholm)

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