



## WORLD INTELLECTUAL PROPERTY ORGANIZATION

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### **THE HAGUE AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF INDUSTRIAL DESIGNS**

#### **Entry into force of the 1999 Act and of the Common Regulations under the 1999 Act, the 1960 Act and the 1934 Act of the Hague Agreement**

##### Entry into force of the 1999 Act

1. On September 23, 2003, the Government of Spain deposited with the Director General of the World Intellectual Property Organization (WIPO), its instrument of ratification of the Geneva (1999) Act of the Hague Agreement Concerning the International Registration of Industrial Designs.
2. Given that Spain is the eleventh Contracting Party to the 1999 Act and, according to the most recent annual statistics collected by the International Bureau, the third Contracting Party to the 1999 Act (along with Slovenia and Switzerland) to have the volume of activity in the field of industrial designs required by Article 28(2) of the 1999 Act for such Act to enter into force, it follows that the 1999 Act of the Hague Agreement will enter into force three months after the deposit by Spain of its instrument of ratification, namely on December 23, 2003.
3. The main innovations of the 1999 Act, compared with the present system established by the 1960 and the 1934 Acts, are summarized in WIPO publication No. 453, the text of which is reproduced in the Annex to the present notice.

##### Adoption and Entry into Force of the Common Regulations under the 1999 Act, the 1960 Act and the 1934 Act of the Hague Agreement

4. At its twenty-second session, which took place in September 2003, the Assembly of the Hague Union adopted Common Regulations under the 1999 Act, the 1960 Act and the 1934 Act and decided that those Common Regulations would enter into force on April 1, 2004.
5. The Assembly of the Hague Union further decided that, as from April 1, 2004, the Common Regulations would replace both the Regulations under the 1999 Act and the Regulations under the 1960 Act and the 1934 Act.
6. The text of the Common Regulations will be available shortly on WIPO's website, at the following address: *www.wipo.int*

7. The implementation of the international procedure under the new Common Regulations further requires that Administrative Instructions be established by the Director General of WIPO after consultation with the Offices concerned. Following such consultation, currently under progress, the Administrative Instructions will be established by the Director General to enter into force on the same date as the entry into force of the Common Regulations, on April 1, 2004.

8. It follows that, *as from April 1, 2004*, users of the Hague system will be required to comply with the requirements provided for by the Common Regulations and the corresponding Administrative Instructions. In particular, they will be required to use the new official forms established by the International Bureau in connection with the implementation of the Common Regulations. These forms will be made available on WIPO's website early in 2004.

9. Moreover, in order for users of the Hague system to become acquainted with the international procedure under the Common Regulations and the Administrative Instructions, a *Guide to the International Registration of Industrial Designs* will be issued by the International Bureau early in 2004 and will be also accessible on WIPO's website.

October 1, 2003

## ANNEX

### MAIN INNOVATIONS OF THE 1999 ACT COMPARED WITH THE PRESENT SYSTEM ESTABLISHED BY THE 1960 AND THE 1934 ACTS

#### **Introduction**

1. On July 2, 1999, a Diplomatic Conference meeting in Geneva adopted a new Act of the Hague Agreement and Regulations thereunder. Today therefore there are three separate Acts of the Hague Agreement, namely the London Act (1934), the Hague Act (1960) and the Geneva Act (1999), which coexist with respect to their substantive provisions on the international registration of industrial designs.

#### **Why a New Act of the Hague Agreement?**

2. Even though the international registration system provided for in the 1934 and 1960 Acts is being used to the satisfaction of owners of industrial designs in countries party to those Acts, the countries themselves are still relatively few in number, and their geographical spread is small. At present, only 34 States are members of the Hague Union. Missing from those are a certain number of countries that are very active in the deposit of industrial designs and yet consider that the 1934 and 1960 Acts, as they stand, do not meet their needs (they are mainly the countries whose legislation requires deposited designs to undergo examination for novelty).

3. The 1999 Act has a twofold objective, namely:

– on the one hand, to extend the Hague system to new members; to do that, the 1999 Act has introduced a certain number of features into the Hague system with a view to allowing or facilitating the accession of States whose legislation provides for a novelty examination;

– on the other hand, to preserve the fundamental simplicity of the Hague system and make it more attractive to applicants.

