

## **Working Group on the Legal Development of the Hague System for the International Registration of Industrial Designs**

**Eighth Session**  
**Geneva, October 30 to November 1, 2019**

### **PROPOSAL FOR A NEW RULE TO PROVIDE FOR THE ADDITION OF A PRIORITY CLAIM AFTER FILING**

*Document prepared by the International Bureau*

#### **I. BACKGROUND**

1. Article 6(1)(a) of the Geneva (1999) Act of the Hague Agreement (hereinafter referred to as the “1999 Act”) provides that “(t)he international application may contain a declaration claiming, under Article 4 of the Paris Convention for the Protection of Industrial Property (hereinafter referred to as the “Paris Convention”), the priority of one or more earlier applications filed in or for any country party to that Convention or any member of the World Trade Organization”.
2. Article 6(1)(b) of the 1999 Act further provides that “(t)he Regulations may provide that the declaration referred to in subparagraph (a) may be made after the filing of the international application. In such a case, the Regulations shall prescribe the latest time by which such declaration may be made”.
3. At present, the Common Regulations Under the 1999 Act and the 1960 Act of the Hague Agreement (hereinafter referred to as the “Common Regulations”) do not provide for the possibility to claim priority after the filing of the international application, as authorized under Article 6(1)(b) of the 1999 Act. Rule 7(5)(c) of the Common Regulations simply sets forth requirements for a priority claim made upon filing. As such, applicants or holders who omitted to include a priority claim at the time of filing have no mechanism under which they can add the priority claim afterwards.

## DIPLOMATIC CONFERENCE IN 1999

4. During the *Diplomatic Conference for the Adoption of a New Act of the Hague Agreement Concerning the International Deposit of Industrial Designs (Geneva Act)* (hereinafter referred to as the “Diplomatic Conference”) in 1999, it was noted that Article 6(1)(b) of the 1999 Act makes reference to the Regulations for the possibility of providing a priority claim after the filing of the international application, and for prescribing the latest time limit by which it may be made. It was further noted that such a possibility was not excluded under the Paris Convention (Article 4D(1))<sup>1</sup>.

5. During the discussions on Article 6(1) of the 1999 Act, one delegate pointed out that “any time limit for a late claim of priority that would be prescribed in the future would have to take into account the need for Examining Offices to be aware of such late claims before they started examining the international registration concerned.” It was also stated that “any late claim of priority would have to be made before the International Bureau began the preparations for publication of the international registration”. The Secretariat took note of the statements<sup>2</sup>.

6. As prescribed in Article 6(1)(b) of the 1999 Act, and as agreed at the Diplomatic Conference, this document considers the possible introduction of a new rule in the Common Regulations that would allow the addition of a priority claim after the filing of the international application, prescribing the latest time limit by which it may be made.

## II. OVERVIEW OF OTHER RELEVANT INTERNATIONAL SYSTEMS/TREATIES

### PATENT COOPERATION TREATY (PCT) SYSTEM<sup>3</sup>

#### Addition of Priority Claim after Filing

7. The PCT System contains a provision for the addition of a priority claim after the filing of an international application. While PCT Article 8(1) only states that “[t]he international application may contain a declaration, as prescribed in the Regulations, claiming priority of one or more earlier applications...”, Rule 26*bis*.1 of the Regulations under the PCT (hereinafter referred to as the “PCT Regulations”) provides for the correction or addition of a priority claim after the filing of the international application<sup>4</sup>.

<sup>1</sup> Refer to document H/DC/5, paragraphs 6.04 and 6.05.

<sup>2</sup> Diplomatic Conference, Summary Minutes, paragraphs 155 and 156.

<sup>3</sup> As of the date of this document, 152 States are party to the PCT.

<sup>4</sup> PCT Rule 26*bis*.1 Correction or Addition of Priority Claim

(a) *The applicant may correct a priority claim or add a priority claim to the request by a notice submitted to the receiving Office or the International Bureau within a time limit of 16 months from the priority date or, where the correction or addition would cause a change in the priority date, 16 months from the priority date as so changed, whichever 16-month period expires first, provided that such a notice may be submitted until the expiration of four months from the international filing date. The correction of a priority claim may include the addition of any indication referred to in Rule 4.10.*

(b) *Any notice referred to in paragraph (a) received by the receiving Office or the International Bureau after the applicant has made a request for early publication under Article 21(2)(b) shall be considered not to have been submitted, unless that request is withdrawn before the technical preparations for international publication have been completed.*

(c) *Where the correction or addition of a priority claim causes a change in the priority date, any time limit which is computed from the previously applicable priority date and which has not already expired shall be computed from the priority date as so changed.*

8. PCT Rule 26*bis*.1 entered into force on July 1, 1998. The rationale behind the adoption of this provision was to make it easier for applicants to correct mistakes, such as the omission to make a priority claim at the time of filing, without adversely affecting the interests of third parties, and taking into account the needs of Offices<sup>5</sup>.

