

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

Geneva, May 30 to June 1, 2011

ISSUES RELATING TO THE EFFECTS OF THE RECORDING OF A CHANGE IN OWNERSHIP IN THE INTERNATIONAL REGISTER

Document prepared by the International Bureau

I. INTRODUCTION

1. A major advantage that the Hague system offers to its users is what is referred to as the “central management of international registrations”. For example, at the request of the holder of an international registration, a change in ownership, a change in the name or address of the holder, a limitation of the international registration to one or some of the industrial designs or a renunciation of the international registration in respect of any or all of the designated Contracting Parties may be recorded in the International Register. Pursuant to Article 16(2) of the Geneva (1999) Act of the Hague Agreement Concerning the International Registration of Industrial Designs (hereinafter referred to as “the 1999 Act” and as “the Hague Agreement” respectively), any such recording shall have the same effect as if it had been made in the Register of the Office of each of the Contracting Parties concerned. This Article provides for one possible exception, however, and that is that a Contracting Party may, in a declaration, notify the Director General of the World Intellectual Property Organization (WIPO) that a recording of a change in ownership in the International Register shall not have effect in that Contracting Party until the Office of that Contracting Party has received the statements or documents specified in that declaration.

2. This exception was included in the 1999 Act at a proposal of the Delegation of the United States of America in the Diplomatic Conference for the Adoption of a New Act of the Hague Agreement (hereinafter referred to as “the Diplomatic Conference”), in 1999¹. The Delegation explained that, under its national law, the actual assignment agreement or any other type of conveyance in order to give effect to a recording of a change in ownership was required².
3. In this context, the Secretariat of the Diplomatic Conference pointed out that the International Bureau would prepare a standard document, along the lines of the one provided for under the Trademark Law Treaty (hereinafter referred to as “the TLT”)³ and the one proposed under the draft Patent Law Treaty (hereinafter referred to as “the PLT”)⁴ in order to reduce the additional burden for holders of international registrations⁵. It was further indicated that the standard document would be prepared in all necessary languages in cooperation with the interested Contracting Parties, and would only require the insertion of relevant data, such as the name of the parties⁶. Since then, the Singapore Treaty on the Law of Trademarks (hereinafter referred to as “the Singapore Treaty”) was adopted in 2006, building on the TLT⁷.
4. At the time of preparing the present document, while two Contracting Parties to the 1999 Act, namely, the African Intellectual Property Organization (OAPI) and Denmark, have made the declaration under Article 16(2) of the 1999 Act⁸, they have not yet been concerned by any change in ownership recorded in the International Register. However, this finding is probably largely attributable to the fact that it has been possible to designate these two Contracting Parties only as from the second part of 2008⁹ and, at any rate, further accessions or ratifications by Contracting Parties, the national/regional legislation of which would allow them to make the declaration under Article 16(2) of the 1999 Act, remain entirely possible. Thus, mechanisms to handle such requirements need to be explored with a view to reducing the burden for the holders of the international registrations concerned.

¹ See Records of the Diplomatic Conference, document H/DC/31, p. 313.

² See Records of the Diplomatic Conference, paragraph 811, p. 482.

³ At the time of preparing the present document, there are 47 Contracting Parties to the TLT.

⁴ The PLT was adopted, by the Diplomatic Conference for the Adoption of the Patent Law Treaty, in 2000. The PLT entered into force on April 28, 2005, and at the time of preparing the present document there are 27 Contracting Parties to the PLT.

⁵ See Records of the Diplomatic Conference, paragraphs 811-812, p. 482.

⁶ See Records of the Diplomatic Conference, paragraph 826, p. 484.

⁷ The Singapore Treaty was adopted by the Diplomatic Conference for the Adoption of a Revised Trademark Law Treaty, in 2006. The Singapore Treaty entered into force on March 16, 2009, and at the time of preparing the present document there are 24 Contracting Parties to the Singapore Treaty.

⁸ The declaration by OAPI specifies that a copy of a legally valid document which constitutes the change in ownership shall be submitted to its Office. The declaration by Denmark specifies that a document establishing the change in ownership or other documentation showing to the satisfaction of the Office that a change in ownership has taken place shall be submitted.

⁹ The accession to the 1999 Act by OAPI entered into force in September 2008 and the ratification of the 1999 Act by Denmark in December 2008. Thus, OAPI and Denmark have since been designated in only 164 and 48 international registrations, respectively. To give a reference point, in 2008, 2009 and 2010, respectively, 470, 215 and 628 changes in ownership were recorded in the International Register while on December 31, 2010, there were 25,633 international registrations in force.

