

PART B

INTERNATIONAL PROCEDURE

CHAPTER I: GENERAL

INTRODUCTION

This Chapter is concerned with procedural matters which are of interest both to applicants and holders and to Offices. It deals with communications with the International Bureau (including the modalities of communication, the calculation of time limits and the languages of communication), the payment of fees and representation before the International Bureau.

01. COMMUNICATIONS WITH THE INTERNATIONAL BUREAU

*Rule 1(1)(v) and
Rule 2*

01.01 Three routes of communications are possible as part of the international procedure, namely:

– between the International Bureau and the Office of a Contracting Party;

– between the International Bureau and the applicant or holder, or his representative¹;

– between the applicant or holder (or representative) and the Office of a Contracting Party. These latter communications, which do not involve the International Bureau, are outside the scope of the Hague Agreement. The modalities of such communications are exclusively a matter for the law and practice of the Contracting Party concerned. For example, the question as to whether an appeal against a refusal of protection may be filed by post, facsimile or by electronic means with a given Office is a matter for determination by the legislation and/or practice of that particular Contracting Party.

¹ Unless otherwise specified, where this Guide refers to a communication being sent to or by an applicant or holder, this is to be understood as meaning that, where a representative is recorded in the International Register for that applicant or holder, the communication will be sent to, or may validly be sent by, that representative (see paragraphs B.I.06.12 *et seq.*).

Modalities of Communications

A.I. Section 201(a) 01.02 Communications addressed by an applicant, holder or an Office to the International Bureau must be in writing and be typed or otherwise printed. Handwritten communications are not acceptable. The communication must be signed. The signature may be handwritten, printed or stamped, or may be replaced by a seal. If the communication is made by electronic means, the signature must be made in the manner determined by the International Bureau or agreed upon between the International Bureau and the Office concerned, as the case may be.

A.I. Section 202

01.03 Communications addressed to the International Bureau may be delivered by hand, sent by mail, by facsimile² or by electronic means.

Communications Sent by Mail

01.04 Any communication may be sent to the International Bureau by mail, through a postal or other delivery service, at the following address:

World Intellectual Property Organization
34, chemin des Colombettes, P.O. Box 18,
1211 Geneva 20, Switzerland

A.I. Section 201(b) 01.05 If several documents are mailed to the International Bureau in one envelope, they should be accompanied by a list identifying each one of them. The International Bureau informs the sender of any discrepancy between the list and what is actually received.

Communications Sent by Facsimile

A.I. Section 203(a) 01.06 Any communication may be sent to the International Bureau by facsimile (and be effective as from the date of its receipt by the International Bureau), *except international applications containing a reproduction to be published in color*. This exclusion is due to the fact that facsimile communications do not allow for the identification of colors, so that facsimiles of color reproductions cannot be effective as from the date of their receipt.

A.I. Section 203(b) 01.07 Where an international application containing reproductions to be published only in black and white is addressed to the International Bureau by facsimile, such application will only be effective as from the date of its receipt if *the original* of the international application form, along with *the original* of the reproductions, is received by the International Bureau prior to the expiration of 20 days from the date of receipt of the facsimile communication. If that time limit is not complied with, the international application bears the date on which the originals referred to above were in fact received by the International Bureau.

² While the provisions of the Administrative Instructions refer to “telefacsimile”, the present Guide uses the word “facsimile” instead, for the sake of simplicity (these two terms having the same meaning).

A.I. Section 203(c) 01.08 Where a communication is transmitted to the International Bureau by facsimile, the Bureau promptly informs the sender of its receipt, also by facsimile, provided the sender can be identified and reached. The Bureau also informs him of any deficiencies in the transmission (for example, if it is incomplete or illegible). Except for international applications, any other communications (such as responses to irregularity notices or requests for the recording of changes in ownership, limitations, renunciations, etc.) may be addressed to the International Bureau by facsimile without the need for applicants or holders to send subsequently the original of those communications to the International Bureau.

01.09 Whenever a communication is required to be presented on an official form, that form must be used for the purposes of any facsimile communication.

