

CHAPTER II:

INTERNATIONAL PROCEDURE (1960 AND 1999 ACTS)

INTRODUCTION

This Chapter describes the procedures under the Hague system. It follows, as far as possible, the life of an international registration, starting with the international application and proceeding through to the recording of the international registration. It then deals with the various events which can occur following an international registration, such as refusal of protection, requests for the recording of certain changes (change in name or address, change in ownership, limitation, renunciation or cancellation) and renewal of the international registration.

For the reasons explained in paragraph A.02.03, the present Chapter deals only with the international procedure under the 1999 Act and/or the 1960 Act. The procedural specificities of the 1934 Act, as applicable since the freezing of its application on January 1, 2010, are described separately in Chapter B.III.

01. HARMONIZATION OF TERMINOLOGY

Rule 1(2) 01.01 The 1960 Act, on the one hand, and the 1999 Act, on the other hand, refer at times to identical concepts while using different terminology. Therefore, for the sake of simplicity and consistency and throughout the Common Regulations, the terminology of the 1960 Act has been brought into line with the more modern terminology used in the 1999 Act. For the purpose of the Common Regulations, five terms contained in the 1960 Act have been harmonized with those contained in the 1999 Act:

– reference to “international application” or “international registration” is deemed to include a reference to “international deposit”, as referred to in the 1960 Act;

– reference to “applicant” or “holder” is deemed to include a reference to, respectively, “depositor” or “owner” as referred to in the 1960 Act;

– reference to “Contracting Party” is deemed to include a reference to a State party to the 1960 Act;

– reference to “Contracting Party whose Office is an Examining Office” is deemed to include a reference to “State having a novelty examination” as defined in Article 2 of the 1960 Act;

– reference to “individual designation fee” is deemed to include a reference to the fee mentioned in Article 15(1)(2)(b) of the 1960 Act.

02. ENTITLEMENT TO FILE AN INTERNATIONAL APPLICATION

60 Article 3 02.01 To be entitled to file an international application, an applicant must
99 Article 3 satisfy at least one of the following conditions:

(i) be a national of a State that is a Contracting Party or of a State member of an intergovernmental organization that is a Contracting Party, *or*

(ii) have a domicile in the territory of a State that is a Contracting Party or in the territory in which the treaty establishing an intergovernmental organization that is a Contracting Party applies, *or*

(iii) have a real and effective industrial or commercial establishment in the territory of a State that is a Contracting Party or in the territory in which the treaty establishing an intergovernmental organization that is a Contracting Party applies.

02.02 In addition, but only under the 1999 Act, an international application may be filed on the basis of a habitual residence in a Contracting Party.

02.03 The interpretation of “national”, “domicile”, “habitual residence” and “real and effective commercial or industrial establishment” is exclusively a matter for the laws of the Contracting Parties to determine. This Guide can therefore only give some guidance in that regard.

02.04 The term “national” is intended to have the same meaning as in Articles 2 and 3 of the Paris Convention. It is taken to be capable of including both natural and legal persons. The question as to whether a natural person is a national of a particular country, and the criteria for deciding whether a legal entity is regarded as a national of that country (for example, place of incorporation or headquarters), are matters for the law of such country.

02.05 The concept of “domicile” can have different meanings, depending on national legislation. It is for the law of a Contracting Party to determine the criteria for either a natural person or a legal entity to be regarded as domiciled in that Contracting Party. Under some legislations a natural person can obtain domicile only by virtue of an official authorization. Other legislations interpret “domicile” as more or less equivalent to “residence”. It is generally believed that the Paris Convention did not seek, by using the expression “domicile”, to indicate a legal situation, but rather a more or less permanent situation of fact, so that a foreign national residing in a Contracting Party would, in most cases, be eligible to claim entitlement through domicile. With respect to legal entities, their “domicile” can be considered to be the place of their actual headquarters.

02.06 The term “habitual residence” is taken from the Berne Convention for the Protection of Literary and Artistic Works. It has been used in the 1999 Act in order to compensate for any excessively narrow interpretation that might be given to the concept of “domicile” under domestic laws.

02.07 The expression “real and effective industrial or commercial establishment” is taken from Article 3 of the Paris Convention, to which it was added at the first conference for the revision of the Convention which took place in Brussels in 1897 - 1900. It was felt that the original provision, which referred simply to “an establishment”, was too broad and should be restricted. The intention was that, by using the French term “*sérieux*” (“real” in English), fraudulent or fictitious establishments would be excluded. The term “effective” makes it clear that, while the establishment must be one at which some industrial or commercial activity takes place (as distinct from a mere warehouse), it need not be the principal place of business (at the Brussels Conference, the proposal by one of the States party to the Madrid Agreement to narrow down the requirement of the establishment to the principal place of business was not adopted).

Determination of the State of Origin (Under the 1960 Act) and Determination of the Applicant’s Contracting Party (Under the 1999 Act)

02.08 The “State of origin” under the 1960 Act and the “applicant’s Contracting Party” under the 1999 Act both correspond to the Contracting Party in respect of which the applicant derives his right to file an international application under the Hague Agreement, i.e., the Contracting Party with which the applicant has the required entitlement (through establishment, domicile, nationality or, in respect of the 1999 Act, habitual residence).

02.09 However, where an applicant has an entitlement with *several* Contracting Parties (see paragraphs B.II.04.11 to 04.18), the “State of origin” and the “applicant’s Contracting Party” are determined according to different principles under, respectively, the 1960 Act and the 1999 Act.

Determination of the State of Origin Under the 1960 Act

60 Article 2

02.10 The State of origin is determined as:

(a) the Contracting State to the 1960 Act in which the applicant has a real and effective industrial or commercial establishment; or

(b) *if he has no such establishment in such a State*, the Contracting State to the 1960 Act in which he has his domicile; or

(c) *if he has neither an establishment nor a domicile in such a State*, the Contracting State to the 1960 Act of which he is a national.

02.11 Thus, where an applicant has multiple entitlements in different Contracting Parties, the State of origin cannot be freely chosen by that applicant; it is to be determined in accordance with the above described hierarchy.

*Determination of the Applicant's Contracting Party Under the
1999 Act*

99 Article 1(xiv) 02.12 The “applicant’s Contracting Party” is defined by the 1999 Act in such a way as to permit the applicant to freely choose his Contracting Party on the basis of establishment, domicile, habitual residence or nationality. For example, if an applicant indicates a domicile in Contracting Party A, bound by the 1999 Act, and the nationality of Contracting Party B, also bound by the 1999 Act, the applicant’s Contracting Party is, among Contracting Parties A and B, the one which is indicated as such by the applicant in the international application (see paragraph B.II.04.19).

Plurality of Entitlements

02.13 An applicant enjoying multiple and independent entitlements may cumulate these with a view to obtaining protection on a broader geographical scale. For example, an applicant having the nationality of Contracting Party A, bound *exclusively* by the 1960 Act and whose domicile is located in Contracting Party B, bound *exclusively* by the 1999 Act, could, as a result, designate all Contracting Parties bound by the 1960 and/or 1999 Acts.

02.14 A special case of plurality of entitlements arises in respect of States member of an intergovernmental organization that is a Contracting Party to the 1999 Act, where those States are themselves bound by the 1960 Act. For example, an applicant having the nationality of Contracting Party A, bound *exclusively* by the 1960 Act, that is a member State of the European Union, could, as a result, designate all Contracting Parties bound by the 1960 and/or 1999 Acts, as the European Union is a Contracting Party to the 1999 Act.

02.15 Where an applicant enjoying a plurality of independent entitlements under the 1960 and 1999 Acts designates a Contracting Party bound by the same Acts, the designation of that Contracting Party will be governed by the 1999 Act, which is the most recent Act (see paragraphs A.04.13 to 04.16).

Several Applicants

02.16 Two or more parties (whether natural persons or legal entities) may jointly file an international application, provided that each of them is in a position to establish an entitlement through a Contracting Party bound by the same Act or Acts. It is not necessary that the Contracting Party concerned be the same in respect of each applicant, nor is it necessary that the nature of the entitlement (nationality, domicile, habitual residence or establishment) be the same for each applicant.

02.17 For example, where Applicant 1 is a national of Contracting Party A, bound by the 1999 Act, and Applicant 2 has a domicile in Contracting Party B, also bound by the 1999 Act, these applicants may jointly file an international application.

03. CONTENTS OF THE INTERNATIONAL APPLICATION

03.01 The contents of an international application may be divided into three categories, namely, the mandatory contents, the additional mandatory contents where certain Contracting Parties are designated and the optional contents.

Mandatory Contents

Rule 7(3) 03.02 The mandatory contents consist of the information which must be contained in every international application or accompany it (such as the prescribed particulars concerning the applicant, a reproduction of the designs for which protection is sought or the indication of the designated Contracting Parties; see paragraphs B.II.04.01 *et seq.*).

Additional Mandatory Contents

Rule 7(4) 03.03 The additional mandatory contents consist of certain elements that may be notified by a Contracting Party whose Office is an Examining Office, and which must be included in an international application where such Contracting Party has been designated. The elements that may be notified in this way are limited to three, namely (i) information concerning the identity of the creator; (ii) a brief description of the reproduction or of the characteristic features of the industrial design in respect of which the application is filed; (iii) a claim. Those three additional elements correspond to the requirements that certain potential Contracting Parties require in order for a national application to be accorded a filing date under their domestic legislation (see paragraphs B.II.04.29, 04.38 and A.05.23).

03.04 Even when information concerning the identity of the creator, or a brief description, is not required following the designation of a Contracting Party which has made the declaration referred to in paragraph A.05.23, such elements may nevertheless be included in the international application, at the applicant's choice. In contrast, however, a claim cannot be indicated by the applicant if the international application has not designated a Contracting Party requiring it.

Optional Contents

Rule 7(5) 03.05 A number of optional elements may also be provided by the applicant (for instance a declaration claiming the priority of an earlier application, or the appointment of a representative), but their absence does not constitute an irregularity in the international application (see paragraphs B.II.04.51 to 04.60).

Rule 7(5)(f)
A.I. Section 407

03.06 The international application may also contain any declaration, statement or other relevant indication as may be specified in the Administrative Instructions. Section 407 has been introduced into the Administrative Instructions to address the specific features in some jurisdictions concerning the relation with a principal industrial design or a principal application or registration. In these jurisdictions, the law provides for a “similar design” system or a “related design” system, so that, under certain circumstances, a reference to the “principal design” must be indicated in an application for the registration of a “similar design” or “related design”. The Offices of the concerned Contracting Parties need to identify the “principal design” since a “similar design” or a “related design” can only be registered if the latter is considered by the Office to be similar or related to the “principal design” and if both the “similar design” or “related design” and the “principal design” belong to the same applicant/holder. In principle, if the international application complies with this requirement, the “principal design” will not be considered as a prior design that would prevent its “similar design” or “related design” from being registered¹.

Special Requirements

03.07 The 1999 Act provides for two types of special requirements that may be notified by a Contracting Party and with which the applicant must comply if he designates such Contracting Party under the 1999 Act in the international application.

Special Requirements Concerning the Applicant

Rule 8 03.08 Any Contracting Party whose legislation requires an application for the registration of an industrial design to be filed in the name of the creator of the design may notify that fact to the Director General of WIPO. If that Contracting Party is designated in the international application, the identity of the creator of the industrial design must be furnished and that person is deemed to be the applicant for the purposes of the Contracting Party concerned, whether or not the international application was filed in his name. Furthermore, if the person mentioned in the international application as the creator is not the same as the person named as the applicant, the international application must be accompanied by a statement or document, depending on what the Contracting Party concerned may require, to the effect that the international application has been assigned by the person identified in the international application as the creator to the person named as the applicant.

¹ At the time of printing this Guide, none of the current Contracting Parties has such a feature in its law. However, it is foreseen that the legislation of some future Contracting Parties may provide for a “similar design” system or a “related design” system. Upon accession of the first such Contracting Party, the application form (DM/1) and the electronic filing interface (E-filing) will be amended accordingly.

Special Requirements Concerning the Unity of the Design

99 Article 13 03.09 Any Contracting Party whose law, at the time of its becoming party to the 1999 Act, contains a requirement of unity of design (according to which, generally speaking, two or more industrial designs included in the same application have to conform to the same creative concept) may notify that fact to the Director General of WIPO. The purpose of the notification is to enable the Office of the Contracting Party that has made it to refuse the effects of the international registration, pending compliance with the requirement in question. In that case, the international registration may be divided before the Office concerned in order to overcome the ground of refusal based on lack of unity of design. The Office is entitled to charge the holder of that registration as many additional fees as divisions prove necessary. The mode of payment of additional fees of this type is not governed by the Hague system; they will be specified by each Contracting Party concerned, which will collect them directly from the owner.

A.I. Section 502 03.10 Where an international registration has been divided before the Office of a designated Contracting Party following a notification of refusal based upon lack of unity of design, that Office must notify the International Bureau of that fact, together with the following additional particulars:

- the Office making the notification;
- the number of the international registration concerned;
- the numbers of the industrial designs which have been the subject of the division with the Office concerned; and
- the resulting national or regional application numbers or registration numbers.

03.11 It is to be understood that the requirement of unity of design notified by a Contracting Party under the 1999 Act does not affect the applicant's right, even if he designates the Contracting Party that made the notification, to include two or more industrial designs in the international application.

Language of the International Application

Rule 6 03.12 An international application may be in English, French, or Spanish, at the applicant's option. However, where an international application is presented to the International Bureau through the intermediary of an Office, that Office may restrict the choice of the applicant and require the application to be in any one or two of those three languages.

Rule 14(3) 03.13 If the international application is not in one of the prescribed languages, this constitutes an irregularity entailing a postponement of the filing date of the international application (see paragraph B.II.06.07).

03.14 With regard to the language of communications relating to an international application or to the resulting international registration, see paragraphs B.I.04.02.

04. INTERNATIONAL APPLICATION

Rule 7(1) 04.01 An international application may be presented to the International Bureau on the relevant official form (form DM/1) or through the electronic filing (E-filing) interface made available by the International Bureau. In principle, paper applications may be submitted either directly to the International Bureau or via the Office of a Contracting Party (see paragraphs B.II.06.01-04). The official form, the E-filing interface as well as a help document DM/1.inf “How to file an international application” are available on the WIPO website, at www.wipo.int/hague/en.

04.02 The E-filing interface has a number of advantages over filing a paper application, such as:

- Rule 9(1)*
A.I. Section 401(c)
- faster delivery of the application;
 - lower fees when the application contains many reproductions of the industrial designs to be registered, since reproductions submitted on paper are subject to a fee for each page beyond the first (see paragraph B.II.04.72);
 - automatic checking of much of the information provided, reducing the likelihood of irregularities.

04.03 The following explanations follow the structure of the official paper form for an international application (form DM/1) and refer to the successive items contained in the form. It is understood that these explanations apply *mutatis mutandis* to the E-filing interface.

Item 1: Applicant

Name

Rule 7(3)(i)
A.I. Section 301 04.04 Where the applicant is a natural person, the name to be indicated is the family (or principal) name and the given (or secondary) name(s) of the natural person, as customarily used by that person and in the order in which they are customarily used. Where the applicant is a legal entity, its full official designation must be given. Where the name of the applicant is in characters other than Latin characters, the name must be indicated as a transliteration into Latin characters, following the phonetics of the language of the international application. Where the applicant is a legal entity, the transliteration may be replaced by a translation into the language of the international application.