5. Moreover, it is to be noted that under some national/regional laws, there are cases where a change in ownership may not be recorded or given effect for reasons entirely different from, and more fundamental than those contemplated under Article 16(2). Generally speaking then, a mechanism which would allow the Office of a designated Contracting Party to refuse the effects of the recording of the change in ownership in the International Register may be needed in the Hague system. The introduction of such a mechanism would also be in the interest of third parties as it would be providing them with accurate information as regards the identity of the true holder of the rights. Chapter II further elaborates on these considerations and on a proposal for a possible new Rule to that effect.
6. Furthermore, as suggested during the Diplomatic Conference, the establishment of standard forms for the purpose of Article 16(2) of the 1999 Act would be beneficial to the users of the Hague system. It is proposed in Chapter III of the present document that the Working Group considers whether the establishment of standard forms under the 1999 Act in respect of a certificate of transfer and transfer document would be feasible.

II. POSSIBLE NEW RULE ON THE REFUSAL OF THE EFFECTS OF THE RECORDING OF A CHANGE IN OWNERSHIP

Presentation of Statements and Documents Specified in a Declaration under Article 16(2) of the 1999 Act

7. Pursuant to Article 16(2) of the 1999 Act, a Contracting Party may make a declaration that a recording of a change in ownership in the International Register shall not have effect in that Contracting Party until the Office of that Contracting Party has received the statements or documents required by it. This is to say, from a legal point of view, that until such statements or documents have been received by the Office, the international registration remains in the name of the transferor with respect to the designation of the Contracting Party having made the said declaration. When the required statements or documents have been received by the Office, the Office could confirm the receipt directly to the party having submitted them.
8. As regards the recording of a change in ownership in the International Register, the change is recorded in respect of all the designated Contracting Parties affected by the change despite the fact that its effect in some Contracting Parties may be pending the compliance with the requirements declared by those Contracting Parties, respectively. 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 any mechanism whereby the Office of a designated Contracting Party may remind the holder of the international registration that it has not received the required statements or documents, or notify the International Bureau of that fact. As a consequence, third parties cannot be aware that the change in ownership has not taken effect unless they consult the Office concerned.
9. In order to enhance the transparency of the international registration system, it appears to be preferable to establish a mechanism to update the International Register with feedback from the Office of the Contracting Party concerned.

Change in Ownership Incompatible with Some National/Regional Laws

10. Where there is more than one design contained in an international registration, part of these may be assigned independently from the others and this fact leads to a recording of a partial change in ownership in the International Register¹⁰. However, there are situations under some national/regional laws, where the recording of such type of partial change in ownership is not allowed. For example, under certain jurisdictions, a set of industrial designs is considered to constitute a single industrial design, which means that all the designs belonging to the same set acquire legal protection as a whole. In other words, the industrial designs forming the set do not acquire protection independently. As a consequence, all the designs forming the set can only be transferred to the same transferee at the same time. It remains, however, that in the International Register, all such designs would have been recorded as independent designs rather than as a single design for a set if so was the wish of the applicant. Therefore, in that case, there is nothing that would prevent some of them from being the subject of a recording for a partial change in ownership.
11. Furthermore, in some jurisdictions, an industrial design similar to another design whose application was filed on the same day or earlier can be registered only where the latter design is in the name of the applicant of the former design. In other words, by fulfilling such a condition, the latter design (the similar design in question) shall not be considered as a prior design that would hinder another design belonging to the same person from being registered. However, designs registered under this particular condition can only be transferred all together at the same time.
12. Therefore, a certain mechanism would be necessary in the international registration system to allow current or prospective Contracting Parties to refuse the effects of the recording of a change in ownership, where such recording under their national/regional laws is not allowed. Such a mechanism would also be in the interest of the third parties by reducing the uncertainty as to the identity of the holder of the rights deriving from the international registration.