A.I. Section 203(d) 01.10 Where a communication is transmitted to the International Bureau by facsimile and, because of the time difference between the place from where the communication is transmitted and Geneva, the date on which the transmittal started is different from the date of receipt by the International Bureau of the complete communication, the earlier of the two dates shall be considered as the date of receipt by the International Bureau.

Communications Sent by Electronic Means

A.I. Section 204(a) 01.11 Any communication between, on the one hand, an applicant or holder or Office of a Contracting Party and, on the other hand, the International Bureau, including the presentation of an international application, may be made by electronic means. The particulars of the format and manner of such communication are published in the Bulletin. At the date of printing of the present Guide, these provide only for the filing of the international application through the electronic filing interface available on WIPO's website (www.wipo.int/hague/en). Notwithstanding the above, electronic communications between an Office and the International Bureau may take place in a way agreed upon between the International Bureau and the Office concerned. Each Office wishing to receive communications sent by electronic means shall indicate to the International Bureau the email address to which the said communication shall be sent.

A.I. Section 204(c) 01.12 Where a communication is transmitted to the International Bureau by electronic means and, because of the time difference between the place from where the communication is sent and Geneva, the date on which the sending started is different from the date of receipt by the International Bureau of the complete communication, the earlier of the two dates shall be considered as the date of receipt by the International Bureau.

A.I. Section 204(b) 01.13 Provided the sender can be identified and can be reached, the International Bureau will promptly inform him, also by electronic transmission, of the receipt of the electronic communication, and of any deficiencies in the transmission (for example, if it is incomplete or illegible). Such an acknowledgement shall contain the date of receipt in the case of an international application.

Official Forms

Rule 1(1)(vi) 01.14 All official forms are established by the International Bureau. Copies of such forms are available for downloading from WIPO's website (*www.wipo.int*).

Rule 1(1)(vi) 01.15 As an alternative to using a form produced by the International Bureau, Offices, applicants or holders may generate their own forms. Such self-generated forms are acceptable to the International Bureau provided that they have the same contents and format as the official forms.

01.16 The items in such self-generated forms need not have the same spacing and layout as in the forms established by the International Bureau. Indeed, one advantage of producing such forms is that as much space can be allocated to a given item as is needed; for example, where an international application is in the names of several applicants, or there is a particularly large number of industrial designs, use of such forms can avoid the need for continuation sheets. The following prescriptions must, however, be observed:

- the form must be on A4 paper, written on one side only;
- it must contain the same items, with their numbering and titles, in the same order, as the official form established by the International Bureau;
- where an item is not used or is not applicable, the item should not be omitted, but should be included with an appropriate indication, such as “not applicable”, “nil” or “not used”; for example, if an international application submitted on a self-generated form does not include a claim to priority, the form should still include the relevant entry, between items 10 and 12, with an appropriate indication, such as: “Priority Claim: *Not applicable*”.

Continuation Sheets

01.17 Where the space available in any part of a form is insufficient (for example, in the case of an international application, because there is more than one applicant, or more than one priority claim) one or more continuation sheets should be used (unless a self-generated form has been used). On the continuation sheet, it is necessary to indicate “*Continuation of item number ...*”, the information then being presented in the same manner as required in the form itself. The number of continuation sheets used should be indicated in the box provided at the beginning of the form.

Indication of Dates

01.18 Any indication of a date in an official form must consist of the day in two digits, followed by the number of the month in two digits, followed by the number of the year in four digits, all in Arabic numerals and day, month and year being separated by slashes (/). For example, the date March 9, 2004, is to be written as “09/03/2004”.

Unofficial Forms

01.19 In addition to the official forms, several unofficial forms are available, for example for renewing an international registration. The use of these forms is not compulsory; they are provided by the International Bureau for the convenience of users and are also available on WIPO's website (*www.wipo.int*).

