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**SPECIAL UNION FOR THE INTERNATIONAL DEPOSIT OF INDUSTRIAL DESIGNS
(HAGUE UNION)**

ASSEMBLY

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MATTERS CONCERNING THE HAGUE UNION: REGULATIONS

Document prepared by the International Bureau

1. Under Article 2(2)(a)(iii) of the Complementary Act of Stockholm of July 14, 1967, the Assembly of the Hague Union may modify the Regulations Under the Hague Agreement Concerning the International Deposit of Industrial Designs (hereinafter referred to as “the Regulations”). The present document contains proposals to amend Rules 5.1(a)(iv), 5.1(b)(ii) and (c)(ii), 8.3(b), 12.1(a) and (b), 14.1 and 2(c), 19.1(a), 24.2(a) and 28.1(b) of the Regulations.

2. Rule 31.1(a) of the Regulations provides that the Director General may modify the Administrative Instructions for the Application of the Hague Agreement Concerning the International Deposit of Industrial Designs (hereinafter referred to as “the Administrative Instructions”) and, for that purpose, shall consult the national or regional Offices which have a direct interest in the proposed modification of those Administrative Instructions. The proposed amendments to Rules 8.3(b) and 14.2(c) of the Regulations would entail amendments to Sections 107 and 304 of the Administrative Instructions. To facilitate the task of interested Offices, those consequential amendments to the Administrative Instructions are also presented in this document, and comments by the said Offices are invited thereon (this procedure constituting the consultation referred to in Rule 31.1(a) of the Regulations).

Irregularities Which Affect the Date of the International Deposit

3. Article 6(2) of the 1960 Act of the Hague Agreement provides that the international deposit shall be deemed to have been made on the date on which the International Bureau received the application in due form, together with the fees payable and the required reproductions. Under Rule 14.2(c) of the Regulations, failure to comply with any of the requirements listed in that provision affects the date of the international deposit. It is believed that the depositor could be given opportunities in more cases to remedy irregularities without the date of international deposit being affected. The proposed amendments to Rule 14.2(c) would provide a less stringent test of what is meant by an application “in due form,” and would also relax the requirement that the fees must be paid in full in order to obtain a date of international deposit. This proposal also goes in the same direction as Article 8(3) of the draft new Act of the Hague Agreement (see document H/CE/VI/2).

4. If these amendments are adopted, the following irregularities would no longer affect the date of deposit (it being understood that, if they were not corrected in time, the international deposit would be declined under Rule 14.2(d)):

- the application does not contain all of the indications referred to in Rule 5.1(a)(iii) (State(s) of nationality, residence and establishment of the depositor), provided, however, that it contains sufficient indications to permit the conclusion that the depositor is entitled to own an international deposit (Rule 14.2(c)(iv));

- the application does not contain the indications referred to in Rule 5.1(a)(v) (exact designation of the article or articles in which it is intended to incorporate the designs), (vi) (number of designs included in the international deposit) and (vii) (indication of the amounts of fees paid, name of the person making the payment and mode of payment);

- the application is not signed;

- the graphic representations or samples furnished do not comply with the applicable requirements under Rule 12 (for example, those concerning the dimensions of the representation; or the quality of the photographs, graphic representations or photographic transparencies);

- the prescribed fees have not been paid or have not been paid in full.

5. If the proposals described in paragraph 4, above, were accepted, the irregularities affecting the date of the international deposit that would remain would be the following:

- the application does not contain an indication to the effect that it is filed under the Agreement;

- the application does not contain the necessary indications to identify the depositor and reach him by post (in other words, lack of indications allowing the identity of the depositor to be established and enabling the depositor or his representative, if any, to be contacted);

- the indications contained in the application are not such as to permit the conclusion that the depositor is entitled to own an international deposit;

- the application is not in the prescribed language or one of the prescribed languages;
- no graphic representations or samples were furnished in respect of a given article or design (it being understood that if only one representation/sample is furnished instead of two, this would continue not to be a “filing date irregularity”);
- the application (governed exclusively by the 1934 Act) does not contain an indication of the type of deposit (open or sealed), or the indication given is at variance with the notice referred to in Rule 11.1;
- the application (governed exclusively or partly by the 1960 Act) does not designate at least one State bound by the 1960 Act.

6. The irregularities affecting the date of the international deposit would, on the one hand, correspond, *mutatis mutandis*, to those existing in the Madrid system of international registration of marks (see Rule 15(1)(a) of the Common Regulations Under the Madrid Agreement and the Madrid Protocol (in force since April 1, 1996)), and, on the other hand, to those same irregularities as proposed in Article 8(3) of the draft new Act of the Hague Agreement (see document H/CE/VI/2).

