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Special Union for the International Deposit of Industrial Designs (Hague Union)

Assembly

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COVID-19 MEASURES: MAKING E-MAIL ADDRESS A REQUIRED INDICATION

Document prepared by the Secretariat

I. BACKGROUND

1. The COVID-19 pandemic and measures taken in connection with it have resulted in severe disruptions for the IP community including users of the Hague System for the International Registration of Industrial Designs (hereinafter referred to as “the Hague System”) in terms of communications between applicants, holders or their representatives and the International Bureau.
2. Before the COVID-19 pandemic, as a matter of practice, the International Bureau transmitted its communications to applicants, holders and their representatives by postal service. For irregularities concerning international applications only, the electronic version of the communications was also made available in eHague where the international application had been filed using eHague.
3. On March 30, 2020, the International Bureau announced that it had stopped transmitting paper communications due to the suspension of postal services between Switzerland and a number of countries and in order to comply with guidance from public health authorities¹. Instead, the International Bureau started to send e-mails allowing a specific communication to be retrieved through a secure download mechanism, where the party concerned had provided an e-mail address. The overall feedback from users in respect of this change to electronic communication has been very positive.

¹ Refer to Information Notice No. 6/2020, available at the following address:
https://www.wipo.int/edocs/hagdocs/en/2020/hague_2020_06.pdf.

4. However, the International Bureau had to search for e-mail addresses associated with the parties concerned in approximately 16 per cent of the international registrations. At the time of writing this document and following further research, the International Bureau has not been able to obtain the e-mail addresses for less than 3 per cent of the cases. In such instances, the International Bureau has sent or will send the communication by traditional postal mail.

5. The current COVID-19 pandemic has shown the need for the International Bureau to effect notifications in electronic form. Electronic communication is the fastest, most efficient, resilient and secure means to transmit information. As the default means of communication, it would benefit users of the Hague System, since it would ensure prompt delivery without negatively affecting delays to respond to time sensitive communications, such as, notifications of refusal.

6. In view of the above and due to the urgency of the situation, this document presents a proposal to amend the Common Regulations Under the 1999 Act and the 1960 Act of the Hague Agreement (hereinafter referred to as “the Common Regulations”) directly to the Assembly of the Hague Union for its immediate consideration, with a view to ensuring that users of the Hague System benefit from receiving electronic communication from the International Bureau.

7. A similar proposal is also submitted directly to the fifty-fourth (31st extraordinary) session of the Assembly of the Madrid Union in order to amend the Regulations under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks².

II. PROPOSAL TO AMEND RULES 3, 7 AND 21

8. It is proposed that Rules 3(2)(c) and (3)(a), 7(3)(ii) and (5)(b), and 21(2)(iii) of the Common Regulations be amended, so as to ensure that applicants, new owners and their representatives provide an e-mail address in an international application, in a request for the recording of a change in ownership, or in a separate communication appointing a representative.

9. The proposed amendments aim to ensure that all users of the Hague System benefit from receiving electronic communication from the International Bureau. Electronic communication is traceable and allows the International Bureau to determine whether a communication has reached its intended recipient.

10. The proposed amendments to Rules 3(2)(c) and (3)(a) and 7(5)(b) would require that the communication to appoint a representative must contain an e-mail address of the representative. This would include all communications in which the recording of a representative is requested, such as an international application, a request for the recording of a change, a request for renewal, and a separate communication to appoint a representative (power of attorney).

11. Simply to clarify and to remain consistent with other relevant provisions³, the opportunity is seized to prescribe that all such communications must contain the name and address of the representative, given in accordance with the Administrative Instructions.

12. The proposed amendments to Rules 7(3)(ii) and 21(2)(iii) would require that an international application must contain an e-mail address of the applicant and that a request for the recording of a change in ownership must contain an e-mail address of the new owner of the international registration, respectively.

² Refer to document MM/A/54/1.

³ Such as Rules 7(3)(i) and (ii) and (5)(b) and 21(2)(iii).

