

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

Fifth Session
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PROPOSAL FOR AMENDMENTS TO RULE 5 OF THE COMMON REGULATIONS UNDER THE 1999 ACT AND THE 1960 ACT OF THE HAGUE AGREEMENT

Document prepared by the International Bureau

I. BACKGROUND

DISCUSSIONS IN THE WORKING GROUP ON THE LEGAL DEVELOPMENT OF THE HAGUE SYSTEM FOR THE INTERNATIONAL REGISTRATION OF INDUSTRIAL DESIGNS (HEREINAFTER REFERRED TO AS THE “(HAGUE) WORKING GROUP” AND THE “HAGUE SYSTEM”)

1. It is recalled that Rule 5 of the Common Regulations Under the 1999 Act and the 1960 Act of the Hague Agreement (hereinafter referred to as the “(Hague) Common Regulations”) provides for a safeguard in the case of irregularities in postal and delivery services. Under that Rule, the failure to meet a time limit shall be excused if the interested party submits evidence showing, to the satisfaction of the International Bureau of the World Intellectual Property Organization (WIPO), that circumstances as described in Rule 5(1) or (2) caused that failure.
2. It is likely that in the future all communications between users and the International Bureau would take place in electronic format. In that regard, the Working Group discussed, at its second and third sessions, the failure to meet a time limit for an electronic communication addressed to the International Bureau, and a possible safeguard against non-delivery of an electronic communication in the case of non-availability of electronic communications services¹.

¹ Refer to documents H/LD/WG/2/9, H/LD/WG/3/3 and H/LD/WG/3/8.

At its third session held in Geneva from October 28 to 30, 2013, the Working Group discussed, in particular, a possible amendment to Rule 5 proposed by the Delegation of Spain. Following the discussion, the International Bureau was requested to revise the proposed amendment, taking into account comments made at that session².

DISCUSSIONS IN THE WORKING GROUP ON THE LEGAL DEVELOPMENT OF THE MADRID SYSTEM FOR THE INTERNATIONAL REGISTRATION OF MARKS

3. Since the holding of the third session of the Hague Working Group, the Working Group on the Legal Development of the Madrid System for the International Registration of Marks (hereinafter referred to as the “Madrid Working Group”) held its twelfth session in Geneva from October 20 to 24, 2014. On that occasion, it considered a proposal to amend Rule 5 of the Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement (hereinafter referred to as the “Madrid Common Regulations”), to provide for remedies where the late receipt of a communication occurs as a result of failure in electronic communications services³. Similar to Rule 5 of the Hague Common Regulations, Rule 5 of the Madrid Common Regulations provides for remedies where a time limit for a communication sent through a postal or delivery service is not met due to cases of *force majeure*, and does not contemplate failure to meet a time limit when a communication is sent through electronic means.

4. Following the discussion, the Madrid Working Group recommended that the following amendment to Rule 5 be adopted by the Madrid Union Assembly in October 2015⁴.

“Rule 5

“Irregularities in Postal and Delivery Services and in Communications Sent Electronically

[...]

“(3) [Communication Sent Electronically] Failure by an interested party to meet a time limit for a communication addressed to the International Bureau and submitted by electronic means shall be excused if the interested party submits evidence showing, to the satisfaction of the International Bureau, that the time limit was not met because of failure in the electronic communication with the International Bureau, or which affects the locality of the interested party owing to extraordinary circumstances beyond the control of the interested party, and that the communication was effected not later than five days after the electronic communication service was resumed.

“(4) [Limitation on Excuse] Failure to meet a time limit shall be excused under this Rule only if the evidence referred to in paragraph (1), ~~or (2)~~ or (3) and the communication or, where applicable, a duplicate thereof are received by the International Bureau not later than six months after the expiry of the time limit.”

² Refer to paragraph 63 of document H/LD/WG/3/8.

³ Refer to paragraphs 2 to 7 and Annex I of document MM/LD/WG/12/2.

⁴ Refer to paragraphs 14 to 42 and 391 and Annex I of document MM/LD/WG/12/7 Prov.2, and to paragraph 3 and Annex I of document MM/A/49/3.

