

Hague Agreement Concerning the International Registration of Industrial Designs

Amendments to the Common Regulations and to the Administrative Instructions

1. At its thirtieth (18th ordinary) session, which took place in Geneva from September 26 to October 5, 2011, the Assembly of the Hague Union adopted amendments to the Common Regulations under the 1999 Act and the 1960 Act of the Hague Agreement. Furthermore, the Assembly was invited to comment on proposed amendments to the Administrative Instructions for the Application of the Hague Agreement, this with a view to proceeding to the consultation required pursuant to Rule 34(1)(a) of the Common Regulations. No comments were made on this occasion and, as a result of the said consultation, the Administrative Instructions have been amended by the Director General of the World Intellectual Property Organization (WIPO).

2. The bulk of the amendments to the Common Regulations and to the Administrative Instructions relates to the publication and contents of the *International Designs Bulletin* (hereinafter referred to as “the Bulletin”). Furthermore, a new Rule 21*bis* on the refusal of the effects of the recording of a change in ownership in the International Register has been added to the Common Regulations. Finally, a new Section 407 concerning an indication of a principal industrial design or a principal application or registration in an international application has been added to the Administrative Instructions. All these amendments will come into effect on January 1, 2012, and are further described below.

Publication and contents of the *International Designs Bulletin*

3. Upon recommendation by the *ad hoc* Working Group on the Legal Development of the Hague System for the International Registration of Industrial Designs (hereinafter referred to as “the *ad hoc* Working Group”), the Assembly adopted amendments to Rule 26(3) of the Common Regulations to reflect the fact that the publication itself of an issue of the Bulletin on the WIPO website will be deemed to replace the sending of the Bulletin, as referred to in Articles 10(3)(b) and 16(4) of the 1999 Act and Article 6(3)(b) of the 1960 Act.

4. Furthermore, as supported by the *ad hoc* Working Group, a weekly publication of the Bulletin will be implemented as from January 2012 (see Information Notice No.15/2011). As a consequence, Rule 26(3) of the Common Regulations was further amended to the effect that the obligation of the International Bureau to communicate the publication date of the Bulletin to the Office of each Contracting Party be removed. Under this weekly publication cycle, the Bulletin will be published on a given day of the week and that would make such communications obsolete. In this context, Section 204(d) of the Administrative Instructions has been amended so that at the express wish of the Office of a Contracting Party, the International Bureau would nonetheless continue sending this communication to the said Office.

5. In addition, Section 601 of the Administrative Instructions has been amended to the effect that the request for the recording of a renunciation or limitation concerning the international registration will now have to be received no later than three weeks prior to the expiry of the period of deferment, as opposed to three months.

6. Finally, the Assembly adopted amendments to the titles of Chapter 6 and Rule 26, and with respect to Rules 26(2) and (3), 28(2)(c) and (d) and 34(3)(a) and (b) of the Common Regulations to clearly reflect the fact that the WIPO website itself has become the central source of official information on the Hague system (such as declarations made by Contracting Parties) by replacing any reference to the Bulletin, as contained in these provisions by a reference to the WIPO website. Sections 204(a)(i) and (d) and 402(b) of the Administrative Instructions have been amended in a similar way.

Declaration that a change in ownership has no effect

7. Upon recommendation by the *ad hoc* Working Group, the Assembly adopted new Rule 21 *bis*, entitled “Declaration That a Change in Ownership Has No Effect”. This new Rule sets up a mechanism to allow the Office of a Contracting Party to send a declaration to the International Bureau that the recording of a change in ownership in the International Register shall have no effect in its territory, where such a change in ownership is not compatible with its national/regional law. The said declaration shall be sent to the International Bureau within six months from the date of publication of the change in ownership in the Bulletin or within the applicable refusal period in accordance with Article 12(2) of the 1999 Act or Article 8(1) of the 1960 Act, whichever expires later, and shall comply with the requirements under the said new Rule.