Proposal for a New Rule on the Refusal of the Effects of the Recording of a Change in Ownership

13. In view of the situations described in the preceding paragraphs, one may consider the introduction of a new rule to the Common Regulations, which would allow the Office of a designated Contracting Party to declare that the recording of a change in ownership has no effect in the said Contracting Party.
14. It is recalled that under the Madrid system for the international registration of marks, such a rule exists. More precisely, Rule 27(4) of the Common Regulations under the Madrid Agreement and the Protocol (hereinafter referred to as the "Madrid Regulations"), provides that the Office of a designated Contracting Party may declare that the change in ownership

¹⁰ The number of recordings of a partial change in ownership with respect to some of the designs are five in 2008, one in 2009, and two in 2010, respectively. However, in view of the expansion of the membership, this figure may increase in the future.

has no effect in the said Contracting Party¹¹. The effect of such a declaration is that, with respect to the said Contracting Party, the international registration concerned remains in the name of the transferor. This mechanism was introduced under the Madrid system to handle situations where the change in ownership cannot be accepted based on the ground that it does not comply with certain requirements under the national/regional law. In some jurisdictions, a registered trademark similar to another registered trademark held by the same owner may not be transferred independently from that other mark. This situation is analogous to that described in paragraph 11, above, in respect of industrial designs.

15. In view of the interest for holders and third parties in minimizing the uncertainty over the rights deriving from an international registration, a time limit for sending the declaration should be established. In that respect, it is recalled that the time limit as prescribed in Rule 27(4)(c) of the Madrid Regulations is 18 months from the date of the notification of the change in ownership. As the Madrid Protocol provides for the possibility to extend the refusal period from one year to 18 months (Article 5(2)(b)), this helps to avoid the inconvenience that would otherwise be caused if the time limit under Rule 27(4) were to end before examination of the international registration concerned has started or even ended in a designated Contracting Party. Under the Madrid system still, this risk is not unlikely given the possibility of “subsequent designation”, *i.e.* the fact of adding a new designation to an existing registration, thus opening up a new period of refusal for the Contracting Party so designated. Under the Hague system, however, no such possibility exists. Thus a time limit of six months would probably suffice in most cases, as it would be unlikely for a change in ownership to occur so early in the life of the international registration that the latter would still be pending examination with the Offices of certain Contracting Parties. Still, so as to not completely overlook that exceptional situation, the proposed new Rule 21**bis** envisages an alternative, namely that the time limit would be either six months from the date of the publication of the change in ownership or the applicable refusal period, whichever expires later.

¹¹ Rule 27(4) [*Declaration That a Change in Ownership Has No Effect*] of the Common Regulations under the Madrid Agreement and the Protocol reads as follows:

- “(a) *The Office of a designated Contracting Party which is notified, by the International Bureau, of a change in ownership affecting that Contracting Party may declare that the change in ownership has no effect in the said Contracting Party. The effect of such a declaration shall be that, with respect to the said Contracting Party, the international registration concerned shall remain in the name of the transferor.*
- (b) *The declaration referred to in subparagraph (a) shall indicate*
- (i) *the reasons for which the change in ownership has no effect,*
- (ii) *the corresponding essential provisions of the law, and*
- (iii) *whether such declaration may be subject to review or appeal.*
- (c) *The declaration referred to in subparagraph (a) shall be sent to the International Bureau before the expiry of 18 months from the date on which the notification referred to in subparagraph (a) was sent to the Office concerned.*
- (d) *The International Bureau shall record in the International Register any declaration made in accordance with subparagraph (c) and, as the case may be, record as a separate international registration that part of the international registration which has been the subject of the said declaration, and shall notify accordingly the party (holder or Office) that presented the request for the recording of a change in ownership and the new holder.*
- (e) *Any final decision relating to a declaration made in accordance with subparagraph (c) shall be notified to the International Bureau which shall record it in the International Register and, as the case may be, modify the International Register accordingly, and shall notify accordingly the party (holder or Office) that presented the request for the recording of a change in ownership and the new holder.”*