Several Applicants

04.05 Where there is more than one applicant, the appropriate box should be ticked and the relevant information regarding each of the other applicants should be furnished on a continuation sheet. The E-filing interface also allows the indication of several applicants.

Address

Rule 7(3)(ii)
A.I. Section 301(d)

04.06 The address of the applicant must be given in such a way as to satisfy the customary requirements for prompt postal delivery and should consist, at least, of all the relevant administrative units up to, and including, the house number, if any. In addition, telephone or facsimile numbers and an email address may be given. For E-filing, if no representative under item 5 is appointed, then an email address has to be indicated as the International Bureau will confirm receipt of the international application at that email address.

Item 2: Address for Correspondence

04.07 Where the name and address of a representative has been given in item 5 of the international application form, all communications which are required to be sent by the International Bureau to the applicant are sent to that address. Otherwise, all communications are sent to the address of the applicant, as indicated in item 1 of the application form.

04.08 Where, however, an applicant has not indicated the name and address of a representative and requires to have correspondence sent to an address other than that indicated in item 1 of the application form, an address for correspondence should then be indicated in item 2. In other words, when there is just one applicant, the field "*Address for Correspondence*" should be completed only (a), where no representative has been appointed and (b), the address to which communications should be sent differs from that indicated in item 1.

Several Applicants: Address for Correspondence

A.I. Section 302

04.09 Where there are several applicants with different addresses and the name and address of a representative has not been indicated in item 5 of the application form, a separate address for correspondence *must* be indicated. In default of such indication in the application form, the address of the first person named as the applicant in item 1 is treated as the address for correspondence.

Phone and Facsimile Number and Email Address

04.10 The numbers or email address given should be those of the person whom the International Bureau should contact if and when it needs to get in touch with the applicant.

Item 3: Entitlement to File

Rule 7(3)(iii) 04.11 Although only one entitlement with one Contracting Party is required in order to file an international application, more than one Contracting Party may be indicated for each criterion in item 3. The applicant is required to indicate in item 3 the Contracting Party(ies) in which he has a real and effective industrial or commercial establishment (if any), as well as the Contracting Party(ies) in which he has a domicile (if any), and also the Contracting Party(ies) of which he is a national (if applicable).

04.12 In addition, the applicant is required to indicate the Contracting Party(ies) in which he has habitual residence (if any), provided that such Contracting Party is bound by the 1999 Act. In fact, the possibility of claiming an entitlement through habitual residence is contemplated only by the 1999 Act, and not by the 1960 Act.

04.13 For a paper application, the full name of the Contracting Party should be indicated. For an electronic application, the official two-letter code² for the Contracting Party should be selected from the corresponding dropdown list.

04.14 The indications concerning each of the above criteria must all be completed, even if the Contracting Party concerned is the same in each case. If any criterion is not applicable, the applicant should simply write “None”.

04.15 Applicants having a real and effective industrial or commercial establishment, a domicile or a habitual residence, in a Contracting Party that is a member State of an intergovernmental organization that is a Contracting Party, or being a national of a Contracting Party that is a member State of an intergovernmental organization that is a Contracting Party, should indicate both that Contracting Party and that intergovernmental organization. However, where entitlement is derived from a connection with a member State of an intergovernmental organization but which is not itself a Contracting Party, only the name of the intergovernmental organization should be indicated.

04.16 It is important for the applicant to indicate his *multiple* entitlements in different Contracting Parties, since that applicant would then be in a position to cumulate those multiple entitlements with a view to obtaining protection on a broader geographical scale.

04.17 For example, an applicant having the nationality of Contracting Party A, bound exclusively by the 1960 Act and whose domicile is located in Contracting Party B, bound exclusively by the 1999 Act, could, as a result, designate all Contracting Parties bound by the 1960 and/or 1999 Acts.

² The list of official two-letter codes for Contracting Parties is available on the WIPO website, at www.wipo.int/export/sites/www/standards/en/pdf/03-03-01.pdf.

04.18 Where an applicant enjoying a plurality of independent entitlements under the 1960 and 1999 Acts designates a Contracting Party bound by the same Acts, the designation of that Contracting Party will be governed by the 1999 Act, which is the most recent Act (see paragraphs A.04.12 to 15).

Item 4: Indication of Applicant's Contracting Party

99 *Article 1(xiv)* 04.19 Under the 1999 Act, the applicant's Contracting Party is the
Rule 7(4)(a) Contracting Party through which the applicant derives the right to file an international application. If only one Contracting Party bound by the 1999 Act is indicated under item 3, that Contracting Party must also be indicated under item 4. On the other hand, if several Contracting Parties bound by the 1999 Act are indicated under item 3, one of them must be selected as the applicant's Contracting Party. That Contracting Party must be specified by the applicant in any international application governed exclusively or partly by the 1999 Act (as regards the determination of the applicant's Contracting Party, see paragraphs B.II.02.08 et seq).

04.20 The indication of the State of origin under the 1960 Act is not required in international applications since such indication does not have any effect on the examination carried out by the International Bureau. It may however be deduced through the indications of the entitlements claimed in the international application form (as regards the determination of the State of origin, see paragraphs B.II.02.08 et seq).

Item 5: Appointment of a Representative

Rules 3 and 7(5)(b) 04.21 If the applicant wishes to be represented before the International
A.I. Section 301 Bureau, the name and address of the representative should be given in this part of the form. The information should be sufficient to enable correspondence to be sent to the representative, and should preferably include telephone and facsimile numbers and any email address. For E-filing, the email address has to be indicated as the International Bureau will confirm receipt of the international application at that email address.

A.I. Section 301(c) 04.22 Where the name of the representative is in characters other than Latin characters, the name must be indicated as a transliteration into Latin characters, following the phonetics of the language of the international application. Where the representative is a legal entity, the transliteration may be replaced by a translation into the language of the international application.

Rule 3(2)(a) 04.23 In order to give effect to the appointment of a representative, the international application form must either be signed by the applicant at item 14 or be accompanied by a power of attorney, and the appropriate box should be ticked in item 5. For E-filing, a power of attorney shall be scanned and attached to the electronic application form. The attachment shall be in the image formats JPEG or

TIFF and shall not exceed the file size of 2 megabytes. If the application is not signed by the applicant and a power of attorney cannot be provided at the time of filing, the application may nonetheless be submitted, bearing in mind that a power of attorney must be received as soon as possible to avoid delaying treatment of the application.

04.24 The Hague system does not contain any restriction or requirement as to who may be appointed as representative before the International Bureau (concerning, for example, professional qualification, nationality or residence). It follows that an applicant may appoint a representative residing or carrying on business in a Contracting Party which is not the State of origin or the applicant's Contracting Party, and it is not even necessary that the representative be residing or carrying on business in a Contracting Party.

04.25 The appointment of a representative in the international application empowers the representative to act only before the International Bureau. It may subsequently become necessary to appoint one or more further representatives to act before the Offices of designated Contracting Parties, for example, in the event of a refusal of protection notified by such an Office. In such case, the appointment of a representative is governed by the requirements of the Contracting Party concerned.

04.26 The International Bureau records in the International Register the appointment of a representative and any other relevant fact concerning such representative.

Item 6: Identity of the Creator of the Industrial Design

04.27 As a matter of principle, the identity of the creator of the designs is an optional indication which may be included in any international application. However, such indication may be mandatory in some circumstances under the 1960 and/or the 1999 Act.

60 Article 8(4)(a)

04.28 Under the 1960 Act, the law of a Contracting Party may require such information where it is designated under that Act (without the need to make a corresponding notification to the Director General of WIPO). Therefore, whenever such a Contracting Party is designated under the 1960 Act, the international application should contain the identity of the creator. Failure to provide this indication may lead to a refusal of protection being issued by the Office of the Contracting Party in question. However, given that the requirement to furnish the identity of the creator does not have to be notified to the Director General of WIPO under the 1960 Act, the International Bureau does not carry out an examination in that respect.

99 Article
5(2)(b)(i)

04.29 Under the 1999 Act, any Contracting Party whose Office is an Examining Office and whose law requires that an application for the grant of protection to an industrial design should contain the identity of the creator in order for that application to be accorded a filing date may, in a declaration, notify the Director General of WIPO accordingly. In addition, any Contracting Party to the 1999 Act whose legislation requires an application for the registration of an

99 Article 10(2)(b)

Rule 7(4)(b)
Rule 8(1)

industrial design to be filed in the name of the creator of the design may notify that fact to the Director General of WIPO. In the latter case, if the person identified as the creator is other than the applicant, when designating the Contracting Party having made such a declaration, the applicant also states under item 10 of the form that the present international application has been assigned by the creator to him and that the creator declares that he believes himself to be the creator of the industrial design (see paragraphs A.1.05.13 and B.II.04.50). Where any such Contracting Party as mentioned above is designated under the 1999 Act, the international application should contain the identity of the creator. In default, the international application is considered as irregular (see paragraph B.II.06.06 *et seq.*). Both the paper form (DM/1) and the E-filing interface clearly indicate in respect of which Contracting Parties this indication is required.

Item 7: Number of Industrial Designs, Reproductions and/or Specimens

04.30 The following must be indicated in item 7 of the international application form:

- Rule 7(3)(v)*
- (a) the total number of industrial designs included in the international application – which may not exceed 100,
 - (b) the total number of reproductions, in black and white, and in color,
 - (c) the total number of A4 pages comprising reproductions (see paragraphs B.II.05.01 *et seq.*), and
 - (d) the total number of specimens, if any (see paragraphs B.II.05.16 and 05.16).

04.31 For E-filing, paragraphs (a) and (b) under item 7 will be filled in automatically based on the information and reproductions provided. Information in respect of paragraph (c) is not relevant when filing electronically. Furthermore, E-filing is unavailable if the application includes specimens of the industrial design(s) instead of reproductions.

Item 8: Products Which Constitute the Industrial Design or in Relation to Which It Is to Be Used

- 60 Article 5(2)*
99 Article 5(1)(iv)
- 04.32 Item 8 provides for a table in which the applicant must indicate what the industrial designs consist of. Such indication must be considered differently, depending upon whether one is concerned with a two-dimensional or a three-dimensional design :

– if the industrial design consists of a product, the usual generic name of that product should be indicated, for example: “chair”;

– if the industrial design consists of a decorative motif in two-dimensions destined to be used in relation to a product, that product should be indicated, for example: “drawing to be used on dishes” or “motif for textiles”.

04.33 These indications must be given for each industrial design, in numerical order.

Rule 7(7) 04.34 The applicant may also indicate the (single) class of the Locarno Classification to which those industrial designs belong. In the case of several designs included in the same international application, all those designs must belong to the same class of the Locarno Classification (see paragraph A.02.09).

04.35 In addition, in the right-hand side of the table, the sub-class to which the product(s) concerned belong may also be indicated.

04.36 The indications relating to the class and sub-class(es) are not compulsory and therefore failure to provide them does not result in an irregularity being raised by the International Bureau. However, if the International Bureau finds that several designs included in the same international application belong to different classes of the Locarno classification, this constitutes an irregularity which will have to be remedied (see paragraph B.II.06.06).

Item 9: Description

Rule 7(5)(a) 04.37 As a matter of principle, the description of the industrial designs is an optional indication which may be included in any international application. Only the characteristic features that appear in a reproduction should be described. The description should not disclose technical features of the operation of an industrial design, or its possible utilization. If the description exceeds 100 words, an additional fee of 2 Swiss francs per word exceeding 100 is payable.

Rule 7(4)(b) 04.38 However, under the 1999 Act, any Contracting Party whose Office is an Examining Office and whose law requires that an application for the grant of protection to an industrial design should contain a description in order for that application to be accorded a filing date may, in a declaration, notify the Director General of WIPO accordingly. Where such Contracting Party is designated under the 1999 Act, the international application should contain the required description. Failure to provide the necessary description results in the international application being considered as irregular and may entail the postponement of the date of the international registration (see paragraph B.II.06.07). Both the paper form (DM/1) and the E-filing interface clearly indicate in respect of which Contracting Parties the description is required.

A.I. Section 403 04.39 The description may also serve as a way of disclaiming protection in respect of some characteristics of the industrial designs.

Item 10: Designated Contracting Parties

- 60** Article 5(2) 04.40 The applicant must, by ticking the appropriate box, designate each
99 Article 5(1)(v) Contracting Party where protection is sought.
Rule 7(3)(vi)

What Contracting Parties May Be Designated?

04.41 Each designated Contracting Party must be bound by an Act - the 1999 Act and/or the 1960 Act – to which one of the Contracting Parties indicated in item 3 (*Entitlement to File*) is also bound. A table of Contracting Parties, with an indication of the Act or Acts to which each particular State is party, is annexed to official form DM/1. In the E-filing interface, the selection of Contracting Parties that may be designated is determined automatically on the basis of the entitlement to file data provided under item 3.

04.42 For example, if an applicant has indicated that he has an establishment only in Country A, which is bound exclusively by the 1999 Act, and has not indicated any other entitlements, he may only designate Contracting Parties which are bound by the 1999 Act, whether or not such Contracting Parties are also bound by the 1960 Act. He may not, however, designate Contracting Parties bound exclusively by the 1960 Act.

04.43 If, instead, the applicant has indicated that he has an establishment in Country A, which is bound by the 1960 Act, and that he also has a domicile in Country B, which is bound by the 1999 Act, the application may cumulatively designate Contracting Parties which are party to either the 1960 Act exclusively, the 1999 Act exclusively, or to both the 1960 Act *and* the 1999 Act.

04.44 A special case of plurality of entitlements arises in respect of States members of an intergovernmental organization that is a Contracting Party, where those States are themselves bound by the 1960 Act. For example, an applicant having the nationality of Contracting Party A, bound *exclusively* by the 1960 Act, that is a member State of the European Union, could, as a result, designate all Contracting Parties bound by the 1960 or 1999 Acts, as the European Union is a Contracting Party to the 1999 Act.

04.45 Where an applicant enjoying a plurality of independent entitlements under the 1960 and 1999 Acts designates a Contracting Party bound by the same Acts, the designation of that Contracting Party will be governed by the 1999 Act (see paragraphs A.04.13 to 04.15).

04.46 It is essential that an applicant designates, at the time of filing of the international application, *all* those Contracting Parties where it is intended to seek protection for an industrial design. If it subsequently becomes necessary to extend protection to additional Contracting Parties, this can only be done by means of filing a new international application.

Protection in the State of Origin and in the Applicant's
Contracting Party

04.47 As a matter of principle, it is possible for an applicant under the Hague system to request protection in the State of origin and in the applicant's Contracting Party (see paragraphs B.II.02.08 *et seq.*).

60 Article 7(2) 04.48 The 1960 Act provides as a principle that an international registration has effect in the State of origin, unless otherwise specified in its national legislation. Given that information concerning such exclusion is not required to be communicated to the Director General of WIPO, the International Bureau does not carry out an examination in that respect.

