

Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications

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RELATIONSHIP BETWEEN THE HAGUE SYSTEM FOR THE INTERNATIONAL REGISTRATION OF INDUSTRIAL DESIGNS AND THE DRAFT DESIGN LAW TREATY

Document prepared by the Secretariat

INTRODUCTION

1. At its twenty-eighth session, held in Geneva from December 10 to 14, 2012, the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (hereinafter referred to as “the Standing Committee” or “the SCT”) requested the Secretariat to prepare a document describing the relationship between the Hague System for the International Registration of Industrial Designs (hereinafter “the Hague system”) and the draft Design Law Treaty (hereinafter “the draft DLT”).
2. Pursuant to that request, the Secretariat has prepared the present document, which is divided into two chapters. Chapter I provides a general overview of the nature and objectives of the draft DLT and the Hague system. Chapter II describes the relationship between the draft DLT and the Hague Agreement.

I. NATURE AND OBJECTIVES OF THE DRAFT DLT AND THE HAGUE SYSTEM

The Draft DLT

3. The draft DLT is a potential new international treaty on industrial design formalities and procedures. It is accompanied by draft Regulations (hereinafter “the Regulations”).

4. As it is well known, designers seeking industrial design protection must meet formality requirements and follow certain procedures. Those requirements and procedures are often complex and vary from one jurisdiction to another. The aim of the draft DLT is to establish a dynamic and predictable legal framework for the simplification and harmonization of industrial design formalities and procedures set by national/regional offices. The draft DLT does not create a single set of standard requirements, but rather a maximum set of requirements to be applied by the Offices of Contracting Parties.
5. The draft DLT provides, in particular:
- (i) A maximum set of requirements for applications for registration or grant of protection of industrial designs, as well as for requests for recording of licenses and changes;
 - (ii) A maximum list of filing-date requirements;
 - (iii) A grace period for filing further to a disclosure of the industrial design;
 - (iv) A mechanism of amendment or division of an application that includes two or more industrial designs;
 - (v) Mechanisms to avoid the unintentional loss of rights as a result of failure to comply with time limits.
6. The draft DLT does not contain a definition of “industrial design” and does not harmonize aspects of substantive design law.

The Hague System

7. The Hague system is constituted by the Hague Agreement Concerning the International Registration of Industrial Designs (hereinafter “the Hague Agreement”), an international treaty administered by the International Bureau of the World Intellectual Property Organization (WIPO). At present, there are 60 Contracting Parties to the Hague Agreement, which are listed in the Annex of the present document.
8. The Hague Agreement consists of three independent Acts, *i.e.*, the London (1934) Act, the Hague (1960) Act and the Geneva (1999) Act. Given the freezing of the application of the 1934 Act¹ and the significant decrease of the registration activity under the 1960 Act², the present document will focus only on the 1999 Act (also referred to as “the Geneva Act”) and on the Common Regulations Under the 1999 Act and the 1960 Act of the Hague Agreement (hereinafter “the Common Regulations”).
9. The Geneva Act provides a centralized and standard mechanism for the registration of industrial designs in several countries and/or intergovernmental organizations, which are members of the Geneva Act (hereinafter “the Contracting Parties”). This mechanism offers applicants the possibility of obtaining protection for their industrial design(s) in the Contracting Parties of their choice, by filing a single international application with the International Bureau of WIPO, complying with one set of formalities, in one language, with one set of fees, to be paid in one currency (Swiss francs). The Geneva Act also allows for the recording in a centralized register, the International Register, of renewal and of subsequent changes affecting an international application or registration, such as a change in ownership, through a single procedure with the International Bureau.
10. In essence, the main features of the registration process under the Geneva Act may be summarized as follows. An applicant files an international application in which he/she designates the Contracting Parties where protection is sought. The international application is filed generally directly with the International Bureau, which is responsible for carrying out a

¹ Since January 1, 2010. See document H/A/28/3.