16. Article 16(2) of the 1999 Act, however, creates a situation that is specific to the Hague system¹². As this provision does not set up any procedure, the situation that it provides for, *i.e.* that a recording of a change in ownership shall not have effect in the Contracting Party concerned until its Office has received the required statement or document, remains open-ended. This can be problematic for all parties concerned, *i.e.*, the holder, the Office of the designated Contracting Party concerned and third parties. On the other hand, if the Office of the designated Contracting Party were allowed to send to the International Bureau a declaration of refusal of the effect of the change in ownership, that refusal would be recorded in the International Register and published accordingly. Furthermore, that would help to prevent the International Bureau from recording a subsequent change in ownership from the holder who is, in fact, not considered as such with respect to the designation of that Contracting Party. Thus, it appears desirable for the proposed new rule to also apply in this case.
17. As provided for in proposed new Rule 21 *bis*, as produced in Annex I, a declaration of refusal should indicate (i) the reasons for which the change in ownership has no effect, (ii) the corresponding essential provisions of the law, (iii) the numbers of the designs concerned by the declaration where it does not relate to all the designs that are the subject of the change in ownership, and (iv) whether such declaration may be subject to review or appeal.
18. Upon its receipt, the International Bureau would record the declaration in the International Register and notify accordingly the previous holder (the transferor) and the new holder (the transferee). The International Bureau would also modify the International Register, whereby that part of the international registration which has been the subject of the said declaration would be recorded as a separate international registration in the name of the previous holder (the transferor). The International Bureau would notify accordingly the previous holder (the transferor) and the new holder (the transferee).
19. It is further proposed that the withdrawal of a declaration of refusal issued under this rule shall be notified to the International Bureau which shall then record it in the International Register, modify the International Register accordingly, and notify accordingly the previous holder (the transferor) and the new holder (the transferee).
20. The following example may illustrate how the proposed rule would work: a given international registration contains the designations of Contracting Parties A and B under the 1999 Act, Contracting Party A having made the declaration under Article 16(2) of the 1999 Act. A total change in ownership of the international registration has been recorded in the International Register from holder X to new holder Y. After three months from the date of publication of the recording of the said change in ownership, the International Bureau receives from the Office of Contracting Party A the declaration that the change in ownership has no effect in that Contracting Party. The International Bureau records the said declaration in the International Register and notifies accordingly the previous holder (the transferor) and the new holder (the transferee), in accordance with paragraph (4) of the proposed rule. Pursuant to the said paragraph, the International Bureau modifies the total change in ownership to a change in ownership in respect of Contracting Party B, this modification leading to the creation of a new international registration in the name of X for Contracting Party A. According to the general principle established under Rule 21(7) for the recording of partial change in ownership, the new international registration would bear

¹² The possibility to require such statements or documents in order to give effect to a recording of a change in ownership is not provided for in the Madrid Agreement or the Protocol.

the number of the original international registration, together with a capital letter. In the event of a further decision to withdraw the aforementioned declaration of refusal in Contracting Party A, it shall be notified to the International Bureau pursuant to paragraph (5) of the proposed rule. The International Bureau then modifies the name of the holder of the new international registration from X (the previous holder) to Y (the new holder) and notifies the previous and the new holder accordingly. If Y then wishes to merge those two international registrations, this could be requested at any time, in accordance with Rule 21(8) of the Common Regulations.

21. *The Working Group is invited to comment on the proposal above and to indicate whether it would recommend to the Hague Union Assembly the introduction to the Common Regulations of proposed new Rule 21bis, as reproduced in Annex I to the present document and, in such case, to indicate also the date it would recommend for the entry into force.*

III. CONSIDERATIONS RELATING TO POSSIBLE STANDARD FORMS

Model International Forms Under the PLT and Under the Singapore Treaty

22. Pursuant to Article 14(1)(c) of the PLT, the Assembly of the PLT shall establish Model International Forms with the assistance of the International Bureau. Furthermore, Article 8(3) of the PLT prescribes that a Contracting Party shall accept the presentation of the contents of a communication on a form which corresponds to a Model International Form in respect of such a communication provided for in the Regulations under the PLT, if any.
23. Under Rule 16(2) of the Regulations under the PLT, several grounds from which a change in ownership may result are listed, such as a contract, a merger, the reorganization or division of a legal entity or a court decision. Furthermore, in Rule 20, the different types of Model International Forms, including a form in respect of a certificate of transfer are defined (the said form is reproduced in Annex II to the present document). The third ordinary session of the PLT Assembly in 2007, established those Forms which entered into force on April 1, 2008.
24. In accordance with Article 22(1)(b) of the Singapore Treaty, Model International Forms form a part of the Regulations Under the Singapore Treaty. Form No. 5 "Certificate of Transfer" (the form is reproduced in Annex III to the present document) and Form No. 6 "Transfer Document" (the form is reproduced in Annex IV to the present document) are the ones provided for under the TLT. Furthermore, pursuant to Article 8(5), any Contracting Party shall accept the presentation of a communication, the content of which corresponds to the relevant Model International Form, if any, provided for in the Regulations.

