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CONCERNING THE INTERNATIONAL DEPOSIT
OF INDUSTRIAL DESIGNS**

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NOTES ON THE
DRAFT NEW ACT OF THE HAGUE AGREEMENT CONCERNING
THE INTERNATIONAL REGISTRATION OF INDUSTRIAL DESIGNS

prepared by the International Bureau

INTRODUCTION

The present document contains Notes on the draft new Act contained in document H/CE/VII/2.

Notes on Article 1

1.01 *Article 1* contains explanations of a number of abbreviated expressions and definitions of a number of terms that are used throughout the draft new Act.

1.02 *Item (i)*. As noted in the Introduction, the name of the Hague Agreement would be changed by replacing the words “international deposit” by the words “international registration.” In addition, throughout the text of the draft new Act, the words “application” and “registration” are used instead of the word “deposit,” which is used in the 1934 and 1960 Acts. The new terminology is considered to reflect more accurately the terminology in existing and proposed legislative texts at the national and regional levels, as well as the procedure leading to an international registration under the draft new Act.

1.03 *Items (ii) to (iv)*. These items seem to be self-explanatory.

1.04 *Item (v)*. Upon filing either direct with the International Bureau, or indirectly through the intermediary of the Office of a Contracting Party, an international application is given a filing date in accordance with Article 4(2) or (3). That filing date determines the date of international registration (provided that the international application does not contain an irregularity entailing the postponement of the date of international registration (see Article 8), which, in turn, is the operative date for various purposes under the draft new Act (for example, the date of commencement of the period of deferment of publication (Article 9(1)) and the date from which the expiry of the minimum term of protection is calculated (Article 14(3)(a)).

1.05 *Item (vi)*. The definition of “International Register” would allow the maintenance of the data concerning international registrations in paper form or as a computerized data base, using whatever technology may be most appropriate. It should be noted that a Contracting Party could maintain a national register without being in breach of its obligations under the new Act provided that there is no obligation for the holder of an international registration to pay fees for the latter’s recordal in the national register or for the publication of any data already published by the International Bureau.

1.06 *Item (vii)*. The term “Gazette” is construed sufficiently broadly in order to allow the International Bureau to make publications in paper form or in and any other form, such as, for example, on CD-ROM (see Note 7.05).

1.07 *Item (viii)*. The draft Regulations contain a definition of “legal entity” (see Rule 1(2)(v)).

1.08 *Item (ix)*. This item seems to be self-explanatory.

1.09 *Item (x)*. This item seems to be self-explanatory.

1.10 *Item (xi)*. It is proposed that the new Act be open to both States and certain types of intergovernmental organizations. The intergovernmental organizations that are eligible to become party are those that satisfy the criteria set out in Article 29(1)(ii). The term “intergovernmental organization” is used as an abbreviated expression in respect of them throughout the text.

1.11 *Item (xii)*. Since it is proposed that both States and intergovernmental organizations be eligible to become party to the draft new Act, the term “Contracting Party” has been used throughout the text of the draft new Act.

1.12 *Item (xiii)*. Where, under Article 3, an applicant derives its entitlement to file an international application from several Contracting Parties, the indication of a given Contracting Party as the applicant’s Contracting Party may, under Article 4, entail certain consequences with respect to the procedure to be followed for the filing of the international application. For example, in the case of indirect filing, the international application has to be filed through the intermediary of the Office of the Contracting Party indicated in the international application as the applicant’s Contracting Party and cannot be filed via another Contracting Party’s Office. Furthermore, where the Contracting Party indicated as the applicant’s Contracting Party has, under Article 4(1)(b), notified the Director General that international applications may not be filed through the intermediary of its Office, indirect filing is not available to the applicant.

1.13 *Item (xiv)* explains the meaning of the expression “territory of a Contracting Party” used in Article 3.

1.14 *Item (xv)*. The term “Office” covers both national and regional Offices, including a common Office such as the Benelux Designs Office. The expression “grant of protection for industrial designs” is used to refer to the protection accorded to industrial designs both through the registration of industrial designs and by way of the grant of a design patent. It is expected that the majority of Offices would accord protection through registration. Protection of industrial designs by copyright or by trademarks is not covered by the expression “grant of protection for industrial designs” and falls outside the scope of the draft new Act. As regards the applicability of the various forms of protection that may be granted to industrial designs, see the Notes on Article 2.

1.15 *Item (xvi)*. In recognition of the different requirements of those Offices that *ex officio* examine applications as to substance—namely, as regards novelty and perhaps other substantive requirements such as originality or non-functionality—the draft new Act contains a number of provisions which concern only Examining Offices. Those provisions are the subject of a new Chapter in the draft new Act, namely, Chapter II, consisting of Articles 17 to 20.

1.16 *Items (xvii) and (xviii)*. Article 21 provides that, where several States party to the new Act have effected the unification of their domestic legislation on industrial designs and established a common Office for the purposes of the registration of industrial designs with effect on the whole of their territories, and where that common Office does not constitute an intergovernmental organization entitled to become a Contracting Party itself, such States may notify their intention to be considered as a single Contracting Party for the purposes of designations.

1.17 *Items (xix) to (xxiii)* seem to be self-explanatory.

1.18 *Item (xxiv)*. As noted in the Introduction, Contracting Parties would be members of the same Union as States party to the 1934 Act or the 1960 Act which are not bound by the new Act (see also item (xxv)).

1.19 *Item (xxv)*. The Assembly of the Union was established by the Complementary Act of 1967, to which all members of the Union are party, with the exception of six, namely, Egypt, Holy See, Indonesia, Morocco, Spain and Tunisia.

1.20 *Items (xxvi) to (xxxiv)* seem to be self-explanatory.

1.21 *Item (xxxv)*. It may be noted that membership in the Locarno Union would not be a prerequisite to becoming party to the new Act (nor is it a prerequisite to becoming party to any other Act of the Hague Agreement).

Notes on Article 2

2.01 *Article 2* contains a provision to similar effect as Article 18 of the 1960 Act.

2.02 *Paragraph (1)* aims at confirming that the new Act, which would establish a centralized procedure for obtaining in each Contracting Party the same protection as that accorded by the grant of protection for an industrial design in that Contracting Party, does not of itself affect the availability of any other protection that may be accorded to the industrial design under the law of a Contracting Party, provided, of course, that the other protection does not diminish or interfere with the enjoyment of rights assured by the new Act. The expression “law” is to be understood to include, throughout the draft new Act, all binding norms issued by the legislative or the executive branch of the Government of a State or by an intergovernmental organization, including any rules issued by their Offices, as well as court decisions. The expression “other protection” would cover protection accorded under the national or regional trademark, unfair competition or copyright law of a Contracting Party. In case the protection accorded to industrial designs by the law of a Contracting Party interferes with or diminishes the rights afforded to applicants or holders under the new Act, the provisions of the new Act prevail.

2.03 *Paragraph (2)* concerns certain international treaties. Item (i) deals with the specific case of “protection accorded to works of art and works of applied art by international copyright treaties and conventions.” Where an industrial design that is the subject of an international registration qualifies for protection by virtue of such treaties and conventions, the protection under those treaties and conventions is not affected by virtue of the fact that the industrial design is the subject of an international registration.

2.04 Item (ii) refers to the Agreement on Trade-Related Aspects of Intellectual Property Rights (the “TRIPS Agreement” which constitutes Annex 1C to the Agreement Establishing the World Trade Organization) and clarifies that the provisions of the new Act do not affect the protection accorded to industrial designs under the TRIPS Agreement. This means that membership in the new Act does not in itself imply that a Contracting Party is necessarily in compliance with its obligations under the TRIPS Agreement.

2.05 Under Article 29, membership in the new Act is open to States which are members of the World Intellectual Property Organization without being party to the Paris Convention and to certain intergovernmental organizations. Therefore, paragraph (3) provides that each Contracting Party must comply with the provisions of the Paris Convention which concern

industrial designs. They are the following: Article 2 (which deals with national treatment for nationals of countries of the Paris Union), Article 3 (which provides for the same treatment for certain categories of persons as for nationals of countries of the Paris Union), Article 4A to E (which deal with the right of priority), Article 5B and D (which deal with failure to work and marking of industrial designs), Article 5*bis*(1) (which provides for a period of grace for the payment of fees for the maintenance of rights), Article 5*quinquies* (which requires the protection of industrial designs), Article 11 (which deals with temporary protection of industrial designs at certain international exhibitions) and Article 12 (requiring the establishment of special national industrial property services).