99 Article 14(3) 04.49 The 1999 Act expressly provides that any Contracting Party whose Office is an Examining Office may, in a declaration, notify the Director General of WIPO that, where it is the applicant's Contracting Party, its designation in an international registration has no effect. Where a Contracting Party which has made that declaration is indicated in an international application both as the applicant's Contracting Party and as a designated Contracting Party, the International Bureau disregards the designation of the Contracting Party in question.

Application filed in the Name of the Creator

Rule 8(1) 04.50 If the person identified as the creator in item 6 of the application form is other than the applicant, through designating the Contracting Party having made a declaration under Rule (8)(1) that its legislation requires an application for the registration of an industrial design to be filed in the name of the creator of the design, the applicant states that the present international application has been assigned by the creator to him and that the creator declares that he believes himself to be the creator of the industrial design (see paragraphs A.05.13 and B.II.04.29).

Item 11: Priority

60 Article 5(2) 04.51 Priority of an earlier filing may be claimed under Article 4 of the Paris
99 Article 6(1)(a) Convention. Priority may be claimed on the basis of a first filing made in one of the States party to the Paris Convention or any member of the World Trade Organization.

04.52 Conversely, since an international application for registration of industrial designs may be a *first* application under the Hague system, it may itself also serve as a basis for claiming priority with regard to a subsequent national or regional application.

04.53 Where it is intended to claim priority, this should be indicated in item 11, by ticking the appropriate box, whether the priority relates to a single earlier filing or whether multiple priorities are claimed.

Rule 7(5)(c) 04.54 Where priority is claimed, there must be indicated the name of the Office with which the earlier filing was made, together with the number of the earlier filing (if available), and the date of the earlier filing (in the order of day, month and year). Where priority is claimed from more than one earlier filing and all the relevant indications cannot be accommodated in the space provided, then (unless a self-generated form is used) those with the earliest date should be indicated in item 11 and the remainder should be set out on a continuation sheet.

04.55 Where the earlier filing does not relate to all the designs included in the international application, the applicant has the option of indicating either those designs for which priority is claimed, or is not claimed, depending on which is more convenient. Such indication should be made by reference to the numbers of the designs in question. If no indication is made in this part of item 11, it will be assumed by the International Bureau that the priority relates to *all* the designs.

04.56 The International Bureau disregards any claimed priority which bears a date which is more than six months earlier than the filing date of the international application, and so informs the applicant (and, if the international application has been filed through an Office, that Office).

04.57 Where an applicant claims the priority of an earlier application, copies of the earlier application documentation upon which priority is based should not be included with the international application sent to the International Bureau. The International Bureau confines itself to establishing only that the required particulars have been included in the international application form. This does not preclude an Office from requesting that the holder, in any particular case, furnish a copy of the priority document to it directly. Such a request could, for example, be made in the context of a refusal where the Office takes the view that the priority document is necessary in order to establish novelty, because of disclosure during the period covered by the priority claim.

Item 12: International Exhibition Priority

Rule 7(5)(d) 04.58 Temporary protection of designs exhibited at certain exhibitions may be claimed under Article 11 of the Paris Convention. If it is intended to claim exhibition priority in the international application, the applicant should so indicate, by ticking the relevant box in item 12 of the international application form.

04.59 In addition, the application form must indicate where the exhibition took place, the date on which the product was first exhibited and the number of each industrial design shown at the exhibition.

04.60 Where the claim does not relate to all the designs included in the international application, then the applicant has the option of indicating either those designs for which exhibition priority is claimed, or is not claimed, depending on which is more convenient. If no design is indicated, it is assumed by the International Bureau that all the designs were shown at the exhibition in question.

Item 13: Publication of the International Registration

04.61 If the reproductions, or some of the reproductions, are submitted in color, they will be published in color. However, if the applicant requires the publication in black and white, this should be indicated by ticking the appropriate box in item 13 of the international application form.

Rule 17(1)(iii) 04.62 With regard to the timing of publication, the general rule is that publication takes place six months after the date of the international registration, unless the applicant requests otherwise (see paragraphs B.II.07.08 *et seq.*). The period of six months takes account of the fact that, under some national and regional laws on the protection of industrial designs, deferment of publication is not allowed but a certain period of time elapses before the registration of an industrial design is published, since the examination (whether it be formal or substantive) and the technical preparations for publication require that period of time. Therefore, by providing for the period of six months, the Common Regulations, in effect, grant to the holder of an international registration the same benefit of *de facto* deferment that he would have enjoyed if he had filed national and regional applications.

04.63 There are two exceptions to the general rule that an international registration is published six months after the date of the international registration, namely, where an applicant requests immediate publication or requests deferment of publication.

Immediate Publication

Rule 17(1)(i) 04.64 An applicant may request immediate publication by ticking the appropriate box in item 13. There may be situations where early publication could be an advantage. For instance, under a national or regional law it may be the case that the right flowing from registration of an industrial design may only be enforced after it has been published. However, the notion of “immediate” publication should in any event also take account of the time required by the International Bureau to carry out the relevant technical preparations.

Deferred Publication

Rule 17(1)(ii) 04.65 An applicant may request that publication of the international registration be deferred, by ticking the appropriate box at item 13 on the international application form. In such case, the period of deferment which is required should be indicated in the appropriate part of this item, expressed in months.

04.66 With regard to the duration of deferment which may be requested, see paragraphs B.II.07.16 *et seq.* Both the paper form (DM/1) and the E-filing interface clearly indicate the periods of deferment which may be requested in respect of certain Contracting Parties.

Item 14: Signature by the Applicant or his Representative

Rule 7(1)
A.I. Section 202

04.67 The international application form may be signed by the applicant or his representative (or by an Office when the international application has been presented to the International Bureau through that Office). The signature may be replaced by the affixing of a seal. In either case, the name of the signatory should be indicated separately.

Name of Contact Person

04.68 It is not obligatory, but may be useful, for the applicant to indicate the name of the person to contact, if necessary. This may be particularly of interest where the international application is filed in the name of a legal entity.

Item 15: Office Presenting the Request (if applicable)

Date of Receipt

04.69 If an international application, governed exclusively by the 1999 Act, has been presented to the International Bureau through an Office, the Office should indicate the date on which it received the international application. This date is important since it will become in principle the date of the international registration (see paragraph B.II.08.03).

Payment of Fees and Fee Calculator

The following paragraphs should be read in conjunction with the general remarks in paragraphs B.I.05.01 et seq concerning fees.

04.70 There must be indicated, on the fee payment sheet which precedes the Fee Calculations Sheet and forms part of the international application form:

– an authorization to debit the required amount from an account opened with the International Bureau (indicating also the name of the holder of the account, the account number and the identity of the party giving the authorization),
or

– the amount of fees being paid, the method by which payment is being made and the identification of the party making the payment.

04.71 Where the former method is adopted, it is not then necessary to specify the amount of the fees in question. This has the advantage of avoiding the risk of a fees irregularity.

Fees Due

Rule 12(1) 04.72 The fees payable in connection with an international application consist of:

(i) a basic fee;

(ii) a standard designation fee (level one, two or three) or, where a designated Contracting Party is one in respect of which an individual designation fee is payable, that fee (see paragraph B.I.05.04);

(iii) a publication fee, consisting of an amount to be paid in respect of each reproduction to be published and, where these reproductions are shown on a page of A4 format (see paragraphs B.II.05.01 *et seq*), an amount to be paid in respect of each such page, in addition to the first.

04.73 For international applications filed by applicants whose sole entitlement is a connection with a Least Developed Country (LDC), in accordance with the list established by the United Nations, or with an intergovernmental organization the majority of whose member States are LDCs, the fees intended for the International Bureau are reduced to 10% of the prescribed amounts (rounded to the nearest full figure). The reduction also applies in respect of an international application filed by an applicant whose entitlement is not solely a connection with such an intergovernmental organization, provided that any other entitlement of the applicant is a connection with a Contracting Party which is an LDC or, if not an LDC, is a member State of that intergovernmental organization and the international application is governed exclusively by the 1999 Act. If there are several applicants, each must fulfill the said criteria.

04.74 The reduction to 10% of the regular amount of the fee which is referred to in paragraph 04.73 also applies to the standard designation fees under the same conditions.

04.75 The Assembly of the Hague Union adopted, at its twenty-sixth (10th extraordinary) session, the following recommendation concerning individual fees:

“Contracting Parties that make, or that have made, a declaration under Article 7(2) of the 1999 Act or under Rule 36(1) of the Common Regulations are encouraged to indicate, in that declaration or in a new declaration, that for international applications filed by applicants whose sole entitlement is a connection with a Least Developed Country, in accordance with the list established by the United Nations, or with an intergovernmental organization the majority of whose member States are Least Developed Countries, the individual fee payable with respect to their designation is reduced to 10% of the fixed amount (rounded, where appropriate, to the nearest full figure). Those Contracting Parties are further encouraged to indicate that the reduction also applies in respect of an international application filed by an applicant whose entitlement is not solely a connection with such an

intergovernmental organization, provided that any other entitlement of the applicant is a connection with a Contracting Party which is a Least Developed Country or, if not a Least Developed Country, is a member State of that intergovernmental organization and the international application is governed exclusively by the 1999 Act.”

Rule 12(2) 04.76 These fees are payable at the time of filing the international application, except that, where the international application contains a request for deferment of publication, the publication fee may be paid later (see paragraph B.II.07.13). In such case the applicant should tick the appropriate box on the fee payment sheet.

04.77 The amounts of the basic fee, the standard designation fee and the publication fee are set out in the Schedule of Fees comprised in the Common Regulations. With regard to individual fees, users should refer to the WIPO website (www.wipo.int/hague/en) where details of individual fees are published and updated in the form of *Information Notices*.

04.78 In addition, there is also available on the WIPO website a fee calculator which takes into account all the possible fee permutations, depending upon the particular Contracting Parties designated in any given international application, the number of industrial designs, etc.

04.79 As far as E-filing is concerned, the fee calculator automatically calculates and indicates the fees to be paid, based on the data entered by the applicant.

05. THE REPRODUCTIONS OF THE INDUSTRIAL DESIGNS

Mode of Reproduction

Rule 9(1)
99 Article 5(1)(iii)
A.I. Section 401(a) 05.01 The reproductions of the designs for which registration is sought may be in the form of photographs or other graphic representations of the industrial designs, or of the products which constitute the industrial designs. A single international application may at the same time comprise both photographs and graphic representations, which may be in black and white or in color.

A.I. Section 401(c)
A.I. Section 401(d) 05.02 The reproductions accompanying an international application filed on paper should be either pasted or printed directly onto a separate sheet of A4 paper which is white and opaque. The separate sheet of paper should be used upright and should not contain more than 25 reproductions. The reproductions should be arranged in the orientation in which the applicant wishes them to be published. Where the application is filed on paper a margin of at least five millimeters should be left around the representation of each industrial design.

- A.I. Section 401(e)* 05.03 Each reproduction should fall within a right-angled quadrilateral containing no other reproduction, or part of another reproduction, and no numbering. The term 'right angled quadrilateral' is intended to include both squares and rectangles. The reproductions should not be folded, stapled or marked in any way.
- 05.04 For E-filing, any reproduction accompanying an international application shall be in the image formats JPEG or TIFF, its file size shall not exceed 2 megabytes, and it shall be in RGB (not CMYK) color mode.
- A.I. Section 402(a)* 05.05 The reproductions should represent the industrial design alone, or the product in relation to which the industrial design is to be used, to the exclusion of any other object, accessory, person or animal. Thus, for example, if protection is sought for a bowl, the bowl should be represented without fruit, or a frame for which protection is sought should be represented without a picture.
- A.I. Section 402(c)* 05.06 Technical drawings showing articles in section or in plan, particularly with axes, dimensions, explanatory text or legends, are not acceptable.
- A.I. Section 404(a)* 05.07 If the reproductions consist of photographs, such photographs must be of professional standard and have all their edges cut at right angles. In such case, the industrial design must be shown against a neutral plain background and photographs may not be retouched with ink or correcting fluid.
- A.I. Section 404(b)* 05.08 If the reproductions consist of other graphic representations, they must be of professional standard and produced with drawing instruments or by electronic means and, where the application is filed on paper, must be produced on good quality white, opaque paper, and have all their edges cut at right angles. The representation may comprise shading and hatching to provide relief. Graphic representations executed by electronic means may be shown against a background, provided that it is neutral and plain and has only edges cut at right angles.

Disclaimer

- A.I. Section 403* 05.09 Matter which is shown in a reproduction, but for which protection is not claimed, may be indicated by means of dotted or broken lines, and/or in the description (see paragraph B.II.04.39).

Number of Reproductions

- Rule 9(1)(b)*
A.I. Section 401(b) 05.10 There is no limit on the number of reproductions which can be submitted for each design included in an international application. Only a single copy of each reproduction should be submitted (by default, reproductions are published in color). An applicant wishing to obtain the maximum protection for a design should ensure that the design is fully represented, as only aspects visible in the reproduction will be protected. It may be necessary, therefore, to represent a single article from many angles and submit several different views. However, several views shown from different angles may not be included in a single reproduction. Each view must be represented separately.

Numbering of Reproductions

A.I. Section 405 05.11 Where there are several designs included in an international application, each design must be identified by an individual number appearing in the margin of each reproduction. The E-filing interface automatically proceeds to the numbering of the reproductions filed by the applicant. When the same design is represented from different angles, the numbering must consist of two separate figures, separated by a dot (for example, 1.1, 1.2, 1.3, etc., for the first design, and 2.1, 2.2, 2.3, etc., for the second design, and so on). In such case, the reproductions should be submitted in ascending numerical order.

05.12 An applicant may choose to submit different views of the same industrial design, in order either to illustrate all the characteristic features of a three-dimensional design or to comply with the requirement of the law of a designated Contracted Party which has made a declaration whereby it requires certain specified views of the product concerned (see paragraph A.05.10).

Dimensions of the Reproductions

A.I. Section 402(b) 05.13 The dimensions of the representation of each industrial design appearing in a photograph or other graphic representation may not exceed 16 x 16 centimeters, and one of those dimensions must be at least 3 centimeters.

05.14 In respect of E-filing, any reproduction shall be in a combination of pixel number and resolution such that, when that reproduction is printed, the dimensions of the reproduction of each design appearing in a photograph or other graphic representation will not exceed 16 x 16 centimeters, and one of those dimensions will be at least 3 centimeters.

Quality of the Reproductions

Rule 9(2)(a) 05.15 Reproductions must be of a quality permitting all the details of the industrial design to be clearly distinguished and permitting publication. The reproductions which accompany an international application should be of the highest possible quality, since, in the final analysis, it is upon the content and quality of the reproductions that the scope of protection will depend.

Filing of Specimens Under the 1999 Act

Rule 10(1) 05.16 Where an international application is governed exclusively by the 1999 Act, it is permissible in certain limited circumstances to substitute reproductions by specimens. This is possible where the international application:

- is governed *exclusively* by the 1999 Act, and
- contains a request for deferment of publication, and

- concerns a two-dimensional industrial design.

05.17 Where specimens are submitted instead of reproductions, the applicant must furnish one specimen for the International Bureau and one further specimen for each designated national Office that has notified the International Bureau that it wishes to receive copies of international registrations. This requirement aims at enabling Examining Offices to take into account the industrial designs which are the subject of the international registration when carrying out the novelty examination provided for by their domestic legislation (see paragraph B.II.09.02 *et seq*).