#### Applicable Time Limit

9. The applicable time limit under PCT Rule 26*bis*.1(a) is 16 months from the priority date or, where that addition would cause a change in the priority date, 16 months from the priority date so changed, whichever 16-month period expires first, provided that such a priority claim may be submitted until the expiration of four months from the filing date of the international application. The request may be submitted to the receiving Office or the International Bureau.

#### Request for Early Publication

10. The PCT System also provides that where the applicant has made a request for early publication of the international application, any notice to add a priority claim received by the International Bureau after that request was made will be considered not to have been submitted, unless that request is withdrawn before the technical preparations for international publication have been completed (PCT Rule 26*bis*.1(b)).

#### Change in the Priority Date

11. Finally, PCT Rule 26*bis*.1(c) regulates that where the addition of the priority claim causes a change in the priority date, any time limit which is computed from the previously applicable priority date and which has not already expired shall be computed from the priority date as so changed.

#### Fees

12. No fee is required under the PCT System for the correction or addition of a priority claim.

#### Statistics

13. According to the PCT Statistics, in 2018, the International Bureau corrected or added a priority claim in less than one per cent of international applications filed<sup>6</sup>.

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<sup>5</sup> Refer to document PCT/A/XXIV/6, paragraphs 31 to 42.

<sup>6</sup> More precisely, the International Bureau issued a notification relating to a priority claim in respect of 1,748 international applications in 2018. This is the number of international applications in respect of which Form IB/318 was issued by the International Bureau (addition or correction of a priority claim, or a priority claim considered void). There could be cases in which more than one Form IB/318 was issued for the same international application.

## PATENT LAW TREATY (PLT)

### Addition of Priority Claim after Filing

14. The PLT was adopted in 2000 and entered into force on April 28, 2005<sup>7</sup>. It provides that a Contracting Party shall provide for the addition of a priority claim (Article 13(1)). This provision was modeled after PCT Rule 26*bis*.1, and permits the applicant to correct or add a priority claim to an application which could have claimed the priority of an earlier application but did not do so<sup>8</sup>.

### Applicable Time Limit

15. PLT Rule 14(3) provides that “(t)he time limit referred to in Article 13(1)(ii) shall be not less than the time limit applicable under the Patent Cooperation Treaty to an international application for the submission of a priority claim after the filing of an international application”.

### Request for Early Publication

16. PLT Rule 14(1) expressly states that “no Contracting Party shall be obliged to provide for the correction or addition of a priority claim under Article 13(1), where the request referred to in Article 13(1)(i) is received after the applicant has made a request for early publication or for expedited or accelerated processing, unless that request for early publication or for expedited or accelerated processing is withdrawn before the technical preparations for publication of the application have been completed”.

### Fees

17. Article 13(4) of the PLT provides that a Contracting Party may require that a fee be paid in respect of such a request.

## DRAFT DESIGN LAW TREATY (DLT)

### Addition of Priority Claim after Filing

18. At the twenty-fifth session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT), it was suggested to include a provision on the correction or addition of a priority claim<sup>9</sup>.

19. At the twenty-eighth session of the SCT, some delegations presented for discussion a draft Article 13*bis*, modeled on Article 13 of the PLT, and a draft Rule 11*bis* containing the details concerning Article 13*bis*, modeled on PLT Rule 14. Following the thirtieth session of the SCT, Article 13*bis* was renumbered as Article 14, and corresponding Rule 11*bis* as Rule 12, to follow the natural numbering sequence<sup>10</sup>.

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<sup>7</sup> As of October 30, 2019, 42 States are party to the PLT.

<sup>8</sup> Refer to Explanatory Notes on the Patent Law Treaty and Regulations Under the Patent Law Treaty, Notes on Article 13.

<sup>9</sup> Refer to document SCT/25/7, paragraph 134.

<sup>10</sup> Refer to document SCT/28/8, paragraphs 251 to 262, and document SCT/35/2, Notes on Article 14.

20. Current draft Article 14(1) of the DLT permits the applicant to correct or add a priority claim to an application which could have claimed the priority of an earlier application but did not do so<sup>11</sup>.

### Applicable Time Limit

21. Draft DLT Rule 12(2) provides that “[t]he time limit referred to in Article 14(1)(ii) shall not be less than six months from the priority date or, where the correction or addition would cause a change in the priority date, six months from the priority date as so changed, whichever six-month period expires first, provided that the request may be submitted until the expiration of two months from the filing date”.