02. CALCULATION OF TIME LIMITS

02.01 The Hague system lays down time limits within which certain communications must be made. Normally the date on which the time limit expires is the date on which the communication must be received by the International Bureau. An exception to this is the time limit within which the Office of a designated Contracting Party may notify refusal of protection; in this case, it is the date on which the Office sends the notification to the International Bureau which is decisive (see also A.I. section 501). Any communication from the International Bureau which refers to a time limit indicates the date of expiry of that time limit, calculated in accordance with the following rules:

Rule 4(1) – any period expressed in years expires, in the relevant subsequent year, on the same day and month as the event from which the period started to run, except that a period which started on February 29, and ends in a year in which there is no such date, will expire on February 28. For example, a period of 10 years from February 20, 1996, will expire on February 20, 2006; a period of 10 years from February 29, 1996, will expire on February 28, 2006;

Rule 4(2) – any period expressed in months expires, in the relevant subsequent month, on the day having the same number as the day of the event from which the period started to run, except that if there is no day with that number, the period expires on the last day of the month. For example, a period of two months which begins on January 31 ends on March 31, while a period of three months which begins on the same date ends on April 30;

Rule 4(3) – any period expressed in days starts on the day following the day on which the relevant event occurred. For example, a period of ten days which is to be reckoned from an event which occurred on the twelfth day of a month will expire on the twenty-second day of that month.

Rule 4(4) 02.02 If a period within which a communication must be received by the International Bureau would expire on a day on which the International Bureau is not open to the public, it will expire on the next subsequent day on which the Bureau is open. For example, if a period within which a communication must be received by the International Bureau ends on a Saturday or Sunday, the deadline will be met if the communication is received on the following Monday (assuming that the Monday is not a holiday). For example, a period of three months starting from October 1 will not expire on January 1 (which is a holiday at the International Bureau), but on the next working day. A list of the days on which the International Bureau is not scheduled to be open to the public during the current and the following calendar year is published in the Bulletin.

Rule 26(2)

Rule 4(4) 02.03 Likewise, if the period within which a communication (such as a notification of refusal of protection) must be sent by an Office to the International Bureau would expire on a day on which the Office concerned is not open to the public, it will expire on the next subsequent day on which the Office is open. It should be noted that this applies only where the period in question is specified in terms of the communication being *sent* by an Office within that period. On the other hand, where the period is specified in terms of the communication being *received* by the International Bureau within that period, it is paragraph B.I.02.02 that applies; in such a case, late receipt of the communication by the International Bureau cannot be excused on the ground that its dispatch was delayed because the Office which sent it was closed.

03. IRREGULARITIES IN POSTAL AND DELIVERY SERVICES

Rule 5(1) and (2) 03.01 Where a time limit is not met because a communication addressed to the International Bureau by an applicant or holder or by an Office is unduly delayed or is lost because of an irregularity in a postal or delivery service, this may be excused, provided due care has been exercised by the sender and the communication was dispatched in good time. The rule is that failure to meet a time limit will be excused if the party which sent the communication submits evidence showing, to the satisfaction of the International Bureau:

(i) that the communication was mailed or sent to the International Bureau at least five days prior to the expiry of the time limit, or, where the postal or delivery service was, on any of the 10 days preceding the day of expiry of the time limit, interrupted on account of war, revolution, civil disorder, strike, natural calamity, or other like reason, that the communication was mailed or sent not later than five days after postal or delivery service was resumed;

(ii) that the mailing of the communication was registered, or details of the communication were recorded by the postal or delivery service at the time of mailing; and

(iii) in the case of a communication sent by a postal service from a location from which not all classes of mail normally reach the International Bureau within two days of mailing, that the communication was either mailed by a class of mail which normally reaches the International Bureau within two days of mailing, or was sent by airmail.

Rule 5(3) 03.02 Failure to meet a time limit will be excused only if the evidence referred to in paragraph B.I.03.01, and the communication, or a duplicate thereof, are received by the International Bureau not later than six months after the expiry of the time limit.

04. LANGUAGES

International Applications

Rule 6(1) 04.01 An international application may be filed in either English or French, at the applicant's option.

Rule 6(3) 04.02 Any communication concerning such an international application or the international registration resulting therefrom must be

(i) in English or French where such communication is addressed to the International Bureau by the applicant or holder or by an Office;

(ii) in the language of the international application where the communication is addressed by the International Bureau to an Office, unless that Office has notified the International Bureau that all such communications are to be in English or that all such communications are to be in French;

(iii) in the language of the international application where the communication is addressed by the International Bureau to the applicant or holder unless the applicant or holder has expressed the wish to receive all such communications in English, although the international application was in French, or *vice versa*.