² See documents H/LD/WG/1/4 and H/LD/WG/2/5.

formal examination to verify that the application complies with all the prescribed formal requirements. If this is the case, the International Bureau registers the application as an international registration in the International Register and publishes the registration in the *International Designs Bulletin*. This publication takes place electronically on the WIPO web site and serves as notification to the designated Contracting Parties. As of its date of registration, any international registration has the same effect in each designated Contracting Party as a regularly-filed application for the grant of protection of the industrial design under the law of that Contracting Party³. It is for each Office to grant or refuse protection to the industrial design(s) contained in the international registration, following a substantive examination, if any, according to its domestic law. Any refusal of protection must be notified to the International Bureau within six or 12 months from the publication of the international registration. If protection is not refused in a designated Contracting Party, or if a refusal is withdrawn, the international registration has the same effect as a grant of protection, under the law of that Contracting Party. An international registration is registered for an initial period of five years and may be renewed for at least two additional five-year terms.

11. The Geneva Act does not contain a definition of “industrial design” and does not aim at harmonizing the industrial design law of Contracting Parties. However, taking into account the mandatory character of some provisions of the Hague Agreement, such as the term of protection, Contracting Parties wishing to accede to, or ratify, the Agreement may need to modify their laws. There follows that the Hague Agreement may have a harmonization effect in the laws of the Contracting Parties to that Agreement.

II. RELATIONSHIP BETWEEN THE DRAFT DLT AND THE HAGUE AGREEMENT

Requirements under the draft DLT are independent from requirements established under the Hague Agreement

12. While the draft DLT and the Hague Agreement seek different purposes, as explained in the preceding chapter, both instruments establish requirements concerning the contents of an application⁴ and the contents of a request for recording certain changes. Such requirements are established under each instrument in an independent manner. This means that, in establishing requirements, the draft DLT does not refer to the provisions under the Hague Agreement. Thus, the requirements under the draft DLT are not always in line with those under the Hague Agreement⁵. Moreover, any change to the requirements under the Hague Agreement does not affect those under the draft DLT.

13. This approach can be explained by the fact that the requirements under the draft DLT were established as a result of a process that identified areas of convergence and common trends among members of the SCT (see documents SCT/21/4, 22/6 and 23/5), not all of which are members of the Hague Agreement.

14. A similar approach is followed by the Trademark Law Treaty (TLT) and the Singapore Treaty on the Law of Trademarks (STLT), where requirements concerning the contents of an application and of requests for recording certain changes are established independently from corresponding requirements under the Madrid Agreement Concerning the International Registration of Marks and the Protocol relating thereto.

³ Article 14(1) of the Geneva Act.

⁴ Under the draft DLT, requirements are established in respect of national/regional applications in the Contracting Parties; under the Hague Agreement, requirements are established in respect of an “international application” filed generally with the International Bureau of WIPO.

⁵ In practice, there are few differences in the requirements concerning the contents of an application and the contents of a request for recording certain changes under the DLT and the Hague Agreement (Geneva Act).

15. By contrast, the Patent Law Treaty (PLT) refers to the provisions of the Patent Cooperation Treaty (PCT) as regards the requirements concerning the form or contents of an application and the contents of a request, among others, so that these requirements under the PLT are fully in line with those under the PCT. Moreover, any revision, amendment or modification of the PCT, which is consistent with the articles of the PLT, applies for the purposes of the PLT and the Regulations, if the PLT Assembly so decides by a majority of three-fourths of the votes cast (Article 16 of the PLT).

16. The above relationship between the PLT and the PCT can be explained by the fact that membership to the PCT was very high at the time of adopting the PLT. Since the PCT already provided standardized formal requirements for international patent applications and since these standards were already applied by more than 100 members of the PCT, it was decided to adopt in the PLT the provisions of the PCT and its Regulations, as well as of its Administrative Instructions, wherever appropriate, to avoid creating new or different standards⁶.

