

Hague Agreement Concerning the International Registration of Industrial Designs

Amendments to the Administrative Instructions

1. At its fourth session, which took place in Geneva from June 16 to 18, 2014, the Working Group on the Legal Development of the Hague System for the International Registration of Industrial Designs was invited to comment on proposed amendments to the Administrative Instructions for the Application of the Hague Agreement. This was with a view to proceeding to the consultation required pursuant to Rule 34(1)(a) of the Common Regulations Under the 1999 Act and the 1960 Act of the Hague Agreement (hereinafter referred to as “Common Regulations”). As a result of the said consultation, the Administrative Instructions have been amended by the Director General of the World Intellectual Property Organization (WIPO).
2. The amendments to the Administrative Instructions consist of amendments to Section 402, entitled “Representation of the Industrial Design”, Section 403, entitled “Disclaimers and Matter That Does Not Form Part of the Industrial Design or the Product in Relation to Which the Industrial Design is to be Used” and Section 405, entitled “Numbering of Reproductions and Legends” and of a new Section 408, entitled “Permitted Matters in the International Application and Permitted Documents Accompanying an International Application”.
3. It is recalled that, pursuant to Rule 9(4) of the Common Regulations, an Office may refuse the effects of the international registration on the ground that the reproductions contained in the international registration are not sufficient to disclose fully the industrial design. As the Hague System expands to integrate more examination systems, there will be an accrued risk of refusals issued under Rule 9(4). The Offices of current and prospective Contracting Parties may apply different requirements concerning an appropriate disclosure of an industrial design, for example, concerning the representation of the industrial design or the views required for sufficient disclosure. The purpose of the amendments to Sections 402, 403 and 405 is to mitigate the aforementioned risk. The above-mentioned amendments seek to relax somewhat certain formal requirements regarding the reproductions and representations of the industrial design by giving applicants more flexibility in terms of providing elements that may be useful with regard to improved disclosure of the industrial design.

4. The purpose of new Section 408 is to complement Rule 7(5)(f) and (g) of the Common Regulations. Rule 7(5)(f) of the Common Regulations states that the international application may also contain any declaration, statement or other relevant indication as may be specified in the Administrative Instructions. Moreover, Rule 7(5)(g) prescribes that an international application may be accompanied by a statement that identifies information known by the applicant to be material to the eligibility for protection of the industrial design concerned. Furthermore, pursuant to Rule 7(6) of the Common Regulations, if the international application contains any matter other than that required or permitted by the 1999 Act, the 1960 Act, the Common Regulations or the Administrative Instructions, the International Bureau shall delete it *ex officio*. Rule 7(6) further states that if the international application is accompanied by any document other than those required or permitted, the International Bureau may dispose of the said document. To avoid the above-mentioned situations, a complete list of permitted matters and documents which, at the applicant's option and in accordance with Rule 7(5)(f) and (g) may be included in the international application, is provided in Section 408.

5. All the aforementioned amendments will come into effect on July 1, 2014, and are further described below.

IMPROVED DISCLOSURE OF THE INDUSTRIAL DESIGN

DIMENSIONS OF THE REPRESENTATION

Section 402(b)

6. Cases sometimes arise in which one or some of the representations of the industrial design are represented before the International Bureau in a scale that differs from that used for other representations. For instance, in the case where a pen is represented in one scale in a side view, a representation showing the head of the pen from the top angle (top view) would be in a larger scale so as to comply with the requirement that one of the dimensions of the representation be at least 3 centimeters. There is, however, a risk that an Examining Office will consider that the inconsistency in terms of scale among those representations is a source of ambiguity and will feel compelled to issue a refusal under Rule 9(4).

7. To prevent that risk, paragraph (b) of Section 402 has been amended to indicate that it is sufficient if, in respect of at least one representation of each design, one of the dimensions is of at least 3 centimeters. With regard to the example of a pen contained in the previous paragraph, amended paragraph (b) allows for the representation of the head of the pen (top view) in the same scale as the others even if, for example, it would result in this representation being 2 centimeters in diameter. This amendment provides applicants with the flexibility to submit all representations in the same scale, without preventing them from submitting representations in different scales if they so desire.

EXPLANATORY TEXT OR LEGENDS

Section 402(c)(ii)

8. Furthermore, Section 402(c)(ii) has been amended to forbid the indication of explanatory text or legends in the representation itself. This specification has been added to this Section in the interests of clarity as a result of the addition of new paragraph (c) to Section 405, which allows for the indication of legends in a brief description.