7. The proposed changes to Rule 14.2(c) would entail changes to Rule 14.1 and Section 304 of the Administrative Instructions which, as currently drafted, also applies to the date of recordal of an international deposit. Section 304, as amended, is still needed to provide for the date of recordal in the International Register of matters subsequent to the recordal of the international deposit (change in ownership, renunciation, refusal of protection, etc.).

8. The proposed amendments to Rule 14.1 and 2(c) of the Regulations, and the new text of Section 304 of the Administrative Instructions, appear in Annex I.

Reproductions

9. Article 2(1) of the 1934 Act of the Hague Agreement provides that the design included in an international deposit must be in the form of the “industrial product” for which it is intended or in the form of a drawing, photographic or other graphic representation *of the design*. Under Article 5(1) and (2)2. of the 1960 Act of the Hague Agreement, the international deposit consists, *inter alia*, of one or more photographs or other graphic representation *of the design* and the application for international deposit must contain “the designation of the article or articles in which it is intended to incorporate the design.”

10. The Regulations, however, do not only require that the application for international deposit contain “the exact designation of the article or articles in which it is intended to incorporate the designs” (Rule 5.1(a)(v)) but also that it be accompanied by graphic representations *of each article designated* (Rule 12.1(a) and (b)). Section 401 of the Administrative Instructions permits, for its part, that where two or more articles form a whole (e.g., a dinner service), the application be accompanied by the graphic representation of one only of the articles forming the whole.

11. The main consequence of these provisions is that, since each article must not only be designated but also represented, an applicant may not apply for protection of a design *per se*, for example, a decorative motif to be applied to several different articles falling within the same class but not part of a whole. A number of users of the Hague system consider that the current obligations under Rule 12 result from too strict an interpretation of Article 5.2(2) of the 1960 Act of the Hague Agreement. From a practical point of view, they argue that the obligation to furnish a graphic representation of each article designated (unless the articles form a whole) renders the procedure rather cumbersome and increases significantly the costs.

12. It is therefore proposed to amend Rule 12.1(a) and (b) of the Regulations so as to allow an applicant to seek protection for a design to be applied to several different articles without being required to provide a reproduction of any of the articles themselves, while maintaining the obligation to designate in the application the article or articles in which the design is intended to be incorporated and the requirement that those articles belong to the same class of the Locarno Classification.

13. The proposed amendments to Rule 12 would entail the deletion of the words “of the deposited article” from Rule 5.1(b)(ii) and (c)(ii) of the Regulations.

14. The proposed amendments are contained in Annex II.

Amounts and Payment of Fees

15. Rule 28.1(b) of the Regulations deals with the amount of fees to be paid where there has been a change in the Schedule of Fees. Item (i) concerns the fees payable in connection with an application for international deposit. At present, it provides that the fees payable are those in force on the date of receipt by the International Bureau of a deposit complying with the Agreement and the Regulations, that is, on the date when any irregularity in the deposit has been remedied. This means that, where the applicable fees change between the date when the applicant is invited to remedy any irregularity and the date of receipt of the applicant’s response to that invitation, a new irregularity—namely that the fees paid became insufficient—not referred to in the invitation may arise. In order to avoid this, it is proposed that the fees payable be those in force on the date of receipt of that deposit, whether that deposit is regular or requires regularisation. The financial implications on the revenues of the International Bureau that would be entailed by this change are insignificant.

16. Item (ii) of Rule 28.1(b) concerns the fees payable in connection with the prolongation or renewal of an international deposit. Under Rule 24.2(a), these fees may be paid up to one year before the due date. Rule 28.1(b)(ii) has the effect that, where the fees are paid more than six months before the expiry of the term of protection, the fees payable are those in force at the time of payment whereas, where the fees are paid up to six months before the expiry of the term of protection, the fees payable are those in force six months before that date. This system seems unnecessarily complicated and has the inconvenience that it requires the International Bureau to monitor two different Schedules of Fees during the six-month period following the effective date of a change in the Schedule of Fees. It is therefore proposed that both these rules should be changed to the effect that the fees may be paid up to six months before the due date and that the amount payable will simply be the amount in force on the date of the payment.