22. This provision was based on the wording of PCT Rule 26*bis*.1. Moreover, it was considered that “in the context of industrial designs, a six-month period from the priority date or two months from the filing date could be acceptable”<sup>12</sup>.

### Fees

23. As under the PLT, draft Article 14(3) of the DLT provides that a Contracting Party may require that a fee be paid in respect of such a request.

## III. CURRENT HAGUE SYSTEM AND MEMBERS

### STATISTICS ON PRIORITY CLAIMS

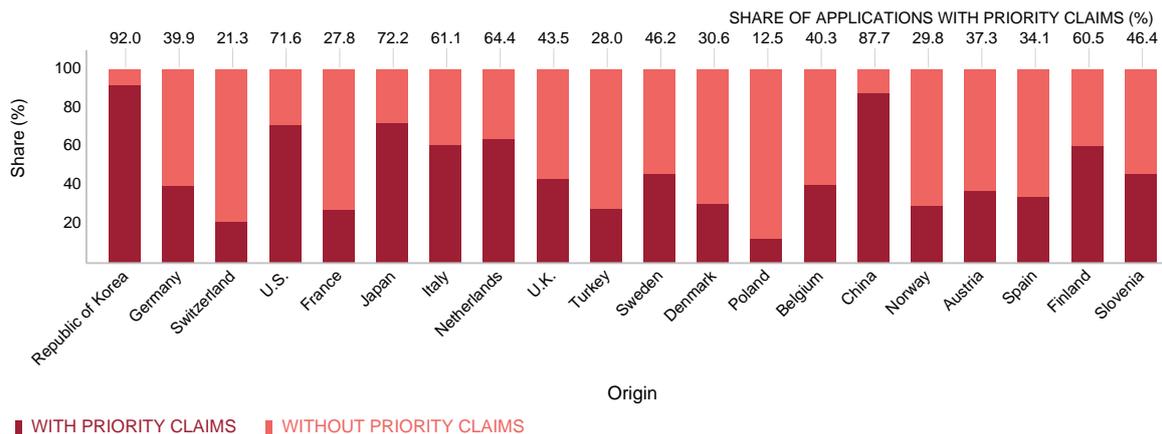
24. While it is technically not possible to extract data in how many cases applicants omitted to include a priority claim at the time of filing, the following statistics are available in relation to priority claims made in international applications. In 2018, 45.7 per cent of international applications filed contained a priority claim<sup>13</sup>. Among the top 20 origins shown in the table below, for instance, 92 per cent of applications originating from the Republic of Korea, 87.7 per cent of applications originating from China, 72.2 per cent of applications originating from Japan, 71.6 per cent of applications originating from the United States, 64.4 per cent of applications originating from the Netherlands, 61.1 per cent of applications originating from Italy, 60.5 per cent of applications originating from Finland contained a priority claim.

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<sup>11</sup> Draft Article 14 Correction or Addition of Priority Claim; Restoration of Priority Right  
 (1) *[Correction or Addition of Priority Claim]* A Contracting Party shall provide for the correction or addition of a priority claim with respect to an application (“the subsequent application”), if:  
 (i) a request to that effect is made to the Office in accordance with the requirements prescribed in the Regulations;  
 (ii) the request is filed within the time limit prescribed in the Regulations; and  
 (iii) the filing date of the subsequent application is not later than the date of the expiration of the priority period calculated from the filing date of the earliest application whose priority is claimed.

<sup>12</sup> Refer to document SCT/28/8, paragraph 255.

<sup>13</sup> Refer to Hague Yearly Review 2019.



Source: WIPO Statistics Database, May 2019

25. While those statistics do not give any indication as to the number of cases in which the applicant may have omitted to include a priority claim at the time of filing, they show the jurisdictions of origin in which applicants would potentially benefit should the addition of a priority claim be permitted after filing international applications.

#### CORRECTION OF PRIORITY CLAIM

26. Rule 22(1) of the Common Regulations provides that, where the International Bureau, acting *ex officio* or at the request of the holder, considers that there is an error concerning an international registration in the International Register, it shall modify the Register and inform the holder accordingly.

27. Rule 22(1) literally handles an error concerning an “international registration” already recorded in the International Register. However, an error may be signaled during the pendency of an international application. In the absence of a similar provision dealing with pending applications, and for the purpose of consistency, the remedy of such an error in the international application is handled in the same manner so as to avoid the recording of an erroneous registration.

28. Rule 22(1) does not specify the particular elements that may be corrected and therefore applies to an error in a priority claim. For instance, if the applicant noticed that the date of the earlier filing indicated in the international application was incorrect and provided the International Bureau with the correct date, the latter would change the priority date as corrected.