INDICATION OF "ENVIRONMENTAL MATTER" AND DISCLAIMER

Section 403

9. In the view of a number of Examining Offices, in order to better understand an industrial design it is necessary to understand the nature of the product itself, as well as its purpose and the environment in which it is intended to be used. In order to convey such information to an Office, as a safeguard against a possible refusal on the ground of insufficient disclosure, the applicant may wish to show use or function of the product with representations of the industrial design that includes environmental matter.

10. New paragraph (b) of Section 403 needs to be read in conjunction with Section 402(a), which provides that the photographs and other graphic representations shall represent the industrial design alone, or the product in relation to which the industrial design is to be used, to the exclusion of any other object, accessory, person or animal. Pursuant to new Section 403(b) "environmental matter", such as accessories, may be shown in a reproduction if it is indicated in accordance with paragraph (a).

11. As a consequence of the addition of new paragraph (b) to Section 403, the previous Section 403 has become paragraph (a).

12. Sub-paragraph (ii) of new Section 403(a) has also been amended to comply with the long-standing practice of the International Bureau to allow the indication of a disclaimer by coloring.

13. The title of Section 403 has been amended to read "Disclaimers and Matter That Does Not Form Part of the Industrial Design or the Product in Relation to Which the Industrial Design is to be Used".

LEGENDS

Section 405(c)

14. According to Section 405(a), when the industrial design is represented from different angles, a number shall be given to each reproduction, as follows: "1.1", "1.2", "1.3", etc. for the first design and "2.1", "2.2", "2.3", etc. for the second design. In addition, according to new Section 402(c)(ii), legends cannot be included in the representation of the industrial design. However, in the absence of any indication of views, it might not be possible to build up a clear picture of the industrial design for which protection is sought. In this regard and in accordance with Article 5(2)(b)(ii) of the 1999 Act, a "brief description of the reproduction" may be contained in the international application. Therefore, paragraph (c) has been introduced in Section 405 to allow for legends indicating the type of view associated with the numbering of each reproduction to be contained in the brief description, for example, "1.1: front view, 1.2: top view...".

15. The title of Section 405 has been amended to read "Numbering of Reproductions and Legends".

PERMITTED MATTERS IN THE INTERNATIONAL APPLICATION AND PERMITTED DOCUMENTS ACCOMPANYING AN INTERNATIONAL APPLICATION

DIGITAL ACCESS SERVICE FOR PRIORITY DOCUMENTS (DAS) CODE

Section 408(a)

16. Rule 7(5)(c) provides for a declaration claiming the priority of an earlier filing in an international application. However, that Rule does not provide for a copy of the application on which the priority is based to be submitted. This does not preclude an Office from requesting the holder directly to provide it with a copy of the priority document. Such a request could be made in the context of a refusal where the Office considers that the priority document is necessary in order to determine novelty.

17. The Offices of some current and prospective Contracting Parties to the 1999 Act require the submission of a copy of the application on which priority is based. New Section 408(a) takes into account the foreseen expansion of the Digital Access Service for Priority Documents (DAS) and provides for the possibility of the indication of the DAS code in the international application to retrieve the document from a digital library. This allows users to bypass extra costs and delays associated with procedures before Offices which require documentation in support of a priority claim.

INDICATION OR CLAIM OF THE APPLICANT'S ECONOMIC STATUS

Section 408(b)

18. New Section 408(b) allows for an indication or claim of the applicant's economic status, which would allow the applicant to benefit from a reduction of an individual designation fee concerning a designated Contracting Party. This provision has been added in anticipation of the accession of the United States of America to the 1999 Act, since it is envisaged that the declaration under Article 7(2) of the 1999 Act by the United States of America will indicate three different amounts of individual designation fees, depending on the economic status of the applicant.

DECLARATION CONCERNING EXCEPTION TO LACK OF NOVELTY AND SUPPORTING DOCUMENTATION

Section 408(c)

19. New Section 408(c) makes it possible for applicants to include a declaration concerning an exception to lack of novelty and its supporting documentation in an international application. This new provision would allow applicants to claim benefits from exceptional treatments for disclosure of an industrial design during the grace period provided for in the national law of certain Contracting Parties.