No formal link between the draft DLT and the Hague Agreement

17. There is no formal link between the draft DLT and the Hague Agreement. It is to be noted, in particular, that a State or intergovernmental organization complying with the conditions under Article 25 of the draft DLT would not need to accede to, or ratify, any of the Acts of the Hague Agreement, in order to accede to, or ratify, the DLT. Similarly, any State or, under the Geneva Act, any intergovernmental organization which complies with the conditions under the relevant Act of the Hague Agreement to be a Contracting Party will continue to be able to accede to, or ratify, the relevant Act of the Hague Agreement, without acceding to, or ratifying, the DLT.

18. Moreover, the draft DLT and the Hague Agreement do not impose upon their respective Contracting Parties any of the obligations established under the other treaty. For instance, Contracting Parties to the DLT that are not Contracting Parties to the Geneva Act would not be obliged to give effect to international applications filed under the Geneva Act or international registrations registered under that Act. Likewise, Contracting Parties to the Geneva Act that are not Contracting Parties to the DLT would not be obliged by the provisions of the DLT.

III. CONCLUSION

19. This document first gives an overview of the main features of the draft DLT and the Hague Agreement. It is recalled that both the draft DLT and the Hague Agreement deal with industrial design formalities and procedures. However, while the draft DLT aims at simplifying and harmonizing industrial design formalities and procedures set by national/regional offices, so as to reduce discrepancies among future Contracting Parties, the Hague Agreement establishes a centralized and standard registration mechanism for industrial designs at the international level.

20. The document then goes on to describe the relationship between the draft DLT and the Hague Agreement. While both instruments establish requirements concerning the contents of an application and the contents of a request for recording certain changes, they do so in an independent manner. Thus, requirements under one instrument may be different from those under the other instrument. Moreover, changes in the requirements under one instrument do not affect the requirements under the other.

⁶ See WIPO publication No. L450PLT, "What is the PLT?"

21. Chapter II further explains that there is no formal link between the draft DLT and the Hague Agreement, so that no obligation under any of the Acts of the Hague Agreement would be imposed upon Contracting Parties to the DLT, and *vice versa*.

22. In conclusion, although both the Hague Agreement and the DLT, if adopted, would be WIPO treaties in the area of industrial design formalities and procedures, there is no formal or direct link between them. The Hague Agreement and the DLT would pursue different goals, would be fully autonomous and independent from each other, and neither would prevail over the other.

23. The SCT is invited to consider the present document.

[Annex follows]

7. Hague Agreement Concerning the International Registration of Industrial Designs¹

Hague Agreement (1925), revised at London (1934) and at The Hague (1960)² (supplemented by the Additional Act of Monaco (1961)),³ the Complementary Act of Stockholm (1967) and the Protocol of Geneva (1975),⁴ and amended in 1979), and the Geneva Act (1999) (Hague Union)