Rule 6(2) 04.03 The recording in the International Register and the publication in the Bulletin of an international registration and of any data to be both recorded and published in respect of that international registration takes place in English and in French.

Translation

Rule 6(4) 04.04 The translations into English or French needed for the recordings in the International Register and publications in the Bulletin are made by the International Bureau. The applicant may annex to the international application a proposed translation of any text matter contained in the international application. If the proposed translation is not considered by the International Bureau to be correct, it is corrected by the International Bureau after having invited the applicant to make, within one month from the invitation, observations on the proposed correction.

05. PAYMENT OF FEES TO THE INTERNATIONAL BUREAU

Rule 27(1) 05.01 The amounts of the fees payable in connection with an international application or registration are either prescribed in the Schedule of Fees appended to the Regulations or, in the case of individual fees, fixed by the Contracting Party concerned. Information concerning individual fees is published in the Bulletin and is also available on WIPO's website.

- Rule 27(2)(a) and (b)* 05.02 Fees may be paid by the applicant or holder directly to the International Bureau. As regards, in particular, an international application, the fees may also be paid by the Office of the applicant's Contracting Party if the application is filed through that Office and the Office accepts to collect and forward such fees to the International Bureau.

Currency of Payment

- Rule 28(1)* 05.03 All payments to the International Bureau must be made in Swiss currency. An Office which accepts to collect and forward fees may collect payments from the applicant in another currency, but the payment forwarded to the International Bureau by the Office must be in Swiss currency.

Individual Designation Fees

- 99 Article 7(2)* 05.04 Declaration concerning individual designation fees (see paragraphs A.05.19 to 05.21) must indicate the amount of such fees, expressed in the currency used by the Office concerned and, where applicable, any change in the amount. Where this currency is other than Swiss currency, the Director General of WIPO, in consultation with the Office, establishes the amount of the fees in Swiss currency on the basis of the official exchange rate of the United Nations.
- Rule 28(2)(c)* 05.05 Where, for more than three consecutive months, the official exchange rate of the United Nations between a Contracting Party's currency and Swiss currency is higher or lower by at least 5% than the last exchange rate used to establish the amount of the individual fees in Swiss currency, the Office of that Contracting Party may ask the Director General of WIPO to establish new amounts in Swiss currency for the individual fees.
- Rule 28(2)(d)* 05.06 Where, for more than three consecutive months, this exchange rate is lower by at least 10% than the last rate applied, the Director General of WIPO, at his own initiative, establishes new amounts in Swiss currency for the individual fees. The amounts so fixed are published in the Bulletin and become applicable at a date to be fixed by the Director General of WIPO, which is between one and two months after such publication.

Mode of Payment

- A.I. Section 801* 05.07 Fees may be paid to the International Bureau:
- (i) by debit to a current account with the International Bureau;
 - (ii) by payment into the Swiss postal account or to any of the specified bank accounts of the International Bureau;
 - (iii) by credit card through an electronic interface for online payment made available by the International Bureau.

05.08 An applicant, holder, representative, or an Office having frequent dealings with the International Bureau, may find it useful to maintain a current account with the International Bureau. This greatly simplifies the payment of fees and reduces the risk of irregularities due to late or incorrect payment. This method of payment is of course dependent on there being a sufficient balance in the account; the International Bureau informs the holder of the account whenever the balance has diminished to an extent that there is a danger that it might be insufficient to cover the next fee.

Rule 27(4) 05.09 Whenever a fee is paid to the International Bureau, the purpose of the payment must be indicated, together with information identifying the application or registration concerned. This information should include:

– at the stage of the international application, the name of the applicant and the industrial design to which the payment relates;

– in connection with international registrations, the name of the holder and the international registration number.