17. The proposed amendments are contained in Annex III.

Request for Recording of Change in Ownership

18. Rule 19.1(a), which concerns the recordal of a change in the ownership of an international deposit, does not prescribe the use of a form issued by the International Bureau (as is the case for an application for international deposit under Rule 8.1(a)). In order to facilitate the task of the owners of international deposits, the International Bureau makes available an “unofficial form” (DM/25) for the purposes of requesting the recordal of a change in ownership. Many owners use that form; however, the International Bureau also receives such requests in the form of a mere letter, sometimes handwritten and, in most cases, defective.

19. In order to facilitate compliance with the requirements of Rule 19.1(b) and (c), and the work of the International Bureau, it is proposed that the “unofficial” form (DM/25) become a model form. Consequently, it is proposed that Rule 19.1(a) be worded in the same manner as Rule 8.1 of the Regulations (which concerns the international deposit). The only consequence of failure to use the form would be that the International Bureau would invite the party concerned to use it; the date of recordal would be postponed until a request made on the model form was received. The proposed amendment is contained in Annex IV.

20. If this amendment is adopted, Section 102 of the Administrative Instructions (Use of the Forms) and the first page of Annex B of those Instructions (Forms) will be adjusted. Furthermore, Form DM/25 will be included in Annex B. Since those adjustments are merely of an editorial nature, they have not been included in Annex IV.

Non-Prescribed or Non-Authorized Documents

21. Applications for international deposits are frequently accompanied by documents (catalogues, brochures) showing how the article or design is displayed or, where priority is claimed, by documents (certified copy of first filing) in support of the priority claim. Furthermore, requests for recordal of a change in ownership are sometimes accompanied by supporting documents (for example, a copy of an assignment deed). However, the filing of such documents is neither prescribed nor permitted by the Regulations.

22. Rule 8.3(b) of the Regulations states that documents accompanying the application for international deposit which are not prescribed or permitted are to be returned to the depositor at his expense. As regards documents accompanying any other request sent to the International Bureau, Section 107 of the Administrative Instructions provides that they will be returned where practicable. Obviously, the returning of unwanted documentation entails unnecessary work for the International Bureau and unnecessarily adds to the cost of the procedure. It is consequently proposed to amend Rule 8.3(b) of the Regulations and Section 107 of the Administrative Instructions so as to allow the International Bureau to dispose of those documents without being required to inform the sender accordingly. The proposed amendments are contained in Annex V.

Indication of a Telefacsimile Number in the International Deposit

23. Under Rule 5.1(a)(iv) of the Regulations, it is recommended that, in his application, the applicant indicate, in addition to his telephone number, any “telegraphic or teleprinter address” that he may have. It is proposed to replace those terms by “telefacsimile number,” since the International Bureau now uses telefacsimile instead of telegram or teleprinter. If this amendment is adopted by the Assembly, the application forms annexed to the Administrative Instructions (which already include an entry for the indication of a telefacsimile number) will be amended accordingly. The proposed amendment is contained in Annex VI.

Date of Entry into Force

24. It is proposed that the amendments to the Regulations described in the preceding paragraphs enter into force on October 1, 1997, except for the amendments to Rule 19.1(a) and Rule 8.3(b) (Annexes IV and V, respectively), for which advance warning to the users is required. It is proposed that the latter amendments enter into force on January 1, 1998.

25. The Assembly of the Hague Union is invited to adopt the amendments of Rules 5.1(a)(iv), 5.1(b)(ii) and (c)(ii), 8.3(b), 12.1(a) and (b), 14.1 and 2(c), 19.1(a), 24.2(a) and 28.1(b) of the Regulations appearing in Annexes I to VI of this document and to decide that those amendments will enter into force as proposed in paragraph 24, above.

[Annexes follow]

ANNEX I

IRREGULARITIES WHICH AFFECT THE DATE
OF THE INTERNATIONAL DEPOSIT

Proposed Amendments to Rule 14.1 and 2(c) of the Regulations

CURRENT TEXT	PROPOSED TEXT
14.1 Subject to Rule 14.2, the International Bureau shall record the international deposit in the International Register as of the date on which it is in possession of the application accompanied by the items required under Rule 12 and the prescribed fees.	14.1 Subject to Rule 14.2, the International Bureau shall record the international deposit in the International Register as of the date on which it receives the application.
14.2(a) Where the International Bureau finds that the application or the items that should accompany it have not been filed as provided under the Agreement or these Regulations, or that the prescribed fees have not been paid or have not been paid in full, it shall invite the depositor, unless it is clearly impossible to reach him, to correct the defect within three months from the date of the invitation.	14.2(a) [No change]
14.2(b) If the defect is corrected within the period referred to in paragraph (a), the International Bureau shall record the international deposit in the International Register as of the date indicated in Rule 14.1, subject to paragraph (c).	14.2(b) [No change]
14.2(c) The international deposit shall bear the date on which the correction of the defect was received by the International Bureau where the defect was one of the following: (i) the application did not contain the indication referred to in Rule 5.1(a)(i); (ii) the application did not contain the necessary indications to identify the depositor and reach him by post;	14.2(c) The international deposit shall bear the date on which the correction of the defect was received by the International Bureau where the defect was one of the following: (i) [No change] (ii) [No change]