13. The International Bureau estimates that there remain over 5,000 international registrations in force for which neither the holder nor the representative has indicated an e-mail address. The International Bureau would continue to perform a succinct search to collect their e-mail addresses with respect to those international registrations. The International Bureau also encourages holders and their representatives to provide or update their e-mail addresses by using forms DM/6 (request for the recording of a change in name and/or address of the holder) or DM/8 (request for the recording of a change in name and/or address of the representative). The International Bureau would continue to send its communications by postal services until it has collected the relevant e-mail addresses.

14. E-mail addresses are recorded in the International Register as part of information of applicants, holders and their representatives. However, as it is currently the case and to address privacy concerns, the International Bureau would not include the e-mail address of applicants, holders or representatives in the *International Designs Bulletin* and online information services (e.g., Hague Express, and the Global Design Database) available on WIPO's website.

15. The proposed amendments to the aforementioned provisions would not have an impact on the IT system nor on the operations of the International Bureau.

III. ENTRY INTO FORCE OF THE PROPOSED AMENDMENTS

16. As indicated earlier, the COVID-19 pandemic and measures taken in connection with it have resulted in severe disruptions for users of the Hague System that are likely to continue for some time in several regions of the world.

17. In view of the above and the need to safeguard the interests of the users of the Hague System, it is recommended that the proposed amendments to Rules 3, 7 and 21 enter into force on February 1, 2021.

18. *The Assembly of the Hague Union is invited to adopt the amendments to Rules 3, 7 and 21 of the Common Regulations, as set out in the Annex to document H/A/40/1, with a date of entry into force of February 1, 2021.*

[Annex follows]

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

(as in force on [February 1, 2021])

[...]

**CHAPTER 1
GENERAL PROVISIONS**

[...]

Rule 3

Representation Before the International Bureau

[...]

(2) *[Appointment of the Representative]* (a) The appointment of a representative may be made in the international application. The naming of the representative in the international application at the time of filing shall constitute an appointment by the applicant of such representative.

(b) The appointment of a representative may also be made in a separate communication which may relate to one or more specified international applications or international registrations of the same applicant or holder. The said communication shall be signed by the applicant or the holder.

(c) The communication to appoint a representative shall contain the name and address, given in accordance with the Administrative Instructions, and email address of the representative. Where the International Bureau considers that the appointment of a representative is irregular, it shall notify accordingly the applicant or holder and the purported representative.

(3) *[Recording and Notification of Appointment of a Representative; Effective Date of Appointment]* (a) Where the International Bureau finds that the appointment of a representative complies with the applicable requirements, it shall record the fact that the applicant or holder has a representative, as well as the name, address and email address of the representative, in the International Register. In such a case, the effective date of the appointment shall be the date on which the International Bureau received the international application or separate communication in which the representative is appointed.

[...]

[...]

CHAPTER 2 INTERNATIONAL APPLICATIONS AND INTERNATIONAL REGISTRATIONS

Rule 7

Requirements Concerning the International Application

[...]

(3) *[Mandatory Contents of the International Application]* The international application shall contain or indicate

- (i) the name of the applicant, given in accordance with the Administrative Instructions;
- (ii) the address ~~of the applicant~~, given in accordance with the Administrative Instructions, and email address of the applicant;

[...]

(5) *[Optional Contents of an International Application]*

[...]

(b) Where the applicant has a representative, the international application shall state the name and address ~~of the representative~~, given in accordance with the Administrative Instructions, and email address of the representative.

[...]

CHAPTER 4 CHANGES AND CORRECTIONS

Rule 21

Recording of a Change

[...]

(2) *[Contents of the Request]* The request for the recording of a change shall, in addition to the requested change, contain or indicate

- (i) the number of the international registration concerned,
- (ii) the name of the holder, unless the change relates to the name or address of the representative
- (iii) in case of a change in the ownership of the international registration, the name and address, given in accordance with the Administrative Instructions, and email address of the new owner of the international registration,

[...]

[End of Annex and of document]