Notes on Article 3

3.01 *Article 3* sets out the conditions that determine entitlement to file an international application. The word “person” is defined in Article 1(vii) to mean both a natural person and a legal entity. The term “territory of a Contracting Party” is also defined in Article 1, in item (xiii).

3.02 The conditions that establish entitlement to file an international application are

(i) nationality of a State that is a Contracting Party or of a State that is a member of an intergovernmental organization that is a Contracting Party;

(ii) domicile in the territory of a State that is a Contracting Party or in the territory in which the constituent treaty of an intergovernmental organization that is a Contracting Party applies;

(iii) habitual residence in the territory of a State that is a Contracting Party or in the territory in which the constituent treaty of an intergovernmental organization that is a Contracting Party applies, or

(iv) a real and effective industrial or commercial establishment in the territory of a State that is a Contracting Party or in the territory in which the constituent treaty of an intergovernmental organization that is a Contracting Party applies.

3.03 The third of the conditions mentioned in the preceding paragraph uses a term (“habitual residence”) that has been borrowed from the Berne Convention for the Protection of Literary and Artistic Works. The term has been used in order to compensate for any excessively narrow interpretation of the concept of “domicile” that might be adopted under national laws.

3.04 By virtue of the definition of “person” in Article 1(vii), each of the conditions of entitlement mentioned in Note 3.02, above, applies to both natural persons and legal entities. In order to clarify the application of the condition of nationality to legal entities, the draft Regulations prescribe under which conditions a legal entity is to be considered a national of a State (see Rule 1(2)(v)).

Notes on Article 4

4.01 *Article 4* deals with certain basic matters concerning the manner in which an international application may be filed.

4.02 *Paragraph (1)(a)* provides that an international application may be filed, at the applicant's choice, either with the International Bureau, or indirectly through the intermediary of the Office of the applicant's Contracting Party. The expression "applicant's Contracting Party" is defined in Article 1(xiii) as the Contracting Party from which the applicant derives its entitlement to file an international application by virtue of satisfying, in relation to that Contracting Party, at least one of the conditions specified in Article 3. Consequently, to be able to file an international application through the intermediary of the Office of a Contracting Party, the applicant must have the necessary connection with that Contracting Party which, under Article 3, establishes entitlement to file an international application. Thus, in order to be able to file through the intermediary of the Office of a Contracting Party, the applicant must

(i) where the Contracting Party is a State, be a national of that State, or, where the Contracting Party is an intergovernmental organization, be a national of a State that is a member of that organization; or

(ii) have a domicile in the territory of the Contracting Party; or

(iii) have a habitual residence in the territory of the Contracting Party; or

(iv) have a real and effective industrial or commercial establishment in the territory of the Contracting Party.

4.03 While the general principle is that an applicant may choose to file either direct or indirectly, *paragraph (1)(b)* permits Contracting Parties to close the indirect route if they so choose.

4.04 *Paragraph (2)* provides for each international application to be accorded a filing date (subparagraph (a)), which, in the case of direct filings, will be the date on which the International Bureau receives the international application (subparagraph (b)) and, in the case of indirect filings, will be the date on which the intermediary Office receives the international application (subparagraph (c); see, however, paragraph (3)). The filing date determines the date of international registration (provided that the international application does not contain an irregularity entailing the postponement of the date of international registration (see Article 8)).

4.05 Where the international application is filed through the intermediary of the Office of the applicant's Contracting Party (*subparagraph (c)*), the date of receipt of the international application by that Office will be determined by the national or regional law of that Contracting Party.

4.06 *Paragraph (3)* provides, in the case of indirect filing, that the international application must be transmitted by the Office through which it is filed to the International Bureau. The draft Regulations provide that the applicant will be notified by that Office of the receipt of the

international application (see Rule 11(1)). As regards the time limit for the transmission of the international application, this draft maintains a proposal which was discussed, for the first time, at the sixth session of the Committee of Experts, namely a time period of either one month, under subparagraph (a), or three months, under subparagraph (b), or even six months, under subparagraph (c), from the date of receipt of the international application. If the international application is not transmitted to the International Bureau within the applicable period of time, the filing date is postponed to the date on which the International Bureau receives the international application from the Office concerned. For that reason, Rule 12(1) provides that, even in the case of indirect filings, the filing date will be accorded by the International Bureau, which will notify the applicant thereof. According to Rule 11(1), the Office which acts as an intermediary must note and transmit to the International Bureau, together with the international application, the date on which it has actually received the latter.

4.07 The period of one month allowed under subparagraph (a) for the transmission of the international application seems to be sufficient for those Contracting Parties which do not carry out a security clearance. The reduction of that period from three months (as provided for in the previous draft) to one month benefits those applicants whose applications contain mistakes which entail the postponement of the filing date (see Article 8(3)), because they will be given an earlier occasion for the correction of such irregularities. The period of three months allowed under subparagraph (b) is intended to permit the granting of security clearance in respect of international applications in those Contracting Parties where such clearance is required at the time when such Contracting Parties become party to the new Act.

4.08 Furthermore, subparagraph (c) deals with a possible extension, for security clearance, of the three-month period allowed under subparagraph (b). This extension is provided for in order to take into account the fact that the Delegation of the United States of America indicated in the fourth session of the Committee of Experts that, in certain cases, the procedure of security clearance may take longer than three months. Subparagraph (c) allows the period of three months to be extended to six months, provided that the Office concerned notifies both the International Bureau and the applicant that, for reasons of security clearance, the three-month limit cannot be respected. Notification to the applicant has been required in order to allow the applicant the possibility of considering any action that might be available, under the applicable law, in order to endeavor to have the security clearance expedited. It should be noted that designated Offices will have to accept the “international application” effect under Article 11(1) with respect to designs whose existence may have been unknown to them for a considerable period of time, possibly more than one year (six months if priority is claimed, plus six months under Article 4(3)(c), plus the time necessary for transmitting a copy under Article 19 if publication is deferred).

4.09 The draft new Act does not envisage any other role (than security clearance) on the part of an Office through which an international application is filed. In other words, the formalities examination would be undertaken by the International Bureau, regardless of whether the international application is filed direct or indirectly. This approach of one, centrally performed formalities examination is considered to be preferable in order to avoid the possibility of inconsistent applications of the new Act.

4.10 *Paragraph (4).* Rule 11(2) provides that the amount and due date of the transmittal fee are to be fixed by each Contracting Party imposing such a fee, and notified by the Office of that Contracting Party to the International Bureau for the purposes of publication by the

International Bureau in the Guide or other information materials to be made available by the International Bureau in respect of the new Act of the Hague Agreement.

Notes on Article 5

5.01 *Article 5* sets out the contents of international applications.

5.02 *Paragraph (1)(a)* lists the mandatory requirements that all international applications, regardless of the Contracting Parties designated, must satisfy.

5.03 *Items (i) and (ii) of paragraph (1)(a)* seem to be self-explanatory (see also Rule 7(3)).

5.04 *Item (iii) of paragraph (1)(a)*. The term “reproduction” is intended to cover both photographs and other graphic representations, as well as any other form of representation that may be devised, in the future, to accurately produce a likeness of the industrial design. The manner of presenting the reproduction is prescribed in the draft Regulations (see Rule 8). Therefore, Offices of Contracting Parties will not be allowed to refuse the effect of an international registration, partly or in whole, on grounds of non-compliance with requirements of their national or regional law relating to the form of a reproduction contained in an international application that are additional to, or different from the requirements provided for by this Act and the Regulations, such as a certain style of drawings or the use of shadings (see Article 10(1) and Note 10.01). The number of copies in which the reproduction of the design must be furnished will be prescribed in the Administrative Instructions (see Rule 8(1)(b)). The expression “or several different reproductions” refers to the case where the applicant wishes to submit different views of the same design in order either to illustrate all the characteristic features of a three-dimensional design or to comply with the requirement of the law of a designated Contracting Party, it being understood that such requirement is not a requirement for the according of a filing date.