05.10 Where payment is made other than by debit from a current account with the International Bureau, the amount being paid should be stated. Where payment is made from a current account with the International Bureau, it is sufficient to give a general instruction to the International Bureau to debit whatever is the correct amount for the transaction in question (by ticking the appropriate box on the fee payment sheet which is part of the official form). Nevertheless, if a specific amount is indicated, the International Bureau treats it as indicative only, debits the correct amount and notifies accordingly the party (applicant, holder, representative or Office) that gave the instruction.

Date of Payment

Rule 27(5)(a) 05.11 The fees are considered to have been paid on the date on which the International Bureau received the required amount. However, in the case of a renewal, if a payment is received by the International Bureau earlier than three months before the date on which the renewal of the international registration is due, it is considered as having been received three months before that date.

Rule 24(1)(d)

Change in the Amount of Fee

Rule 27(6)(a) 05.12 Where an international application is filed through the Office of the applicant's Contracting Party and the amount of the fee payable changes between the date on which the application was received by such Office and the date on which it was received by the International Bureau, it is the fee that was valid on the date of reception of the international application by the Office that is applicable.

Rule 27(6)(b) 05.13 Where the renewal of an international registration is requested and the amount of the fee payable changes between the date of payment and the date on which renewal is due, then

– where payment is made not more than three months before the date on which renewal is due, it is the fee that was valid on the date of payment that is applicable;

Rule 24(1)(d) – where the fee is paid more than three months before the date on which renewal is due, the payment is considered to have been received three months before the due date, and it is the fee that was valid three months before the due date that is applicable (see paragraph B.I.05.11).

Rule 27(6)(b) 05.14 Where the renewal fee is paid after the due date, it is the fee that was valid on the due date that is applicable.

Rule 27(6)(c) 05.15 In any other case, the applicable amount is that which was valid on the date on which the payment was received by the International Bureau.

Crediting of Fees

Rule 29 05.16 Any standard designation fee or individual designation fee collected by the International Bureau is credited to the account maintained with the Bureau by the Contracting Party concerned. This is done within the month following the month during which was recorded the international registration or renewal in connection with which the fee was paid or, as regards the payment of the second part of an individual fee, upon its receipt by the International Bureau.

06. REPRESENTATION BEFORE THE INTERNATIONAL BUREAU

Rule 3(1)(a) 06.01 An international application may be filed with the International Bureau directly by the applicant. If he so wishes, the applicant may appoint a representative to act on his behalf before the International Bureau.

06.02 The provisions of the Hague system relate only to the representation before *the International Bureau*. Requirements as to the appointment of a representative before the Office of a Contracting Party (in the event, for example, that an appeal is lodged against a refusal of protection) are outside the scope of the Hague system and are exclusively a matter for the law and practice of the Contracting Party concerned.

06.03 With respect to who may be appointed as a representative before the International Bureau, the Hague system does not provide for any requirement as to professional qualification, nationality or domicile.

Method of Appointment of a Representative

In the International Application

Rule 3(2)(a) 06.04 A representative may be appointed in an international application by indicating the name and address of such representative in the corresponding item 5 of the international application form. For the appointment of the representative to be effective, the international application must either be signed by the applicant or be accompanied by a power of attorney (and the appropriate box in item 5 ticked accordingly) (see paragraphs B.II.04.17 to 04.22).

In a Request for the Recording of a Change

06.05 A representative may be appointed in a request for the recording of a change (limitation, renunciation, change in ownership, change in the name and/or address of the holder) by indicating the name and address of such representative in the corresponding item of the form concerned. For the appointment of the representative to be effective, the request must be signed by the holder or be accompanied by a power of attorney or form DM/7 duly completed (and the appropriate box ticked accordingly) (see the corresponding paragraphs in Part B.II relating to each of these changes).

In a Separate Communication

Rule 3(2)(b) 06.06 The appointment of a representative may also be made at any time in a separate communication. Such separate communication must be signed by the holder.

06.07 The communication may be a simple letter. It suffices that it clearly identifies the person making the appointment, the name and address of the appointed representative and the international application or registration concerned. Although not compulsory, an unofficial form (DM/7) for appointing a representative is available from the International Bureau for the convenience of applicants and holders.

