

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

Assembly

Forty-Second (19th Extraordinary) Session Geneva, July 14 to 22, 2022

PROPOSED AMENDMENTS TO THE COMMON REGULATIONS UNDER THE 1999 ACT AND THE 1960 ACT OF THE HAGUE AGREEMENT

Document prepared by the Secretariat

INTRODUCTION

1. The Working Group on the Legal Development of the Hague System for the International Registration of Industrial Designs (hereinafter referred to as “the Working Group”), at its tenth session held on December 13 and 14, 2021, basing itself on document H/LD/WG/10/2, considered favorably the submission of proposals to amend Rules 21 and 26 of the Common Regulations Under the 1999 Act and the 1960 Act of the Hague Agreement (hereinafter referred to as “the Common Regulations”), to the Assembly of the Hague Union (hereinafter referred to as “the Assembly”)¹ for their adoption². The following paragraphs summarize the proposed amendments as reproduced in Annex I (using “track-changes”) and Annex II (“clean” text).

¹ Refer to document H/LD/WG/10/6, “Summary by the Chair”.

² It is recalled that at its eighth session held from October 30 to November 1, 2019, the Working Group discussed a proposal to amend the Common Regulations with respect to the Schedule of Fees, and favorably considered the submission to the Assembly of the proposed increase of the amount of the basic fee for each additional design set out in item 1.2 from 19 Swiss francs to 50 Swiss francs. However, this proposal was not submitted to the fortieth session of the Assembly, which took place in September 2020, as the latter was held with a reduced agenda, nor to the forty-first session of the Assembly, which took place in October 2021, due to the negative

PROPOSED AMENDMENTS TO RULES 21 AND 26

2. Where a representative is appointed at the time of filing or during the pendency of an international application, such appointment is recorded in the International Register and published in the *International Designs Bulletin* (hereinafter referred to as “the Bulletin”) as part of the international registration. Currently, however, neither the appointment of a representative, nor the cancellation thereof, nor the change in the name or address of the representative is published in the Bulletin if it takes place after the international registration.
3. The proposed amendments to Rules 21 and 26 of the Common Regulations would provide for publication in the Bulletin of such up-to-date information concerning representatives as well, so that the Office of a designated Contracting Party would continue to be notified³ in that respect.
4. The proposed introduction of item (v) in subparagraph (1)(a) of Rule 21, in conjunction with paragraph (6), would formalize the current practice of the International Bureau to record in the International Register a change in the name or address of the representative. The proposed amendment to item (ii) of newly numbered subparagraph (2)(a)⁴ would clarify that such a request should contain the name of the representative currently recorded in the International Register for verification.
5. The proposed introduction of subparagraph (2)(b) in Rule 21 would clarify that where a representative is appointed along with a request for the recording of a change in ownership, such an appointment would be published as part of the recording of the change in ownership.
6. The proposed amendment to subparagraph (1)(iv) of Rule 26 would simplify the current text by no longer listing each type of the changes covered by subparagraph (1)(a) of Rule 21, and would also encompass the publication of a change in the name or address of the representative, as referred to in proposed item (v) of subparagraph (1)(a) of Rule 21.
7. The proposed introduction of subparagraph (1)(ivbis) in Rule 26 would ensure that the appointment or cancellation of a representative would be published in the Bulletin, where such appointment has not been published as part of the international registration or of the recording of a change in ownership, or such cancellation cannot be inferred otherwise⁵.
8. Finally, the opportunity is seized to add to Rule 26(3) a reference to Article 17(5) of the 1999 Act, in order to clarify that the publication of each issue of the Bulletin is deemed to replace the sending of the Bulletin under Article 17(5) for the purpose of notifying recordings of renewal to the Office of each of the designated Contracting Parties concerned.

economic impact of the COVID-19 pandemic on users at the time. Given the ongoing negative economic impact of COVID-19 as of the date of this document, the said proposal is, in this instance again, not included in the present submission.

³ Paragraph 25 of document H/LD/WG/10/2 describes in detail how the proposed amendments to Rules 21 and 26 would provide for the publication in the Bulletin of the appointment or cancellation of a representative and of any update concerning the representative.

⁴ The addition of reference to “(a)” in paragraph (2) of Rule 21 is a consequence of the proposed introduction of subparagraph (2)(b), as explained in paragraph 5 of the present document.

⁵ Cancellation of the appointment of the current representative may be inferred where a new representative was appointed, or where a change in ownership is recorded and no representative is appointed by the new holder (Rule 3(5)(a)).

ENTRY INTO FORCE OF THE PROPOSED AMENDMENTS

9. The Working Group recommended that the proposed amendments to Rules 21 and 26 enter into force on April 1, 2023. Accordingly, the amendments would apply to appointments, cancellations thereof and changes in the name or address of a representative recorded on and after the date of entry into force.

10. The Assembly of the Hague Union is invited to adopt the proposed amendments to Rules 21 and 26 of the Common Regulations, as set out in Annexes I and II to document H/A/42/1, with a date of entry into force of April 1, 2023.