Filing of Specimens Under the 1960 Act

- 60 Article 5(3)(b)** 05.18 In the case of an international application is governed exclusively or partly by the 1960 Act, the application *may* be accompanied *also* by specimens. This means that the filing of specimens is optional but does not exempt the applicant from the requirement to furnish a reproduction of the designs.

Requirements Concerning Specimens

- Rule 10(2)* 05.19 All the specimens should be contained in a single package. None of the dimensions of the package should exceed 30 centimeters and the overall weight of the package and its packing should not exceed four kilograms.
- A.I. Section 406(b)*
- A.I. Section 406(a)* 05.20 The individual specimens may be folded and may not exceed 26.2 centimeters x 17 centimeters in size (unfolded), 50 grams in weight, or 3 millimeters in thickness. The specimens should also be pasted on sheets of A4 paper and numbered in ascending numerical order. If, and when, in due course, the reproductions are submitted to the International Bureau, the number assigned to each reproduction should be the same as the number assigned to each corresponding specimen.
- A.I. Section 406(c)* 05.21 Perishable products or products which may be dangerous to store are not accepted by the International Bureau.

No Additional Matter

- Rule 7(6)* 05.22 If the international application contains any matter other than that required or permitted by the 1999 Act, the 1960 Act, the Common Regulations or the Administrative Instructions, the International Bureau deletes it *ex officio*. If the international application is accompanied by any document other than those required or permitted, the International Bureau may dispose of such document.

06. PRESENTATION OF THE INTERNATIONAL APPLICATION TO THE INTERNATIONAL BUREAU

Channels of Communication

06.01 An international application is normally sent directly by the applicant or his representative to the International Bureau. However, a number of exceptions to that principle are provided for by the 1960 and the 1999 Acts.

60 Article 4 06.02 Under the 1960 Act, an international application may be filed through the Office of a Contracting State if such State so permits. In addition, a Contracting State may *require* that, where it is considered to be the State of origin, the deposit be filed through its national Office. To the extent that such requirement is not required to be notified to the Director General of WIPO under the 1960 Act, the International Bureau does not check whether an international application governed exclusively or partly by the 1960 Act has been presented through the Office of the State of origin pursuant, where applicable, to the law of that Contracting State. Non-compliance with this requirement shall not prejudice the effects of the international deposit in the other Contracting States.

*99 Article 4
Rule 13(2)* 06.03 Under the 1999 Act, it is possible for Contracting Parties to prohibit the indirect route, but they are not allowed to impose it. Where an international application is presented to the International Bureau through the intermediary of an Office, that Office may fix, and collect for its own benefit, a fee to cover the cost of the work involved in handling the international application. An Office that requires a transmittal fee must notify the International Bureau of the amount of such fee, which should not exceed the administrative costs of receiving and transmitting the international application, and its due date.

Rule 13(3) and (4) 06.04 Where an international application governed exclusively or partly by the 1999 Act is addressed to the International Bureau through the Office of the applicant's Contracting Party, it must be received by the International Bureau within a period of one month from the date of receipt by that Office. However, that period may not be sufficient for a Contracting Party whose law requires a security clearance. The possibility has therefore been provided for such a Contracting Party to notify the replacement of the period of one month by a period of six months. If the applicable time limit is not complied with, the filing date of the international application is the date of its receipt by the International Bureau.

Filing Date of the International Application

06.05 Provided that the international application does not contain any irregularities entailing a postponement of the filing date (see paragraph B.II.06.07), the International Bureau allocates to the international application a filing date in accordance with the following principles:

Rule 13(3)(ii) – in the case of direct filings, and in the case of indirect filings of international applications other than international applications governed exclusively by the 1999 Act, the filing date is the date of receipt by the International Bureau of the international application (see paragraphs B.I.01.04 *et seq*);

Rule 13(3)(i) and (4) – in the case of indirect filings of international applications governed exclusively by the 1999 Act, the filing date is the date on which the application was received by the Office of the applicant's Contracting Party concerned, *provided* that it is received by the International Bureau within one month of that date or within six months in case of security clearance (see paragraphs A.05.14 and B.II.06.04). If that time limit is not complied with, the filing date of the international application is the date of its receipt by the International Bureau.

Irregularities in the International Application

Time Limit for Correcting Irregularities

Rule 14(1) 06.06 If the International Bureau finds that the international application does not, at the time of its receipt by the International Bureau, fulfill the applicable requirements, it invites the applicant to make the required corrections within three months from the date of the invitation sent by the International Bureau. Where an irregularity is not remedied within this three-month time limit, the international application is considered abandoned and the International Bureau refunds any fees paid in respect of that application, after deduction of an amount corresponding to the basic fee.

Rule 14(3)

Irregularities Entailing a Postponement of the Filing Date of the International Application

Rule 14(2) 06.07 Where the international application has, on the date on which it is received by the International Bureau, an irregularity which is prescribed as an irregularity entailing a postponement of the filing date, the filing date is the date on which the correction of such irregularity is received by the International Bureau. The irregularities which are prescribed as entailing a postponement of the filing date of the international application are the following:

(a) the international application is not in one of the prescribed languages;

(b) any of the following elements is missing from the international application:

(i) an express or implicit indication that international registration under the 1999 Act or the 1960 Act is sought;

(ii) indications allowing the identity of the applicant to be established;

(iii) indications sufficient to enable the applicant or its representative, if any, to be contacted;

(iv) a reproduction, or, in accordance with Article 5(1)(iii) of the 1999 Act, a specimen, of each industrial design that is the subject of the international application;

(v) the designation of at least one Contracting Party.

Irregularities Concerning the Prohibition on Self-Designation

99 Article 14(3) 06.08 Where a Contracting Party designated under the 1999 Act, whose Office is an Examining Office, has made the declaration prohibiting its self-designation (see paragraph A.05.22) and is indicated in an international application both as the applicant's Contracting Party and as a designated Contracting Party, the International Bureau disregards the designation of that Contracting Party.

Irregularities Concerning Special Requirement Notified by a Contracting Party or Regarding the Identity of the Creator, Description and Claim

06.09 In the case of an irregularity which relates either:

– to a special requirement notified by a Contracting Party concerning the applicant (see paragraph A.05.13), or

– to one of the additional elements which has been notified by a Contracting Party under Article 5(2) of the 1999 Act (namely, indications concerning the identity of the creator, a brief description and/or a claim; see paragraph B.II.03.03),

if the applicant does not remedy such irregularity within the prescribed time limit of three months, the international application is deemed not to contain the designation of the Contracting Party in question.

06.10 Furthermore, if the applicant does remedy an irregularity which relates to Article 5(2) of the 1999 Act, the date of the international registration is the date on which the correction of such irregularity is received by the International Bureau or the filing date of the international application, whichever is the later.

07. PUBLICATION OF THE INTERNATIONAL REGISTRATION

- 99 Article 10(3)(a)** 07.01 Centralized publication of an international registration having effect in
60 Article 6(3) all the designated Contracting Parties is one of the fundamental features of the
Rule 17 international registration system. International registrations are published by the
International Bureau in the *International Designs Bulletin* and such publication is
deemed, in all Contracting Parties, to be sufficient publication and to take the place
of any national or regional publication, so that no other publication may be
required of the holder.
- 07.02 Nevertheless, a Contracting Party is not precluded from republishing
the international registration, in whole or in part, if it so wishes (for example, in
order to translate into its national language the particulars contained in the
international registration). However, in such a case, the republication may not
create for the holder an obligation to furnish further reproductions of the design or
an obligation to pay an additional fee to the Office of that Contracting Party.
- Rule 26(2)* 07.03 Publication of the *International Designs Bulletin* takes place on the
WIPO website. In addition to the relevant data concerning international
registrations, the Bulletin also contains data relating to refusals, invalidations,
changes in ownership, corrections, renewals, etc. Furthermore, the International
Bureau publishes any declaration made by a Contracting Party under the Acts or
the Common Regulations on the WIPO website.
- Rule 26(3)* 07.04 If so requested by the Office of a Contracting Party, the International
A.I. Section 204(d) Bureau communicates to the Office the date on which each issue of the Bulletin is
made available on the WIPO website. Such communication is made electronically
– by email – on the same day as the Bulletin is to appear on the WIPO website.
The publication by the International Bureau of each issue of the Bulletin on the
WIPO website is deemed to replace the “sending” of the Bulletin referred to in the
1999 and the 1960 Acts and will constitute, at the same time, the date of receipt of
the Bulletin by the Offices of the designated Contracting Parties.
- Rule 17(2)* 07.05 The publication of the international registration in the Bulletin contains
the following:
- the relevant data recorded in the International Register;
 - the reproduction or reproductions of the industrial design;
 - where publication has been deferred, an indication of the date on
which the period of deferment expired or is considered to have expired.

Publication Cycle

07.06 The publication cycle of the Bulletin can be broken down into two components: the frequency of publication and the time lag needed for the preparation of the Bulletin. The frequency of publication is the number of times the Bulletin is issued in a given year. The time lag is linked to the preparation work for the Bulletin and refers to the number of days that elapse between the last recording day considered for the insertion of data in a given issue of the Bulletin and actual date of publication of that issue.

07.07 Since January 1, 2012, the Bulletin is published on a weekly basis. In addition, the time required to prepare each issue of the Bulletin has also been shortened to one week.

Timing of Publication

Rule 17(1)(iii) 07.08 The general rule is that an international registration is published six months after the date of the international registration (see paragraph B.II.04.60 *et seq*).

07.09 There are two exceptions to the general rule that an international registration is published six months after the date of international registration.

Rule 17(1)(i) 07.10 Firstly, an applicant may request that an international registration be published immediately.

07.11 The reference to “immediately after the registration” should, however, be taken with some reservation. In effect, where immediate publication is requested, “immediately” should be read as meaning that the publication will take place as soon as the necessary technical preparations have been carried out after the registration of the industrial design, thus, in any event, involving the elapsing of a certain amount of time. For instance, taking into account the shortening of the publication cycle of the Bulletin and of the time lag (see paragraphs B.II.07.06 and 07.07), international registrations programmed for immediate publication and recorded in the International Register during the first week of May 2012 will be published in the issue of the Bulletin released at the end of the second week of May 2012; those recorded in the International Register during the last week of May 2012 will be published in the issue of the Bulletin released at the end of the first week of June 2012.

Rule 17(1)(ii) 07.12 The second exception to the general six-month period concerns those international registrations for which a deferment of publication has been requested. In such case, publication of the international registration takes place immediately after the date on which the period of deferment expired, or is considered to have expired.

Deferment of Publication

Consequences of Deferred Publication

Rule 16(3) 07.13 In the case of deferment of publication, the payment of the publication fee is not required to be made at the time of filing. In addition, in the case of international applications governed exclusively by the 1999 Act, the submitting of reproductions may be provisionally replaced by specimens, provided that the industrial design is two-dimensional. The rationale for permitting the furnishing of specimens instead of reproductions is the relieving of applicants of the higher costs of producing quality reproductions where, having requested deferment of publication, they may eventually decide not to proceed with publication (and protection) of the design. The payment of the publication fee and the submission of reproductions are, however, preconditions to the publication of the international registration, and must take place not later than three months before the period of deferment expires.

07.14 The obligation to furnish the publication fee, and where relevant, submit the reproductions, not later than three months prior to the expiry of the period of deferment applies also in the situation where the period of deferment is “considered to have expired”. This relates to the situation under Article 11(4)(a) of the 1999 Act and Article 6(4)(b) of the 1960 Act where an applicant requests earlier publication than that already indicated in the request for deferment.

Rule 16(5) 07.15 Failure to pay the publication fee or to submit the reproduction earlier than three months before the expiry of the period of deferment results in the cancellation of the international registration. Cancellation will be total in case of missing fees but only partial in case of missing reproductions.

Periods of Deferment

07.16 The conditions which regulate the applicable period of deferment in any given situation depend upon the laws of the various national or regional systems of the Contracting Parties designated in the international application, including the case of Contracting Parties which do not permit deferred publication at all.

60 *Article 6(4)(a)* 07.17 For Contracting Parties designated under the 1960 Act, the maximum period of deferment is 12 months.

99 *Article 11(1)*
Rule 16(1)(a) 07.18 Under the 1999 Act, the general principle is that each Contracting Party is assumed to permit the prescribed period of deferment of 30 months, unless it has notified, in a declaration to the Director General of WIPO, that it authorizes only a shorter period – or that it does not authorize deferment at all (see paragraphs A.05.07 and 05.08).

07.19 It follows that where an international application governed *exclusively* by the 1999 Act (i.e., in respect of which all the designated Contracting Parties have been designated under the 1999 Act) contains a request for deferment of publication, such deferment may in principle be requested for a period up to 30 months from the filing date, or where priority is claimed, from the priority date. However:

99 Article 11(2)(ii) – if such application includes the designation of one Contracting Party that has made a declaration in accordance with which the period of deferment under its legislation is less than the prescribed period of 30 months, then publication takes place on the expiry of the period stated in that declaration;

99 Article 11(2)(ii) – if such application includes the designations of more than one Contracting Party which have made a declaration in accordance with which the period of deferment is less than the prescribed period of 30 months, then publication takes place on the expiry of the shortest of the periods notified in those declarations;

– if such application includes the designation of a Contracting Party which has made a declaration in accordance with which deferment of publication is not possible at all under its law, it is subject to different treatment, depending upon whether the application is accompanied by reproductions or specimens of the filed design. The principles are as follows:

99 Article 11(3)(i) (i) if the international application is accompanied by reproductions of the design, the International Bureau notifies the applicant that the request for deferment of publication is incompatible with the designation of the Contracting Party concerned. If the holder does not withdraw the designation of that Contracting Party within one month from the date of the notification sent by the International Bureau, the request for deferment of publication is not taken into consideration;

Rule 16(2)

99 Article 11(3)(ii) (ii) if the international application is accompanied by specimens of the design, the International Bureau does not take into account the designation of the Contracting Party concerned and so notifies the applicant.

Rule 16(1)(b) 07.20 Where an international application is governed exclusively or partly by the 1960 Act (i.e., in respect of which at least one Contracting Party has been designated under the 1960 Act), deferment of publication cannot exceed 12 months from the filing date, or where priority is claimed, from the priority date of the application concerned. In other words, the designation of a Contracting Party under the 1960 Act can be considered as equivalent to the designation of a Contracting Party which has made a declaration for a deferment period of a maximum of 12 months.

Unofficial Notice of Expiry of Deferment Period

- Rule 16(3)(b)* 07.21 Six months before the expiry of the period of deferment of publication, the International Bureau sends an unofficial reminder notice to the holder of the international registration as well as to the holder's representative (if any), indicating the date by which the publication fee and the reproductions must be submitted.