4. The 1999 Act also provides for the establishment of a link between the international registration system and regional systems, such as the designs system of the European Community or that of the African Intellectual Property Organization (OAPI), by providing that intergovernmental organizations may become party to the Act.

5. The main innovations made by the 1999 Act as compared with the present system provided for in the 1934 and 1960 Acts may be summarized as follows.

### **The Name of the Hague Agreement**

6. The 1999 Act changes the name of the Hague Agreement, which in future will be The Hague Agreement Concerning the International *Registration* (replacing International *Deposit*) of Industrial Designs. Also, throughout the 1999 Act (and the Regulations under it), the words “application” and “registration” are used instead of the word “deposit” of the 1934 and 1960 Acts. This new terminology corresponds more closely to that to be found in existing national and regional legislation and more accurately reflects the procedure leading to international registration under the 1999 Act.

### **Who Can Accede to the 1999 Act?**

7. The possibility of acceding to the 1999 Act is available not only to States but also to certain intergovernmental organizations. Contracting States and contracting intergovernmental organizations are collectively known as Contracting Parties.

8. In order to become party to the 1999 Act:

- a *State* has to meet just one condition, namely membership of WIPO;
- an *intergovernmental organization* has to maintain an Office authorized to grant protection to industrial designs with effect in the territory to which its constituting treaty applies. Moreover, at least one of the member States of the intergovernmental organization has to be a member of WIPO.

9. The Contracting Parties of the 1999 Act will be members of the same Union (the Hague Union) as the States party to the 1934 and 1960 Acts.

### **Entitlement to File an International Application**

10. Any person who is a national of a State that is a Contracting Party or of a member State of an intergovernmental organization that is a Contracting Party, or has a domicile, a *habitual residence* or a real and effective industrial or commercial establishment in the territory of a Contracting Party, is entitled to file an international application.

11. The right to file an international application on the express basis of habitual residence (being located in the territory of a Contracting Party) is new. The term “habitual residence”, borrowed from the Berne Convention for the Protection of Literary and Artistic Works, has been introduced in order to offset any too-narrow interpretation that might be put on the concept of “domicile” in certain national or regional legislation.

### **Definition, Identification and Designation of “the Applicant’s Contracting Party”**

12. The Contracting Party from which the applicant derives his right to file an international application (by fulfilling, in relation to that Contracting Party, at least one of the conditions set forth in paragraph 10 above) is called “the applicant’s Contracting Party.” Where the applicant can derive his right to file an international application from two or more Contracting Parties, “the applicant’s Contracting Party” is the one which, among those Contracting Parties, is indicated as such by the applicant in the international application.

13. The applicant’s Contracting Party may in principle be designated in an international application. However, any Contracting Party whose Office is an Examining Office<sup>1</sup> may notify the Director General that designating it in the international application has no effect when it is the applicant’s Contracting Party.

### **International Application Procedure**

14. The international application may be filed, at the option of the applicant, either directly with the International Bureau or through the Office of the applicant’s Contracting Party. It is possible for Contracting Parties to prohibit the indirect route, but they are not allowed to impose it.

### **Filing Date of the International Application**

15. For the allocation of a filing date to an international application, the 1999 Act makes a distinction between applications filed directly with the International Bureau by the applicant and those filed through the Office of the applicant’s Contracting Party. The principles are the following:

– in the case of direct filing, the filing date is the date on which the International Bureau receives the international application;

– in the case of indirect filing, it is the date on which the intermediary Office receives the international application, provided that the application is received by the International Bureau within one month thereafter. A Contracting Party whose legislation requires security clearance has the option of giving notice of the replacement of the one-month period by six months.

16. Moreover, where the international application has an irregularity which is prescribed as an irregularity entailing a postponement of the filing date of the international application, the filing date shall be the date on which the correction of such irregularity is received by the International Bureau. The irregularities which entail the postponement of the filing date of the international application are indications whose importance is such that no date can be assigned as long as they have not been provided (for example failure to indicate the identity of the applicant, the absence of reproductions or specimens of the designs or failure to designate at least one Contracting Party).

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<sup>1</sup> The expression “Examining Office” is defined in Article 1(xvii) of the Geneva Act as meaning an Office that examines *ex officio* applications for industrial design protection filed with it at least to determine whether the designs satisfy the condition of novelty.