29. On the other hand, although statistics are not available, the International Bureau routinely receives requests for the inclusion of a priority claim that was omitted from the international application. However, the International Bureau cannot accept such a request in the absence of a rule as envisaged in Article 6(1)(b) of the 1999 Act, since the absence of a priority claim is not considered as an error in the International Register.

## NATIONAL OR REGIONAL SYSTEMS OF CONTRACTING PARTIES

30. After an analysis of the legal framework of the top 10 designations in international applications in 2018<sup>14</sup>, it appears that the European Union allows for the addition of a priority claim within one month from the filing of the application<sup>15</sup>, the Russian Federation within two months from the filing of the application<sup>16</sup> and Ukraine within three months from the filing of the application<sup>17</sup>. As to the United States of America, the priority claim must be submitted during the pendency of the application<sup>18</sup>.

31. This indicates that the Hague System does not provide for a similar safeguard that could have been relied on if the applicant had filed a design application directly with the Offices of these Contracting Parties.

32. Moreover, after an analysis of the legal framework of the top 10 origins (in addition to the top 10 designations), it appears that the Benelux countries allow a priority claim to be made at the time of filing or in the month following filing<sup>19</sup>, Germany allows a priority claim to be made within 16 months from the priority date<sup>20</sup>, and Italy within one month from the date of filing<sup>21</sup>.

33. This indicates that users from those Contracting Parties are used to a certain safeguard when they file domestic design applications with the national or regional Offices.

## IV. CONSIDERATIONS

34. Taking into account the relevant provisions in the PCT, PLT and DLT, as well as the specificity of a design application and the Hague System, the possible introduction of a new rule in the Common Regulations that would allow for the addition of a priority claim after the filing of the international application is considered hereinafter.

### TIME LIMIT

35. Draft DLT Rule 12(2) provides for three different time limits (six months from the priority date before and after the addition of a priority claim or two months from the filing date). As mentioned in paragraph 22, above, these periods are considered “in the context of industrial designs”, for which the Paris Convention provides for the six-month period as opposed to 12 months for patents and utility models (Article 4C(1)).

36. Similarly, the PCT System handles three different time limits (16 months from the priority date before and after the addition of a priority claim or four months from the international filing date). In any case, the applicant always has four months from the international filing date to request the addition of a priority claim. The time limit of 16 months from the priority date was added in order to allow applicants more time in certain cases, for example, where the applicant did not exhaust the 12-month priority period to file the international application. The time limit under PCT Rule 26*bis*.1 is generally considered to be the most difficult one to calculate in the PCT System.

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<sup>14</sup> The top 10 designations are the European Union, the United States of America, Switzerland, Turkey, Japan, the Republic of Korea, Norway, Singapore, the Russian Federation and Ukraine.

<sup>15</sup> Refer to Article 8 of the CDIR and Article 42 of the CDR.

<sup>16</sup> Refer to Article 1382 of the Civil Code.

<sup>17</sup> Refer to Article 13(3) of the Law of the Ukraine on Protection of Rights to Industrial Designs.

<sup>18</sup> Refer to 37 CFR 1.55(g). Pendency begins with the filing date and ends with either a patent being issued or the application being abandoned.

<sup>19</sup> Refer to Article 3.10 of the Benelux Convention on Intellectual Property.

<sup>20</sup> Refer to Section 14(1) of the Design Act.

<sup>21</sup> Refer to the Italian Code of Industrial Property, Article 169.

37. Under the PCT System, most time limits are calculated from the “priority date”. For example, the international application shall be published after the expiration of 18 months from the priority date (PCT Article 21). The “priority date” is defined in PCT Article 2 and the “international filing date” is considered to be the “priority date” where the international application does not contain a priority claim.

38. Under the Hague System, time limits or periods are generally calculated from the “filing date” or “date of the international registration”, and not the “priority date” (except for the deferment of publication). In particular, standard publication takes place six months after the date of the international registration (Rule 17(1)(iii) of the Common Regulations).

39. In line with draft DLT Rule 12(2), the International Bureau considers that a time limit of two months counted from the filing date strikes a balance between the interests of applicants or holders for adding an omitted priority claim after filing, the timely processing of applications by the International Bureau and the interests of Offices for timely receiving all information relevant to the international registration.

40. Given the particularities of the Hague System, providing an additional time limit to be calculated from the priority date would not benefit applicants or holders as much as under the PCT System. Setting a single time limit of two months from the filing date would simplify this procedure for users. This would also be in line with many national legal provisions, which appear to calculate the time limit from the filing of an application only.

41. The proposed two-month time limit would allow sufficient time for the International Bureau to prepare the publication of the international registration, which takes place six months after the date of the international registration, unless the applicant requested immediate publication or deferment of publication (Rule 17(1) of the Common Regulations).