(iii) the application did not contain the indications referred to in Rule 5.1(a)(iii);

(iii) [Deleted]

(iv) the indications contained in the application were not such as to permit the conclusion that the depositor was entitled to own international deposits;

(iv) [No change]

(v) the application did not contain the indications referred to in Rule 5.1(a)(v) to (vii);

(v) [Deleted]

(vi) the application was not signed;

(vi) [Deleted]

(vii) the application was not in the prescribed language or one of the prescribed languages;

(vii) [No change]

(viii) the provisions of Rule 12 were not complied with, except in the case where the photographs, other graphic representations, samples or models were furnished in one copy only;

(viii) the provisions of Rule 12.1(a) or of Rule 12.1(b), first sentence, were not complied with, except in the case where the photographs, other graphic representations, samples or models were furnished in one copy only;

(ix) the prescribed fees were not paid or were not paid in full;

(ix) [Deleted]

(x) in the case of international deposits governed exclusively by the 1934 Act, the application did not contain the indication referred to in Rule 5.1(b)(i), or that indication was at variance with the notice referred to in Rule 11.1;

(x) [No change]

(xi) in the case of international deposits governed exclusively or partly by the 1960 Act, the application did not contain the indications referred to in Rule 5.1(c)(i).

(xi) [No change]

Consequential amendment to Section 304 of the Administrative Instructions

CURRENT TEXT

304 Any recording relating to an international deposit shall be effected by the International Bureau under the date on which it received the indications to be recorded and the prescribed fees, in accordance with the provisions of the Agreement, the Regulations and these Administrative Instructions.

NEW TEXT

304 Subject to Rule 14, any recording relating to an international deposit shall be effected by the International Bureau under the date on which it received the indications to be recorded and the prescribed fees.

[Annex II follows]

ANNEX II

REPRODUCTIONS

Proposed Amendments to Rule 12 of the Regulations

CURRENT TEXT	PROPOSED TEXT
Reproduction, Samples and Models of the Article or Articles in which the Designs are Intended to be Incorporated	Reproduction, Samples and Models of the Designs or Articles
12.1(a) In the case of international deposits governed exclusively by the 1934 Act, the application shall be accompanied by two photographs or other graphic representations, or two samples, of each article designated under Rule 5.1(a)(v).	12.1(a) In the case of international deposits governed exclusively by the 1934 Act, the application shall be accompanied by two photographs or other graphic representations, or two samples, of each design or of each article in which it is intended to incorporate the designs.
12.1(b) In the case of international deposits which are governed exclusively or partly by the 1960 Act, the application shall be accompanied, for each article designated under Rule 5.1(a)(v),	12.1(b) In the case of international deposits which are governed exclusively or partly by the 1960 Act, the application shall be accompanied, for each design or for each article in which it is intended to incorporate the designs,
(i) if the depositor does not request that the designs be published in color: by two photographs or other graphic representations in black and white;	(i) [No change]
(ii) if the depositor requests that the designs be published in color: by either two photographs or other graphic representations in color, or one color transparency and two color photographs in color produced from the transparency.	(ii) [No change]
Additionally, the application may be accompanied by samples or models of the article or articles. The dimensions of the representation of the article shown in the photographs or other graphic representations accompanying the application shall be those in which the depositor wishes the design to be published, provided that one of those	Additionally, the application may be accompanied by samples or models of the article or articles. The dimensions of the representation of each design or article shown in the photographs or other graphic representations accompanying the application shall be those in which the depositor wishes the design to be published, provided that one

dimensions shall not be less than 3 cm. The dimensions of the representations of the articles shall not be more than 16 cm x 16 cm	of those dimensions shall not be less than 3 cm. The dimensions of the representations shall not be more than 16 cm x 16 cm.
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Proposed Amendments to Rule 5.1(b)(ii) and (c)(ii) of the Regulations