5.05 As mentioned in the Introduction, the draft new Act provides for the possibility of deferment of publication (see Articles 5(4) and 9). Where deferment of publication of a two-dimensional design is requested, a reproduction of the industrial design (which is necessary for the purpose of the publication) need not be supplied until the time of publication. Accordingly, item (iii) of paragraph (1) permits specimens of a two-dimensional industrial design to be supplied, in the prescribed number, with an international application where a request for deferment of publication has been made. The number of specimens and the manner in which they have to be presented are prescribed in the draft Regulations (see Rule 9) and correspond to the number of designated Contracting Parties having Examining Offices (plus one for the International Bureau) which have notified under Article 19(1) the International Bureau that they wish to receive a copy of each international application whose publication has been deferred, such copy being accompanied by a specimen where specimens have been filed in lieu of reproduction. A reproduction of the industrial design must be supplied, however, in accordance with Article 9(6)(b), at the expiration of the period during which publication was deferred.

5.06 *Item (iv) of paragraph (1)(a)*. The indication of the product or products should be given in words (see Rule 7(3)(d)).

5.07 *Item (v) of paragraph (1)(a).* In contrast to Article 7(2) of the 1960 Act, the applicant's Contracting Party can in all circumstances be designated.

5.08 *Item (vi) of paragraph (1)(a).* The particulars that are prescribed in the draft Regulations deal with such matters as the name and address of any representative of the applicant, priority data (where priority is claimed) and the claiming of temporary protection for an industrial design shown at certain international exhibitions (see Rule 7(4)(b), (c) and (d)).

5.09 *Paragraph (1)(b).* Rule 25 deals with the payment of fees.

5.10 Following the conclusion reached at the sixth session of the Committee of Experts, the possibility for Contracting Parties to declare that they cannot be designated in an international application by applicants from certain other Contracting Parties is not retained (see document H/CE/VI/5, paragraph 50).

5.11 *Paragraph (2)* provides applicants with the option of including in the international application such additional elements as are specified by Rule 7(4)(f) and (g). Those elements may be included by applicants in order to avoid unnecessary refusals during examination if they decide to deal with those elements at the application, rather than examination, stage. However, this provision is not intended to extend the scope of Article 17(2).

5.12 *Paragraph (3)(a).* The draft new Act does not provide for a maximum number of industrial designs that may be the subject of an international application. The type of industrial design that may be included in the same international application is, however, restricted to those industrial designs that belong to the same class of the International Classification. That restriction is considered to be necessary in order to facilitate the task of both Offices and users that search for pre-existing similar industrial designs to those for which registration is sought.

5.13 *Paragraph (3)(b).* The laws of a number of potential Contracting Parties (for example, Japan, the United Kingdom and the United States of America) contain a requirement of unity of invention or unity of design, pursuant to which an application covering more than one industrial design must be divided where those industrial designs do not conform to the same inventive concept or design concept. The draft Regulation for the Community Design contains a somewhat similar requirement based, however, on the notion of a set or composition of items that is the same. Subparagraph (b) of paragraph (3) seeks to accommodate the requirements of such Contracting Parties, while at the same time not depriving applicants of the possibility of including more than one industrial design in the same international application. It allows Contracting Parties whose law, at the time of becoming party to the new Act, contains a requirement of unity of invention, unity of design, unity of production, or unity of use, or a requirement that designs belong to the same set or composition of items or that only one independent and distinct invention may be claimed in a single application, to notify the Director General accordingly in a declaration. The declaration serves the purpose of enabling the notifying Contracting Party to refuse the effect of an international application for non-compliance with the requirement. In other words, applicants may obtain a filing date on the basis of an international application containing a number of industrial designs that do not conform to such a requirement, but, if the concerned international application designates a Contracting Party that has notified the requirement, the effect of the international registration may be the subject of a notification of refusal.

5.14 Where a notification of refusal is communicated for non-compliance with such a requirement, the designated Office would require the holder of the international registration to divide the international registration for the sole purpose of the designated Contracting Party whose Office has issued the refusal. If the holder divides the international registration accordingly, the numbering of the original international registration would not be affected; however, it may be expected that the designated Office concerned would attribute supplementary numbers for the purpose of the national (or regional) effect of the international registration, which could be effected, for example, by the addition of a different letter for each divisional application.

5.15 It is also intended that, where an international registration has been divided pursuant to a refusal issued on the basis of non-compliance with such a requirement, the designated Office concerned could charge additional fees from the holder of the international registration for as many divisions in addition to the original international registration as are needed in order to comply with the requirement. The modalities of payment of such additional fees are not dealt with in the draft Regulations, but shall be fixed by each Contracting Party concerned (see Article 13(4) and Note 13.14).

5.16 *Paragraph (4)* provides for the possibility of a request for deferment of publication of the industrial design or designs that is or are the subject of an international application. The question of the Contracting Parties to which any such request may apply, and the question of the length of the period of deferment, are dealt with in Article 9.

Notes on Article 6

6.01 *Paragraph (1)*. The period of priority for industrial designs provided for in Article 4 of the Paris Convention is six months (Article 4C(1)), starting from the date of filing of the first application whose priority is claimed (Article 4C(2)).

6.02 The words “filed ... for any country” are intended to cover an application filed with the Office of an intergovernmental organization or with a Common Office of several States or another international application filed under the Hague Agreement.

6.03 *Paragraph (2)*. The expression “regular filing” is defined in Article 4A(3) of the Paris Convention. An international registration has, from the date of international registration, at least the same effect in each Contracting Party designated in that registration as a regularly filed application for the grant of protection of the industrial design under the law of that Contracting Party (see Article 11(1)).

Notes on Article 7

7.01 *Paragraph (1)* provides for the international registration to be effected immediately after the receipt by the International Bureau of the international application, it being understood that only international applications that satisfy all of the applicable requirements are

registered. Registration of a regular international application would thus be effected, in the case of direct filings, immediately after submission of the international application to the International Bureau, and, in the case of indirect filings, immediately after transmission of the international application to the International Bureau by the Office with which the application was filed. This is so even if the international application contains a request for deferred publication under Article 5(4).

7.02 *Paragraph (2)* deals with irregularities concerning the mandatory requirements set out in Article 5(1) and (3)(a), which apply to all international applications, regardless of which Contracting Parties are designated. If any of those requirements is not fulfilled, the applicant is to be invited to correct the international application within a time limit that is prescribed in the draft Regulations (under Rule 12(4), that time limit is three months). Failure to make the corrections required entails the consequence that the international application is considered abandoned. See, however, Rule 5 which allows the International Bureau to excuse certain delays occasioned by irregularities in postal and delivery services.

7.03 Article 7 does not deal with the case where the international application does not contain an optional element referred to in Article 5(2) but contains the designation of a Contracting Party requiring that element. In such a case, the irregularity will not be corrected in the procedure before the International Bureau but will be dealt with in a procedure before the designated Office concerned which will have issued a refusal.

7.04 *Paragraph (3)(a)* provides for the publication, in the Gazette of the International Bureau, of all international registrations. The details to be included in the publication are prescribed by Rule 15(2). The definition of “Gazette” is broad enough to allow, if appropriate, for the Gazette to take the form of a CD-ROM in addition to (or, in due course, in place of) a paper publication (see Article 1(vii) and Note 1.06).

7.05 The first half of the second sentence of paragraph (3)(a) parallels the last sentence of Article 3(5) of the Madrid Agreement and of Article 3(5) of the Madrid Protocol. This wording intends to make it clear that, whereas publication by the International Bureau would not prevent a Contracting Party from republishing the international registration, such republication cannot result in an obligation for the holder to furnish additional reproductions of the industrial design or to pay an additional fee to the Office of such a Contracting Party. The centralized publication of an international registration, with effect for all designated Contracting Parties, is one of the basic features of the international registration system and presents an important benefit for its users. However, where the Office of a designated Contracting Party carries out a novelty examination and where that examination results in the amendment of the industrial design contained in an international registration, such Office is entitled to request the holder of an international registration to pay for the re-publication of the amended industrial design in its Gazette.