#### IMMEDIATE PUBLICATION

42. Under the PCT System, any notice to add a priority claim received after a request for early publication was made will be considered not to have been submitted, unless that request is withdrawn before the technical preparations for international publication have been completed (PCT Rule 26*bis*.1(b)).

43. Under the Hague System, the completion of technical preparation for publication in cases where immediate publication was requested is not a certain point in time on which an applicant or holder could rely on. In 2018, 73 per cent of applications were processed within three weeks from the date of receipt by the International Bureau<sup>22</sup>. Thus, if the application is in order, the international registration could be published immediately. Moreover, there is no procedure to withdraw the request for immediate publication under the current Hague System.

#### INDIRECT FILINGS

44. Under both the Hague (1960) Act of the Hague Agreement (hereinafter referred to as the “1960 Act”) and the 1999 Act, an international application may be filed through the Office of a Contracting Party instead of “directly” with the International Bureau (Article 4 of the 1960 Act; Article 4 of the 1999 Act).

45. In those cases, if the international application is governed exclusively by the 1999 Act and the application is received by the International Bureau within one month from the date of its receipt by that Office, the filing date shall be the date of receipt by the Office. As an exception,

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<sup>22</sup> Refer to WIPO Performance Report 2018, page 162.

a Contracting Party to the 1999 Act whose law requires security clearance can replace this one-month period by a period of six months, through a declaration under Rule 13(4) of the Common Regulations<sup>23</sup>. In all other cases, the filing date shall be the date on which the International Bureau receives the application (Rule 13(3) of the Common Regulations)<sup>24</sup>.

46. Under the PCT System, a receiving Office accords a filing date (PCT Article 11 and Rule 20). A request to add a priority claim may be submitted to the receiving Office as well as the International Bureau (PCT Rule 26*bis*.1(a)). Under the Hague System, only the International Bureau accords a filing date to each international application whether it is submitted directly or through an Office. Furthermore, as described in paragraph 45, above, where the six-month period applies through a declaration under Rule 13(4) of the Common Regulations, the time limit for adding a priority claim may have expired, if it is counted from the filing date<sup>25</sup>. Thus, the time limit should rather be calculated from the *date of receipt* of the application by the International Bureau if the application is filed through an Office.

#### EXCUSE OF DELAY IN MEETING THE TIME LIMIT

47. Under Rule 5 of the Common Regulations, a failure to meet a time limit for a communication addressed to the International Bureau may be excused in certain circumstances. Rule 5 would also apply to the time limit to add a priority claim after filing.

#### FORM AND POSSIBLE ELEMENTS

48. A request for the addition of a priority claim should be made in accordance with Rule 7(5)(c) of the Common Regulations, for which a dedicated form would be provided. The form would contain a declaration claiming priority, together with items in which the name of the Office of earlier filing, the date of earlier filing and, where available, the number of earlier filing should be indicated.

49. The form would also allow the provision of an access code for the WIPO Digital Access Service (DAS) to support a priority claim for the designations of those Contracting Parties whose Offices participate in DAS<sup>26</sup>, in accordance with Section 408(a) of the Administrative Instructions for the Application of the Hague Agreement (hereinafter referred to as the “Administrative Instructions”)<sup>27</sup>.

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<sup>23</sup> At present, the Russian Federation and the United States of America are the only Contracting Parties that have made this declaration.

<sup>24</sup> These other cases include any international application governed exclusively or partly by the 1960 Act and where the international application governed exclusively by the 1999 Act filed through the Office of the applicant's Contracting Party is not received by the International Bureau within the said one month-period.

<sup>25</sup> Since the ratifications of the 1999 Act by the United States of America and the Russian Federation, respectively, and as of August 1, 2019, the International Bureau received 537 international applications from the United States Patent and Trademark Office (USPTO) and four international applications from the Federal Service for Intellectual Property (ROSPATENT). In both cases, 75 per cent of those international applications were received within one month from the date of their receipt by the respective Offices. The International Bureau received one international application 100 days after the date of its receipt by ROSPATENT. The International Bureau received 41 international applications more than three months (of which 16 were more than five months) after the date of their receipt by the USPTO.

<sup>26</sup> Currently, the Canadian Intellectual Property Office, Korean Intellectual Property Office (KIPO), the Spanish Patent and Trademark Office and the United States Patent and Trademark Office participate in DAS with respect to industrial design applications both as depositing and accessing Offices. They should be joined by the Japan Patent Office from January 1, 2020.

<sup>27</sup> Furthermore, KIPO currently accepts the submission of a priority document through the International Bureau, which is only possible at the time of filing the international application. The form should allow the enclosing of the said document, but should be limited only to the time of requesting the addition of a priority claim.