Events During Period of Deferment

07.22 The deferment period is computed from the filing date of the international application, or from the claimed priority date, if any. During the period of deferment of publication, the following actions may be initiated by the holder with regard to the international registration:

Request for Earlier Publication

- 60 Article 6(4)(b)* 07.23 The holder may request earlier publication – i.e., publication prior to the expiry of the deferment period already requested – in respect of any or all of the designs contained in the international registration. The deferment period is then considered to have expired on the date on which the request for earlier publication has been received by the International Bureau.
- 99 Article 11(4)(a)*

Request to Provide Extract or Authorize Access

- 07.24 It is a general principle that international applications and international registrations are kept secret by the International Bureau until publication. This principle of confidentiality also applies to any document accompanying the international application. However, there may be situations where the holder may wish no longer to preserve such confidentiality, for example, in order to assert his rights before a jurisdiction or third parties. Therefore, the holder may request the International Bureau to provide an extract of the international registration to a third party he has designated, or to authorize access to the international registration by a third party.
- 99 Article 11(4)(b)*

Renunciation or Limitation

- 60 Article 6(4)(b)* 07.25 The holder may renounce the international registration in respect of all the designated Contracting Parties. In such case, the industrial design or designs that are the subject of the international registration will not be published. The holder may also limit the international registration, for all the designated Contracting Parties, in respect of some only of the industrial designs that are the subject of the international registration. In such case, only the industrial designs that are not affected by the limitation will be published.
- 99 Article 11(5)*

A.I. Section 601 07.26 Where the publication of an international registration is deferred, a request for the recording of a limitation or renunciation concerning that registration, complying with the applicable requirements (see paragraphs B.II.15.01 *et seq* and 16.01 *et seq*), must be received by the International Bureau not later than three weeks prior to the expiry of the period of deferment. In default of this, the international registration is published at the expiration of the period of deferment without account being taken of the request for the recording of a limitation or renunciation. Provided that the request for limitation or renunciation complies with the applicable requirements, the limitation or renunciation is nevertheless recorded in the International Register.

*Furnishing of Confidential Copies to Examining Offices;
Confidentiality*

60 Article 6(4)(d) 07.27 As a general principle, the International Bureau keeps in confidence each international application and each international registration until publication in the Bulletin (see paragraphs B.II.07.01 to 07.05).
99 Article 10(4)

99 Article 10(5)(a) 07.28 However, when publication has been deferred, Examining Offices are faced with the situation in which they need to examine applications without knowing whether an international registration whose publication has been deferred is included in the prior art. In order to resolve this problem, immediately after registration has been completed, the International Bureau must send a copy of the international registration, along with any documentation accompanying the international application, to each Office that has notified the International Bureau that it wishes to receive such a copy and has been designated in an international application.

99 Article 10(5)(b) 07.29 In such case, the Office is required to maintain the confidentiality of the international registration until publication, and may use the documentation sent to it only for the purpose of the examination of other applications. It may not divulge the contents of the international registration to any persons outside the Office, except for the purposes of administrative or legal proceedings involving a conflict over entitlement to file the international application on which the international registration is based.

07.30 If an Examining Office concludes that an application concerns a design that is similar to a design that is the subject of an unpublished international registration resulting from an earlier application, of which it has received a confidential copy, it must suspend the prosecution of the later application until publication of the international registration, since it will not be able to divulge the content of the international registration to the holder of the later application.

07.31 The Office may notify the holder of the later application of the fact that prosecution of that application is suspended on account of possible conflict with an as yet unpublished registration resulting from an earlier application. If the later filing is also an international registration, the Examining Office will refuse the effect of that later international registration until the earlier unpublished international registration has been published and it has taken a decision regarding the conflict between the two registrations.

Rule 10(1)(ii) 07.32 If the international application is accompanied by a specimen, instead of a reproduction, the designated Examining Office receives a specimen at the same time as a copy of the international registration. In effect, therefore, the number of copies of specimens accompanying an international application in cases where specimens can take the place of reproductions (see paragraphs B.II.05.16 to 05.18) corresponds to the number of Contracting Parties designated in the international application under the 1999 Act, having an Examining Offices, and having made a notification under Article 10(5) of the 1999 Act – plus one copy for the International Bureau.

08. THE INTERNATIONAL REGISTRATION

Registration in the International Register

Rule 15(1) 08.01 Where the International Bureau finds that the international application conforms to the applicable requirements, it registers the industrial design in the International Register and sends a certificate to the holder. This is so, whether or not deferment of publication of the international registration has been requested.

Rule 15(2) 08.02 The international registration contains:

- all the data contained in the international application, except any priority claim where the date of the earlier filing is more than six months before the filing date of the international application;
- any reproduction of the industrial design;
- the date of the international registration;
- the number of the international registration;
- the relevant class of the International Classification, as determined by the International Bureau.

Date of the International Registration

08.03 As a matter of principle, the date of the international registration is the filing date of the international application (see paragraph B.II.06.05). However, where the international application has, on the date on which it is received by the International Bureau, an irregularity which relates to one of the additional elements which may be notified by a Contracting Party to the 1999 Act (namely the identity of the creator, a brief description and/or a claim; see paragraph B.II.06.09), the date of the international registration is the date on which the correction of such irregularity is received by the International Bureau or the filing date of the international application, whichever is the later.

09. REFUSAL OF PROTECTION

Notion of Refusal

09.01 Under the Hague Agreement, the word “refusal” does not mean a *final* decision of refusal, that is to say, a decision that is no longer subject to review or appeal. All that is required is that, within the applicable refusal period (see paragraphs B.II.09.07 *et seq*), a designated Office indicate the grounds which may be *liable* to lead to a refusal of protection. In other words, what must be notified within the applicable refusal period is simply a provisional objection. In practice, therefore, refusals may be based on:

– an objection (still provisional) resulting from the *ex officio* examination undertaken by an Office;

– an opposition lodged by a third party. It must be emphasized that, under the wording of the Hague Agreement, the simple fact of an opposition being lodged against an international registration must be notified to the International Bureau as a “refusal of protection based on an opposition”. This does not prejudice the eventual decision taken by the Office concerned on the opposition.

Grounds for Refusal

60 Article 8(1) 09.02 Each designated Contracting Party has the right to refuse, in its
99 Article 12(1) territory, the grant of protection to an international registration. Such refusal may be total or partial, in the sense that it may apply to all the designs which are the subject of the international registration or to some only of them.

09.03 Protection may not be refused on the grounds that the international registration does not satisfy formal requirements, since such requirements are to be considered by each Contracting Party as having already been satisfied following the examination carried out by the International Bureau. For example, a designated Office may not refuse protection on the ground that the required fees have not been paid or that the quality of the reproductions is not sufficient, since such verification is the exclusive responsibility of the International Bureau.

Rule 9(4) 09.04 Likewise, a Contracting Party may not refuse the effects of the international registration on the ground that requirements relating to the form of the reproductions that are additional to, or different from, those which may have been notified by that Contracting Party (see paragraphs B.II.05.10 *et seq*) have not been met. A Contracting Party may however refuse protection on the ground that a reproduction does not sufficiently disclose the appearance of the industrial design. In such a case, the reason for the refusal would be the substantive ground that the industrial design is not sufficiently disclosed, *not* the formal ground that the reproduction, for example, does not contain surface shading.

99 Article 13(2)
Rule 18(3)
A.I. Section 502

09.05 In the particular case where, following a notification of refusal based on lack of unity of design (see paragraph A.05.09), an international registration is divided before the Office of a designated Contracting Party in order to overcome such ground of refusal, the Office must notify the International Bureau of that fact, together with the following information:

- the Office making the notification;
- the international registration number concerned;
- the numbers of the industrial designs which are the subject of the division with the Office; and,
- the resulting national or regional application or registration numbers.

09.06 It is not within the competence of the International Bureau to express an opinion as to the justification of a refusal of protection or to intervene in any way in the settlement of the substantive issues raised by such a refusal.

Time Limits for Refusal

Rule 18
Rule 19(1)(a)(iii)

09.07 A refusal of protection must be notified to the International Bureau within a prescribed time limit. Any refusal sent after the expiry of that time limit will not be considered as such by the International Bureau (see paragraphs B.I.02.01 *et seq.*).

Rule 18(1)(a)

09.08 As a matter of principle, the time limit for the notification of a refusal is six months from the date of publication of the international registration.

Rule 18(1)(b)

09.09 However, any Contracting Party to the 1999 Act whose Office is an examining Office or whose law provides for opposition proceedings may declare that, for international registrations in which it is designated under the 1999 Act, the time limit of six months is replaced by a time-limit of 12 months.

A.I. Section 501

09.10 In order to determine whether a notification of refusal of protection meets the applicable time limit, it is the date of *sending* of the notification of refusal, by the Office concerned, which is decisive. In the case of a notification of refusal sent by mail, the date of sending is determined by the postmark. If the postmark is illegible or missing, the International Bureau will treat the notification as having been sent 20 days before the date on which it was actually received by the International Bureau; if, however, this date would be earlier than the date of any refusal or date of sending mentioned in the notification, the notification will be treated as having been sent on the latter date. In the case of a notification sent through a delivery service, the date of sending will be determined on the basis of the information recorded by the delivery service.

Procedure for Refusal of Protection

Rule 18(2)(a) 09.11 A notification of refusal must relate to only one international registration. It must also be dated and signed by the Office making the notification.

Contents of the Notification

Rule 18(2)(b) 09.12 A notification of refusal must contain the following information and indications:

- the Office making the notification;
- the number of the international registration;
- all the grounds on which the refusal is based, together with a reference to the corresponding essential provisions of the law;
- if the grounds refer to similarity with an industrial design that is the subject of an earlier national, regional or international application or registration, all relevant data concerning that industrial design, including the filing or registration date and number, the priority date (if any), a copy of a reproduction of the earlier industrial design (if the reproduction is accessible to the public, see paragraphs B.II.07.13 *et seq*) and the name and address of the owner of the industrial design in question³;
- if the refusal does not concern all the industrial designs that are the subject of the international registration, those to which it does or does not relate;
- if the refusal may be subject to review or appeal, the time limit, reasonable under the circumstances, for filing a request for review of, or appeal against, the refusal, and the authority to which such request for review or appeal lies; if such request for review or appeal must be filed through the intermediary of a representative whose address is within the territory of the Contracting Party whose Office has pronounced the refusal, this should also be indicated. In such a case, the requirements for appointment of a representative is governed by the law and practice of the Contracting Party concerned;

³ In the event of a refusal based on similarity with a design that is the subject of an earlier registration that has not been published (in particular because deferred publication has been requested), the Office will not be able to provide the data concerning the conflicting earlier design since it is required to keep the copy of that earlier registration secret. In such case it will have to indicate in its notification, as ground for refusal, similarity with an earlier unpublished registration. The holder of the later international registration should receive the detailed contents of the earlier registration once publication has taken place. The time limits applicable to a possible appeal against refusal would be set accordingly.

- the date on which the refusal was pronounced.

09.13 A refusal must state the grounds on which it is based in order to enable the holder to assess the appropriateness of challenging these grounds in a review or appeal procedure before the Office or other authority concerned.

09.14 The requirement to state in the notification of refusal all grounds on which the refusal is based does not prevent new grounds from being raised subsequently during the procedure before the Office, even after expiry of the time limit for refusal, as a result of the holder's reaction to the refusal, or during an appeal procedure lodged by the holder, since the latter is informed of those grounds under the procedure in question.

Recording and Publication of the Refusal; Transmittal to the Holder

Rule 18(5) and (6) 09.15 A refusal of protection is notified to the International Bureau by the Office of the Contracting Party concerned. The International Bureau records such refusal in the International Register (unless it is not considered as such; see paragraph B.II.09.18), publishes it in the Bulletin, and transmits a copy of the notification to the holder of the international registration concerned.

Language of the Notification of Refusal

09.16 The refusal may be notified to the International Bureau in English, French, or Spanish, at the option of the Office making the notification. The refusal is recorded and published. The holder receives from the International Bureau a copy of the notification of refusal, in the language in which it was sent by the Office of the designated Contracting Party.

Irregular Notifications of Refusal

09.17 There are two kinds of irregular refusals, those which can be remedied and those which entail that the notification of refusal is not considered as such by the International Bureau.

Rule 19(1)(a) 09.18 A notification of refusal is not regarded as such by the International Bureau (and is therefore not recorded in the International Register) if:

- it does not contain an international registration number (unless other indications contained in the notification permit the International Bureau to identify the international registration concerned);
- it does not indicate any grounds for refusal; or
- it was sent to the International Bureau after the expiry of the applicable refusal period (six months or 12 months, as the case may be; see paragraphs 09.07 *et seq.*).

Rule 19(1)(b) 09.19 In all three cases, the International Bureau nevertheless transmits a copy of the notification to the holder and informs him (and at the same time the Office that issued it) that it does not regard the notification of refusal as such, and indicates the reasons therefor.

09.20 It is useful for the holder of the international registration to receive from the International Bureau copies of such notifications of refusal (even if they have not been regarded as such, and consequently have not been recorded in the International Register), because this holder should be aware of potential grounds of refusal in the Contracting Party concerned. For example, a third party might initiate an invalidation action against the designation, based on the same grounds as were cited by the Office in the defective notification of refusal.

Rule 19(2) 09.21 If the notification is irregular in other respects (for example, it is not signed by the Office or it does not indicate the date of refusal), the International Bureau nonetheless records the refusal in the International Register and transmits a copy of the (irregular) notification to the holder. If the holder so requests, the International Bureau invites the Office concerned to rectify its notification without delay.

09.22 Where an Office rectifies a notification of refusal that specified a period for requesting review or appeal, it should also, where appropriate, specify a new period (for example, starting from the date on which the rectified notification was sent to the International Bureau), preferably with an indication of the date on which the new time limit expires.

Procedure Following Notification of Refusal

60 Article 8(3) 09.23 Where the holder of an international registration receives, through the
99 Article 12(3)(b) International Bureau, a notification of refusal, he has the same rights and remedies (such as review of, or appeal against, the refusal) as if the industrial design had been filed directly with the Office that issued the notification of refusal. The international registration is, therefore, with respect to the Contracting Party concerned, subject to the same procedures as would apply to an application for registration filed with the Office of that Contracting Party.

09.24 When lodging a request for review or an appeal against a decision of refusal or responding to an opposition, the holder may, even if this is not required by the law of the Contracting Party concerned, find it useful to appoint a local representative who is familiar with the law and practice (and the language) of the Office that pronounced the refusal. The appointment of such a representative is entirely outside the scope of the Hague Agreement and the Common Regulations, and is governed by the law and practice of the Contracting Party concerned.

Notification of Withdrawal of Refusal

- 99 Article 12(4)* 09.25 An Office which has issued a notification of refusal may withdraw the said notification, following, in particular, the lodging of an appeal by the holder.
Rule 18(4)(a)
- Rule 18(4)(b)* 09.26 A notification of withdrawal of refusal must contain the following information and indications:
- the Office making the notification;
 - the number of the international registration;
 - if the withdrawal does not concern all the industrial designs that are the subject of the refusal, those to which it does, or does not, relate;
 - the date on which the refusal was withdrawn.
- Rule 18bis(2)* 09.27 A withdrawal of refusal by an Office that has communicated a notification of refusal may also take the form of a statement to the effect that the Office concerned has decided to grant protection to the industrial designs, or some of the industrial designs, as the case may be, that are the subject of the international registration.
- Rule 18(5), (6)* 09.28 The International Bureau records any withdrawal of refusal or
and 18bis(3) statement of grant of protection in the International Register and transmits a copy to the holder. Such a withdrawal or statement is also published in the Bulletin.