Status on January 15, 2013

State/IGO	Date on which State/IGO became party to the Agreement	Date on which State became party to the London Act	Date on which State became party to the Hague Act ²	Date on which State became party to the Complementary Act of Stockholm	Date on which State/IGO became party to the Geneva Act
African Intellectual Property Organization (OAPI)	September 16, 2008	–	–	–	September 16, 2008
Albania	March 19, 2007	–	March 19, 2007	March 19, 2007	May 19, 2007
Armenia	July 13, 2007	–	–	–	July 13, 2007
Azerbaijan	December 8, 2010	–	–	–	December 8, 2010
Belgium ⁵	April 1, 1979	–	August 1, 1984	May 28, 1979	–
Belize	July 12, 2003	–	July 12, 2003	July 12, 2003	–
Benin	November 2, 1986	November 2, 1986	November 2, 1986	January 2, 1987	–
Bosnia and Herzegovina	December 24, 2008	–	–	–	December 24, 2008
Botswana	December 5, 2006	–	–	–	December 5, 2006
Bulgaria	December 11, 1996	–	December 11, 1996	December 11, 1996	October 7, 2008
Côte d'Ivoire	May 30, 1993	May 30, 1993	May 30, 1993	May 30, 1993	–
Croatia	February 12, 2004	–	February 12, 2004	February 12, 2004	April 12, 2004
Democratic People's Republic of Korea	May 27, 1992	–	May 27, 1992	May 27, 1992	–
Denmark	December 9, 2008	–	–	–	December 9, 2008 ⁶
Egypt	July 1, 1952	July 1, 1952	–	–	August 27, 2004
Estonia	December 23, 2003	–	–	–	December 23, 2003
European Union	January 1, 2008	–	–	–	January 1, 2008
Finland	May 1, 2011	–	–	–	May 1, 2011
France ⁷	October 20, 1930	June 25, 1939 ⁸	August 1, 1984	September 27, 1975	March 18, 2007
Gabon	August 18, 2003	–	August 18, 2003	August 18, 2003	–
Georgia	August 1, 2003	–	August 1, 2003	August 1, 2003	December 23, 2003
Germany	June 1, 1928	June 13, 1939 ⁹	August 1, 1984	September 27, 1975	February 13, 2010
Ghana	September 16, 2008	–	–	–	September 16, 2008
Greece	April 18, 1997	–	April 18, 1997	April 18, 1997	–
Hungary ¹⁰	April 7, 1984	–	August 1, 1984	April 7, 1984	May 1, 2004
Iceland	December 23, 2003	–	–	–	December 23, 2003
Italy	June 13, 1987	–	June 13, 1987	August 13, 1987	–
Kyrgyzstan	March 17, 2003	–	March 17, 2003	March 17, 2003	December 23, 2003
Latvia	July 26, 2005	–	–	–	July 26, 2005
Liechtenstein	July 14, 1933	January 28, 1951 ¹¹	August 1, 1984	September 27, 1975	December 23, 2003
Lithuania	September 26, 2008	–	–	–	September 26, 2008
Luxembourg ⁵	April 1, 1979	–	August 1, 1984	May 28, 1979	–
Mali	September 7, 2006	–	September 7, 2006	September 7, 2006	–
Monaco	April 29, 1956	April 29, 1956 ¹²	August 1, 1984	September 27, 1975	June 9, 2011
Mongolia	April 12, 1997	–	April 12, 1997	April 12, 1997	January 19, 2008
Montenegro	June 3, 2006	–	June 3, 2006	June 3, 2006	March 5, 2012
Morocco	October 20, 1930	January 21, 1941 ¹³	October 13, 1999	October 13, 1999	–
Namibia	June 30, 2004	–	–	–	June 30, 2004
Netherlands ⁵	April 1, 1979	–	August 1, 1984 ¹⁴	May 28, 1979 ¹⁴	–
Niger	September 20, 2004	–	September 20, 2004	September 20, 2004	–
Norway	June 17, 2010	–	–	–	June 17, 2010
Oman	March 4, 2009	–	–	–	March 4, 2009
Poland	July 2, 2009	–	–	–	July 2, 2009
Republic of Moldova	March 14, 1994	–	March 14, 1994	March 14, 1994	December 23, 2003
Romania	July 18, 1992	–	July 18, 1992	July 18, 1992	December 23, 2003
Rwanda	August 31, 2011	–	–	–	August 31, 2011
Sao Tome and Principe	December 8, 2008	–	–	–	December 8, 2008
Senegal	June 30, 1984	June 30, 1984	August 1, 1984	June 30, 1984	–
Serbia ¹⁵	December 30, 1993	–	December 30, 1993	December 30, 1993	December 9, 2009
Singapore	April 17, 2005	–	–	–	April 17, 2005

- 20 -

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(Hague Union)

State/IGO	Date on which State/IGO became party to the Agreement	Date on which State became party to the London Act	Date on which State became party to the Hague Act ²	Date on which State became party to the Complementary Act of Stockholm	Date on which State/IGO became party to the Geneva Act
Slovenia.....	January 13, 1995	–	January 13, 1995	January 13, 1995	December 23, 2003
Spain.....	June 1, 1928	March 2, 1956 ¹⁶	–	–	December 23, 2003
Suriname.....	November 25, 1975	November 25, 1975	August 1, 1984	February 23, 1977	–
Switzerland.....	June 1, 1928	–	August 1, 1984	September 27, 1975	December 23, 2003
Syrian Arab Republic.....	May 7, 2008	–	–	–	May 7, 2008
Tajikistan.....	March 21, 2012	–	–	–	March 21, 2012
The former Yugoslav Republic of Macedonia.....	March 18, 1997	–	March 18, 1997	March 18, 1997	March 22, 2006
Tunisia.....	October 20, 1930	October 4, 1942 ¹⁷	–	–	June 13, 2012
Turkey.....	January 1, 2005	–	–	–	January 1, 2005
Ukraine.....	August 28, 2002	–	August 28, 2002	August 28, 2002	December 23, 2003
(Total: 60)	(60)	(12)	(34)	(34)	(45)