### **Contents of the International Application**

17. The 1999 Act makes a distinction between three categories in the contents of the international application, namely the mandatory contents, the additional mandatory contents where certain Contracting Parties are designated and the optional contents.

18. The *mandatory contents* consist of the information that has to be contained in every international application or accompany it (such as the prescribed particulars concerning the applicant, a reproduction<sup>2</sup> of the designs for which protection is sought, an indication of the product or products constituting the industrial design or in relation to which the design is to be used, an indication of the designated Contracting Parties and the prescribed fees.

19. The *additional mandatory contents* have to be included in an international application where one or more particular Contracting Parties have been designated. They are additional elements that may be notified by a Contracting Party whose Office is an Examining Office. Where that Contracting Party is designated, the elements that it has notified have to be included in the international application (failing which, if the applicant does not act on an invitation sent him by the International Bureau within the prescribed period of three months, the international application is regarded as not containing the designation of the Contracting Party concerned). The elements that may be notified in that 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 have declared essential to the grant of a filing date under their national legislation.

20. Finally, certain *optional elements* may be provided by the applicant (for instance a declaration claiming the priority of an earlier application, or a statement identifying information known by the applicant to be material to the eligibility for protection of the design concerned), but their absence would not constitute an irregularity in the international application. Those optional elements may be provided by applicants as a means of avoiding refusal on the part of a designated Contracting Party.

### **Special Requirements**

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

#### *Special Requirements Concerning the Applicant*

22. Any Contracting Party whose legislation requires the 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. If that Contracting Party is designated in the international application, the identity of the creator of the industrial design has to be given and that person is deemed to

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<sup>2</sup> If deferment of the publication of a two-dimensional design is requested, the reproduction of the industrial design (which is needed for publication) does not have to be submitted before the time of publication. Consequently, it is provided that a prescribed number of *specimens* of the industrial design may be submitted with the international application in place of reproductions. That option offers great advantages to certain applicants, for instance in the textile industry.

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 has to 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.

*Special Requirements Concerning the Unity of the Design*

23. Any Contracting Party whose laws, at the time of its becoming party to the 1999 Act, contain 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. The purpose of the notification is to enable the Contracting Party that has made it to refuse the effects of an international registration if the requirement in question has not been met. In that case, the Office that has issued the refusal may ask the holder of the international registration to divide it solely for the designated Contracting Party concerned. The Office may charge the holder of that registration as many additional fees as divisions prove necessary (over and above the fee for the initial international registration). The mode of payment of additional fees of this type is not governed by the 1999 Act or by the Regulations under it; they will be specified by each Contracting Party concerned, which will collect them directly from the owner.

24. It is understood that such a notification 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.

**Standard and Individual Designation Fees**

25. The 1999 Act provides that the prescribed fees shall include a designation fee that has to be paid for each designated Contracting Party.

26. However, any Contracting Party whose Office is an Examining Office and any Contracting Party that is an intergovernmental organization may declare that, for each international application in which it is designated, and for the renewal of each international registration resulting from such an international application, the standard designation fee is replaced by an individual designation fee, the amount of which is specified in the declaration. That amount, although set by the Contracting Party itself, may not exceed the amount equivalent to what the Contracting Party in question would be entitled to receive from the applicant in the case of an application filed directly with its Office (for the same term of protection and for the same number of industrial designs), that amount being reduced by the amount of the savings resulting from the international procedure.

27. The declaration concerning the individual designation fee may also specify that the fee is to be paid in two parts, the first on the filing of the international application and the second at a later date fixed in accordance with the legislation of the Contracting Party concerned (in practice when the Office considers that the industrial design concerned may be granted protection on its territory).

### **Date of the International Registration**

28. The date of the international registration is normally the filing date of the international application (see paragraphs 15 and 16). However, where the international application has an irregularity relating to one of the additional elements notified by a designated Contracting Party (see paragraph 19), the date of the international registration is the date on which the correction of such irregularity is received by the International Bureau.

### **Publication**

29. The international registration is in principle published six months after the date on which it took place. That six-month delay is intended to allow the holder of an international registration to benefit from the *de facto* deferment that he would have had if he had filed a national application (namely the time that elapses before national publication, due account being taken of the time required for examination—both substantive and as to form—and for the technical preparations for publication).