10. STATEMENT OF GRANT OF PROTECTION

Statement of Grant of Protection in the Absence of a Prior Notification of Refusal

- Rule 18bis(1)(a)* 10.01 The Office of a designated Contracting Party which has not communicated a notification of refusal may, within the applicable refusal period, send to the International Bureau a statement to the effect that protection is granted to the industrial designs that are the subject of the international registration in the Contracting Party concerned.
- 10.02 However, no legal consequences result from the fact that such a statement of grant of protection has not been sent by an Office. It remains the case that the industrial designs that are the subject of the international registration are protected if no notification of refusal has been sent within the applicable refusal period.

Sending of a Statement of Grant of Protection

Rule 18bis(1)(b) 10.03 A statement of grant of protection should indicate the name of the Office that sent it and the number of the international registration to which it relates. Since, by definition, the statement must relate to all the industrial designs for which protection is sought in the Contracting Party concerned, the statement should not extend to some only of the industrial designs.

Rule 18bis(3) 10.04 The International Bureau records any statement of grant of protection in the International Register, informs the holder accordingly and, where the statement was communicated, or can be reproduced, in the form of a specific document, transmits a copy of that document to the holder. Such a statement is also published in the Bulletin.

11. EFFECTS OF THE INTERNATIONAL REGISTRATION

Effects of the International Registration in Respect of Contracting Parties Designated Under the 1999 Act

11.01 The 1999 Act provides for the recognition of, successively, two sets of effects to an international registration.

99 Article 14(1) 11.02 To begin with, the international registration has at least the same effect in each designated Contracting Party as a regularly-filed application under the law of that Contracting Party. Such effects, whose recognition by each Contracting Party is a minimum (“at least”) condition, commence on the date of the international registration. One of the consequences is that any Contracting Party that affords provisional protection to published *national or regional applications* must also afford that type of protection to published international registrations in which it is designated.

99 Article 14(2) 11.03 Subsequently, in each designated Contracting Party the Office of which has not notified a refusal of protection, the international registration has the same effect as a grant of protection under the law of that Contracting Party. The effects of a grant of protection start to run, at the latest, from the date of expiry of the applicable refusal period (six or 12 months, as the case may be).

99 Article 14(2)
Rule 18(1)(c) 11.04 Furthermore, a Contracting Party whose Office is an Examining Office, or whose law provides for the possibility of opposition to the grant of protection, may, by making the corresponding declaration to the Director General of WIPO, further derogate from the principle whereby an international registration must have the effect of a grant of protection at the latest from the date of expiry of the refusal period. Such a Contracting Party may specify that the international registration will have such effect at the latest:

– at a time specified in the declaration which may be later than the date of expiry of the applicable refusal period but which may not be more than six months after that date (in such case, the effect as a grant of protection begins at the time stated in that declaration), or

– at a time at which protection is granted according to the law of the Contracting Party where a decision regarding the grant of protection was unintentionally not communicated; in the latter case, the Office of the Contracting Party concerned should notify the International Bureau accordingly and endeavor to communicate its decision to the holder of the international registration promptly thereafter.

99 Article 14(2)(c) 11.05 The effect as a grant of protection, as described above, applies to the industrial design or designs that are the subject of that registration as received from the International Bureau by the designated Office or, where applicable, as amended in the procedure before that Office.

11.06 The words “at the latest” mean that each Contracting Party has the possibility of recognizing that the international registration has the effect of a grant of protection under its laws at an earlier date, for example as from the date of the international registration. Moreover, it is to be understood that, where a multiple international registration has been refused with respect to some only of the industrial designs contained in the registration, protection of the international registration under the applicable law is limited to those industrial designs that are not subject to the notification of refusal.

99 Article 14(2)(b) 11.07 Where a refusal of protection has been notified and subsequently withdrawn (totally or partially), the effects as a grant of protection under the law of the Contracting Party concerned must be afforded to the international registration, to the extent that the refusal is withdrawn, at the latest on the date of its withdrawal. Again in this case, the words “at the latest” mean that each Contracting Party has the possibility of recognizing that the effect of protection under its applicable law begins at an earlier date, for example retroactively as from the date of the international registration. The words “to the extent that the notification of refusal is withdrawn” indicate that, where a refusal is withdrawn with respect to some only of the industrial designs that were the subject of the notification, the protection under the applicable law does not extend to the designs with regard to which the refusal has not been withdrawn. Since a withdrawal of refusal may take the form of a statement of grant of protection, the foregoing applies where such a statement is issued in the context of a withdrawal of refusal (see paragraph B.II.09.27).

11.08 The Office of a designated Contracting Party may, within the applicable refusal period, send to the International Bureau a statement of grant of protection where it has not communicated a notification of refusal and has decided to accept the effects of an international registration (see paragraph B.II.10.01). In such a case, the international registration may have, in accordance with the law of the designated Contracting Party, the effect as a grant of protection, for example, as from the date on which the statement of grant of protection was issued, since each Contracting Party has the possibility of recognizing that the effect of protection begins at an earlier date. As regards the latest time at which protection must be granted, the principles explained in paragraphs B.II.11.03 and 11.04 remain applicable.

Effects of the International Registration in Respect of Contracting Parties Designated Under the 1960 Act

60 Articles 8(1)
and 11(1)(b)

11.09 If no refusal is notified within the prescribed time limit of six months by a Contracting Party designated under the 1960 Act, the international registration becomes effective in that Contracting Party as from the date of the international registration. However, in a Contracting Party having a novelty examination, the international registration becomes effective from the expiration of the refusal period unless the domestic law provides for an earlier date for registrations made with its national Office. Furthermore, if, under the provisions of the domestic law of a Contracting State having a novelty examination, protection commences at a date later than that of the international registration, the term of protection must be computed from the date at which protection commences in that State. The fact that the international registration is not renewed or is renewed only once shall in no way affect the terms of protection thus defined.

11.10 Where a refusal of protection has been notified and subsequently withdrawn (totally or partially), the effects under the law of the Contracting Party must be afforded to the international registration, in accordance with the principles mentioned in the previous paragraph (B.II.11.09).

11.11 Where a statement of grant of protection has been notified in the absence of a prior notification of refusal, the same considerations as outlined in paragraph B.II.11.08 apply (see paragraph B.II.10.01). As regards the latest time at which protection must be granted, the principles explained in paragraph B.II.11.09 remain applicable.

Term of Protection of International Registrations in Respect of Contracting Parties Designated Under the 1999 Act

99 Article 17

11.12 With respect to Contracting Parties designated under the 1999 Act, the international registration is effected for an initial period of five years and may be renewed for two additional five-year periods before each of those periods expires. Subject to renewal, the minimum duration of protection in each Contracting Party designated under the 1999 Act is therefore 15 years following the date of international registration.

11.13 Moreover, if the national legislation of a Contracting Party provides for a duration of protection in excess of 15 years for designs filed for registration by the national route, the international registration may be renewed with respect to that Contracting Party for additional periods of five years up to the expiry of the total duration of protection provided for in its national legislation.

Term of Protection of International Registrations in Respect of Contracting Parties Designated Under the 1960 Act

60 Article 11(1)(a) 11.14 With respect to Contracting Parties designated under the 1960 Act, the international registration is made for an initial period of five years and may be renewed for one additional period of five years. Subject to renewal, the minimum duration of protection in each Contracting Party designated under the 1960 Act is therefore 10 years following the date of international registration.

60 Article 11(2) 11.15 Moreover, if the national legislation of a Contracting Party provides for a duration of protection in excess of 10 years for designs filed for registration by the national route, the international registration may be renewed with respect to that Contracting Party for additional periods of five years up to the expiry of the total duration of protection provided for in its national legislation.

12. CHANGES IN THE INTERNATIONAL REGISTRATION

Types of Changes

12.01 A request for the recording of a change may relate to any of the following:

- Rule 21(1)(a)(i)* – change in ownership of an international registration (form DM/2);
- Rule 21(1)(a)(ii)* – change in the name and/or address of the holder (including address for correspondence) (form DM/6);
- Rule 21(1)(a)(iii)* – renunciation of the international registration in respect of any or all of the designated Contracting Parties (form DM/5);
- Rule 21(1)(a)(iv)* – limitation, in respect of any or all of the designated Contracting Parties, to one or some of the industrial designs that are the subject of the international registration (form DM/3).

Rule 21(1) 12.02 Where the request for the recording of a change concerns any of the above, such request must be presented to the International Bureau on the corresponding official form. The official forms are available for downloading from the Internet on the WIPO website, at www.wipo.int/hague.

13. CHANGE IN OWNERSHIP

99 Article 16(1)(i) 13.01 The ownership of an industrial design may change for various reasons and in different ways. A change in ownership may result from a contract, such as an assignment. Other reasons might be a court decision, or operation of law, such as an inheritance or bankruptcy, or from the merger of two companies.

Rule 21(2)(v) 13.02 The change in ownership of an international registration may relate to all the industrial designs covered by the international registration, or to some only of them. Similarly, the change in ownership may be in respect of all the designated Contracting Parties or some only of them.

13.03 The Common Regulations do not distinguish between such different causes for, or different types of, change in ownership. The uniform terminology “change in ownership” is used for all cases. Until the change has been recorded in the International Register, the former owner of the international registration is referred to as the “holder”, since this term is defined as the person or legal entity in whose name the international registration is recorded. The new owner is referred to as the “transferee”. Once the change in ownership has been recorded, the transferee becomes the holder of the international registration.

13.04 Furthermore, the issue of the recording of a change in ownership in the International Register must be distinguished from that of the validity of such change in ownership. The Hague Agreement does not set out, for example, the conditions to be met regarding the validity of a deed of assignment relating to an international registration. These conditions are, and remain, governed exclusively by the relevant domestic legislation, and may therefore vary from one Contracting Party to another (e.g., the need for execution of a document in writing certifying the assignment, proof of the age of the parties in order to assess their legal entitlement, etc.).

13.05 The Hague Agreement provides only for the requirements to be complied with in order to validly record a change in ownership in the International Register. This issue is therefore a matter which comes into play only subsequently to the formal conclusion of the contractual arrangement or to the occurring of the non-contractual cause for the change in ownership.

13.06 The recording of a change in ownership normally aims at ensuring that such change in ownership will be effective against third parties.

Entitlement to Be Recorded as New Holder

99 Article 3
Rule 21(2)(iv) 13.07 Where there has been a change in the ownership of an international registration, the new owner (transferee) may be recorded as the new holder in respect of a given designated Contracting Party provided he holds an entitlement (i.e., by virtue of establishment, domicile, habitual residence or nationality) in a Contracting Party bound by an Act to which the designated Contracting Party concerned is also bound.

13.08 For example, if a designated Contracting Party is bound by both the 1960 Act and the 1999 Act, the transferee could be recorded as the new holder in respect of such Contracting Party to the extent that he holds an entitlement in a Contracting Party bound by either (but at least one) of these Acts. On the other hand, where the transferee is a company holding an entitlement only in a Contracting Party bound *exclusively* by the 1999 Act, such transferee cannot be recorded as new holder in respect of designated Contracting Parties bound *exclusively* by the 1960 Act (or *vice-versa*).

13.09 In certain situations, the application of this principle may entail a change in the Act governing the designation of the Contracting Party concerned *vis à vis* the Contracting Party of the new holder. The following example may illustrate the issue concerned.

13.10 An applicant originates from a Contracting Party bound exclusively by the 1960 Act and has designated a Contracting Party bound by both the 1960 and the 1999 Acts. Such designation is therefore governed by the 1960 Act (the single common Act). The corresponding registration is subsequently assigned to a company established in a Contracting Party bound exclusively by the 1999 Act. This transfer can be recorded in the International Register, since the 1999 Act is common to the Contracting Party of the new holder and the designated Contracting Party concerned. For the very same reason, however, it follows that the designation of that Contracting Party is no longer governed by the 1960 Act, but instead by the 1999 Act (the only common Act between the designated Contracting Party and the Contracting Party of the *new* holder).

13.11 Where this situation occurs, however, the following consequences must be inferred.

Refusal Period

13.12 If the recording of the change in ownership takes place during the course of the refusal period, and given that such period may differ according to whether a Contracting Party has been designated under the 1960 Act or under the 1999 Act (see paragraphs B.II.09.07 *et seq*), the recording of the change in ownership does not have the effect of prolonging – or reducing – the refusal period allowed for a designated Contracting Party to notify a refusal of protection. This solution was approved by the Assembly of the Hague Union at its twenty second session in September/October 2003, by means of an interpretative statement.

Deferment of Publication

13.13 If the recording of the change in ownership takes place during the period for deferment of publication, and given that such period under the 1999 Act (up to 30 months) may be longer than the maximum period of deferment provided for by the 1960 Act (12 months), the recording of the change in ownership does not have the effect of reducing the applicable deferment period where (i) deferment of publication had been requested for a period of more than 12 months under the 1999 Act and (ii) the international registration concerned is transferred, during this deferment period, to a person having an entitlement in a Contracting Party bound *exclusively* by the 1960 Act. This solution was approved by the Assembly of the Hague Union at its twenty second session in September/October 2003, by means of an interpretative statement.

Individual Renewal Fees

13.14 Given that an individual fee may be required at the stage of renewal for Contracting Parties designated under the 1999 Act, but that such a fee is not provided for in respect of Contracting Parties designated under the 1960 Act in the context of renewal, it follows that the *new holder* may have to pay individual renewal fees in a designated Contracting Party (while such possibility had been precluded with respect to the initial holder), or *vice versa*. This solution was approved by the Assembly of the Hague Union at its twenty second session in September/October 2003, by means of an interpretative statement.

Entitlements of the New Owner in Several Contracting Parties Bound by Different Acts (Plurality of Entitlements)

13.15 The transferee may indicate, in the request for the recording of change in ownership, an entitlement in *several* Contracting Parties which may be bound by different Act(s) (see paragraphs B.II.02.01 *et seq*). Therefore, assuming for example that the transferee:

- claims a domicile in a Contracting Party bound exclusively by the 1960 Act (Contracting Party A) and the nationality of a Contracting Party bound exclusively by the 1999 Act (Contracting Party B), and
- requests to be recorded as the new holder in respect of a Contracting Party bound by both Acts (Contracting Party C),

it is the more recent (1999) Act which is taken into account to determine which Act governs the designation of the Contracting Party concerned (Contracting Party C) *vis-à-vis* the new holder (the same result would ensue if, in the example above, Contracting Party B was not the State from which the assignee is a national but an intergovernmental organization of which Contracting Party A is a member State). This solution was approved by the Assembly of the Hague Union at its twenty second session in September/October 2003, by means of an interpretative statement. It results mainly from the fact that the 1999 Act is the more modern legal instrument and that such a solution is also in the spirit of Article 31(1) of the 1999 Act and Article 31(1) of the 1960 Act, which give preference to the more recent Act.

Who Can Present the Request

Rule 21(1)(b) 13.16 As a matter of principle, requests for the recording of changes must be presented and signed by the holder. However, a request for the recording of a change in ownership (form DM/2) may also be presented by the *new* owner, provided that it is

- signed by the holder, or

– signed by the new owner and accompanied by an attestation from the competent authority of the holder's Contracting Party that the new owner appears to be the successor in title of the holder.