7.06 *Paragraph (3)(b)* stipulates that, as a basic rule, the international registration is published six months after the date of international registration. The period of six months, which is suggested in the present version of the draft new Act for the first time, takes account of the fact that, under national and regional laws on the protection of industrial designs, a certain period of time elapses before the registration of an industrial design is published. The reason for this delay is that the examination (whether it is formal or substantive) of an application for the registration of an industrial design and the technical preparations for

publication need time. There are, however, two exceptions to the rule that an international registration is published six months after the date of international registration. One exception concerns the situation in which an applicant requests that an international registration be published immediately. This might be of importance where, under a given national or regional law, an industrial design may be enforced only after it had been published. Therefore, early publication of the international registration might be requested in cases of imminent infringement. The second exception concerns international registrations for which a deferment of publication had been requested (see Article 9 and the corresponding Notes).

7.07 *Paragraph (3)(c)* confirms that a copy of the publication of the international registration will be sent by the International Bureau to each designated Office. Rule 8(2)(a) deals with the question of the quality of reproductions.

Notes on Article 8

8.01 *Article 8* sets out the rules for determining the date of an international registration. It distinguishes between three situations (see also Article 18 and the corresponding Notes).

8.02 The first situation concerns an international application which, when received by the International Bureau, satisfies the requirements of the new Act and the Regulations. In this case, the date of the international registration is the filing date of the international application (Article 8(1)).

8.03 The second situation concerns an international application which suffers from an irregularity other than any one of the irregularities mentioned in Article 8(3). If that irregularity is corrected within the time limit prescribed under Article 7(2), the irregularity is considered not to affect the date of international registration, which will be, in consequence, the filing date of the international application (with the as yet uncorrected irregularity) (Article 8(2)(i)). If the irregularity is not corrected within the time limit prescribed under Article 7(2), the international application will be, in accordance with Article 7(2), considered abandoned.

8.04 The third situation concerns an international application which suffers from any of the irregularities specified in Article 8(3). Those irregularities relate to items and information which, because of their importance, are considered to be such that the international application cannot be accorded a filing date before the item or information is supplied and, consequently, a date of international registration cannot be accorded. If such an irregularity is corrected within the time limit prescribed under Article 7(2), the international registration will bear the date on which that correction is received by the International Bureau (Article 8(2)(ii)). Failure to make the required corrections within the prescribed time limit entails the consequence that the application is considered abandoned (Article 7(2)).

8.05 *Paragraph (3)*. It is understood that the amendment of an international application which leads to the introduction of new matter may entail the postponement, by a designated Office, of the filing date of the application, whether or not the amendment results from the correction of an irregularity listed under paragraph (3).

Notes on Article 9

9.01 *Article 9* establishes the principle of deferment of publication and sets out the conditions under which such deferment may take place. Those conditions are designed to enable the principle of deferred publication to be included in the draft new Act in such a way as to accommodate the different national systems prevailing in relation to deferred publication, including the situation of Contracting Parties that do not allow deferment of publication.

9.02 With regard to the different existing systems for deferment of publication, *paragraph (1)* sets out three possibilities for deferment of publication, thereby dividing Contracting Parties into three groups: those Contracting Parties whose law allows for a period of deferment of 30 months or more, those whose law allows for deferment of publication for a period of less than 30 months, and those whose law does not allow for deferment of publication. The general principle is that every Contracting Party is presumed to allow the maximum period of deferment of publication (30 months) unless it has notified, in a declaration to the Director General, either a period of less than 30 months (*subparagraph (a)*), or that deferment of publication is not possible at all (*subparagraph (b)*).

9.03 *Paragraph (2)* provides that publication will be deferred wherever the international application contains a request for deferment of publication made under Article 5(4) and establishes the applicable period of deferment. Nevertheless, there is one derogation from that principle. Where the international application designates a Contracting Party which has declared that, under its applicable law, deferred publication is not allowed, the International Bureau will notify the holder accordingly. If the holder does not renounce the designation of that Contracting Party within one month from the date of the notification sent by the International Bureau (see Rule 12(6)), the request for deferred publication will be disregarded and publication will take place (see Article 9(3)). However, Article 7(3)(b) will apply, namely publication will not take place earlier than six months from the date of international registration even where the minimum period of deferment allowed is less than six months or where no deferment is allowed.

9.04 *Paragraphs (2) and (3)* accommodate the different national approaches recognized under paragraph (1) to requests for deferred publication in international applications. The basic approach adopted is to allow deferment of publication, following a request for such deferment, for the shortest period of deferment envisaged in the laws of the designated Contracting Parties. The period of deferment starts running from the date of the international registration or from a validly claimed priority date. This means that if the date of the international registration is after six months from the priority date, the priority can no longer be validly claimed and the period of deferment is calculated from the date of the international registration.

9.05 The following examples illustrate the proposed system for deferment:

(i) An international application designates three Contracting Parties (A, B and C). None of those Contracting Parties has made a declaration under Article 9(1). The publication of the international registration is deferred for 30 months from the date of the international registration or, where priority has been validly claimed, from the priority date.

(ii) An international application designates three Contracting Parties (A, B and C). Contracting Party A has not made a declaration under Article 9(1). Contracting Party B has made a declaration under Article 9(1)(a) that the allowable period of deferment under its law is 18 months from the filing date or the priority date. Contracting Party C has made a declaration under Article 9(1)(a) that the allowable period of deferment under its law is 12 months from the filing date. The publication of the international registration is deferred for 12 months from the date of the international registration.

(iii) An international application designates three Contracting Parties (A, B and C). Contracting Party A has not made a declaration under Article 9(1). Contracting Party B has made a declaration under Article 9(1)(a) that the allowable period of deferment under its law is 18 months from the filing date or the priority date. Contracting Party C has made a declaration under Article 9(1)(b) that its law does not provide for the deferment of publication of the registration of industrial designs. The International Bureau notifies the applicant that deferment of publication is not possible in respect of Contracting Party C. If within a period of one month from the date of that notification the applicant does not withdraw the designation of Contracting Party C, the international registration is published six months from the date of the international registration. If, on the other hand, the applicant withdraws the designation of Contracting Party C, the international registration will be published 18 months from the date of the international registration or, where priority has been validly claimed, from the priority date.

9.06 A solution to the problem that would have confronted Examining Offices in proceeding with the processing of other applications without knowing that an international application whose publication has been deferred forms part of the prior art is contained in Chapter II (see Article 19 and the corresponding Notes), since this problem is of concern only to Contracting Parties with Examining Offices.

9.07 *Paragraphs (4) and (5)* deal with certain actions that may be taken by a holder in respect of an international registration in the period during which publication is deferred, as well as the consequences of those actions. Four actions are explicitly envisaged. First, the holder may request earlier publication, that is, publication before the expiration of the period of deferment established under paragraph (2) (*paragraph (4)(a)*). In such a case, the period of deferment is considered to have expired on the date of receipt of that request by the International Bureau. Second, the holder may request the International Bureau to provide an extract from, or to allow access to, the international registration to a specified third party (*paragraph (4)(b)*). Such an extract or access may be required by the holder for the purposes of pursuing legal enforcement of its rights in the design or designs that are the subject of the international registration. The third possible action by the holder is the renunciation or the limitation of the international registration in respect of all of the designated Contracting Parties, in which case there will be no publication of the industrial designs (following a renunciation) or of the industrial designs concerned (following a limitation) (*paragraph (5)*); see also paragraphs 15.05 and 15.06 of the Notes on Article 15). The fourth possible action by the holder is the renunciation of the international registration in respect of any Contracting Party that has notified a period of deferment of less than 30 months. The period of deferment of publication of the international registration would then be extended to the next shortest period of deferment notified by any of the designated Contracting Parties or to 30 months, as the case may be.

9.08 *Paragraph (6)*. At the end of the period of deferment established under paragraph (2), the international registration is published. That period of deferment will expire either at the end of the shortest period of deferment declared by any of the designated Contracting Parties, or upon receipt of a request for earlier publication, or after 30 months, depending on the circumstances of the particular international registration. In order for publication to take place, the prescribed fees must be paid (*subparagraph (a)*). In addition, where a specimen of an industrial design had been filed with the international application instead of a reproduction under Article 5(1)(a)(iii), the prescribed reproductions must be furnished (*subparagraph (b)*).

