

WIPO



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WORLD INTELLECTUAL PROPERTY ORGANIZATION

GENEVA

WORKINGGROUPONTHE ESTABLISHMENTOFNE W REGULATIONSONDERTHE HAGUEAGREEMENT CONCERNINGTHEINTERNATIONALREGISTRATIONOF INDUSTRIALDESIGNS

Geneva,June24to27,2003

NOTESCONCERNINGTHE ADMINISTRATIVEINSTRUCTIONSFOR THE
APPLICATIONOF THE HAGUEAGREEMENT CONCERNINGTHE
INTERNATIONALREGISTRATIONOF INDUSTRIAL DESIGNS

DocumentpreparedbytheInternationalBureau

1. UnderRule33oftheproposedCommonRegulations(whichcorrespondstoRule31of theRegulationsunderthe1999ActandRule31oftheRegulationsunderthe1960andthe 1934Acts),AdministrativeInstructionsareestablishedbytheDirectorGeneralafter consulting theOfficesdirectlyinterested.TheNotescontainedinthisdocumentwere preparedfordiscussionswithintheworkinggroupofthesedraftAdministrativeInstructions forthepurposeofsuchconsultation.
2. Itshouldbenotedthatwhereaprovisiondoesnotrequireexplanation,nonotehasbeen provided.

Notes on Part Two

02.01 Part Two implements Rule 2 of the proposed Common Regulations which requires that communications with the International Bureau shall be effected "as specified in the Administrative Instructions".

02.02 Most of the provisions under this Part are modelled on the Administrative Instructions under the Madrid system concerning the international registration of marks, which have been established very recently by the Director General, following consultation with the Offices concerned (with effect as from April 1, 2002).

02.03 Section 201(a) provides for the general requirement to address all communications to the International Bureau in writing, no hand-written, and signed. It is modelled on Section 6 of the Administrative Instructions under the Madrid system.

02.04 Section 202 deals with signature and follows Section 7 of the Administrative Instructions under the Madrid system.

02.05 Section 203 concerns telefacsimile communications. It results from Section 203(a) that any communication may be addressed to the International Bureau by fax, with the exception of international applications containing a reproduction to be published in colour. (Such exclusion is due to the fact that telefacsimile communications do not allow the identification of colours, so that reproductions in colour should not be effective as from the date of their receipt by fax).

02.06 Section 203(b). As regards international applications containing only reproductions to be published in black and white, and addressed to the International Bureau by fax, such applications could only be effective as from the date of their receipt by fax if the original of the international application form, along with the original of the reproductions and/or specimens concerned, are received by the International Bureau prior to the expiration of twenty days counted from the date of receipt of the telefacsimile communication. This requirement is the same as that provided for in Section 106(c) of the existing Administrative Instructions under the Hague Agreement.

02.07 Section 203(c) requires the International Bureau to acknowledge receipt of international applications sent by fax. It is modelled on Section 10(a) of the Administrative Instructions under the Madrid system.

02.08 It is to be noted that, except for international applications, any other communications (such as responses to irregularity notices or requests for the recording of changes in ownership, limitations, refusal of protection, etc) may be addressed to the International Bureau by fax *without the need for applicants, holders and/or Offices to send subsequently the original of that communication to the International Bureau*.

02.09 Section 204(a) provides for the principle of electronic communication with the International Bureau. Considering that the date of implementation of the international procedure under the Common Regulations is still unknown at this stage, and given the rapidity with which electronic technology develops, the conditions and modalities for such mode of communications have not been determined in the Administrative Instructions themselves. It is considered more appropriate to provide that the relevant particulars of the manner and/or format of electronic communications (which are currently under study by the International Bureau) be published in the Bulletin. Such publication would also specify the date from which electronic communications will be effective.

02.10 Under Rule 26(3) of the proposed Common Regulations, the date on which each issue of the Bulletin is published on WIPO's website must be "electronically communicated" by the International Bureau to the Office of each Contracting Party. For the purpose of receiving such information from the International Bureau, Section 204(d) provides that each Office shall indicate an email address to the International Bureau (see also, in document H/WG/3, Notes 26.01 to 26.06 relating to Rule 26(3)).

Notes on Part Three

03.01 Section 301 implements Rules 7(3)(i) and (ii), 7(5)(b), 11(1) and 21(2)(iii) of the proposed Common Regulations in accordance with which the name and address of, respectively, the applicant, the representative, the creator of the industrial designs and the new owner, must "be given in accordance with the Administrative Instructions". The wording of Section 301 is modelled on Section 12 of the Administrative Instructions under the Madrid system.

03.02 Section 302 provides for the requirement to indicate an address for correspondence in the case of an international application jointly owned by several applicants (this prescription aims at avoiding the sending by the International Bureau of various communications and notifications to *each* co-applicant indicated in an international application). That provision is modelled on Section 13 of the Administrative Instructions under the Madrid system.

Notes on Part Four

04.01 The implementation of the international procedure under the proposed Common Regulations requires that a number of Administrative Instructions be established in order to specify the conditions concerning the presentation of the reproductions of the industrial designs included in an international application.

04.02 The vast majority of the provisions under this Part are taken from the existing Administrative Instructions under the Hague Agreement, as those latter provisions are operating to the satisfaction of users.

