

CHAPTER III:

THE 1934 ACT AND THE FREEZING OF ITS APPLICATION

INTRODUCTION

Chapter III deals with the 1934 Act, the application of which is frozen since January 1, 2010. The freezing of the application of the 1934 Act means that, as from January 1, 2010, it is no longer possible to file international deposits under the 1934 Act, or to make designations governed by that Act. However, the prolongation (the renewal) of designations made under the 1934 Act before January 1, 2010, and the recording of any changes affecting such designations continues to be possible in the International Register up to the maximum duration of protection under the 1934 Act, which is 15 years¹. As a result of the freeze, all the activities under the 1934 Act will gradually diminish, and, finally, terminate at the latest on December 31, 2024, i.e., 15 years after the last possible deposits or designations under the 1934 Act were made. Because no new international applications or designations under the 1934 Act may be filed, Chapter III will focus only on the procedures which are still applicable to registrations and designations under the 1934 Act.

01. IMPLICATIONS OF THE FREEZING OF THE APPLICATION OF THE 1934 ACT

01.01 The Common Regulations have been amended so as to reflect the freezing of the application of the 1934 Act. In particular, new Rule 37(1), containing a transitional provision relating to the 1934 Act, was added to the Common Regulations.

01.02 As from January 1, 2010, no new registrations or designations under the 1934 Act may be recorded in the International Register. However, those with a registration date prior to January 1, 2010, remain in force. This means, more precisely, that those registrations and designations could be the subject of a renewal or any other recording provided for in the version of the Common Regulations that was in force before January 1, 2010.

¹ See document H/A/28/3 entitled “Freezing of the Application of the London (1934) Act of the Hague Agreement” and document H/A/28/1, entitled “Proposed Amendments to the Common Regulations under the 1999 Act, the 1960 Act and the 1934 Act of the Hague Agreement”, both published on WIPO’s website, at www.wipo.int/meetings/en/details.jsp?meeting_id=18648.

Rule 37(1)(b) 01.03 As provided for in Rule 37(1)(b), the Common Regulations, as in force before January 1, 2010, that is the Common Regulations Under the 1999 Act, the 1960 Act and the 1934 Act of the Hague Agreement, as in force on January 1, 2009, remain applicable to an international application governed exclusively by the 1934 Act (see paragraph B.III.02.01) and filed before that date and that was still pending on that date, as well as in respect of any Contracting Party designated under the 1934 Act in an international registration resulting from an international application filed before that date. For users' convenience, the full text of that version of the Common Regulations is made available in Part C.

02. INTERNATIONAL REGISTRATIONS RESULTING FROM INTERNATIONAL APPLICATIONS GOVERNED EXCLUSIVELY BY THE 1934 ACT

02.01 An international application was considered as governed exclusively by the 1934 Act where all the Contracting Parties designated in that international application were designated under the 1934 Act

Rule 30(1)² 02.02 As a general principle, the international procedure described in Part B.II applies equally to international registrations resulting from international applications governed exclusively by the 1934 Act, subject however to the exceptions mentioned below.

Language

Rule 30(2)(a)² 02.03 Any communication concerning an international registration resulting from an international application governed exclusively by the 1934 Act must be in French. This is in contrast with communications in respect of the other kinds of international registrations, which may be in English, French or Spanish. The recording and publication of any new data will also be made only in French. (The publication of an international registration in the Bulletin under the 1934 Act contains only bibliographical data relating to that registration.)

No Refusal of Protection

Rule 30(2)(j)² 02.04 The 1934 Act does not provide for the possibility for the Offices of the designated Contracting Parties to notify a refusal of protection, therefore, international registrations resulting from international applications governed exclusively by the 1934 Act may not be the subject of such refusals.

² As in the Common Regulations "in force before the effective date of the freeze", that is, the version that came into force on January 1, 2009.

