

## **Special Union for the International Deposit of Industrial Designs (Hague Union)**

### **Assembly**

**Thirty-Fourth (15<sup>th</sup> Extraordinary) Session  
Geneva, September 22 to 30, 2014**

### **REPORT**

*adopted by the Assembly*

1. The Assembly was concerned with the following items of the Consolidated Agenda (document A/54/1): 1, 3, 4, 5, 6, 12, 20, 26 and 27.
2. The report on the said items, with the exception of item 20, is contained in the General Report (document A/54/13).
3. The report on item 20 is contained in the present document.
4. In the absence of the Chair and unavailability of the Vice-Chairs, Mrs. Grace Issahaque (Ghana) acted on an *ad hoc* basis as Chair of the meeting.

## ITEM 20 OF THE CONSOLIDATED AGENDA

### HAGUE SYSTEM

5. Discussions were based on documents H/A/34/1 and H/A/34/2.
  6. The Chair opened the meeting and welcomed the delegations to the Hague Union.
  7. At the invitation of the Chair, the Secretariat referred to the accessions of Brunei Darussalam and the Republic of Korea to the 1999 Act and welcomed their participation for the first time as members in the Assembly of the Hague Union. The Secretariat further referred to the statements by a number of delegations during the Assemblies concerning their intention to become members of the Hague Union. To foster the geographic expansion of the Hague System and sustain the growth in filings, it was essential that both the Information Technology (IT) framework and the legal framework of the Hague System evolve in a coordinated and integrated fashion. The two documents submitted to the Assembly aimed at achieving this objective.
  8. The Delegation of China expressed its appreciation of the proactive role of the International Bureau for the development of the Hague System. The Delegation indicated that China was ready to contribute to the further improvement of the Hague System to make it even more user-friendly and flexible. The Delegation explained that internal procedures for China's accession to the 1999 Act were well underway.
  9. The Delegation of Japan explained that Japan, with strong support from WIPO, had been advancing national initiatives that would enable its accession to the 1999 Act of the Hague Agreement aiming to accept the first international registrations designating Japan in spring 2015. The Delegation believed that it was crucial to further improve the Hague System in terms of legal and operational aspects, so as to assist countries that are either considering or are in the process of acceding to the Hague Agreement. Also, in order to address the further increase in the number of Hague member States, it was essential for WIPO to enhance its function, so as to ensure that the Hague System operates efficiently and appropriately.
- Information Technology Modernization Program (Hague International Registration System): Progress Report
10. Discussions were based on document H/A/34/1.
  11. The Secretariat introduced the document and outlined the progress made in the Information Technology Modernization Program since the last Hague Union Assembly.
  12. The Secretariat stated that since the last Assembly, focus had been on the delivery of Phase II of the Program, and informed that a Phase II delivery for the Madrid component had been received from the external implementation partner, and that delivery was currently being subject to system testing by internal technical staff.
  13. The Secretariat also informed that as far as the Hague Registry was concerned, and prior to the end of 2013, it became clear that the imminent accessions of new Hague member States would require substantive modification to the Hague IT System procedures. It was felt that there would be less operational risk with these developments, if they were undertaken in the legacy IT system. As a result, Phase II activities for the Hague Registry had been suspended, and they would recommence when the changes in the legacy IT system had stabilized.

14. The Secretariat noted that the Independent Validation and Verification Exercise currently being undertaken by the Madrid Registry, would also be of benefit to the Hague Registry in its future Phase II deployment.

15. The Assembly took note of the content of the Progress Report on the Information Technology Modernization Program (Hague International Registration System), as described in document H/A/34/1.

#### Matters Concerning the Legal Development of the Hague System

16. Discussions were based on document H/A/34/2.

17. The Secretariat introduced the document and explained that document H/A/34/2 contained recommendations made by the Working Group on the Legal Development of the Hague System for the International Registration of Industrial Designs at its fourth session, which was held from June 16 to 18, 2014. Firstly, the document contained a proposal for a recommendation for making the “Certificate of Transfer” an acceptable document in the Contracting Parties having made a declaration under Article 16(2) of the 1999 Act. Secondly, the document contained proposals for amendments to the Common Regulations under the 1999 Act and the 1960 Act of the Hague Agreement.

18. Pursuant to Article 16(2) of the 1999 Act, a recording of a change in ownership in the International Register should not have effect in a Contracting Party having made a declaration under that Article, until the Office of that Contracting Party has received the statements or documents specified in that declaration. At present, three Contracting Parties had made a declaration under Article 16(2) but it was expected that some future Contracting Parties would also make the said declaration.

19. To avoid the situation where the users of the Hague System would have to submit various sets of different documents or statements to the Offices requiring them, the Working Group agreed on the format and contents of a standard document, the “Certificate of Transfer”. Furthermore, the Working Group favorably considered the submission of the standard document through the International Bureau and its electronic distribution to the Offices concerned.

20. The Secretariat emphasized that the purpose of the recommendation merely was to encourage the Offices concerned to accept the standard document as having the same effect as a statement or document submitted for that purpose under the law of the Contracting Party concerned. If the Assembly were to adopt this recommendation, the International Bureau, after consultation with the Offices of the Contracting Parties concerned, would establish a list of those Offices able to follow the recommendation and make that list available on the web site of the Organization alongside the “Certificate of Transfer”.

21. The Secretariat then introduced the proposals for amendments to the Common Regulations and to the Schedule of Fees in the Common Regulations. It was recalled that Article 14(2)(c) of the 1999 Act provided that the effect given to the international registration under Article 14(1), (2)(a) and (b) shall apply to the industrial design as received from the International Bureau by the Office of a designated Contracting Party or, where applicable, “as amended in a procedure before that Office”.

22. The Working Group agreed on the need to establish a mechanism for such amendments to be communicated to the International Bureau by the Office of a designated Contracting Party and to be made publicly available in a centralized manner by the International Bureau (the “Feedback Mechanism”). A proper way to convey the information concerning amendments would be through a statement of grant of protection as provided for in Rule 18*bis*(1) and (2) and a notification of withdrawal of refusal as provided for in Rule 18(4) of the Common Regulations.

Any withdrawal of refusal and any statement of grant of protection would be recorded in the International Register and published in the *International Designs Bulletin*. In this regard, noting the variety in types of amendments, the surest and most pragmatic solution to make the information concerning amendments publicly available would be for the International Bureau to upload a copy of the notification or statement as received from the Office and to make it available through the Bulletin.

23. In addition, the fourth session of the Working Group considered that “the date on which the international registration produced (or shall produce) the effect as a grant of protection under the applicable law” would be an important element to be communicated to the International Bureau by the Office of a designated Contracting Party and to be made publicly available in a centralized manner by the International Bureau. Furthermore, it was agreed that the issuance of the statement of grant of protection would be obligatory under certain circumstances. Finally, the Working Group considered favorably the proposal to amend the Schedule of Fees to authorize the International Bureau to collect a fee for additional services, for example, the late submission of priority documents after the filing of an international application.

24. The Assembly:

- (a) adopted the recommendation for making the Certificate of Transfer an acceptable document in the Contracting Parties having made a declaration under Article 16(2) of the 1999 Act, as set out in Annex I of document H/A/34/2;
- (b) adopted the amendments to the Common Regulations with respect to Rule 18(4), and Rule 18*bis*(1) and (2), as set out in Annex V of document H/A/34/2, with a date of entry into force of January 1, 2015;
- (c) adopted the amendments to the Common Regulations with respect to the Schedule of Fees, as set out in Annex V of document H/A/34/2, with a date of entry into force of January 1, 2015.

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