Relation with a principal industrial design or a principal application or registration

8. A new Section 407, entitled “Relation with a Principal Industrial Design or a Principal Application or Registration”, has been added to the Administrative Instructions, to address the specific features under the law of some jurisdictions, which provide for a “similar design” system or a “related design” system. The new Section prescribes that where the applicant wishes any or all of the industrial designs contained in the international application to be considered, under the law of a designated Contracting Party that so provides, in relation to any national or international application or registration, or to any industrial design contained in a national or international application or registration, the international application shall contain an indication to that effect.

9. None of the current Contracting Parties to the Hague Agreement has such a feature in its law but it is foreseen that the legislation of some future Contracting Parties may provide for a “similar design” system or a “related design” system.

Annexes and further information

10. The amended text of the Common Regulations and the Administrative Instructions is reproduced in Annexes I and II.

11. A more detailed presentation of the amendments referred to above can be found in the Hague Union Assembly document H/A/30/1, which is available on the WIPO web site, at the following address: http://www.wipo.int/meetings/en/details.jsp?meeting_id=23141.

December 20, 2011

**Common Regulations
Under the 1999 Act and the 1960 Act
of the Hague Agreement**

(as in force on January 1, 2012)

[...]

CHAPTER 4

CHANGES AND CORRECTIONS

[...]

Rule 21bis

Declaration That a Change in Ownership Has No Effect

(1) *[Declaration and Its Effect]* The Office of a designated Contracting Party may declare that a change in ownership recorded in the International Register has no effect in the said Contracting Party. The effect of such a declaration shall be that, with respect to the said Contracting Party, the international registration concerned shall remain in the name of the transferor.

(2) *[Contents of the Declaration]* The declaration referred to in paragraph (1) shall indicate

- (a) the reasons for which the change in ownership has no effect,
- (b) the corresponding essential provisions of the law,
- (c) where the declaration does not relate to all the industrial designs that are the subject of the change in ownership, those to which it relates, and
- (d) whether such declaration may be subject to review or appeal and, if so, the time limit, reasonable under the circumstances, for any request for review of, or appeal against, the declaration and the authority to which such request for review or appeal shall lie, with the indication, where applicable, that the request for review or the appeal has to be filed through the intermediary of a representative whose address is within the territory of the Contracting Party whose Office has pronounced the declaration.

(3) *[Period for Declaration]* The declaration referred to in paragraph (1) shall be sent to the International Bureau within six months from the date of the publication of the said change in ownership or within the applicable refusal period in accordance with Article 12(2) of the 1999 Act or Article 8(1) of the 1960 Act, whichever expires later.

(4) *[Recording and Notification of the Declaration; Consequential Modification of the International Register]* The International Bureau shall record in the International Register any declaration made in accordance with paragraph (3) and shall modify the International Register, whereby that part of the international registration which has been the subject of the said declaration shall be recorded as a separate international registration in the name of the previous holder (transferor). The International Bureau shall notify accordingly the previous holder (transferor) and the new holder (transferee).

(5) *[Withdrawal of Declaration]* Any declaration made in accordance with paragraph (3) may be withdrawn, in part or in whole. The withdrawal of declaration shall be notified to the International Bureau which shall record it in the International Register. The International Bureau shall modify the International Register accordingly, and shall notify accordingly the previous holder (transferor) and the new holder (transferee).

[...]

CHAPTER 6

PUBLICATION

Rule 26 Publication

[...]

(2) *[Information Concerning Declarations; Other Information]* The International Bureau shall publish on the web site of the Organization any declaration made by a Contracting Party under the 1999 Act, the 1960 Act or these Regulations, as well as a list of the days on which the International Bureau is not scheduled to open to the public during the current and the following calendar year.

(3) *[Mode of Publishing the Bulletin]* The Bulletin shall be published on the web site of the Organization. The publication of each issue of the Bulletin shall be deemed to replace the sending of the Bulletin referred to in Article 10(3)(b) and 16(4) of the 1999 Act and Article 6(3)(b) of the 1960 Act, and, for the purposes of Article 8(2) of the 1960 Act, each issue of the Bulletin shall be deemed to have been received by each Office concerned on the date of its publication on the web site of the Organization.

[...]

CHAPTER 7

FEES

[...]

Rule 28 Currency of Payments

[...]

(2) *[Establishment of the Amount of Individual Designation Fees in Swiss Currency]*

[...]