CURRENT TEXT	PROPOSED TEXT
5.1(b) In the case of international deposits governed exclusively by the 1934 Act, the application shall contain, in addition to the indications referred to in paragraph (a): ... 5.1(b)(ii) an indication of the documents, photographs, other graphic representations or samples of the deposited article accompanying the application; 5.1(c) In the case of international deposits governed exclusively or partly by the 1960 Act, the application shall contain, in addition to the indications referred to in paragraph (a): ... 5.1(c)(ii) an indication of the documents, photographs, transparencies, other graphic representations of the deposited article accompanying the application;	5.1(b) [No change] ... 5.1(b)(ii) an indication of the documents, photographs, other graphic representations or samples accompanying the application; 5.1(c) [No change] ... 5.1(c)(ii) an indication of the documents, photographs, transparencies or other graphic representations accompanying the application;

[Annex III follows]

ANNEX III

AMOUNTS AND PAYMENT OF FEES

Proposed Amendment to Rule 24.2(a) of the Regulations

CURRENT TEXT

24.2(a) Renewal shall be effected simply by payment, during the last year of each period of five years, of the international renewal fee and the renewal fees payable to States.

PROPOSED TEXT

24.2(a) Renewal shall be effected simply by payment, during the last six months of each period of five years, of the international renewal fee and the renewal fees payable to States.

Proposed Amendments to Rule 28.1(b) of the Regulations

CURRENT TEXT

28.1(b) The fees payable shall be:

(i) where they concern an international deposit, the fees in force on the date of receipt by the International Bureau of a deposit which complies with the Agreement and these Regulations;

(ii) where they concern a prolongation or renewal, the fees in force at the time of payment or, if payment is made within the six months preceding the expiration date of the current term, the fees in force six months before that date.

PROPOSED TEXT

28.1(b) The fees payable shall be:

(i) where they concern an international deposit, the fees in force on the date of receipt by the International Bureau of that deposit;

(ii) where they concern a prolongation or renewal, the fees in force at the time of payment.

[Annex IV follows]

ANNEX IV

REQUEST FOR RECORDING OF CHANGE IN OWNERSHIP

Proposed Amendment to Rule 19.1(a) of the Regulations

CURRENT TEXT

19.1(a) The International Bureau shall, on request, record any change in ownership in the International Register.

PROPOSED TEXT

19.1(a) The request for recording a change in ownership in the International Register shall be established in accordance with the model form issued by the International Bureau. On request, printed copies of the model form shall be furnished free of charge by the International Bureau. The form shall be filled in preferably by typewriter and shall be easily legible.

[Annex V follows]

ANNEX V

NON-PRESCRIBED OR NON-AUTHORIZED DOCUMENTS

Proposed Amendment to Rule 8.3(b) of the Regulations

CURRENT TEXT

8.3(b) If the application contains matter other than matter so prescribed or permitted, the International Bureau shall delete it *ex officio*; and if it is accompanied by any document other than those prescribed or permitted, the International Bureau shall treat such document as if it had not been transmitted to it and shall return the said document to the depositor at his expense.

PROPOSED TEXT

8.3(b) If the application contains matter other than matter so prescribed or permitted, the International Bureau shall delete it *ex officio*. If the application is accompanied by any document other than those prescribed or permitted, the International Bureau shall dispose of the said document.

Consequential amendment to Section 107 of the Administrative Instructions

CURRENT TEXT

107 Subject to Rule 8.3(b), any document other than those prescribed or authorized by the Agreement, the Regulations or these Administrative Instructions shall be treated by the International Bureau as if it had not been received and the said Bureau shall, where practicable, return the document and inform its sender that it is being so treated.

NEW TEXT

107 Any document other than those prescribed or authorized by the Agreement, the Regulations or these Administrative Instructions shall be treated by the International Bureau as if it had not been received and the said Bureau shall dispose of the document.

[Annex VI follows]

ANNEX VI

INDICATION OF A TELEFACSIMILE NUMBER
IN THE INTERNATIONAL DEPOSIT

Proposed Amendment to Rule 5.1(a)(iv) of the Regulations

CURRENT TEXT		PROPOSED TEXT	
5.1(a)	Any application shall contain:	5.1(a)	[No change]
	...		...
	(iv) ... Any telegraphic or teleprinter address and telephone number that the applicant may have should preferably also be indicated. ...		(iv) ...Any telephone and telefacsimile numbers that the applicant may have should preferably also be indicated. ...

[End of Annex VI and of document]