DISCUSSIONS IN THE PATENT COOPERATION TREATY (PCT) WORKING GROUP

5. The PCT Working Group held its seventh session in Geneva from June 10 to 13, 2014, and considered a proposal to amend the PCT Regulations dealing with extending time limits or excusing delays in meeting time limits to cover non-availability of electronic communications services⁵. Specifically, the document proposed the following amendments:

(a) to extend the time limit to the following day if the electronic systems of an Office or organization for submitting a document or paying a fee were not available to users for a significant period of a day (Rule 80.5); and

(b) to add widespread and unexpected loss of access to electronic communication services as a situation where an interested party could apply to an Office for excuse of delay in meeting a time limit (Rule 82*quater*.1).

6. Rules 80.5⁶ and 82*quater*.1⁷ of the PCT Regulations are provisions that are equivalent, in their nature and respectively, to Rules 4(4) and 5 of the Hague Common Regulations. It is to be noted that, under the PCT System, not only the International Bureau but also national Offices and intergovernmental Organizations are in a position to receive various types of communications from users in different capacities such as a receiving Office, an International Searching Authority, an Authority specified for supplementary search, or an International Preliminary Examining Authority.

7. While the PCT Working Group agreed that proper protection against failure of electronic communication systems was important, the proposed amendment to Rule 80.5 was considered too prescriptive and it was felt that the matter was better left to the discretion of individual national Offices. Some delegations supported the proposed amendment to Rule 82*quater*, but others felt it lacked clarity, or else did not offer a distinct benefit over the provisions of the existing Rule⁸. In conclusion, the International Bureau invited Contracting Parties to provide information on national laws or processes which offered protection for users against the failure of electronic communication systems. Accordingly, a Circular was sent out and the International Bureau received 37 responses⁹.

⁵ Refer to document PCT/WG/7/24.

⁶ "80.5 Expiration on a Non-Working Day or Official Holiday

"If the expiration of any period during which any document or fee must reach a national Office or intergovernmental organization falls on a day:

"(i) on which such Office or organization is not open to the public for the purposes of the transaction of official business;

"(ii) on which ordinary mail is not delivered in the locality in which such Office or organization is situated;

[...]"

the period shall expire on the next subsequent day on which none of the said four circumstances exists.

⁷ "82*quater*.1 Excuse of Delay in Meeting Time Limits

"(a) Any interested party may offer evidence that a time limit fixed in the Regulations for performing an action before the receiving Office, the International Searching Authority, the Authority specified for supplementary search, the International Preliminary Examining Authority or the International Bureau was not met due to war, revolution, civil disorder, strike, natural calamity or other like reason in the locality where the interested party resides, has his place of business or is staying, and that the relevant action was taken as soon as reasonably possible.

"(b) Any such evidence shall be addressed to the Office, Authority or the International Bureau, as the case may be, not later than six months after the expiration of the time limit applicable in the given case. If such circumstances are proven to the satisfaction of the addressee, delay in meeting the time limit shall be excused.

[...]"

⁸ Refer to paragraphs 99 to 103 of document PCT/WG/7/29, and to paragraphs 306 to 319 of document PCT/WG/7/30.

⁹ Refer to Circular C. PCT 1433 of November 27, 2014, and to document PCT/WG/8/22.

8. At its eighth session held in Geneva from May 26 to 29, 2015, the International Bureau proposed to amend the PCT Regulations, having taken into account the comments made at the previous session and the responses to the Circular. Following the discussion, the PCT Working Group approved the following amendment to Rule 82*quater*.1, with a view to submitting it to the PCT Assembly in October 2015 for adoption¹⁰:

“82*quater*.1 Excuse of Delay in Meeting Time Limits

“(a) Any interested party may offer evidence that a time limit fixed in the Regulations for performing an action before the receiving Office, the International Searching Authority, the Authority specified for supplementary search, the International Preliminary Examining Authority or the International Bureau was not met due to war, revolution, civil disorder, strike, natural calamity, [a general unavailability of electronic communications services](#) or other like reason in the locality where the interested party resides, has his place of business or is staying, and that the relevant action was taken as soon as reasonably possible.”