## MATTERS THAT MAY BE AFFECTED BY THE LATE ADDITION OF A PRIORITY CLAIM

### Confidential Copies

50. As a general principle, the International Bureau keeps in confidence each international application and each international registration until publication in the Bulletin (Article 6(4)(d) of the 1960 Act; Article 10(4) of the 1999 Act). However, under Article 10(5) of the 1999 Act, the International Bureau provides “confidential copies” to each Office that has requested to receive such a copy when it is designated in an international application.

51. Pursuant to Section 901(a) of the Administrative Instructions, confidential copies are currently transmitted to each Office by electronic means. Section 902 further provides for the updating of data concerning the international registration whose confidential copy was transmitted.

52. The Office may use confidential copies for the purpose of the examination of other applications or for the examination of the international registration. Thus, the Office may be reluctant to accept an addition of a priority claim once it has started or finished the substantive examination. However, the Office cannot take any action against the international registration until its publication. In any case, the refusal period starts from the international publication, and therefore, the addition of a priority claim would not affect the refusal period.

53. On the other hand, the addition of a priority claim to the international registration may affect the examination of other domestic applications or international registrations. For that reason, the time limit of two months from the filing date would appear to strike the balance between the needs of Offices receiving confidential copies and the interests of the applicants or holders.

### Deferment of Publication

54. The applicant may request, in an international application, that the publication be deferred for a period which may not exceed 12 months (under the 1960 Act) or 30 months (under the 1999 Act) from the filing date or, where priority is claimed, from the priority date<sup>28</sup>. Hence, the deferment period is computed from the claimed priority date if the international application contains a priority claim.

55. The addition of a priority claim after filing may affect the publication date where publication is deferred in two instances, either where there was no priority claim at the time of filing, or where a priority claim with an earlier filing date than any priority claim contained in the application as filed was added. In those cases where the applicant requested the deferment of publication, the deferment period would be recomputed from the new priority date. This would be in line with the PCT System (PCT Rule 26*bis*.1(b)).

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<sup>28</sup> Refer to Article 6(4)(a) of the 1960 Act, Article 11(1) and (2) of the 1999 Act, and Rule 16(1) of the Common Regulations. Requesting the maximum 30-month deferment period is subject to designations of Contracting Parties having made a declaration under Article 11(1)(a) or (b) of the 1999 Act. Furthermore, document H/LD/WG/8/6 proposes the extension of the standard publication period which is currently six months after the date of the international registration (Rule 17(1)(iii)). The allowable deferment period may also be subject to the discussion of the said proposal.

## MATTERS NOT AFFECTED BY THE LATE ADDITION OF A PRIORITY CLAIM

### Publication Contents

56. The submission of a request to add a priority claim would only be allowed before publication of the international registration. Thus, the publication should contain all the data recorded in the International Register, including the added priority claim, in accordance with Rule 17(2) of the Common Regulations.

### Notification of Refusal

57. The period for notification of refusal is calculated from the date of publication of the international registration (Rule 18(1) of the Common Regulations) and would not be affected by the addition of a late priority claim.

## CORRECTION OF PRIORITY CLAIM

58. Under the PCT System, the correction of a priority claim is handled by the same provision as the addition of a late priority claim (PCT Rule 26*bis*.1). The PLT and draft DLT suggests the same approach, as a model provision (Article 13 of the PLT; Article 14 of the draft DLT).

59. Under the Hague System however, as explained in paragraphs 26 to 29, above, the correction of an error is governed by Rule 22 of the Common Regulations. In practice, the International Bureau treats and remedies/corrects all errors, including those in priority claims, in the same manner, before or after registration. The difference is that if the error was remedied during the pendency of an application, the International Register would not contain the error. If it was corrected after registration, then the International Register would have to be corrected under Rule 22(1), which would be published in the Bulletin as such (Rule 26(1)(v) of the Common Regulations). Accordingly, if the priority date or the application number was erroneously provided in the application, it could be the subject of a remedy/correction before or after registration.

60. In view of the above, the International Bureau considers that the correction of an error in a priority claim should continue to be handled in the same manner. When it comes to a possible correction of an error, in principle, the same criteria and judgement should apply regardless of the types of elements. Moreover, Rule 22(1) of the Common Regulations applies even after the publication of the international registration without a specific time frame, while Rule 22(2) of the Common Regulations allows the Office of a designated Contracting Party to refuse to recognize the effects of the correction. Thus, setting a certain time limit only for the correction of an error in a priority claim would rather be detrimental to the interests of users and create some inconsistency<sup>29</sup>.