30. An applicant may, however, ask for the international registration to be published immediately after the entry of the industrial design registration in the International Register. He may also ask for publication of the international registration to be deferred.

### **Deferment of Publication**

31. Where the international application contains a request for deferment of publication, the international registration will be published on the expiry of a period of 30 months from the filing date or, if priority has been claimed, from the priority date. However:

– where one or more of the designated Contracting Parties have declared that their legislation authorizes deferment of publication for a period shorter than 30 months, publication will occur on the expiry of the shortest of the periods mentioned in their declarations;

– where one of the designated Contracting Parties has declared that deferment is not possible under its legislation, the applicant (in so far as his international application is accompanied by reproductions rather than specimens<sup>3</sup>) will be invited to withdraw the designation of that Contracting Party within a period of one month following the date of the notification sent by the International Bureau to that end. Failing that, no account will be taken of the request for deferment of publication.

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<sup>3</sup> Where the international application is accompanied by *specimens* of the design, the International Bureau will not take account of the designation of the Contracting Party concerned and will notify the applicant accordingly.

### **Confidential Copy of an International Registration**

32. Where the publication of an international registration is deferred, a designated Office may receive a confidential copy of the registration provided that it uses that copy only for the purposes of examination or in conflict proceedings. The sending of the confidential copy is intended in particular to enable the Offices concerned to establish the state of the art if need be. The sending of a confidential copy should not be confused with the sending of a copy of the publication of the international registration, which starts the period for the notification of refusal of protection to the International Bureau.

### **Period for Refusal**

33. The prescribed period for the notification of a refusal of the effects of an international registration is six months from the date on which the International Bureau sends a copy of the publication of the international registration to the Office concerned.

34. However, any Contracting Party whose Office is an Examining Office or whose legislation provides for the possibility of filing opposition to the grant of protection may notify the Director General that a twelve-month period is substituted for the six-month period.

35. At any time during the period for refusal, an Office may send the owner a statement to the effect that it has decided to accept the effects of international registration, even where it has not communicated a notification of refusal.

### **Effects of International Registration**

36. Under the 1999 Act, the international registration has the same effects, in each designated Contracting Party as from the date of international registration, as an application for protection regularly filed with the Office of that Contracting Party.

37. Thereafter, in every designated Contracting Party that has not notified refusal of protection, or has notified refusal and subsequently withdrawn it, the international registration enjoys the same protection as would have been obtained by means of an application accepted by that Contracting Party.

38. As a general rule, the international registration produces its effects at the latest on the expiry date of the applicable refusal period. The words “at the latest” indicate that any Contracting Party is entitled to grant protection as from an earlier date, for instance from the date of international registration. Where the international registration has been the subject of a refusal of protection that has been subsequently withdrawn, the international registration produces its effects as from the withdrawal of the refusal of protection.

39. Nevertheless, the effects of the international registration may be delayed with respect to a Contracting Party in two situations. It is possible for a Contracting Party whose Office is an Examining Office or whose legislation provides for an opposition procedure to declare that the international registration will produce its effects:

- at a time that may be later than the expiry of the applicable refusal period, but not by more than six months, or
- at the time of the grant of protection under the legislation of that Contracting Party where the communication of a decision regarding the grant of protection has been unintentionally omitted.

### **Term of Protection**

40. International registration is effected for an initial period of five years following the date of international registration 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 designated Contracting Party is thus 15 years following the date of international registration.

41. 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.

42. Contracting Parties must notify the International Bureau of the maximum duration of protection granted to designs by their legislation. Information received by the International Bureau in that way will be published for the benefit of owners.

### **Relations Between the Contracting Parties and States Party to the 1934 or the 1960 Act**

43. The 1999 Act has no effect between a Contracting Party bound solely by that Act and States party to the 1934 or the 1960 Act but not to the 1999 Act.

44. In the case of States that are party *both* to the 1999 Act *and* to the 1934 or the 1960 Act, there arises the question of which of those Acts will be applicable in their mutual relations. The principle is that only the 1999 Act (the most recent) will bind those States in their mutual relations.

45. Consequently the 1934 and 1960 Acts will eventually fall into disuse as the States currently party to the 1934 or the 1960 Act ratify or accede to the 1999 Act.

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