25. Form "Certificate of Transfer" under the Singapore Treaty corresponds to the Model International Form with the same title under the PLT, whereby the transferor and the transferee certify that ownership of the identified registration has been transferred by contract. In form "Transfer Document" under the Singapore Treaty, however, the transferor and the transferee give effect to the change in ownership, by signing the document, which serves as a contract itself¹³.
26. Under both the PLT and the Singapore Treaty, the legalization or certification of the Model International Forms by a notary public or any other competent public authority may not be required.
27. Pursuant to Article 8(2) of the PLT, a Contracting Party may, except where otherwise provided for by the said treaty or the Regulations under the PLT, require that a communication be in a language accepted by the Office. As regards documents mentioned in the preceding paragraphs, Rule 16(3) of the Regulations Under the PLT provides that a Contracting Party may require the translation if the document submitted is not in a language accepted by the Office. The Singapore Treaty contains a general provision regarding language of communication applicable to all types of communications. Pursuant to Article 8(2)(a) of the Singapore Treaty, any Contracting Party may require that any communication be in a language(s) admitted by the Office. Furthermore, Article 8(2)(c) provides that, where a Contracting Party does not require a communication to be in a language admitted by its Office, the Office may require a translation of that communication by an official translator or a representative, into a language admitted by the Office¹⁴.

Establishment of Standard Forms Under the 1999 Act

28. It is recalled that the required documents under Article 16(2) of the 1999 Act shall be presented directly by the holder of the international registration to the Office of the Contracting Party concerned¹⁵. In view of the interests of, and convenience for, both the Office and the holder, it appears desirable that the contents and form of the required documents be standardized and accepted by the Offices of those Contracting Parties. As mentioned in Chapter I of the present document, at the Diplomatic Conference, the establishment of standard forms along the lines of model international forms provided for in the TLT and the PLT was suggested by the Secretariat. Thus, as described in the preceding paragraphs, Form "Certificate of Transfer" under the PLT and the Singapore Treaty and Form "Transfer Document" under the Singapore Treaty could serve as a basis in establishing the standard forms that may be accepted by the Offices of Contracting Parties having made the declaration under Article 16(2), where the change in ownership results from a contract.

¹³ Paragraph 10.05 of document HM/CE/V/2 (Committee of Experts on the Harmonization of Laws for the Protection of Marks) reads as follows: "[...] *The Regulations provide for a standard certificate of transfer and a standard short contract. The latter can be qualified as a standard short contract. [...]*"

¹⁴ The Model International Forms under the PLT and the Singapore Treaty are made available in Arabic, Chinese, English, French, Russian and Spanish.

¹⁵ In the case that, in the future, more Contracting Parties will make the declaration under Article 16(2) of the 1999 Act, it may be feasible to consider establishing a mechanism taking advantage of the technological developments to make those documents available to the Offices of the Contracting Parties concerned. In any case, even if the International Bureau were to handle such additional documents, the International Bureau would not check their contents or form.

29. The Working Group is invited to consider whether it considers feasible the establishment of standard forms in respect of certificate of transfer or transfer document, as discussed in the Diplomatic Conference. In order to give the desired effect to the standard forms, it would be important that the Offices of the Contracting Parties having made the declaration under Article 16(2) of the 1999 Act or of prospective Contracting Parties that would foresee making that declaration accept the standard forms established by the International Bureau.
30. However, the scope of interested Contracting Parties is larger since the establishment of standard forms would be in the interest of the holders of international registrations, which originate from all the Contracting Parties. Therefore all participants to the Working Group should be involved in their elaboration.
31. *The Working Group is invited to comment on the above and indicate a way forward for the establishment of the standard forms for the purpose of Article 16(2) of the 1999 Act.*

[Annexes follow]