## 1960 ACT

61. The 1960 Act does not contain a provision corresponding to Article 6(1)(b) of the 1999 Act. However, there is no reason to treat international applications governed by the 1960 Act differently. As mentioned in paragraph 4, the Paris Convention refers to the possibility of providing a priority claim after filing (Article 4D).

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<sup>29</sup> Under the PCT System, the time limit to correct a priority claim is the same as for the addition of a priority claim (PCT Rule 26*bis*). However, a correction of the priority claim that does not affect the priority date, such as a correction of the application number of the earlier application, can be corrected upon request by the applicant submitted within 26 months from the priority date (PCT Rule 91).

## FEES

62. No fee is currently payable under the PCT System for the addition of a priority claim, while charging a fee is a possible option under the PLT (Article 13(4)) and the draft DLT (Article 14(3)). Given the financial situation of the Hague Union, the Working Group may wish to consider charging a fee for handling this service under the Hague System, as its introduction would require development and bring an additional workload to the International Bureau.

## V. PROPOSAL

### NEW RULE 22BIS

63. It is proposed to add a new Rule 22*bis* to implement the provision of Article 6(1)(b) of the 1999 Act to allow applicants or holders to add a priority claim after filing international applications, as reproduced in Annex I to this document.

64. Proposed new subparagraph (1)(a) would allow applicants or holders to submit a request to the International Bureau for adding a priority claim within two months from the filing date of the international application. The provision also clarifies that such a possibility is not available if the international application contains a request for immediate publication.

65. Pursuant to proposed new subparagraph (1)(b), such a request must specify the (single) international application or registration concerned and the priority claim must be provided in accordance with Rule 7(5)(c). More than one priority claim may be provided in the request. The request would also be subject to the payment of a fee (refer to paragraphs 72 and 73 below). The fee would be applicable per request, but not per priority claim.

66. Proposed new subparagraph (1)(c) would clarify that if the international application was filed through an Office, the proposed two-month time limit would be counted from the date on which the International Bureau receives the international application because the latter date may not be the filing date as described in paragraphs 44 to 46, above.

67. If the request is in order, pursuant to proposed new subparagraph (2), the International Bureau would promptly add the priority claim and notify that fact to the applicant or holder.

68. Proposed new subparagraph (3)(a) would provide that if the request is received by the International Bureau outside the prescribed time limit, the International Bureau would not add the priority claim. The International Bureau would notify the applicant or holder accordingly and refund any fee paid in this respect.

69. Similarly, pursuant to proposed new subparagraph (3)(b), if the request does not comply with the applicable requirements, for instance, it is not provided in accordance with Rule 7(5)(c) or the prescribed fee has not been paid in full, the International Bureau would invite the applicant or holder to correct the irregularity within one month from the date of the notification of the irregularity. If the irregularity is not remedied within the said one month period, the request would be considered abandoned. The International Bureau would then notify the applicant or holder accordingly and refund any fee paid in this respect.

70. Proposed new paragraph (4) would provide that where the addition of a priority claim causes a change in the priority date, any period which is computed from the previously applicable priority date and which has not already expired would be computed from the priority date as so changed. Accordingly, the applicable maximum deferment period for publication would be recalculated from the priority date as so changed.

## CONSEQUENTIAL AMENDMENT TO RULE 15

71. Rule 15(2) sets out the contents of the international registration. As a consequential amendment, it is proposed to add a new subparagraph (vi) to refer to any priority claim added under Rule 22*bis*(2).

## AMENDMENTS TO THE SCHEDULE OF FEES

72. Consistent with paragraph 62, above, new item 6 would be proposed to be included in the Schedule of Fees, for the addition of a priority claim, as reproduced in Annex I to this document. Since this new type of service does not fit any of the existing categories, the creation of a new Section II for *Miscellaneous Procedures Subsequent to International Application* would also be proposed to contain this new item.

73. As to the amount of the fee, Section V for *Miscellaneous Recordings* currently sets out fee items for the recording of a change, each of the current items charging 144 Swiss francs. Although this new service would expect to require an equivalent workload of the International Bureau, the addition of a priority claim would not be the subject of an independent recording. Given that consideration, it is proposed to charge the amount of 100 Swiss francs for the addition of a priority claim.

## DATE OF ENTRY INTO FORCE

74. As far as the International Bureau is concerned, the implementation of proposed new Rule 22*bis* with the aforementioned features would require certain modifications to the IT system and the examination procedures. Thus, if the proposal was considered favorably by the Working Group and adopted by the Assembly of the Hague Union, the date of entry into force of the proposed amendments would have to be determined and announced by the International Bureau.

## ADMINISTRATIVE INSTRUCTIONS

75. As mentioned in paragraph 51, above, after the transmission of its confidential copy to an Office, data concerning the international registration would be updated pursuant to Section 902 of the Administrative Instructions. If the proposal was considered favorably by the Working Group and adopted by the Assembly of the Hague Union, Section 902 would be amended to include a priority claim that may be added pursuant to proposed new Rule 22*bis*.