Change in Ownership

Rule 30(2)(k)² 02.05 A change in ownership cannot be recorded in respect of a Contracting Party designated under the 1934 Act if that Act would cease to be applicable following the recording of the change in ownership concerned. For example, assuming that Contracting Party A, bound by both the 1960 and the 1934 Acts, has been designated under the 1934 Act and that the international registration concerned is transferred to a new owner originating from Contracting Party B, bound exclusively by the 1960 Act, this change in ownership could not be recorded in the International Register because the 1934 Act would cease to be applicable in such a case. This derogation from the general principle concerning the possibility of recording a change in ownership in the International Register is due to the number and types of features which are exclusive to the 1934 Act.

Renewal

*Rule 30(2)(l),
(m) and (n)²* 02.06 *Only one* renewal may be requested under the 1934 Act (which provides for a *maximum* period of protection of 15 years divided into two periods: one period of five years and one of 10 years). Having regard to this specific feature of the 1934 Act, the renewal of an international registration resulting from an international application governed exclusively by the 1934 Act, for the second period of protection of 10 years, could have been requested at the time of filing the international application concerned.

Rule 30(2)(l)² 02.07 The renewal of an international registration resulting from an international application governed exclusively by the 1934 Act is subject only to the payment of the basic fee, irrespective of the number of designated Contracting Parties. The amount of that fee is prescribed under item IV of the Schedule of Fees, part of the Common Regulations in the version in force before January 1, 2010 (available in Part C).

03. INTERNATIONAL REGISTRATIONS RESULTING FROM INTERNATIONAL APPLICATIONS GOVERNED PARTLY BY THE 1934 ACT

03.01 The international registrations resulting from international applications governed partly by the 1934 Act comprise three categories, namely:

(a) international registrations resulting from international applications governed by both the 1960 and the 1934 Acts, which means that, at the time of filing the application, the designated Contracting Parties included:

- at least one Contracting Party designated under the 1960 Act, and
- at least one Contracting Party designated under the 1934 Act, while

– no Contracting Party had been designated under the 1999 Act.

(b) international registrations resulting from international applications governed by both the 1999 and the 1934 Acts, which means that, at the time of filing the application, the designated Contracting Parties included:

– at least one Contracting Party designated under the 1999 Act, and

– at least one Contracting Party designated under the 1934 Act, while

– no Contracting Party had been designated under the 1960 Act.

(c) international registrations resulting from international applications governed by the 1999, the 1960 and the 1934 Acts, which means that, at the time of filing the application, the designated Contracting Parties included:

– at least one Contracting Party designated under the 1999 Act, and

– at least one Contracting Party designated under the 1934 Act, and

– at least one Contracting Party designated under the 1960 Act.

No Refusal of Protection

Rule 31(2)(c)(ii)² 03.02 In relation to an international registration resulting from an international application governed partly by the 1934 Act (as referred to in paragraph B.III.03.01), the Contracting Party or Parties designated under the 1934 Act may not notify a refusal of protection since such possibility is not envisaged under the 1934 Act.

Change in Ownership

Rule 31(2)(b)² 03.03 A change in ownership cannot be recorded in respect of a designated Contracting Party if the 1934 Act would cease to be applicable, or would become applicable, in respect of that Contracting Party following the recording of the change in ownership. For example, assuming that Contracting Party A, bound by both the 1999 and the 1934 Acts, has been designated under the 1999 Act and that the international registration concerned is transferred to a new owner originating from Contracting Party B, bound exclusively by the 1934 Act, this change in ownership could not be recorded in the International Register given that the 1934 Act would become applicable in such a case (see also paragraph B.III.02.05).

Renewal

- Rule 31(2)(c)(iv)*² 03.04 In relation to an international registration resulting from an international application governed partly by the 1934 Act (as referred to in paragraph B.III.03.01), a renewal cannot be recorded with respect to Contracting Parties designated under the 1934 Act where the maximum duration of international protection of 15 years has expired. This differs from the situation applicable to Contracting Parties designated under the 1999 Act or the 1960 Act (see paragraphs B.II.19.01 to 19.24).
- Rule 31(2)(c)(iii)*² 03.05 The renewal of a designation under the 1934 Act does not give rise to the payment of a designation fee.