Rule 21bis
Declaration That a Change in Ownership Has No Effect

- (1) *[Declaration and Its Effect]* The Office of a designated Contracting Party may declare that a change in ownership recorded in the International Register has no effect in the said Contracting Party. The effect of such a declaration shall be that, with respect to the said Contracting Party, the international registration concerned shall remain in the name of the transferor.
- (2) *[Contents of the Declaration]* The declaration referred to in paragraph (1) shall indicate
 - (a) the reasons for which the change in ownership has no effect,
 - (b) the corresponding essential provisions of the law,
 - (c) where the declaration does not relate to all the industrial designs that are the subject of the change in ownership, those to which it relates, and
 - (d) whether such declaration may be subject to review or appeal and, if so, the time limit, reasonable under the circumstances, for any request for review of, or appeal against, the declaration and the authority to which such request for review or appeal shall lie, with the indication, where applicable, that the request for review or the appeal has to be filed through the intermediary of a representative whose address is within the territory of the Contracting Party whose Office has pronounced the declaration.
- (3) *[Period for Declaration]* The declaration referred to in paragraph (1) shall be sent to the International Bureau within **[six months]** from the date of the publication of the said change in ownership or within the applicable refusal period in accordance with Article 12(2) of the 1999 Act or Article 8(1) of the 1960 Act, whichever expires later.
- (4) *[Recording and Notification of the Declaration; Consequential Modification of the International Register]* The International Bureau shall record in the International Register any declaration made in accordance with paragraph (3) and shall modify the International Register, whereby that part of the international registration which has been the subject of the said declaration shall be recorded as a separate international registration in the name of the previous holder (transferor). The International Bureau shall notify accordingly the previous holder (transferor) and the new holder (transferee).
- (5) *[Withdrawal of Declaration]* Any declaration made in accordance with paragraph (3) may be withdrawn, in part or in whole. The withdrawal of declaration shall be notified to the International Bureau which shall record it in the International Register. The International Bureau shall modify the International Register accordingly, and shall notify accordingly the previous holder (transferor) and the new holder (transferee).

[Annex II follows]

Sheet No.

Continuation of Box No. III FURTHER TRANSFEROR(S)	
<i>If none of the following sub-boxes is used, this sheet should not be included in the certificate.</i>	
Name and address:	Telephone No.
	Facsimile No.
	E-mail address
Name and address:	Telephone No.
	Facsimile No.
	E-mail address
Name and address:	Telephone No.
	Facsimile No.
	E-mail address
Name and address:	Telephone No.
	Facsimile No.
	E-mail address
Name and address:	Telephone No.
	Facsimile No.
	E-mail address
Name and address:	Telephone No.
	Facsimile No.
	E-mail address

Sheet No.

Box No. IV TRANSFEREE(S)	
Name and address: <i>(Family name followed by given name; for a legal entity, full official designation. The address must include postal code and name of country. The country of the address indicated in this Box is the country of residence.)</i>	Telephone No.
	Facsimile No.
	E-mail address
<input type="checkbox"/> Further transferees are indicated on the following sheet: Continuation of Box No. IV	
Box No. V SIGNATURE OR SEAL OF THE TRANSFEROR(S); DATE	
<i>Next to each signature or seal, indicate the name of the person signing or sealing, the capacity in which the person signs or seals (if such capacity is not obvious) and the date of signature or of seal</i>	
Box No. VI SIGNATURE OR SEAL OF THE TRANSFEREE(S); DATE	
<i>Next to each signature or seal, indicate the name of the person signing or sealing, the capacity in which the person signs or seals (if such capacity is not obvious) and the date of signature or of seal</i>	

Sheet No.

Continuation of Box No. IV FURTHER TRANSFEREE(S)	
<i>If none of the following sub-boxes is used, this sheet should not be included in the certificate.</i>	
Name and address:	Telephone No.
	Facsimile No.
	E-mail address
Name and address:	Telephone No.
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	E-mail address
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	Facsimile No.
	E-mail address
Name and address:	Telephone No.
	Facsimile No.
	E-mail address
Name and address:	Telephone No.
	Facsimile No.
	E-mail address

Form PLT/Certificate of transfer (continuation sheet: transferor) (01/04/2008)

[Annex III follows]

MODEL INTERNATIONAL FORM No. 5**CERTIFICATE OF TRANSFER**

in respect of registration(s) and/or
application(s) for registration of mark(s)

submitted to the Office of

FOR OFFICE USE ONLY

1. Certification

The undersigned transferor(s) and transferee(s) hereby certify that the ownership of the registration(s) and/or application(s) identified below has been transferred by contract.

2. Registration(s) and/or Application(s) Concerned

The present certificate concerns the transfer of the following registration(s) and/or application(s):

2.1 Registration number(s):

2.2 Application number(s)¹:

2.3 If the spaces under 2.1 or 2.2 are not sufficient, check this box and provide the information on an additional sheet.

¹ Where the application number of an application has not yet been issued or is not known to the transferor or its representative, that application may be identified by furnishing either: (i) the provisional application number, if any, given by the Office, or (ii) a copy of the application, or (iii) a representation of the mark, accompanied by an indication of the date on which, to the best knowledge of the transferor or its representative, the application was received by the Office and an identification number given to the application by the transferor or its representative.