Contents of the Request

Rule 21(2) 13.17 A request for the recording of a change in ownership (form DM/2) must contain or indicate the following:

– the number of the international registration concerned (a single request form may be used for several international registrations in the name of the same holder, provided that the request relates to a total change in ownership as provided for in item 6(a) of the form. On the other hand, if the request relates to a partial change in ownership, as provided for in item 6(b), the request form may be used only for a single international registration);

– the name of the holder;

A.I. Section 301
A.I. Section 302

– the name and address, given in accordance with the Administrative Instructions, of the new owner of the international registration. Where there are several new owners with different addresses and no representative has been appointed, an address for correspondence should also be indicated. If no such address is indicated, the International Bureau will take as the address for correspondence the address of the person named first (in item 3 of the form). It should also be noted that where there is only one new owner and no representative has been appointed, item 4 of the form (address for correspondence) should be completed only if the correspondence address is, in fact, different from the ordinary address of the applicant already given in item 3(b);

– the Contracting Party or Parties in respect of which the new owner fulfills the conditions to be the holder of an international registration;

– in the case of a change in the ownership of the international registration that does not relate to all the industrial designs and to all the Contracting Parties, the numbers of the industrial designs and the designated Contracting Parties to which the change in ownership relates;

99 *Article 16(3)*

Rule 21(2)(vi)

– the amount of the fees being paid and the method of payment, or instruction to debit the required amount of fees to an account opened with the International Bureau, and the identification of the party effecting the payment or giving the instructions.

Rule 21(1)(b)
A.I. Section 202

13.18 The form should be signed or have a seal affixed and the identity of the signatory should be indicated as provided for in item 7. There is also provision for an indication of the name of the person to be contacted, if necessary. This may prove useful if, for example, the form is submitted in the name of a legal entity.

Appointment of a Representative

- Rule 3(1)(b)* 13.19 The new owner or transferee may also, optionally, appoint a representative, simultaneously with the filing of the request for the recording of the change in ownership. This is provided for in item 8 of the form, which requires that such appointment be made either by means of the attachment of the appropriate power of attorney to form DM/2 (Change in Ownership) or the annexing to form DM/2 of duly completed form DM/7 (Appointment of Representative).

Irregular or Inadmissible Requests

Request Not Admissible

- Rule 21(3)* 13.20 A change in the ownership of an international registration may not be recorded in respect of a designated Contracting Party if that Contracting Party is not bound by an Act to which the Contracting Party, or one of the Contracting Parties, in respect of which the new owner fulfills the conditions to be the holder of an international registration, is also bound (see paragraphs B.II.13.07 *et seq.*).

Irregular Request

- Rule 21(4)* 13.21 If the request does not comply with any of the applicable requirements, the International Bureau notifies that fact to the holder and, if the request was presented by a person claiming to be the new owner, to that person.
- Rule 21(5)* 13.22 An irregularity in a request for recording of a change in ownership may be remedied within three months from the date of the notification of the irregularity by the International Bureau. If the irregularity is not remedied within that three months period, the request is considered abandoned and the International Bureau notifies accordingly and at the same time the holder and, if the request was presented by a person claiming to be the new owner, that person, and refunds any fees paid, after deduction of an amount corresponding to one half of the relevant fees.

Partial Change in Ownership – Numbering

- Rule 21(7)* 13.23 An assignment or other transfer of the international registration in respect of some only of the industrial designs, or some only of the designated Contracting Parties, is recorded in the International Register under the number of the international registration of which a part has been assigned or otherwise transferred. In such case, any assigned or otherwise transferred part is cancelled under the original number of the international registration and is recorded as a separate international registration. The separate international registration bears the number of the international registration of which a part has been assigned or otherwise transferred, together with a capital letter.

Merger

Rule 21(8) 13.24 Where the same person becomes the holder of two or more international registrations resulting from a partial change in ownership, the registrations may be merged at the request of such person. In that regard, the requirements concerning a request for the recording of a change in ownership (see paragraphs B.II.13.01 *et seq*) apply *mutatis mutandis* to the request for the recording of a merger.

13.25 The international registration resulting from the merger bears the number of the international registration of which a part had been assigned or otherwise transferred, together, where applicable, with a capital letter.

Effect of the Recording of a Change in Ownership

60 Article 7(1)(b) 13.26 The recording of a change in ownership in the International Register has the same effect as if it had been made directly at the corresponding national or regional Register of the Office. However, Article 16(2) of the 1999 Act provides for one possible exception, namely a Contracting Party may, in a declaration, notify the Director General of WIPO that a recording of a change in ownership in the International Register shall not have effect in that Contracting Party until the Office of that Contracting Party has received the statements or documents specified in that declaration (see paragraphs B.II.13.29 *et seq.*)
99 Article 16(2)

Recording, Notification and Publication

Rule 21(6)(a) 13.27 Provided that the request is in order, the International Bureau promptly records the change in the International Register and informs both the new holder and the previous holder.

Rule 26(1)(iv) 13.28 The International Bureau publishes in the Bulletin the relevant data concerning the change in ownership.

Refusal of the Effects of the Recording of a Change in Ownership Issued By the Office of a Designated Contracting Party

Rule 21bis 13.29 As indicated above, a Contracting Party may make a declaration under Article 16(2) of the 1999 Act to the effect that the recording of a change in ownership in the International Register does not have effect in that Contracting Party until the Office has received the statements or documents specified in that declaration.

13.30 Furthermore, there are situations under some national/regional laws, where the recording of a partial change in ownership is not allowed. For example, this is the case under certain jurisdictions where a set of industrial designs is considered to constitute a single industrial design, which means that all the designs belonging to the same set acquire legal protection as a whole and do not acquire protection independently. As a consequence, all the designs forming the set can only be transferred to the same transferee at the same time. This is also the case

under certain jurisdictions where the law provides for a “similar design” system or a “related design” system. Industrial designs registered under this particular condition can only be transferred all together at the same time.

13.31 In the situations described above, the recording of a change in ownership in the International Register may have no effect in a given designated Contracting Party. Therefore, where such a change in ownership is not allowed under its national/regional laws, the Office of that Contracting Party may declare that a change in ownership recorded in the International Register has no effect in the said Contracting Party.

13.32 That declaration must be sent by the Office to the International Bureau within six months from the date of publication of the change in ownership or within the applicable refusal period, whichever expires later. The declaration should indicate (i) the reasons for which the change in ownership has no effect, (ii) the corresponding essential provisions of the law, (iii) the numbers of the industrial designs concerned by the declaration where it does not relate to all the industrial designs that are the subject of the change in ownership, and (iv) whether such a declaration may be subject to review or appeal.

13.33 Upon its receipt, the International Bureau records the declaration in the International Register and notifies accordingly the previous holder (the transferor) and the new holder (transferee). The International Bureau also modifies the International Register, so that that part of the international registration which has been the subject of the said declaration be recorded as a separate international registration in the name of the previous holder (the transferor). The International Bureau notifies accordingly the previous holder (the transferor) and the new holder (the transferee).

13.34 The withdrawal of a declaration of refusal issued under this Rule shall be notified to the International Bureau which shall then record it in the International Register, modify the International Register accordingly, and notify accordingly the previous holder (the transferor) and the new holder (the transferee).

Rule 21bis
Rule 21(7)

13.35 The following example may illustrate how this Rule works: a given international registration contains the designations of Contracting Parties A and B under the 1999 Act, Contracting Party A having made the declaration under Article 16(2) of the 1999 Act. A total change in ownership of the international registration has been recorded in the International Register from holder X to new holder Y. After three months from the date of publication of the recording of the said change in ownership, the International Bureau receives from the Office of Contracting Party A the declaration that the change in ownership has no effect in that Contracting Party. The International Bureau records the said declaration in the International Register and notifies accordingly the previous holder (the transferor) and the new holder (the transferee), in accordance with paragraph (4) of this Rule. Pursuant to the said paragraph, the International Bureau modifies the total change in ownership to a change in ownership in respect of Contracting Party B, this modification leading to the creation of a new international registration in the name of X for Contracting Party A. According to the general principle established under Rule 21(7) for the recording of a partial change in ownership, the new international

registration would bear the number of the original international registration, together with a capital letter. In the event of a further decision to withdraw the aforementioned declaration of refusal in Contracting Party A, it shall be notified to the International Bureau pursuant to paragraph (5) of Rule 21*bis*. The International Bureau then modifies the name of the holder of the new international registration from X (the previous holder) to Y (the new holder) and notifies the previous and the new holder accordingly. The International Bureau then merges those two international registrations in the name of Y (the new holder) and informs the new holder (transferee) accordingly.

14. CHANGE IN THE NAME AND/OR ADDRESS OF THE HOLDER

Rule 21(1)(a)(ii) 14.01 A request for the recording of a change in the name and/or address (or address for correspondence) of the holder may be presented to the International Bureau on official form DM/6. This form must *not* be used where the change of name results from a change in ownership. In such a case, form DM/2 should be used (see paragraphs B.II.13.01 *et seq*).

Item 1: International Registration Number

Rule 21(2)(i) 14.02 A single request may relate to several international registrations recorded in the name of the same holder. If, in respect of a given international registration, the number is not known (because the international registration has not yet been effected or notified to the holder), no other number should be given. The holder should wait until he is notified of the international registration number concerned and then make a further request.

Item 2: Holder

Rule 21(2)(ii) 14.03 The name of the holder, as recorded in the International Register, must be indicated in the same way as that described in paragraph B.II.04.03.

Item 3: Change

Rule 21(2)(iii) 14.04 Spaces are provided to indicate the new name, new address, new phone and facsimile numbers and new email address. Only the information which has changed need be indicated. That is, for example, where only the name has changed, it is sufficient to indicate the new name, leaving the other spaces blank; similarly, where only the address has changed, there is no need to repeat the name.

14.05 Where only the telephone and/or facsimile number has changed, it is sufficient to indicate the new number(s) in a letter (the use of form DM/6 is not necessary). Where this is the only change to be recorded, no fee is payable for the request.

Item 4: Address for Correspondence

14.06 Space is provided to indicate an address for correspondence, if any, and if different from the address of the holder indicated in item 2. If this item is *not* completed, an address for correspondence which may already have been recorded in the International Register is automatically disregarded by the International Bureau.

Item 5: Appointment of a Representative

Rule 3(2) 14.07 The holder may also, optionally, appoint a representative, simultaneously with the filing of the request for the recording of the change in the name and/or address of the holder. Such appointment may be made by attaching form DM/6 to the appropriate power of attorney, or form DM/7, or by inserting the holder's signature where indicated in item 6.

14.08 Where there is no change in the representative already recorded, this item of the form should be left blank.

14.09 The observations made above in relation to change in ownership (concerning presentation of the request, irregularities, rectification and effect of the recording, notification and publication) apply in equal measure to requests for the recording of a change of name and/or address (see paragraphs B.II.13.01 *et seq.*).

Item 6: Signature by the Holder or Representative

Rule 21(1)(b)(i) 14.10 The form should be signed or have a seal affixed and the identity of the signatory should be indicated. There is also provision for an indication of the name of the person to be contacted, if necessary. This may prove useful if, for example, the form is submitted in the name of a legal entity.

Fee Calculation Sheet

99 Article 16(3) 14.11 A request to record a change in the name or address of the holder is
Rule 21(2)(vi) subject to the payment of the fee specified in the Schedule of Fees. See the general remarks concerning payment of fees to the International Bureau (paragraphs B.I.05.01 *et seq.*).

Irregular Requests

Rule 21(4) and (5) 14.12 If a request to record a change in name or address of the holder or representative does not comply with any of the applicable requirements, the International Bureau notifies that fact to the holder. The irregularity may be remedied within three months from the date of the notification. If this is not done, the request will be considered abandoned and any fee paid will be reimbursed to the party that paid it, after deduction of an amount corresponding to one half of the relevant fee.

Recording, Notification and Publication

- 99 Article 16(4)* 14.13 Provided that the request is in order, the International Bureau promptly records the change in the International Register and informs the holder. The change is recorded as of the date of receipt by the International Bureau of the request complying with the applicable requirements. Where however the request indicates that the change should be recorded after another change, or after renewal of the international registration, the International Bureau proceeds accordingly.
- Rule 21(6)*

15. RENUNCIATION

- 99 Article 16(1)(iv)* 15.01 Renunciation of an international registration always concerns *all* the industrial designs that are the subject of the international registration, but may relate to some or all of the designated Contracting Parties.
- Rule 21(1)(a)(iii)*
- Rule 21(1)(a)* 15.02 A request for the recording of a renunciation should be presented to the International Bureau on official form DM/5.

Item 1: International Registration Number

- Rule 21(2)(i)* 15.03 If, in respect of a given international registration, the number is not known (because the international registration has not yet been effected or notified to the holder), no other number should be given. The holder should wait until he is notified of the international registration number concerned and then make a further request.
- 15.04 One single form may be used to request the recording of a renunciation in respect of several international registrations of the same holder, provided that the designated Contracting Parties in respect of which the international registration is renounced are the same for each of the international registration concerned.
- 15.05 The request must necessarily relate to all the industrial designs covered by the international registration(s) in respect of some, or all, the designated Contracting Parties. If the request relates to some only of the industrial designs covered by the international registration(s), form DM/3 (limitation) must be used instead.

Item 2: Holder

- Rule 21(2)(ii)* 15.06 The name of the holder, as recorded in the International Register, must be indicated in the same manner as that described in paragraph B.II.04.03.

Item 3: Appointment of a Representative

Rule 3(1)(b) 15.07 The holder may also, optionally, appoint a representative, simultaneously with the filing of the request for the recording of the renunciation. For such appointment to be effective, the request for the recording of a renunciation must be signed by the holder, or be accompanied by a power of attorney or form DM/7 duly completed, and the appropriate box in item 3 should be ticked accordingly.

15.08 Where there is no change in the representative already recorded, this item of the form should be left blank.

Item 4: Contracting Parties

15.09 The holder must indicate whether the request for the recording of the renunciation relates to all designated Contracting Parties (in which case item 4(a) should be ticked) or to some only of the designated Contracting Parties (in which case item 4(b) should be ticked with the boxes corresponding to the Contracting Parties concerned).

Item 5: Signature by the Holder or Representative

Rule 21(1)(b) 15.10 The form should be signed or have a seal affixed and the identity of the signatory should be indicated. There is also provision for an indication of the name of the person to be contacted, if necessary. This may prove useful if, for example, the form is submitted in the name of a legal entity.

Fee Calculation Sheet

99 *Article 16(3)* 15.11 A request to record a renunciation is subject to the payment of the fee
Rule 21(2)(vi) specified in the Schedule of Fees. See the general remarks concerning payment of fees to the International Bureau (paragraphs B.I.05.01 *et seq*).

Irregular Requests

Rule 21(4) and (5) 15.12 If a request to record a renunciation does not comply with any of the applicable requirements, the International Bureau notifies that fact to the holder. The irregularity may be remedied within three months from the date of the notification. If this is not done, the request will be considered abandoned and any fee paid will be reimbursed to the party that paid it, after deduction of an amount corresponding to one half of the relevant fee.

Recording, Notification and Publication

99 Article 16(4) 15.13 Provided that the request is in order, the International Bureau promptly records the renunciation in the International Register and informs the holder. The change is recorded as of the date of receipt by the International Bureau of the request complying with the applicable requirements.
Rule 21(6)

Rule 21(6)(b) 15.14 Normally, the renunciation is recorded as of the date of the receipt of the request by the International Bureau. It may happen, however, that a holder wishes that the date of the recording of a renunciation be linked with the recording of another change.