(c) Where, for more than three consecutive months, the official exchange rate of the United Nations between the Swiss currency and the currency in which the amount of an individual designation fee has been indicated by a Contracting Party is higher or lower by at least 5% than the last exchange rate applied to establish the amount of the fee in Swiss currency, the Office of that Contracting Party may ask the Director General to establish a new amount of the fee in Swiss

currency according to the official exchange rate of the United Nations prevailing on the day preceding the day on which the request is made. The Director General shall proceed accordingly. The new amount shall be applicable as from a date which shall be fixed by the Director General, provided that such date is between one and two months after the date of the publication of the said amount on the web site of the Organization.

(d) Where, for more than three consecutive months, the official exchange rate of the United Nations between the Swiss currency and the currency in which the amount of an individual designation fee has been indicated by a Contracting Party is lower by at least 10% than the last exchange rate applied to establish the amount of the fee in Swiss currency, the Director General shall establish a new amount of the fee in Swiss currency according to the current official exchange rate of the United Nations. The new amount shall be applicable as from a date which shall be fixed by the Director General, provided that such date is between one and two months after the date of the publication of the said amount on the web site of the Organization.

[...]

CHAPTER 9

MISCELLANEOUS

[...]

Rule 34 Administrative Instructions

[...]

(3) [*Publication and Effective Date*] (a) The Administrative Instructions and any modification thereof shall be published on the web site of the Organization.

(b) Each publication shall specify the date on which the published provisions become effective. The dates may be different for different provisions, provided that no provision may be declared effective prior to its publication on the web site of the Organization.

[Annex II follows]

Administrative Instructions for the Application of the Hague Agreement

(as in force on January 1, 2012)

[...]

Part Two Communications with the International Bureau

[...]

Section 204: Electronic Communications

(a) (i) Communications with the International Bureau, including the presentation of the international application, may take place by electronic means at a time and in a manner and format to be ascertained by the International Bureau, the particulars of which shall be published on the website of the Organization.

[...]

(d) Where the Office of a Contracting Party wishes to receive a communication by the International Bureau of the date on which each issue of the Bulletin is published, that Office shall notify the International Bureau of that fact and indicate the email address to which the said communication shall be sent.

Part Four Requirements Concerning Reproductions and Other Elements of the International Application

[...]

Section 402: Representation of the Industrial Design

[...]

(b) 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. With respect to the filing of international applications by electronic means, the International Bureau may establish a data format, the particulars of which shall be published on the website of the Organization, to ensure compliance with these maximum and minimum dimensions.

[...]

*Section 407: Relation with a Principal Industrial Design
or a Principal Application or Registration*

(a) Where the applicant wishes any or all of the industrial designs which are contained in the international application to be considered, under the law of a designated Contracting Party that so provides, in relation to any national or international application or registration (the principal application or registration), or to any certain industrial design contained in a national or international application or registration (the principal industrial design), the international application shall contain a request to that effect, identifying the Contracting Party concerned and providing the reference to the principal application or registration, or to the principal industrial design.

(b) For the purpose of subparagraph (a), the reference to the principal application or registration or to the principal industrial design shall be indicated in either of the following manners:

(i) Where the principal industrial design is contained in the same international application, the number of that industrial design;

(ii) Where the principal industrial design is the subject of another national or international registration, the number of the national or international registration concerned, together with the number of the principal industrial design if such a registration contains more than one industrial design;

(iii) Where the principal industrial design is the subject of a national application which has not matured into registration, the number of the national application concerned or, if not available, the applicant's reference for that national application, together with the number of the principal industrial design if such an application contains more than one industrial design; or

(iv) Where the principal industrial design is the subject of an international application which has not matured into international registration, the reference given by the International Bureau to that international application, together with the number of the principal industrial design if such an application contains more than one industrial design.

(c) Where the request under subparagraph (a) concerns only one or some of the industrial designs which are contained in the international application, the request shall also indicate the numbers of the industrial designs concerned.

[...]

Part Six
Request for the Recording of a Limitation or Renunciation
when Publication Deferred

*Section 601: Latest Time to Request the Recording
of a Limitation or Renunciation*

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, 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 however recorded in the International Register.

[End of Annex II]