3. Goods and/or Services Affected by the Transfer

- 3.1 Check this box where all the goods and/or services listed in the application(s) and/or registration(s) referred to in item 2 have been affected by the transfer.
- 3.2 Check this box where item 2 mentions only one application or registration and where only some of the goods and/or services listed in that application or registration have been affected by the transfer and indicate the goods and/or services that have been affected by the transfer:
- 3.3 Check this box where item 2 mentions more than one application or registration and if in respect of at least one of them the transfer has affected less than all the goods and/or services listed. In this case, indicate on an additional sheet, separately in respect of each application and/or registration, whether the transfer affected all the goods and/or services or only some of them. In respect of any application or registration where only some of the goods and/or services were affected by the transfer, make the indication in the way specified in item 3.2.

4. Transferor(s)

- 4.1 If the transferor is a natural person, the person's
- (a) family or principal name²:
- (b) given or secondary name(s)²:

² The names to be indicated under (a) and (b) are those which were indicated in the application(s), or are recorded in respect of the registration(s), to which the present certificate relates.

Form No. 5, page 3

4.2 If transferor is a legal entity, the entity's full official designation:

4.3 Address (including postal code and country):

Telephone number(s):
(with the area code)

Telefacsimile number(s):
(with the area code)

E-mail address:

4.4 Check this box if there is more than one transferor; in that case, list them on an additional sheet and indicate, in respect of each of them, the data referred to in items 4.1 or 4.2 and 4.3.

5. Transferee(s)

5.1 If the transferee is a natural person, the person's

(a) family or principal name³:

(b) given or secondary name(s)³:

5.2 If the transferee is a legal entity, the entity's full official designation:

5.3 Address (including postal code and country):

Telephone number(s):
(with the area code)

Telefacsimile number(s):
(with the area code)

E-mail address:

³ The names to be indicated under (a) and (b) are either the full names of the transferee or the names customarily used by the transferee.

Form No. 5, page 4

- 5.4 Check this box if there is more than one transferee; in that case, list them on an additional sheet and indicate, in respect of each of them, the data referred to in items 5.1 or 5.2 and 5.3.
-

6. Signatures or Seals

- 6.1 Signature(s) or seal(s) of the transferor(s)
- 6.1.1 Name(s) of the natural person(s) who sign(s) or whose seal(s) is (are) used:
- 6.1.2 Date of signature(s) or of sealing(s):
- 6.1.3 Signature(s) or seal(s):
- 6.2 Signature(s) or seal(s) of the transferee(s)
- 6.2.1 Name(s) of the natural person(s) who sign(s) or whose seal(s) is (are) used:
- 6.2.2 Date of signature(s) or of sealing(s):
- 6.2.3 Signature(s) or seal(s):
-

7. Additional Sheets and Attachments

- Check this box if additional sheets and/or attachments are enclosed and indicate the total number of such sheets and/or attachments:
-

[Annex III follows]

MODEL INTERNATIONAL FORM No. 6**TRANSFER DOCUMENT**

in respect of registration(s) and/or
application(s) for registration of mark(s)

submitted to the Office of

FOR OFFICE USE ONLY

1. Declaration of Transfer

The undersigned transferor(s) transfers (transfer) to the undersigned transferee(s) the ownership of the registration(s) and/or application(s) identified below.

2. Registration(s) and/or Application(s) Concerned

The present document concerns the transfer of the following registration(s) and/or application(s):

2.1 Registration number(s):

2.2 Application number(s)¹:

2.3 If the spaces under 2.1 or 2.2 are not sufficient, check this box and provide the information on an additional sheet.

¹ Where the application number of an application has not yet been issued or is not known to the transferor or its representative, that application may be identified by furnishing either: (i) the provisional application number, if any, given by the Office, or (ii) a copy of the application, or (iii) a representation of the mark, accompanied by an indication of the date on which, to the best knowledge of the transferor or its representative, the application was received by the Office and an identification number given to the application by the transferor or its representative.

3. Goods and/or Services Affected by the Transfer

- 3.1 Check this box where all the goods and/or services listed in the application(s) and/or registration(s) referred to in item 2 are affected by the transfer.
- 3.2 Check this box where item 2 mentions only one application or registration and where only some of the goods and/or services listed in that application or registration are affected by the transfer and indicate the goods and/or services that are affected by the transfer:
- 3.3 Check this box where item 2 mentions more than one application or registration and if in respect of at least one of them the transfer affects less than all the goods and/or services listed. In this case, indicate on an additional sheet, separately in respect of each application and/or registration, whether the transfer affects all the goods and/or services or only some of them. In respect of any application or registration where only some of the goods and/or services are affected by the transfer, make the indication in the way specified in item 3.2.