II. ANALYSIS

EXCUSE OF DELAY IN MEETING TIME LIMITS FOR ELECTRONIC COMMUNICATIONS

9. Throughout the second and third sessions, the Hague Working Group agreed that proper protection against failure of electronic communication systems was important. In this regard and on the same understanding, both the Madrid and the PCT Working Groups concluded their discussions and agreed to submit their respective proposals to their Assemblies in October 2015, for adoption.

10. Rule 82*quater*.1 of the PCT Regulations is a general provision without reference to specific formats of communications. The proposed amendment is to add the wording “a general unavailability of electronic communications services” to its paragraph (a). This should provide clarity for this provision to apply to communications sent electronically, and greater consistency between Offices, as national Offices and intergovernmental Organizations will also apply this provision within their respective capacities. Proposed paragraph (a) reads “(a)ny interested party may offer evidence that a time limit fixed in the Regulations..... was not met due to war, revolution, civil disorder, strike, natural calamity, [a general unavailability of electronic communications services](#) or other like reason in the locality where the interested party resides, has his place of business or is staying, and that the relevant action was taken as soon as reasonably possible.” The provision is intended to apply to outages affecting a high number of users, such as all users in a large area of a city or country, rather than localized problems within a particular building. In this regard, the PCT Working Group also agreed to submit to the PCT Assembly a statement on how the proposed provision should be interpreted¹¹.

¹⁰ Refer to paragraph 148 and Annex V of document PCT/WG/8/25.

¹¹ Refer to paragraphs 22 to 25 of document PCT/WG/8/22. The text of the proposed “Understanding” is reproduced below:

“Application of Rule 82*quater*.1 with regard to a General Unavailability of Electronic Communications Services:

“In considering a request under Rule 82*quater*.1 to excuse a delay in meeting a time limit that has not been met due to a general unavailability of electronic communications services, the Office, Authority or the International Bureau, should interpret general unavailability of electronic communications to apply to outages that affect widespread geographical areas or many individuals, as distinct from localized problems associated with a particular building or single user.”

11. On the other hand, proposed new paragraph (3) of Rule 5 of the Madrid Common Regulations is to deal solely with communications sent electronically. This new provision refers to “failure in the electronic communication with the International Bureau, or which affects the locality of the interested party owing to extraordinary circumstances beyond the control of the interested party, and that the communication was effected not later than five days after the electronic communication service was resumed”. The note of this proposed provision explains that the proposed amendment would also apply to failure on account of a disruption of the Internet services in the locality of the interested party. In such a case, the party could provide the International Bureau with reliable and verifiable information of the situation, for instance, an attestation from the party’s Internet service provider indicating that the service was not available¹².

12. Under both provisions, the interested party needs to submit evidence, to the satisfaction of the International Bureau, showing that the time limit was not met because of failures in the electronic communication with the International Bureau or on account of *force majeure*. Moreover, the time limit for submitting such evidence is six months – the same as under Rule 5(3) of the Hague Common Regulations as it currently stands.

EXTENSION OF A TIME LIMIT DUE TO NON-AVAILABILITY OF ELECTRONIC COMMUNICATION SYSTEMS OF THE INTERNATIONAL BUREAU

13. The Summary of the Chair and Report of the third session of the Hague Working Group indicate that “the Chair noted that the International Bureau was requested to revise the wording and scope of proposed Rule 5(4) taking into account comments made at the session of the Working Group in process, notably in the event that the server of the International Bureau was down”¹³. As regards the latter point, the Secretariat clarified that, if the electronic communication facility on the WIPO website was not available, for instance, due to a problem with the server of the International Bureau, such a circumstance would be tantamount to a situation in which the International Bureau was not open to the public as referred to in Rule 4(4). The Republic of Korea, supported by the Centre for International Intellectual Property Studies (CEIPI), indicated that it would be necessary to have a clear provision to that effect¹⁴.