76. In this regard, pursuant to Rule 34(1)(a) of the Common Regulations, the Director General of the World Intellectual Property Organization (WIPO) may modify the Administrative Instructions after having consulted the Offices of Contracting Parties. To this end, the present document should be considered by the Working Group with a view to proceeding to the aforementioned consultation with respect to the proposed amendment to Section 902, as reproduced in Annex II to this document.

77. *The Working Group is invited to:*

*(i) consider and comment on the proposals made in this document;*

*(ii) indicate whether it would recommend to the Assembly of the Hague Union for adoption, the proposed amendments to the Common Regulations with respect to the addition of Rule 22bis and to the Schedule of Fees, as provided in the draft contained in Annex I hereto, with a date of entry into force to be decided by the International Bureau; and*

*(iii) comment on the proposal to amend Section 902 of the Administrative Instructions, as provided in the draft contained in Annex II, with the same date of entry into force as for proposed Rule 22bis.*

[Annexes follow]

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

(as in force on [.....])

[...]

Rule 22bis

Addition of Priority Claim

(1) [Request and Time Limit] (a) The applicant or holder may add a priority claim to the contents of an international application or international registration by submitting a request to the International Bureau within two months from the filing date, provided that the international application does not contain a request for immediate publication referred to in Rule 17(1)(i).

(b) Any request made under subparagraph (a) shall specify the international application or international registration concerned and provide the priority claim in accordance with Rule 7(5)(c). It shall be accompanied by the payment of a fee.

(c) Notwithstanding subparagraph (a), where the international application is filed through an Office, the two-month period referred to in the said subparagraph shall be counted from the date on which the International Bureau receives the international application.

(2) [Addition and Notification] If the request made under subparagraph (1)(a) is in order, the International Bureau shall promptly add the priority claim to the contents of the international application or international registration and notify that fact to the applicant or holder.

(3) [Irregular Request] (a) If the request made under subparagraph (1)(a) is not submitted within the prescribed time limit, the request shall be considered not to have been made. The International Bureau shall notify the applicant or holder accordingly and refund any fee paid pursuant to subparagraph (1)(b).

(b) If the request referred to in subparagraph (1)(a) does not comply with the applicable requirements, the International Bureau shall notify that fact to the applicant or holder. The irregularity may be remedied within one month from the date of the notification of the irregularity by the International Bureau. If the irregularity is not remedied within the said one month, the request shall be considered abandoned and the International Bureau shall notify the applicant or holder accordingly and refund any fee paid pursuant to subparagraph (1)(b).

(4) [Calculation of Period] Where the addition of a priority claim causes a change in the priority date, any period which is computed from the previously applicable priority date and which has not already expired shall be computed from the priority date as so changed.

[...]

Rule 15

Registration of the Industrial Design in the International Register

[...]

- (2) [Contents of the Registration] The international registration shall contain
- (i) all the data contained in the international application, except any priority claim under Rule 7(5)(c) where the date of the earlier filing is more than six months before the filing date of the international application;
  - (ii) any reproduction of the industrial design;

- (iii) the date of the international registration;
- (iv) the number of the international registration;
- (v) the relevant class of the International Classification, as determined by the International Bureau;
- (vi) [any priority claim added under Rule 22bis\(2\)](#).

[...]

SCHEDULE OF FEES  
(as in force on [.....])

*Swiss francs*

[...]

II. [Miscellaneous Procedures Subsequent to International Application](#)

[6. Addition of a priority claim](#)

[100](#)

[...]

[Annex II follows]

**Administrative Instructions  
for the Application of the Hague Agreement**

(as in force on [     ])

[...]

**Part Nine  
Confidential Copies**

[...]

**Section 902: Updating of Data Concerning the  
International Registration**

(a) Where the international registration referred to in Section 901(a) is cancelled pursuant to Rule 16(5), that cancellation shall be communicated to any Office that has received a confidential copy of the said international registration.

(b) Where, with respect to the international registration referred to in Section 901(a), a change is recorded in the International Register pursuant to Rule 21(1)(a) before the publication of the said international registration, that change shall be communicated to any Office that has received a confidential copy of the international registration, except where the change is specific to the designations of other Contracting Parties.

(c) Paragraph (b) shall apply to any correction effected under Rule 22(1) and to any priority claim added under Rule 22bis(2) before the publication of the international registration.

(d) Any cancellation, change, ~~or~~ correction or priority claim referred to in this section shall be communicated in the same manner as provided for in Section 901(a).

[End of Annex II and of document]