9.09 Article 9 does not make provision for a system of partial or two-stage publication of an international registration for which deferred publication has been requested. Under a two-stage publication scheme, basic bibliographic data (the date and number of the international registration, the name of the holder, an indication of the class of the International Classification and the list of designated Contracting Parties) concerning the international registration could be published immediately following registration and the full data, including the reproduction or reproductions, could be published after the expiration of the period of deferment. Such a two-stage system would, however, be more expensive for applicants.

9.10 *Paragraph (7)* establishes the principle that, until publication in the Gazette of the International Bureau, each international application and each international registration must be maintained in confidence by the International Bureau, subject to the provisions of Article 9(4)(b).

Notes on Article 10

10.01 *Paragraph (1)* establishes the right of Offices of designated Contracting Parties to refuse the effect of international registrations in which they are designated. However, once the International Bureau has checked that requirements under Articles 5 and 17 and the corresponding Rules have been complied with and the international registration has been registered by it, no Office may refuse the effect of an international registration on the ground that formal requirements relating to the form or contents of the international application that are additional to, or different from, those which are provided for in this Act and the Regulations have not been satisfied under the law of the Contracting Party concerned. The wording of this provision is inspired by Article 27(1) of the Patent Cooperation Treaty (PCT). The principle that Contracting Parties “delegate” the examination of the formal contents of an international application to the International Bureau has found wide acceptance within the framework of the PCT, which has currently 91 Contracting Parties. In aligning Article 10(1) of the draft new Act with Article 27(1) of the PCT, potential Contracting Parties are encouraged to accept a feature of the international registration procedure relating to industrial designs which many of them already accept in relation to patents for invention, the registration of which, in general, is subject to a much greater number of formal requirements than the registration of industrial designs. Thus, an Office will not be allowed to require the furnishing of reproductions presented in a different manner than prescribed by the draft Regulations (see Rule 8 and the corresponding Notes). Furthermore, the Office of a Contracting Party will not be allowed to require a translation of the international registration from a prescribed language

into the language or one of the languages accepted by its Office and, consequently, cannot refuse a designation on the ground that such translation was not furnished. It goes without saying that neither can the designation of a Contracting Party be invalidated on that ground. Since the International Bureau is responsible for collecting the required fees from the applicant, and since a designated Contracting Party is, in any case, entitled to receive, from the International Bureau, a certain portion of the fees due for an international registration having effect on its territory, no Office of a Contracting Party may examine whether the fees for an international registration have been paid to the International Bureau. Therefore, the non-payment of the prescribed fees cannot constitute for an Office a valid ground for refusing the effect of an international registration.

10.02 It follows from the scheme of the draft of the new Act that a Contracting Party will be able to exercise its right of refusal in respect of any condition of the grant of protection that is not excluded by the last part of Article 10(1) and is not a requirement that needs to be established in order to obtain a filing date under the applicable law of the Contracting Party. It is intended that the Applicant's Guide for the proposed new Act will set out each of those conditions in respect of each Contracting Party in order to forewarn applicants of the conditions and to provide them with the possibility of satisfying those conditions at the application stage, if they so choose, by including any corresponding elements as optional contents of the international application under Article 5(2).

10.03 *Paragraph (2)* deals with the communication of a refusal of the effect of an international registration by the Office to the International Bureau through a notification of refusal. It envisages a basic time limit for that communication of six months from the date on which the International Bureau sends to the Office a copy of the publication of the international registration (paragraph (2)(a)). In the interest of accommodating the practices of those Offices which carry out novelty examinations of applications or which allow opposition proceedings, the basic time limit of six months may be extended to a maximum of 12 months by any Contracting Party making a declaration to that effect under Article 20 (see that Article and the corresponding Notes).

10.04 The notification of refusal must state all of the grounds on which the refusal is based (paragraph (2)(b)). The purpose of this requirement is to enable the holder to respond to all the grounds that constitute an obstacle to the recognition of the effect of the international registration. This being so, the requirement would not preclude the possibility of new grounds being raised later during the procedure before the Office, as a result of the holder's response to a refusal or of the furnishing by the holder of further information, or in the course of an appeal procedure in which the holder is engaged, since the holder would be apprised of those grounds by virtue of those procedures. In the latter case, the Office would communicate directly with the applicant and not via the intermediary of the International Bureau. A notification of refusal based on lack of unity of design (see Article 5(3)(b)) would not prevent that other grounds for refusing protection be raised later during the procedure before the Office of the designated Contracting Party concerned. The Regulations will provide that, where a communication from an Office to the International Bureau contains a final decision refusing the effect of an international application, that fact must be expressly stated.

10.05 In the case of a refusal based on similarity with a design covered by an earlier-filed international registration that has not been published (because a request for deferment of publication has been made), the refusing Office could not specify the precise grounds of

earlier-filed international registration, and the holder of the later-filed international registration would need to be notified of the precise grounds (that is, details of the earlier-filed refusal, since the copy of the earlier-filed international registration would be held by it confidentially (see Article 19(2) and the corresponding Notes). In such a case, the ground of refusal would have to be notified as similarity with an as yet unpublished and earlier-filed international registration, and the holder of the later-filed international registration would need to be notified of the precise grounds (that is, details of the earlier-filed international registration) once the earlier-filed international registration has been published. Any time limits applicable to an appeal against the refusal would have to be suspended until such time as the earlier-filed international registration is published and the holder of the later-filed international registration has been notified of the precise grounds of refusal.

10.06 The notification of refusal may be withdrawn at any time by the Office that has made it (paragraph (2)(c)). This means that a refusal notified is not necessarily final.

10.07 *Paragraph (3)* allows the Assembly, by unanimous decision of those Contracting Parties represented which have not made a notification under Article 20, to modify the time limit of six months for the communication of notifications of refusal established under paragraph (2). Such a modification might be shown to be necessary as a result of experience gained through the operation of the revised system under the new Act.

10.08 *Paragraph (4)* requires the International Bureau to transmit a copy of the notification of refusal to the holder (subparagraph (a)), and assures the holder of the same remedies as those available under the applicable law of the Office that has notified the refusal (subparagraph (b)). Those remedies must consist at least of the possibility of requesting a re-examination of the refusal or filing an appeal against the refusal. It is understood that the said Office may require the appointment of a local representative if the holder intends to react to the refusal.

Notes on Article 11

11.01 *Article 11* establishes the effects that are to be given to an international application and an international registration in the law of each Contracting Party. In establishing those effects, it seeks to accommodate the various approaches adopted by potential Contracting Parties in giving effect to applications and registrations under their respective applicable laws, and to do so in the most simplified manner possible while still taking into account the variables that exist in those different approaches.

11.02 Article 11 requires that two effects must be recognized by designated Contracting Parties: first, the international application must be given effect as a regularly filed application for the grant of protection; and, secondly, the international registration must be given effect as a grant of protection to the industrial design under that law.

11.03 The effect of the international registration as a regularly filed application under the law of each designated Contracting Party is established by *paragraph (1)*. That effect must be accorded as a minimum (“at least”) by each Contracting Party and must commence from the date of the international registration. It is considered necessary to require that minimum effect because the accommodation of different approaches to giving effect to the international

registration as a registration under the applicable law in the remainder of Article 11 means that the international registration will not have effect as a registration under the applicable law in various cases until well after the date of international registration. One of the consequences of Article 11(1) is that any Contracting Party granting provisional protection to published national applications must also grant such protection to published international registrations designating it.

11.04 The draft new Act that had been submitted to the fifth session of the Committee of Experts contained, within square brackets, an Article X which would have allowed a restriction of the application effect of an international registration, with respect to the prior art effect of the international registration. In view of the fact that Article X was supported by one delegation only, and only by the representatives of two non-governmental organizations from the same country, Article X has not been maintained in the present draft new Act, so that the application effect of an international registration may not be subject to any restriction. At its sixth session, the Committee of Experts noted that it would be left for the Diplomatic Conference to find a solution to this problem.