[Annexes follow]

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

(as in force on [April 1, 2023])

[...]

CHAPTER 4

CHANGES AND CORRECTIONS

Rule 21

Recording of a Change

(1) [*Presentation of the Request*] (a) A request for the recording shall be presented to the International Bureau on the relevant official form where the request relates to any of the following:

- (i) a change in the ownership of the international registration in respect of all or some of the industrial designs that are the subject of the international registration;
- (ii) a change in the name or address of the holder;
- (iii) a renunciation of the international registration in respect of any or all of the designated Contracting Parties;
- (iv) a 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;
- (v) [a change in the name or address of the representative.](#)

[...]

(2) [*Contents of the Request*] (a) 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 or the name of the representative where](#) 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,
- (iv) in case of a change in the ownership of the international registration, the Contracting Party or Parties in respect of which the new owner fulfills the conditions to be the holder of an international registration,
- (v) in 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, and
- (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.

[\(b\) The request for the recording of a change in the ownership of the international registration may be accompanied by a communication to appoint a representative of the new owner. Provided that the requirements under Rule 3\(2\)\(b\) and \(c\) are complied with, the effective date of such appointment shall be the date of the recording of the change in ownership pursuant to paragraph \(6\)\(b\). In such case, the recording of the change in ownership in the International Register shall contain that appointment.](#)

[...]

CHAPTER 6
PUBLICATION

Rule 26
Publication

- (1) [*Information Concerning International Registrations*] The International Bureau shall publish in the Bulletin relevant data concerning
- (i) international registrations, in accordance with Rule 17;
 - (ii) refusals, with an indication as to whether there is a possibility of review or appeal, but without the grounds for refusal, and other communications recorded under Rules 18(5) and 18*bis*(3);
 - (iii) invalidations recorded under Rule 20(2);
 - (iv) changes ~~in ownership and mergers, changes of name or address of the holder, renunciations and limitations~~ recorded under Rule 21;
(iv*bis*) appointments of representatives recorded under Rule 3(3)(a), unless published under items (i) or (iv), and cancellations thereof other than *ex officio* cancellations under Rule 3(5)(a):
 - (v) corrections effected under Rule 22;
 - (vi) renewals recorded under Rule 25(1);
 - (vii) international registrations which have not been renewed;
 - (viii) cancellations recorded under Rule 12(3)(d);
 - (ix) declarations that a change in ownership has no effect and withdrawals of such declarations recorded under Rule 21*bis*.

[...]

- (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 Articles 10(3)(b), ~~and~~ 16(4) and 17(5) 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.

[...]

[Annex II follows]

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

(as in force on [April 1, 2023])

[...]

CHAPTER 4

CHANGES AND CORRECTIONS

Rule 21

Recording of a Change

(1) [*Presentation of the Request*] (a) A request for the recording shall be presented to the International Bureau on the relevant official form where the request relates to any of the following:

- (i) a change in the ownership of the international registration in respect of all or some of the industrial designs that are the subject of the international registration;
- (ii) a change in the name or address of the holder;
- (iii) a renunciation of the international registration in respect of any or all of the designated Contracting Parties;
- (iv) a 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;
- (v) a change in the name or address of the representative.

[...]

(2) [*Contents of the Request*] (a) 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, or the name of the representative where 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,
- (iv) in case of a change in the ownership of the international registration, the Contracting Party or Parties in respect of which the new owner fulfills the conditions to be the holder of an international registration,
- (v) in 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, and
- (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.

(b) The request for the recording of a change in the ownership of the international registration may be accompanied by a communication to appoint a representative of the new owner. Provided that the requirements under Rule 3(2)(b) and (c) are complied with, the effective date of such appointment shall be the date of the recording of the change in ownership pursuant to paragraph (6)(b). In such case, the recording of the change in ownership in the International Register shall contain that appointment.

[...]

CHAPTER 6

PUBLICATION

Rule 26

Publication

- (1) [*Information Concerning International Registrations*] The International Bureau shall publish in the Bulletin relevant data concerning
- (i) international registrations, in accordance with Rule 17;
 - (ii) refusals, with an indication as to whether there is a possibility of review or appeal, but without the grounds for refusal, and other communications recorded under Rules 18(5) and 18*bis*(3);
 - (iii) invalidations recorded under Rule 20(2);
 - (iv) changes recorded under Rule 21;
 - (iv*bis*) appointments of representatives recorded under Rule 3(3)(a), unless published under items (i) or (iv), and cancellations thereof other than *ex officio* cancellations under Rule 3(5)(a);
 - (v) corrections effected under Rule 22;
 - (vi) renewals recorded under Rule 25(1);
 - (vii) international registrations which have not been renewed;
 - (viii) cancellations recorded under Rule 12(3)(d);
 - (ix) declarations that a change in ownership has no effect and withdrawals of such declarations recorded under Rule 21*bis*.

[...]

- (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 Articles 10(3)(b), 16(4) and 17(5) 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.

[...]

[End of Annex II and of document]