PRIOR ART REFERENCE

Section 408(d)

20. In line with Rule 7(5)(g), under the national law of certain prospective Contracting Parties the applicant has a duty of disclosure to submit to the Office information that is material to the patentability of the design for which protection is claimed. For this purpose, the applicant has to submit the form entitled "Information Disclosure Statement", along with relevant prior art references, e.g., bibliographic information, such as titles, articles, patent numbers, web sites.

21. In anticipation of the accession of such Contracting Parties to the 1999 Act, new Section 408(d) allows for the submission of such a statement that identifies information that is material to the eligibility for protection of the industrial design concerned.

22. The amended text of the Administrative Instructions is reproduced in the Annex.

23. A more detailed presentation of the amendments referred to above can be found in the Working Group documents H/LD/WG/4/2 and H/LD/WG/4/5, available on the WIPO web site at the following address: http://www.wipo.int/meetings/en/details.jsp?meeting_id=32042.

June 30, 2014

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

(as in force on July 1, 2014)

[...]

**Part Four
Requirements Concerning Reproductions and Other Elements
of the International Application**

[...]

Section 402: Representation of the Industrial Design

(a) The photographs and other graphic representations shall represent the industrial design alone, or the product in relation to which the industrial design is to be used, to the exclusion of any other object, accessory, person or animal.

(b) The dimensions of the representation of each industrial design appearing in a photograph or other graphic representation may not exceed 16 x 16 centimeters, and in respect of at least one representation of each design, one of those dimensions must be at least 3 centimeters. With respect to the filing of international applications by electronic means, the International Bureau may establish a data format, the particulars of which shall be published on the web site of the Organization, to ensure compliance with these maximum and minimum dimensions.

(c) The following shall not be accepted.

- (i) technical drawings, particularly with axes and dimensions;
- (ii) explanatory text or legends in the representation.

Section 403: Disclaimers and Matter That Does Not Form Part of the Industrial Design or the Product in Relation to Which the Industrial Design is to be Used

(a) Matter which is shown in a reproduction but for which protection is not sought may be indicated

- (i) in the description referred to in Rule 7(5)(a) and/or
- (ii) by means of dotted or broken lines or coloring.

(b) Notwithstanding Section 402(a), matter that does not form part of the industrial design or the product in relation to which the industrial design is to be used may be shown in a reproduction if it is indicated in accordance with paragraph (a).

[...]

Section 405: Numbering of Reproductions and Legends

(a) The numbering stipulated for multiple international applications shall appear in the margin of each photograph or other graphic representation. When the same industrial design is represented from different angles, the numbering shall consist of two separate figures separated by a dot (e.g., 1.1, 1.2, 1.3, etc. for the first design, 2.1, 2.2, 2.3, etc. for the second design, and so on).

(b) The reproductions shall be submitted in ascending numerical order.

(c) Legends to indicate a specific view of the product (e.g., “front view”, “top view”, etc.) may be indicated in association with the numbering of the reproduction.

[...]

Section 408: Permitted Matters in the International Application and Permitted Documents Accompanying an International Application

(a) Where the applicant has made a declaration under Rule 7(5)(c) claiming priority of an earlier filing in the international application, that claim may be accompanied by a code allowing to retrieve that filing in a Digital Access Service for Priority Documents (DAS) digital library;

(b) Where the applicant wishes to benefit from a reduction of an individual designation fee as indicated in a declaration made under Article 7(2) of the 1999 Act by a designated Contracting Party, the international application may contain an indication or claim of the economic status entitling the applicant to the reduced fee as indicated in the declaration, as well as the certificate thereof, where applicable.

(c) (i) Where the applicant wishes to make a declaration concerning exception to lack of novelty in the international application, as may be prescribed under the law of a designated Contracting Party, the declaration shall be worded as follows, with the indication of those industrial designs to which the declaration relates:

“Declaration Concerning Exception to Lack of Novelty

“The applicant claims to benefit from exceptional treatments provided for in the applicable laws of the designated Contracting Parties concerned for disclosure of [all] the [following] industrial designs included in the present application.”

(ii) Where the applicant wishes to submit documentation on the type and date of disclosure, the international application may be accompanied by such documentation.

(d) Where the applicant wishes to submit a statement as referred to in Rule 7(5)(g), the statement shall be in the format established by the International Bureau in agreement with the designated Contracting Party concerned.

[...]

[End of Annex]