11.05 The basic rule concerning the effect of the international registration as a grant of protection under the law of each Contracting Party is contained in *paragraph (2)(a)*. It provides that each designated Contracting Party must recognize the international registration as having that effect at the latest by the date of expiration of the period allowed under Article 10(2) or, where applicable, under Article 20. However, if a Contracting Party has made a declaration under Article 20 and the law of that Contracting Party does not allow the effect of an international registration as grant of protection to take place by the date of expiration of the period specified in that declaration, the said effect shall take place at the latest six months after that date. Since the maximum period now allowed under Article 20 is twelve months (instead of 30 months in the previous draft), the combination of Article 11(2)(a) and of Article 20 leads to the result that the effect as a grant of protection is guaranteed to take place in each Contracting Party that has not communicated a notification of refusal at the latest 18 months (twelve months plus six months) from the publication of the international registration (instead of 30 months under the previous draft).

11.06 The words “at the latest” indicate that any Contracting Party is free to recognize the effect of the international registration as a grant of protection under its applicable law at an earlier date, for example, from the date of international registration. The words “to the extent that a notification of refusal has not been communicated by the Contracting Party concerned” make it clear that, where a multiple international registration has been the subject of a refusal in respect of one or some, but not all, of the industrial designs contained in the registration, the effect of the international registration as a grant of protection under the applicable law is limited to the industrial design or designs that have not been the subject of the notification of refusal.

11.07 Where a notification of refusal, which entails the denial of the effect as a grant of protection under the applicable law, is subsequently withdrawn, the basic rule is modified. In this case, the effect of the international registration as a grant of protection under the law of the Contracting Party concerned must be recognized, to the extent that the notification of refusal is withdrawn, at the latest from the date on which the notification of refusal is withdrawn (*paragraph (2)(b)*). For the same reasons as explained in Note 11.05, an international registration will take effect in a Contracting Party having made a notification

under Article 20 at the latest six months after the withdrawal of a refusal if its law does not allow that effect to take place at the date of withdrawal of the refusal. Again, the words “at the latest” signify that each Contracting Party is free to recognize effect as a grant of protection under its applicable law at an earlier date, for example, retrospectively to the date of international registration. The words “to the extent that the notification of refusal is withdrawn” make it clear that, where a notification of refusal has been withdrawn in respect of only some of the industrial designs that had been the subject of the notification, the effect of the international registration as a grant of protection under the applicable law does not extend to those industrial designs in respect of which the notification of refusal has not been withdrawn.

11.08 *Paragraph (2)(c)* is intended to make it clear that the effect given to the international registration applies to the industrial design or designs that are the subject of that registration as they are received from the International Bureau by the designated Office or, where applicable, as amended in the procedure before that Office (consequent on a refusal). Thus, if there are any differences in the reproduction of the industrial design received by the designated Office compared to the reproduction registered on the International Register, it is to the former that effect is given. Similarly, if there is any amendment to the reproduction of the industrial design in the procedure before the Office, it is to the amended reproduction that effect is given.

Notes on Article 12

12.01 *Article 12* deals with the invalidation of the effect of an international registration in a Contracting Party. Invalidation, which occurs after the effect of an international registration has been recognized (for example, as a result of a judicial decision in the course of an infringement action), is to be contrasted with refusal of the effect of an international registration, where the effect of that registration is never recognized.

12.02 *Paragraph (1)* requires each Contracting Party to afford the holder an opportunity of defending his rights before invalidation may be pronounced. Holders of international registrations will equally benefit from that right to be heard in cases where the law of a Contracting Party provides that an industrial design can be declared non-enforceable without being actually invalidated.

12.03 *Paragraph (2)* requires the Office of the Contracting Party in which the effect of the international registration has been invalidated to notify that invalidation to the International Bureau. Rule 18(1) provides that an invalidation is to be notified to the International Bureau only once it is no longer subject to any review or appeal. However, an Office is only obliged to notify an invalidation to the International Bureau if it had been made aware of that invalidation.

Notes on Article 13

13.01 *Article 13* provides that an international application will be subject to the payment of three categories of fees: an international registration fee and a publication fee, which belong to

the International Bureau, and a designation fee, which belongs to the Contracting Parties which have been designated; the last fee can either be the designation fee fixed by the International Bureau or be replaced by a so-called “individual designation fee.” The question of how are fees to be paid is dealt with by Rule 25.

13.02 The fees specified in Article 13 will appear in a Schedule of Fees which will form part of the Regulations.

13.03 *Paragraph (1)* lists the fees which have to accompany an international application. According to Article 5(1)(a)(vi), payment of the prescribed fees is a mandatory requirement in respect of all international applications; however, it is not listed under Article 8(3) as an irregularity that automatically defers the date of international registration. Thus, if the required fees were not paid at the time of application, the International Bureau would invite the applicant to pay them, and the effective date of payment (provided that it is within the prescribed time limit) would have no effect on the date of international registration, which would remain the filing date of the international application (if it fulfilled the other requirements of the draft new Act and the Regulations).

13.04 *Paragraph (1)(i)* relates to the international registration fee which is intended to cover the expenses of the International Bureau under the new Act. This international registration fee consists of a basic registration fee and, in the case of an international application covering more than one industrial design, an additional registration fee corresponding to a prescribed proportion of the basic registration fee for each additional industrial design.

13.05 *Paragraph (1)(ii)* relates to the publication fee. The Schedule of Fees annexed to the Regulations will provide that its amount is different according to whether publication is in black and white or in color. Furthermore, the amount of the publication fee is going to vary according to the space needed to publish the reproduction of the industrial design which is the subject of the international registration. In that respect, it should be noted that the space needed for publication is not necessarily linked to the number of industrial designs covered by an international registration. Thus, the publication of one single industrial design may require more space than the publication of several industrial designs, for example, where the size of each reproduction of the single industrial design is large and that design is represented from different angles.

13.06 *Paragraph (1)(iii)* relates to the designation fee the amount of which is fixed in the Schedule of Fees, as distinct from the individual designation fee dealt with in paragraph (2). Where the international registration covers more than one industrial design, an additional designation fee, which will correspond to a prescribed proportion of the designation fee, is payable for each additional industrial design.

13.07 *Paragraph (2)* relates to the individual designation fee. In principle, each Contracting Party may choose between being entitled to its own fees (or a certain proportion of them) or being entitled to the designation fee the amount of which is fixed in the Schedule of Fees.

13.08 It would be for the Contracting Party that chooses the individual designation fee system to fix the amount of the individual fee. That amount could be fixed either for the five-year initial period of registration and for each five-year period of renewal, or for the maximum period of protection allowed by the Contracting Party concerned. For example, it would be

possible for a Contracting Party to fix the individual designation fee at a level sufficient to cover the whole of the possible (that is, initial and renewed) term of the international registration and to fix the individual designation fee payable on renewal at zero. Besides, Contracting Parties may require the payment of national fees which are not covered by the individual designation fee (such as fees for appeal or for document inspection).

13.09 The draft new Act contains two restrictions on the amount of the individual designation fee; first, it may not be higher than the equivalent fee payable to the national or regional Office of the Contracting Party and, secondly, its amount must be diminished by the savings resulting from the international procedure (such as the formal examination of the application or the publication of the registered industrial design by the International Bureau).

13.10 Consideration has been given, at the sixth session of the Committee of Experts, to prescribing, either in the Act or in the Regulations, the amount of such diminution. For example, it could be specified that the individual fee fixed by a Contracting Party may not be greater than two thirds or three quarters of the amount of the fee that its Office would receive for an equivalent national or regional registration. Should one follow that course, the last sentence of paragraph (2) could read as follows: "However, they may not be higher than the equivalent of three quarters of the amounts which the Office of that Contracting Party would be entitled to receive from an applicant for a grant of protection for an equivalent period to the same number of industrial designs."

13.11 One could also envisage a double ceiling system as exists under the current Regulations. Rule 13.2 of the current Regulations provides for an "ordinary State fee" and a "State novelty examination fee." The latter fee is payable only for States which carry out novelty examinations and, in effect, in lieu of the ordinary State fee. Under Rule 13.2(e), the State novelty examination fee "shall not be more than three quarters of the fee payable for designs deposited with the national or regional Office or more than 75 Swiss francs for each design." At present, only two States require the payment of a novelty examination fee, namely Bulgaria (as from November 1, 1997) and Hungary. The amount of the fee, payable for each design, is 60 Swiss francs for Bulgaria and 70 Swiss francs for Hungary, compared with the ordinary State fee of 42 Swiss francs for the first design plus 2 Swiss francs for each additional design in the same deposit.