06.08 Such an appointment may relate to any number of international applications or registrations, provided they are all clearly and individually identified. The International Bureau cannot accept, as an appointment of a representative, a communication which simply refers to all international applications and registrations in the name of the same applicant or holder.

Only One Representative

- Rule 3(1)(b)* 06.09 Only one representative may be appointed in respect of a given international application or registration. Therefore, if the appointment indicates more than one representative in respect of the same international application or registration, only the one indicated first is considered to have been appointed.
- Rule 3(1)(c)* Where a partnership or firm of attorneys or patent or trademark agents has been indicated, this is regarded as a single representative.

Irregular Appointment

- Rule 3(2)(c)* 06.10 Where the appointment of a representative does not comply with the applicable requirements, the International Bureau considers the appointment as irregular. It notifies accordingly the applicant or holder and the purported representative and, failing the required correction, it sends all relevant communications to the applicant or holder or their previously appointed representative.

Recording and Notification of Appointment

- Rule 3(3)(a) and (b)* 06.11 If the appointment of the representative complies with the applicable requirements, the International Bureau records that fact, along with the name and address of the representative in the International Register, and notifies both the applicant or holder and the representative concerned.

Effect of the Appointment

- Rule 3(3)(a)* 06.12 The appointment of a representative has effect as of the date on which the International Bureau receives the communication (international application, request to record a change or separate communication) in which the appointment has been made.

- Rule 3(4)(a)* 06.13 Unless the Common Regulations expressly require otherwise, a duly recorded representative may always sign a communication, or carry out any other procedural step, in place of the applicant or holder. Any communication addressed by him to the International Bureau has the same effect as if it had been addressed to the International Bureau by the applicant or holder. Similarly, where a representative is recorded, the International Bureau sends to him any communication which, in the absence of a representative, would have been sent to the applicant or holder. Any such communication has the same effect as if it had been addressed to the applicant or holder.
- Rule 3(4)(c)*
- Rule 3(4)(b)*

06.14 Where a representative is appointed, the International Bureau does not normally send communications also to the applicant or holder. There are a number of exceptions to this rule:

Rule 3(5)(c) – where cancellation of the appointment is requested, the International Bureau so informs both the applicant or holder and the representative (see paragraph B.I.06.20);

Rule 23 – six months before the expiry of a five-year term of protection, the International Bureau sends an unofficial notice to both the holder and his representative;

Rule 24(3) – where insufficient fees are paid for the purpose of renewal, the International Bureau notifies both the holder and his representative.

06.15 Apart from these exceptions, whenever this Guide refers to anything being sent to, or done by, an applicant or holder, this should be understood as a reference to it being sent to, or allowed to be done by, a duly-recorded representative.

Cancellation of Appointment

Rule 3(5)(a) 06.16 The recording of a representative is canceled upon receipt of a corresponding request signed by the applicant, holder or representative. Cancellation may be requested by means of a simple letter or on the unofficial form DM/9. The cancellation of the recording may be effected for all the international applications or registrations of the same applicant or holder in respect of which the representative has been duly appointed, or for any specified international applications or registrations of that applicant or holder.

Rule 3(5)(a) 06.17 The recording of a representative is canceled *ex officio* by the International Bureau where a new representative has been duly appointed. As noted in paragraph B.I.06.09, only one representative may be recognized at any one time; *the appointment of a new representative is therefore assumed to replace any representative previously appointed.*

Rule 3(5)(a) 06.18 The recording of a representative is also canceled *ex officio* by the International Bureau where a change in ownership has been recorded and no representative has been appointed by the new holder.

Rule 3(5)(b) 06.19 The cancellation becomes effective from the date on which the International Bureau receives the communication leading to the cancellation.

Rule 3(5)(c) 06.20 Once the cancellation becomes effective, the International Bureau notifies the cancellation and its effective date to the applicant or holder and to the representative whose appointment has been canceled. It sends all future communications either to the new representative or, where no new representative has been recorded, to the applicant or holder.

No Fees

06.21 The recording of the appointment of a representative, of any change concerning the representative, or of the cancellation of the recording of a representative, is exempted from the payment of fees.