14. Rule 4(4) of the Hague Common Regulations deals with “Expiry on a Day on Which the International Bureau or an Office is Not Open to the Public”. An Office here should refer both to the Office of a designated Contracting Party and to the Office of the applicant’s Contracting Party. Its corresponding provisions are Rule 4(4) [Expiry on a Day on Which the International Bureau or an Office is Not Open to the Public] of the Madrid Common Regulations and Rule 80.5 [Expiration on a Non-Working Day or Official Holiday] of the PCT Regulations. Not only the International Bureau but also, under the Madrid System, the Office of origin and the Office of a designated Contracting Party are concerned by the former provision, while Offices in various capacities, such as the receiving Office, the International Searching Authority, the Authority specified for supplementary search and the International Preliminary Examining Authority, are widely concerned by the latter provision under the PCT.

15. As described in paragraphs 5 and 7, above, in the PCT Working Group, there was an attempt to amend Rule 80.5, but no consensus was reached at its seventh session. From responses to the PCT Circular mentioned in paragraph 7, the Secretariat of the PCT Working Group summarizes that, while most Offices agreed that it should be possible for an Office to extend all time limits expiring on a day when there is a significant outage period in the Office’s electronic communication systems for receiving documents, Offices did not agree on providing

¹² Refer to paragraphs 6 of document MM/LD/WG/12/2

¹³ Refer to paragraph 63 of document H/LD/WG/3/8.

¹⁴ Refer to paragraphs 54 and 55 of document H/LD/WG/3/8.

for an automatic time extension in the PCT Regulations when the length of the outage period exceeded a specified threshold at a particular time in the day. Instead, there was a preference for any decision on whether to extend all time limits expiring on a particular day in relation to international applications to be taken by the Office affected by the problem. Furthermore, Offices already have the possibility under present Rule 80(5)(i) to declare themselves as not open for business on a particular day and extend all time limits expiring on that day. In addition, any delays that are excused for national applications must also be excused for international applications filed under the PCT where the same reasons apply. Therefore, the Secretariat concluded that those provisions appear adequate to allow Offices to extend all time limits expiring on a day when there is a significant disruption to the Office's electronic communication systems. There would, therefore, be no need to amend Rule 80 on the computation of time limits¹⁵. Consequently, the above analyses and views were affirmed by the PCT Working Group at its eighth session held in May 2015.

16. On the other hand, there was no attempt to amend Rule 4(4) of the Madrid Common Regulations in recent discussions in the Madrid Working Group. Instead, proposed Rule 5(3) refers specifically to "failure in the electronic communication with the International Bureau". Although Rule 5 requires the submission of evidence to the satisfaction of the International Bureau, the latter should find itself in the best position to grasp the situation in that particular case. Moreover, as described in paragraph 15, above, and as envisaged under the PCT, the International Bureau may be justified to declare itself as not open for business on a particular day under present Rule 4(4) and extend all time limits expiring on that day in the event of a significant outage period in its electronic communications systems.

17. The foregoing considerations should also apply to the Hague System. In the view of the International Bureau therefore, it would be appropriate to follow the decision or approach taken by the PCT and the Madrid Working Groups. Moreover, it is believed that, in the operation of the PCT, Madrid and Hague Systems, it would rather be desirable for the Bureau to apply a similar threshold when considering the situation and the outage period of electronic communication systems, in order to make a decision on whether to declare itself as not open for business on a particular day. Such a decision should be made on an individual case basis, and may also be different for each of the various electronic communications services provided by the International Bureau, as it is envisaged that only one or few of the electronic communication systems may become unavailable. Nevertheless, some flexibility would allow the International Bureau to better safeguard the interests of the users of the PCT, Madrid and Hague Systems. Consequently, there would be no need to amend Rule 4(4) of the Hague Common Regulations either.

18. If the International Bureau were faced with a situation where it needed to declare itself as not open for business on a particular day, it should put out an announcement to that effect on the WIPO website without delay pursuant to Rule 26(2). Also, once the electronic communication service became available again, a statement to that effect would be published on the website.