04.03 Section 401(a) specifies the possible types of reproductions which may be included in an international application (photographs and/or graphic representation). It follows Section 401(a) of the current Administrative Instructions under the Hague Agreement. n

04.04 As required by Rule 9(1)(b) of the proposed Common Regulations, Section 401(b) specifies the number of copies which shall be submitted to the International Bureau for each reproduction filed (only one).

04.05 Section 401(c) provides for the mode of presentation of the reproductions (either pasted or printed directly onto a separate sheet of A4 paper which is white and opaque), as well as the maximum number of reproductions (25) which may be included in this separate sheet. It is modelled on Section 401(b) of the current Administrative Instructions under the Hague Agreement.

04.06 Section 401(d) and (e) concern the arrangement of reproductions and are modelled on Section 401(c) and (d) of the current Administrative Instructions under the Hague Agreement.

04.07 Section 402 deals with the contents of reproductions (subparagraphs (a) and (c)) and the dimensions of the design appearing in such reproductions (subparagraph (b)). It is modelled on Section 403 of the current Administrative Instructions under the Hague Agreement.

04.08 Section 403 implements Rule 9(2)(b) of the proposed Common Regulations which provides that “matter which is shown in a reproduction but for which protection is not sought may be indicated as provided for in the Administrative Instructions”. As agreed in the course of the Diplomatic Conference¹, such disclosures could be indicated, at the applicant’s option, either in the description (i.e., by words) or by means of dotted or broken lines in a reproduction.

04.09 Section 404 reiterates the substance of Sections 404 and 405 of the existing Administrative Instructions under the Hague Agreement concerning the requirements for photographs and graphic representations.

04.10 Section 405 provides for the numbering system for reproductions and is modelled on Section 402 of the current Administrative Instructions under the Hague Agreement.

04.11 Section 406 specifies the maximum dimensions and weight, along with the presentation of specimens which may accompany an international application.

04.12 Section 407 continues the existing provision of the Administrative Instructions under the Hague Agreement (Section 406) concerning the description of characteristic features.

¹ See document H/DC/6, Note R09.05.

Notes on Part Five

05.01 It was indicated in the course of the Diplomatic Conference that “the Administrative Instructions will deal with the question of notifications of refusal which are sent before the expiry of the relevant period but received by the International Bureau after the expiry of that period; provision could be made along the lines of Rule 18(1)(a)(iii) of the Common Regulations under the Madrid Agreement and Protocol”². As envisaged, Section 501 is mirrored on that provision under the Madrid system (which has, since then, been transferred to the Administrative Instructions under the Madrid system (Section 14)).

05.03 Section 502 implements Rule 18(3) of the proposed Common Regulations which requires the Administrative Instructions to specify, where an international registration is divided before the Office of a designated Contracting Party in order to overcome a ground of refusal based on lack of unity of design, the data which must be notified by that Office to the International Bureau concerning the division. Items (i) to (iv) of Section 503 list the data which are considered to be the most relevant for third parties.

Notes on Part Six

06.01 It results from Article 5(1)(iii) of the 1999 Act and Rule 12(2) of the proposed Common Regulations that, where deferment of publication has been requested, the reproduction of (two-dimensional) industrial designs may be provisionally replaced by specimens, and the publication fee “may be paid later”. Under Rule 16(3), the publication fee shall be paid, and the prescribed reproductions shall be submitted, *before* the applicable period of deferment expires or is considered to have expired.

06.02 In order to enable the International Bureau to proceed with the formalities of publication in due time (i.e., not later than the date on which the period for deferment of publication expires), it is necessary to further specify the period by which the payment of the publication fee and submission of reproductions must reach the International Bureau. To that end, it is proposed in Section 601 that the payment of the publication fee and submission of reproductions should be made not later than *three months* before the expiry of the deferment period.

06.03 Furthermore, for the convenience of users and pursuant to the commitments of the International Bureau made in the course of the Diplomatic Conference³, the second sentence of Section 601 requires the International Bureau to send to the holder concerned, six months before the period for deferment expires, an unofficial reminder notice concerning the payment of the publication fee and the furnishing of reproductions.

² See document H/DC/6, Note R19.01.

³ See document H/DC/6, Note R15.02.

Notes on Part Seven

07.01 Rule 23 of the proposed Common Regulations, dealing with renewals, provides that “six months before the expiration of a five -year term, the International Bureau shall send to the holder and their representative, if any, a notice indicating the date of expiration of the international registration”.

07.02 Section 701 provides that these unofficial notices of expiry shall contain also an indication of the Contracting Parties for which, at the date of the notice, renewal of the international registration is possible. This information would be supplied by the International Bureau in accordance with the maximum duration of protection provided for by the domestic law of the Contracting Parties concerned, which must be notified to the Director General by each Contracting Party pursuant to Article 17(3)(c) of the 1999 Act and Rule 35(2) of the proposed Common Regulations. This is intended to be of assistance to users by reducing the risk of error and allowing the holder to determine accurately the amount of fees due on renewal.

Notes on Part Eight

08.01 Section 801 implements Rule 27(3) of the proposed Common Regulations which requires that “fees shall be paid to the International Bureau in accordance with the Administrative Instructions”. It is modelled on Section 19 of the Administrative Instructions under the Madrid system.

3. *The Working Group is invited to comment on the contents of this document.*

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