13.12 In order to make it possible for more States or Organizations to join the new Act, it would be necessary to have an overall ceiling which is somewhat higher than that of the current State novelty examination fee. It would also probably be necessary to provide for higher designation fees to be paid in respect of such Contracting Parties on renewal. As is customary in the case of patent fees, Offices which examine industrial designs often rely on renewal fees which are as great as, or higher than, the fees payable on application in order to cover their costs. While this would lead to the Schedule of Fees prescribing amounts which are higher than the present levels, this could be considered preferable to leaving the fixing of fees entirely to each Contracting Party, which could result in wide variations in the fees payable for designations.

13.13 *Paragraph (3)* deals with the transfer of designation fees (both the designation fee fixed by the International Bureau and the individual designation fee). It should be noted that the draft new Act does not indicate the frequency of the transfers; this matter is dealt with by Rule 27. The transfers would be made to the department or agency of the Contracting Party

concerned that is specified for that purpose by that Contracting Party to the International Bureau.

13.14 *Paragraph (4)* provides for the possibility of a further fee payable to a designated Office where the international registration is divided before that Office as a result of a refusal on the ground of failure to comply with the requirement of unity of invention, design, production or use, or on the ground that the industrial designs that are the subject of the international registration do not belong to the same set or composition of items (see Article 5(3)(b)). The modalities of payment of any such further fees are not dealt with in the draft Regulations but shall be fixed by each designated Contracting Party concerned which shall charge those fees direct from the applicant. As regards the amount of such a further fee, Contracting Parties would be requested to indicate it to the International Bureau for the purposes of publication, so that potential applicants are informed in advance of what they may have to pay, but it would be expected not to be higher than the additional cost incurred by the designated Office because of the division of the international registration.

13.15 *Paragraph (5)* deals with the payment of fees where a request for deferred publication has been made under Article 5(4). It provides that only a prescribed portion of the international registration fee need be paid when the international application is filed (subparagraph (a)). The balance of the international registration fee, as well as the publication fee and the designation or individual designation fees, become payable either two months before the date of expiration of the period of deferment (subparagraph (b)), or upon the making of a request for earlier publication (subparagraph (c)).

Notes on Article 14

14.01 *Paragraph (1)* provides that the international registration will be effected for a five-year period counted from the date of international registration (see Article 8).

14.02 *Paragraph (2)* seems to be self-explanatory.

14.03 *Paragraph (3)* provides for the minimum and maximum period of protection in the designated Contracting Parties.

14.04 *Paragraph (3)(a)* provides that the period of protection accorded by designated Contracting Parties must not terminate before the expiration of 15 years from the date of international registration. The requirement is expressed in terms of the protection “not terminating,” rather than, for example, in terms of the protection “lasting,” in order to accommodate the position of potential Contracting Parties whose law provides for protection to commence only upon the grant of protection and which does not provide for provisional protection during the period between application and grant.

14.05 In accordance with the agreement reached during the third session of the Committee of Experts, 15 years from the date of international registration has been chosen as the minimum period which must elapse before protection may terminate in place of the 10 years provided in draft new Act considered at that session.

14.06 *Paragraph (3)(b)* provides that, after the minimum period of 15 years, if the law of a Contracting Party provides for a maximum period of protection of more than 15 years for an industrial design, that maximum period will apply to the international registration. In the countries which are party to the Hague Agreement, the period of protection of industrial designs varies from 10 to 50 years, the majority of countries providing for 15 years. Of course, the holder and his representative, if any, should check, once the third period of five years has expired, whether the legislation of any designated Contracting Party permits the period of protection to be prolonged beyond 15 years.

14.07 It would be compatible with paragraphs (1) to (3) for a Contracting Party to provide for a single term of 15 (or more) years and to maintain protection on its territory for that whole term even where the international registration is not renewed. The Regulations will deal with the possibility of the International Register containing an appropriate indication in such cases, so that, if the international registration were not renewed, the continuation of protection on the national level in respect of a Contracting Party having provided for a single term of 15 (or more) years and having required the payment of an initial individual designation fee for the whole of such term, could be noted by users.

14.08 *Paragraph (4)* seems to be self-explanatory. It goes without saying that the renewal of an international registration has the effect to prolong the right as existing in a designated Contracting Party.

14.09 *Paragraph (5)* seems to be self-explanatory. It is important to note that renewal is only subject to the condition of payment of the prescribed renewal fees and to no other conditions. The International Bureau may require, however, sufficient indications (such as bibliographical data) to link the renewal fee with the corresponding international registration. It should also be noted that no publication fee is to be paid for renewal since the reproduction of the industrial design which is the subject of an international registration is not republished at the time of renewal.

14.10 *Paragraph (6)* seems to be self-explanatory.

Notes on Article 15

15.01 *Paragraph (1)(a)* permits the recording in the International Register of a change in ownership of the international registration, provided that the new holder is entitled to file an international application under Article 3. If this latter condition is not fulfilled, the International Bureau will not record the change in ownership. The draft Regulations deal with the question of what signature or evidence is required in connection with a request to record a change in ownership (see Rule 19(1)(b)).

15.02 *Paragraph (1)(b)* seems to be self-explanatory.

15.03 *Paragraph (2)* covers the recording in the International Register of several other subject matters.

15.04 *Items (i) and (ii)* seem to be self-explanatory.

15.05 *Item (iii)* deals with the renunciation, by the holder, of the international registration. A renunciation of an international registration is always total as regards the industrial designs that are the subject of the international registration, but it may be partial or total as regards the designated Contracting Parties.

15.06 *Item (iv)* deals with the limitation of an international registration including two or more industrial designs to one or some (but not all) of the industrial designs that are the subject thereof, such limitation applying in respect of any or all of the designated Contracting Parties. The difference between renunciation and limitation is that a renunciation concerns always the totality of the industrial designs contained in an international application, although not necessarily in respect of all designated Contracting Parties. A limitation, on the other hand, concerns one or several industrial designs contained in a multiple international registration (but never all of such industrial designs) in relation to any or all of the Contracting Parties.

15.07 *Item (v)* seems to be self-explanatory.

15.08 *Item (vi)* provides for the recording of other relevant facts, which could, for example, include licenses. At present, it is not proposed to identify any such fact in the draft Regulations. However, it might be thought appropriate to do so at some time in the future.

15.09 The draft Regulations specify who is entitled to request the recordings referred to in paragraph (2) (see Rules 18 and 19).

15.10 *Paragraph (3)* seems to be self-explanatory. Some of the recordings referred to in paragraph (2) may be exempted from fees.

15.11 *Paragraph (4)* seems to be self-explanatory.

Notes on Article 16

16.01 *Paragraph (1)* provides for the furnishing by the International Bureau of information on or copies of entries in the International Register in respect of a published international registration. The Administrative Instructions will provide for the detailed procedure for accessing such information. However, that information or copies cannot be supplied in respect of any international registration whose publication has been deferred, such registrations being held in confidence by the International Bureau (Article 9(7)), subject to the case referred to in Article 19. Nor will information on or copies of international applications be available to third parties.

16.02 The Administrative Instructions will provide that interested parties may accede to an electronic data base in which would be stored all the information relating to published international registrations. This access would be possible, free of charge, for the Offices of Contracting Parties and, subject to the payment of a fee, for the public.

16.03 *Paragraph (2)* seems to be self-explanatory.

Notes on Article 17

17.01 *Article 17* deals with certain conditions additional to the requirements set out in Article 5(1) that Contracting Parties may require for applications under their applicable laws to be accorded a filing date. It applies only to Contracting Parties whose Offices are Examining Offices (the term “Examining Office” is defined in Article 1(xvi)).

17.02 *Paragraph (1)* allows such Contracting Parties whose law, at the time that they become party to the new Act, requires, for a filing date to be accorded, certain additional conditions to the requirements set out in Article 5(1) to notify those conditions, in a declaration, to the Director General.