III. PROPOSAL

19. It is planned that the Hague Portfolio Manager (hereinafter referred to as the "HPM"), available on the WIPO website, will allow an applicant to reply, through its interface, to an irregularity notice issued by the International Bureau against an international application containing irregularities. The HPM would then extend its service to other types of requests, such as the recording of a change in ownership or of a change in the name or address of the

¹⁵ Refer to paragraphs 20 and 21 of document PCT/WG/8/22.

holder, to cover the whole lifespan of the international registration. More and more communications will therefore be exchanged in electronic format in the near future. For example, in 2014 and so far in 2015, usage of the E-renewal interface has been around 70 per cent.

20. In view of the above, and taking into account the recent discussions in the Hague Working Group, as well as the recent developments observed both in the PCT and the Madrid Working Groups, it is proposed to amend Rule 5 of the Hague Common Regulations in the same context. Given the similarity in the structure of the provision, as in the case with the proposed amendment to Rule 5 of the Madrid Common Regulations, proposed new paragraph (3) of Rule 5 will deal solely with communications sent electronically.

21. The wording of new paragraph (3) is taken from proposed paragraph (3) of Rule 5 of the Madrid Common Regulations. Under this new provision, failure by an interested party to meet the time limit for a communication addressed to the International Bureau and submitted by electronic means would be excused where the interested party submits satisfactory evidence showing that the time limit was not met because of a failure in the electronic communication with the International Bureau or a failure that affects the locality of the interested party due to extraordinary circumstances. As described in paragraph 10, above, in the context of the latter condition, this provision should apply to outages affecting a high number of users, such as all users in a large area of a city or country, rather than localized problems within a particular building. There should be no reason to interpret differently the three proposed provisions in the PCT, Madrid and Hague Regulations in this respect. Thus, the party concerned should provide the International Bureau with reliable and verifiable information on the situation, such as an attestation from the party's Internet service provider indicating that the service was not available during the period in question.

22. This new provision will also require the party concerned to resend the communication shortly after the electronic communication service was resumed. The proposed amendment contains the words "not later than five days after the electronic communication service was resumed", following the proposed amendment to Rule 5 of the Madrid Common Regulations, and along with the foregoing two paragraphs dealing with communications sent through a postal or delivery service. Nevertheless, a shorter time limit may be established, if it is the Working Group's opinion that this is warranted by factors peculiar to electronic communications.

23. Consequential amendments are also proposed for present paragraph (3), which will be renumbered as paragraph (4). The time limit for submitting the evidence, together with the missing communication, if the latter has not been resent, would remain six months – the same for communications sent through a postal or delivery service, following the proposed amendment to Rule 5 of the Madrid Common Regulations. Here again, a shorter time limit may be established, if, in the view of the Working Group, it is warranted by factors peculiar to electronic communications.

24. Furthermore, it is proposed to amend the title of Rule 5 in order to clarify the purpose of the provision.

25. It is also to be made clear that a possible application of Rule 4(4) by the International Bureau on account of emergency or unavailability of its electronic communications services and a possible exercise of Rule 5 on the part of the interested party in a similar circumstance are not mutually exclusive.

26. *The Working Group is invited to:*

(i) consider the proposal made in this document and comment on it; and

(ii) indicate whether it would recommend to the Assembly of the Hague Union to adopt the proposed amendments to the Common Regulations with respect to Rule 5, as provided in the draft contained in the Annex hereto, with a date of entry into force of January 1, 2017.

[Annex follows]

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

(as in force on [January 1, 2017])

Rule 5

~~*Irregularities in Postal and Delivery Services*~~ *Excuse of Delay in Meeting Time Limits*
[...]

(3) [Communication Sent Electronically] Failure by an interested party to meet a time limit for a communication addressed to the International Bureau and submitted by electronic means shall be excused if the interested party submits evidence showing, to the satisfaction of the International Bureau, that the time limit was not met because of failure in the electronic communication with the International Bureau, or which affects the locality of the interested party owing to extraordinary circumstances beyond the control of the interested party, and that the communication was effected not later than five days after the electronic communication service was resumed.

~~(34)~~ [Limitation on Excuse] Failure to meet a time limit shall be excused under this Rule only if the evidence referred to in paragraph (1), ~~or~~ (2) or (3) and the communication or, where applicable, a duplicate thereof are received by the International Bureau not later than six months after the expiry of the time limit.

[End of Annex and of document]