¹ The Geneva (1999) Act of the Hague Agreement Concerning the International Registration of Industrial Designs was adopted on July 2, 1999. The Geneva Act entered into force on December 23, 2003.

² The Protocol to the Hague Act (1960) is not yet in force. It has been ratified by or acceded to by the following States: Belgium, France, Germany, Italy, Liechtenstein, Monaco, Morocco, Netherlands and Switzerland.

³ The Additional Act of Monaco (1961) is in force in respect of the following States as from the dates indicated: France (December 1, 1962), Germany (December 1, 1962), Liechtenstein (July 9, 1966), Spain (August 31, 1969) and Monaco (September 14, 1963).

⁴ The Protocol of Geneva (1975), in accordance with Article 11(2)(a) thereof, ceased to have effect as of August 1, 1984; however, as provided by Article 11(2)(b), States bound by the Protocol (Belgium (as from April 1, 1979), France (as from February 18, 1980), Germany (as from December 26, 1981), Hungary (as from April 7, 1984), Liechtenstein (as from April 1, 1979), Luxembourg (as from April 1, 1979), Monaco (as from March 5, 1981), Netherlands (as from April 1, 1979), Senegal (as from June 30, 1984), Suriname (as from April 1, 1979) and Switzerland (as from April 1, 1979)) are not relieved of their obligations thereunder in respect of industrial designs whose date of international deposit is prior to August 1, 1984.

⁵ The territories in Europe of Belgium, Luxembourg and the Netherlands are, for the application of the Hague Agreement, to be deemed a single country.

⁶ Not applicable to the Faroe Islands but applicable to Greenland as of January 11, 2011.

⁷ Including all Overseas Departments and Territories.

⁸ France has notified acceptance of the termination of the London Act (1934), on September 20, 2010. The termination of the London Act will become effective three months after the Director General of WIPO receives the last required notification of acceptance.

⁹ Germany has notified acceptance of the termination of the London Act (1934), on August 16, 2010. The termination of the London Act will become effective three months after the Director General of WIPO receives the last required notification of acceptance.

¹⁰ With the declaration that Hungary does not consider itself bound by the Protocol annexed to the Hague Act (1960). The London Act ceased to be effective in respect of Hungary as of February 1, 2005.

¹¹ Liechtenstein has notified acceptance of the termination of the London Act (1934), on December 13, 2010. The termination of the London Act will become effective three months after the Director General of WIPO receives the last required notification of acceptance.

¹² Monaco has notified acceptance of the termination of the London Act (1934), on March 9, 2011. The termination of the London Act will become effective three months after the Director General of WIPO receives the last required notification of acceptance.

¹³ Morocco has notified acceptance of the termination of the London Act (1934), on December 4, 2012. The termination of the London Act will become effective three months after the Director General of WIPO receives the last required notification of acceptance.

¹⁴ Ratification for the Kingdom in Europe.

¹⁵ Serbia is the continuing State from Serbia and Montenegro as from June 3, 2006.

¹⁶ Spain has notified acceptance of the termination of the London Act (1934), on September 18, 2012. The termination of the London Act will become effective three months after the Director General of WIPO receives the last required notification of acceptance.

- 21 -

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and the Geneva Act (1999)
(Hague Union)

¹⁷ Tunisia has notified acceptance for the termination of the London Act (1934), on June 10, 2011. The termination of the London Act will become effective three months after the Director General of WIPO receives the last required notification of acceptance.

[End of Annex and of document]