16. LIMITATION

99 Article 16(1)(v) 16.01 A request for the recording of a limitation should be presented to the International Bureau on official form DM/3. It may be used only to request the recording of a limitation for a single international registration.
Rule 21(1)(a)(iv)

16.02 A limitation differs from renunciation in that a renunciation concerns all the industrial designs that are the subject of an international registration, but not necessarily all the designated Contracting Parties. On the other hand, a limitation necessarily concerns some only of the industrial designs, but never all, in relation to any, or all, of the Contracting Parties.

Item 1: International Registration Number

Rule 21(2)(i) 16.03 A request must relate to a single international registration. If the number is not known (because the international registration has not yet been effected or notified to the holder), no other number should be given. The holder should wait until he is notified of the international registration number concerned and then make a further request.

Item 2: Holder

Rule 21(2)(ii) 16.04 The name of the holder, as recorded in the International Register, must be indicated in the same manner as that described in paragraph B.II.04.03.

Item 3: Appointment of a Representative

Rule 3(1)(b) 16.05 The holder may also, optionally, appoint a representative, simultaneously with the filing of the request for the recording of the limitation. Such appointment may be made by attaching to form DM/3 the appropriate power of attorney, or form DM/7, or by inserting the holder's signature where indicated in item 6.

16.06 Where there is no change in the representative already recorded, this item of the form should be left blank.

Item 4: Industrial Designs

16.07 Each industrial design affected by the limitation (that is, for which protection is no longer sought) must be specified by indicating its number.

Item 5: Contracting Parties

16.08 The holder must indicate whether the request for the recording of the limitation relates to all the designated Contracting Parties (in which case box (a) must be ticked) or to some only of the designated Contracting Parties (in which case box (b) must be ticked, along with the boxes corresponding to those Contracting Parties concerned).

Item 6: Signature by the Holder or Representative

Rule 21(1)(b) 16.09 The form should be signed or have a seal affixed and the identity of the signatory should be indicated. There is also provision for an indication of the name of the person to be contacted, if necessary. This may prove useful if, for example, the form is submitted in the name of a legal entity.

Fee Calculation Sheet

99 Article 16(3) 16.10 A request to record a limitation is subject to the payment of the fee
Rule 21(2)(vi) specified in the Schedule of Fees. See the general remarks concerning payment of fees to the International Bureau (paragraphs B.I.05.01 *et seq.*).

Irregular Requests

Rule 21(4) and (5) 16.11 If a request to record a limitation does not comply with any of the applicable requirements, the International Bureau notifies that fact to the holder. The irregularity may be remedied within three months from the date of the notification. If this is not done, the request is considered abandoned and any fee paid is reimbursed to the party that paid it, after deduction of an amount corresponding to one half of the relevant fee.

Recording, Notification and Publication

99 Article 16(4) 16.12 Provided that the request is in order, the International Bureau promptly
Rule 21(6) records the limitation in the International Register and informs the holder. The change is recorded as of the date of receipt by the International Bureau of the request complying with the applicable requirements.

17. IT IS NOT POSSIBLE TO RECORD A LICENSE IN THE INTERNATIONAL REGISTER

17.01 There is no provision in the Hague system allowing for the possibility of recording a license in the International Register. Therefore, formalities which may be necessary to secure the effectiveness of a licensing agreement in a designated Contracting Party must be carried out at the national or regional level directly before the Office of the Contracting Party concerned, provided that the domestic legislation in question so permits.

18. CORRECTIONS IN THE INTERNATIONAL REGISTER

Rule 22(1) 18.01 Where the International Bureau, acting *ex officio* or at the request of the holder, considers that there is an error in the International Register concerning an international registration, it will modify the International Register and inform the holder accordingly.

Rule 22(2) 18.02 The Office of any designated Contracting Party has however the right to declare in a notification to the International Bureau that it refuses to recognize the effects of such correction. Rules 18 and 19, concerning refusal of protection, apply *mutatis mutandis*.

19. RENEWAL OF THE INTERNATIONAL REGISTRATION

99 Article 17 19.01 With respect to Contracting Parties designated under the 1999 Act, the international registration is valid for an initial period of five years and may be renewed for two additional five-year periods. Subject to renewal, the duration of protection available in each Contracting Party designated under the 1999 Act is at least 15 years, counted from the date of international registration. Moreover, if the national legislation of a Contracting Party provides for a duration of protection in excess of 15 years for designs filed for registration by the national route, the international registration may be renewed with respect to that Contracting Party for additional periods of five years up to the expiry of the total duration of protection provided for in its national legislation.

60 Article 11(1)(a) item 2
60 Article 11(1)(a) item 1
60 Article 11(2) 19.02 With respect to Contracting Parties designated under the 1960 Act, the international registration is valid for an initial period of five years and may be renewed for an additional period of five years. Subject to renewal, the duration of protection available in each Contracting Party designated under the 1960 Act is at least 10 years counted from the date of international registration. Moreover, if the national legislation of a Contracting Party provides for a duration of protection in excess of 10 years for designs filed for registration by the national route, the international registration may be renewed with respect to that Contracting Party for additional periods of five years up to the expiry of the total duration of protection provided for in its national legislation.

- 99 Article 17(3)(c)* 19.03 Contracting Parties are required to notify to the Director General of WIPO the maximum duration of protection provided for by their domestic law. This information is supplied to holders in the unofficial notices of expiry which are sent by the International Bureau six months before the expiration of each five-year term (see paragraph B.II.19.07). Where the holder wishes to renew the international registration in respect of a designated Contracting Party notwithstanding the fact that the maximum period of protection in that Contracting Party has expired, payment of the required fees for that Contracting Party must be accompanied by a statement that the renewal of the international registration is to be recorded in the International Register in respect of that Contracting Party. Allowing a renewal with respect to a designated Contracting Party notwithstanding the fact that the maximum period of protection in that Contracting Party, as notified to the Director General of WIPO, has expired is aimed at preserving the rights of the holder in the event, for example, of a change in the maximum duration of protection under the law of a Contracting Party which has not yet been notified to the Director General of WIPO.
- Rule 36(2)*
- Rule 23*
- Rule 24(2)(b)*

Renewal Following Refusal or Invalidation

- Rule 24(2)(c)* 19.04 If a refusal is recorded in the International Register with respect to a particular Contracting Party for all the industrial designs covered by the international registration, the holder may nevertheless request the renewal of the international registration with respect to that Contracting Party. The payment of the renewal fees must however be accompanied by a statement that the renewal is to be recorded in respect of that Contracting Party. The reason for allowing a renewal with respect to a Contracting Party that has pronounced a refusal is that, at the time of renewal, there may still be pending a judicial or administrative procedure in respect of such refusal. The rights of the holder may need to be preserved where the refusal was the subject of an appeal and no final decision had been taken by the date on which the renewal was due. A designated Contracting Party which has pronounced a refusal is, of course, free to determine the effects in its territory of such a renewal.
- Rule 20* 19.05 The situation is different with respect to an invalidation, since the recording of an invalidation in the International Register means, by definition, that the invalidation is no longer subject to appeal. The international registration may not, therefore, be renewed with respect to a Contracting Party for which an invalidation has been recorded for all the industrial designs. Nor may it be renewed with respect to a Contracting Party in respect of which a renunciation has been recorded. Furthermore, the international registration may not be renewed in respect of any Contracting Party for those industrial designs in respect of which an invalidation in that Contracting Party has been recorded. Nor may it be renewed for those industrial designs in respect of which a limitation has been recorded in that Contracting Party.
- Rule 21*
- Rule 24(2)(d)*

Procedure for Renewal

Rule 23
A.I. Section 701

19.06 Six months before the expiry of each five-year term, the International Bureau sends to the holder and the representative, if any, a notice indicating the date of expiry of the international registration, along with the maximum term of protection which has been notified to the Director General of WIPO by the Contracting Parties concerned (see paragraph A.05.05). If however the holder (or representative) does not receive such unofficial notice, this does not constitute an excuse for failure to comply with any time limit for payment of the renewal fees due.

99 Article 17(4)
Rule 24(2)(a)

19.07 The international registration may be renewed for some only of the designated Contracting Parties and for some only of the industrial designs that are the subject of the international registration.

19.08 No official form is prescribed for the renewal of an international registration. Renewal may be effected by any communication giving the required indications (number(s) of the international registration(s) concerned and purpose of the payment). Holders may however find it convenient to use the unofficial form DM/4 which provides for the necessary information, namely:

- the number of the international registration to be renewed;
- the name and address of the holder (which must be the same as the name and address recorded in the International Register);
- either (in item 3(a)) that the international registration is to be renewed for all the designs and for all the designated Contracting Parties – including, where applicable, those Contracting Parties in respect of which a total refusal has been recorded in the International Register and those Contracting Parties designated under the 1999 Act or the 1960 Act in respect of which the maximum period of protection has expired – or (in item 3(b)) the indication of the designated Contracting Parties and/or industrial designs for which the international registration is *not* to be renewed. Where item 3(b) has been ticked, it is understood that the renewal is to be recorded in respect of all the Contracting Parties not indicated in item 3(b)(ii) – including, where applicable, those Contracting Parties in respect of which a total refusal has been recorded in the International Register and those Contracting Parties designated under the 1999 Act or the 1960 Act in respect of which the maximum period of protection has expired;
- the signature of the holder or his representative;
- the fees being paid and the method of payment, or instructions to debit the required fees from an account with the International Bureau.

19.09 An electronic renewal (E-renewal) interface is available on the WIPO website for total or partial renewal of international registrations. In case of partial renewal (*i.e.* for only *some* of the industrial designs and/or only *some* of the designated Contracting Parties), the E-renewal interface allows the holders of international registrations to specify the scope of renewal in a more granular

manner than which may be requested through the unofficial DM/4 form. In particular, the E-renewal interface permits the selection of *different sets* of designated Contracting Parties for which *different sets* of industrial designs are to be renewed.

19.10 In addition, the E-renewal interface automatically calculates the renewal fees to be paid based on the data entered by the holder of a given international registration and allows the latter to view the reproductions of the industrial designs contained in the international registration. The E-renewal interface allows the payment of the renewal fees either through a current account opened with the International Bureau or by credit card.

Fees for Renewal

Rule 24(1) 19.11 The fees due for the renewal of an international registration must be paid directly to the International Bureau by the holder. Those fees consist of:

- a basic fee;
- an individual designation fee for each Contracting Party designated under the 1999 Act which has required such fee;
- a standard designation fee in respect of each other Contracting Party for which the international registration is to be renewed.

99 *Article 17(2)* 19.12 The payment of individual designation fees in the context of renewal
Rule 24(1)(iii) may only apply to Contracting Parties designated under the 1999 Act (provided that they have requested such fees) and cannot concern those Contracting Parties designated under the 1960 Act. In fact, the 1960 Act envisages solely the payment of “individual designation fees” in the context of a designation in the international application and not at the stage of renewal.

19.13 The fee calculator on the WIPO website may be used to calculate the fees payable for the renewal of an international registration. The E-renewal interface automatically calculates the renewal fees to be paid taking into account the scope of the renewal.

Rule 24(1)(c) 19.14 The fees should be paid to the International Bureau by, at the latest, the date of expiry of the registration. However, payment may still be made within six months from the date on which the renewal of the international registration is due, provided that the surcharge specified in the Schedule of Fees is paid at the same time.

Rule 24(1)(d) 19.15 If any payment made for the purposes of renewal 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 27(6)(b) 19.16 If the amount of a renewal fee changes between the date on which the fee was paid to the International Bureau and the date on which renewal is due,

– 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;

– 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;

– where the renewal fee is paid after the due date, it is the fee that was valid on the due date that is applicable.

Insufficient Fees Paid

Rule 24(3) 19.17 If the amount received is less than the amount required for renewal, the International Bureau promptly notifies at the same time both the holder and the representative, if any, accordingly. The notification specifies the missing amount.

19.18 If the amount received, after the expiry of the period of six months following the date on which renewal was due, is less than the amount required (including the surcharge for late payment), the renewal is not recorded. The International Bureau refunds the amount received and notifies accordingly the holder and the representative, if any.

19.19 Where the amount paid is insufficient, the holder may, instead of paying the missing amount, ask for some of the designated Contracting Parties and/or industrial designs to be omitted, thereby reducing the amount due. This request must however be made within the time within which the missing payment would have had to be made.

Recording of the Renewal; Certificate and Publication

Rule 25(1) 19.20 The International Bureau records the renewal in the International
99 Article 17(5) Register, with the date on which it was due, even if the fees required were paid within the grace period of six months after the due date. The relevant data
Rule 26(1)(vi) concerning the renewal is published in the Bulletin.

Rule 25(2) 19.21 Where the international registration has been renewed, the International Bureau sends a certificate of renewal to the holder.

Non-Renewal

19.22 If an international registration is not renewed (because the holder did not pay the renewal fees or because the fees paid were not sufficient), it lapses with effect from the date of expiry of the previous period of protection.

Rule 26(1)(vii) 19.23 Where the international registration has not been renewed, that fact is published in the Bulletin. Such publication is not made until there is no longer any possibility that the international registration might be renewed, that is, after the expiry of the period of six months following the due date (within which period renewal was possible upon payment of a surcharge).

19.24 Where the required renewal fees have not been paid by the due date, no recordings concerning the international registration concerned may be recorded in the International Register during the period of six months after the due date within which renewal remains possible upon payment of a surcharge. It is only after renewal has been recorded in the International Register that changes may be recorded in the International Register.

20. INVALIDATION IN A DESIGNATED CONTRACTING PARTY

Rule 20 20.01 The term “invalidation” must be understood as encompassing any decision by a competent authority (whether administrative or judicial) of a designated Contracting Party revoking or canceling the effects, in the territory of that Contracting Party, of an international registration with regard to all or some of the industrial designs covered by the designation of that Contracting Party.

20.02 Proceedings concerning such invalidation take place directly between the holder of the international registration, the party who has brought the action for invalidation and the competent authority concerned (Office or tribunal). It may be necessary for the holder to appoint a local representative. The proceedings are governed entirely by the law and practice of the Contracting Party concerned. However, the invalidation of an international registration may not be pronounced without the holder having, in good time, been afforded the opportunity to defend his rights.

20.03 The procedures governing such invalidation should be the same as for industrial designs registered directly with the Office of that Contracting Party. For example, the protection of an industrial design may be revoked in proceedings brought by a third party, or in a counterclaim in infringement proceedings.

Rule 20(1) 20.04 Where the effects of an international registration are invalidated (in whole or in part) in a Contracting Party, and the invalidation is no longer subject to any appeal, the Office of that Contracting Party, where it is aware of the invalidation, must notify the International Bureau of the relevant facts, namely:

- the authority (for example, the Office or tribunal) which pronounced the invalidation;
- the fact that the invalidation is no longer subject to appeal;
- the number of the international registration;

- if the invalidation does not concern all the industrial designs, those which are concerned (either by indicating those industrial designs which are no longer covered or those which are still covered);
- the date on which the invalidation was pronounced and its effective date.

Rule 20(2) 20.05 The International Bureau records the invalidation in the International Register, together with the data contained in the notification. It also publishes the invalidation in the Bulletin.