4. Transferor(s)

- 4.1 If the transferor is a natural person, the person's
- (a) family or principal name²:
- (b) given or secondary name(s)²:
-

² The names to be indicated under (a) and (b) are those which were indicated in the application(s), or are recorded in respect of the registration(s), to which the present document relates.

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4.2 If transferor is a legal entity, the entity's full official designation:

4.3 Address (including postal code and country):

Telephone number(s): Telefacsimile number(s): E-mail address:
(with the area code) (with the area code)

4.4 Check this box if there is more than one transferor; in that case, list them on an additional sheet and indicate, in respect of each of them, the data referred to in items 4.1 or 4.2 and 4.3.

5. Transferee(s)

5.1 If the transferee is a natural person, the person's

(a) family or principal name³:

(b) given or secondary name(s)³:

5.2 If the transferee is a legal entity, the entity's full official designation:

5.3 Address (including postal code and country):

Telephone number(s): Telefacsimile number(s): E-mail address:
(with the area code) (with the area code)

³ The names to be indicated under (a) and (b) are either the full names of the transferee or the names customarily used by the transferee.

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- 5.4 Check this box if there is more than one transferee; in that case, list them on an additional sheet and indicate, in respect of each of them, the data referred to in items 5.1 or 5.2 and 5.3.
-

6. Additional Indications (see the Annex to this form (attached))

(the furnishing of any of those indications is optional for the purposes of recordal of the change in ownership)

- Check this box if the Annex is used.
-

7. Signatures or Seals

7.1 Signature(s) or seal(s) of the transferor(s)

7.1.1 Name(s) of the natural person(s) who sign(s) or whose seal(s) is (are) used:

7.1.2 Date of signature(s) or of sealing(s):

7.1.3 Signature(s) or seal(s):

7.2 Signature(s) or seal(s) of the transferee(s)

7.2.1 Name(s) of the natural person(s) who sign(s) or whose seal(s) is (are) used:

7.2.2 Date of signature(s) or of sealing(s):

7.2.3 Signature(s) or seal(s):

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8. Additional Sheets, Attachments and Annex

- Check this box if additional sheets and/or attachments are enclosed and indicate the total number of such sheets and/or attachments:

 - Check this box if an Annex is enclosed and indicate the number of the pages of the Annex and the number of any additional sheets to the Annex:
-

Annex to Form No. 6

**Additional Indications Relating
to a Transfer Document (Item 6)**

A. Transfer of Goodwill or Business

- (a) Check this box where the transfer is made with the relevant goodwill or the business in respect of all the goods and/or services listed in the application(s) and/or registration(s) referred to in item 2 of the transfer document.
- (b) Check this box where item 2 of the transfer document mentions only one application or registration and where the transfer is made with the relevant goodwill or the business in respect of only some of the goods and/or services listed in that application or registration and indicate the goods and/or services in respect of which the transfer is made with the relevant goodwill or the business:
- (c) Check this box where item 2 of the transfer document mentions more than one application or registration and if in respect of at least one of them the transfer is made with the relevant goodwill or the business in respect of less than all the goods and/or services listed. In this case, indicate on an additional sheet, separately in respect of each application and/or registration, whether the transfer is made with the relevant goodwill or the business in respect of all the goods and/or services or only some of them. In respect of any application or registration where the transfer is made with the relevant goodwill or the business in respect of only some of the goods and/or services, make the indication in the way specified in item (b).

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B. Transfer of Rights Resulting from Use

The rights, arising from the use of the mark, are transferred in respect of

- (a) all registration(s) and/or application(s).
- (b) only the following registration(s) and/or application(s):

C. Transfer of the Right to Sue

The transferee shall have the right to sue for past infringements.

D. Consideration

- (a) The transfer is effected in consideration for money received.
- (b) The transfer is effected in consideration for money received and other good and valuable consideration.
- (c) The transferor hereby acknowledges receipt of the above-mentioned consideration.

E. Effective Date of the Transfer

- (a) The transfer is effective as of the date of signature of the present transfer document.
- (b) The transfer is effective as of the following date:

[End of Annex IV and of document]