17.03 *Paragraph (2)* limits the additional conditions that may be notified by Contracting Parties having Examining Offices to three, namely, indications of the identity of the creator of the industrial design (item (i)), a brief description of the reproduction or of the characteristic features of the industrial design (item (ii)) and a claim (item (iii)). The limitation to those three additional conditions is considered necessary in the interests of simplicity and of curtailing the number of possible requirements that an applicant may be asked to satisfy in order to be able to use the new Act with respect to the Contracting Parties in question. The three permitted additional conditions are intended to correspond to those requirements which certain delegations have stated were indispensable for obtaining a filing date under their national laws. The requirement in item (i) was specified as necessary in Brazil, Romania, the Russian Federation and the United States of America; the requirement in item (ii) was specified as necessary in the Republic of Korea, Romania and the Russian Federation, and the requirement in item (iii) as necessary in the United States of America.

17.04 *Paragraph (3)* requires an international application that contains the designation of the Contracting Party that has notified any additional conditions under paragraph (1) to satisfy the additional conditions that have been notified. The consequences of non-compliance with any additional condition notified under Article 17 are dealt with in Article 18.

17.05 The draft Regulations prescribe the requirements to be complied with for the conditions referred to in paragraph (2) to be fulfilled (see Rule 10): if those requirements are complied with, the Office of the Contracting Party concerned may not refuse the effect of the international registration (see Article 10(1) and the corresponding Notes).

Notes on Article 18

18.01 *Article 18* deals with the additional requirements, referred to in Article 17(2), that an international application must satisfy if it contains the designation of a Contracting Party which has notified any of those additional requirements. This Article envisages two different cases in which there is an irregularity concerning any of the requirements of Article 17(2), and provides for different courses of action to be followed and consequences to ensue in those cases. The aim of making the distinction between the two cases is to avoid a postponement of the date of

international registration by reason only of an irregularity concerning the requirements of Article 17(2).

18.02 The first case, dealt with in *item (i)*, occurs when the international application contains an irregularity relating to any of the requirements of Article 17(2), but does not contain any of the irregularities mentioned in Article 8(3) that entail a postponement of the date of international registration. Since the requirements of Article 17(2) correspond to requirements under the law of the concerned designated Contracting Party that are necessary for the establishment of a filing date, the international application could not be accorded a date of international registration for the purposes of that designated Contracting Party until the irregularities are corrected. However, since the international application does not contain any of the irregularities referred to in Article 8(3), it is in order for the establishment of a date of international registration for all the other designated Contracting Parties to which the requirements of Article 17(2) do not apply. In order to avoid the postponement of the date of international registration for all designated Contracting Parties, therefore, item (i) does not provide for an invitation to correct to be issued, but, rather, provides for the designation of the Contracting Party to which the requirements of Article 17(2) relate to be disregarded. The applicant would then be free to pursue protection in that Contracting Party via the usual national or regional route. It should be noted that what precedes equally applies whether the international application has an irregularity referred to in Article 8(2)(i), namely, an irregularity which does not entail a postponement of the date of international registration.

18.03 The Regulations will provide for notification to the applicant of the disregarding of the designation of a Contracting Party under Article 18(i), thereby providing the applicant with the requisite notice to enable it to decide whether to proceed via the national or regional route in respect of that Contracting Party.

18.04 The second case, dealt with in *item (ii)*, occurs where the international application contains an irregularity relating to any of the requirements of Article 17(2), as well as an irregularity mentioned in Article 8(3), namely, an irregularity entailing a postponement of the date of international registration. In this case, the applicant is invited to make the required corrections relating to the requirements of Article 17(2) (by virtue of Article 7(2) the invitation will also cover the irregularity concerning the requirements of Article 8(3)). If the applicant fails to make the corrections relating to the requirements of Article 17(2) within the prescribed time limit and at the same time as or before the irregularity mentioned in Article 8(3) is corrected, the designation of the Contracting Party to which the requirements of Article 17(2) apply is disregarded. Again, this result is proposed in order to avoid the further postponement of the date of international registration for all designated Contracting Parties. Again, also, it should be noted that what precedes equally applies whether the international application contains or does not contain an irregularity referred to in Article 8(2)(i), namely, an irregularity which does not entail a postponement of the date of international registration.

Notes on Article 19

19.01 Where the publication of an international application has been deferred, Examining Offices are confronted with the problem that they have to examine other applications without knowing whether an international application whose publication has been deferred forms part

of the prior art. In order to overcome this problem, Article 19 provides that a designated Examining Office may receive a confidential copy of each international registration whose publication is deferred (paragraph (1)), provided it uses such copy only for the purpose of the examination of other applications (paragraph (2)).

19.02 The designated Examining Office must keep the transmitted copy confidential and may not divulge its contents. One exception is provided for, following a request to this effect by the Delegation of the United States of America in the fourth session of the Committee of Experts: the contents of the transmitted copy may be disclosed in confidence to parties involved in an administrative or legal proceeding before an Office concerning a dispute over entitlement to file the international application on which the international registration was based--typically, an interference proceeding as existing in the United States of America--it being understood that participation in such a proceeding presupposes consent to such disclosure and that any breach of the confidentiality requirement imposed upon the parties in such a case would be sanctioned in accordance with the provisions of the applicable law.

19.03 If an Examining Office formed the view that a later filed application was similar to a design covered by an earlier-filed international registration of which it had received a confidential copy, it would be required to suspend the processing of the later-filed application until the earlier-filed international registration was published, since it could not divulge the contents of the international registration to the applicant of the later-filed application. It could notify that applicant of the suspension of processing on the ground of a possible conflict with an as yet unpublished earlier-filed registration. If the later-filed registration were also an international registration, the Examining Office would refuse the effect of that later-filed international registration until the earlier-filed international registration was published and until it took a decision on the conflict between the two registrations.

19.04 Where the international application was accompanied by a specimen, and not a reproduction, of the industrial design in accordance with Article 5(1)(a)(iii), the designated Examining Office would receive, with a copy of the international registration, a specimen. For that purpose, Article 5(1)(a)(iii) provides that the international application must, where a specimen is filed in lieu of a reproduction, be accompanied by the prescribed number of specimens. As mentioned in Note 5.05, the number of specimens required corresponds to the number of Contracting Parties having an Examining Office and having made a notification under Article 19(1) designated in the international application plus one for the International Bureau (see Rule 9(1)).

Notes on Article 20

20.01 In order to accommodate the practices of those Contracting Parties whose Offices carry out novelty examinations of applications or which allow opposition proceedings, the basic time limit for a notification of refusal of six months provided by Article 10(2)(a) may be extended to a maximum period of 12 months by a Contracting Party making a declaration to that effect.

20.02 The solution of providing a maximum period of 12 months rather than 30 months is proposed following the sixth session of the Committee of Experts in which it was noted that,

with the exception of two countries, the law of none of the potential Contracting Parties represented at that session required a period for the notification of refusal exceeding twelve months. As regards one potential Contracting Party whose delegation had indicated that an international registration could be examined within twelve months, but that further time was needed in order to give effect to that international registration in its country, reference is made to Article 11(2) and the corresponding Notes.

Notes on Article 21

21.01 *Article 21*, which corresponds to Article 30 of the 1960 Act, Article 9^{quater} of the Madrid Agreement Concerning the International Registration of Marks (“the Madrid Agreement”) and Article 9^{quater} of the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (“the Madrid Protocol”), makes provision for the special case of States that establish a common Office for the grant of protection for industrial designs with effect in each State according to uniform domestic legislation in each of the States. The concrete example of such a situation is the Benelux Designs Office which registers industrial designs with effect in each of Belgium, the Netherlands and Luxembourg according to the same law in each of those States.

21.02 *Paragraph (1)* allows States having uniform domestic legislation and a common Office, as described in the preceding paragraph, to notify the Director General that the common Office shall be substituted for the national Office of each of them and that the whole of the territories of those States shall be deemed to be a single Contracting Party for the purposes of Articles 1, 3 to 16 and 33 of the new Act. Articles 1 and 3 to 16 cover the substantive provisions that establish the procedure and conditions for international applications and international registrations. Article 33 establishes the rules which determine the relations between Contracting Parties and States that are party to the 1934 or the 1960 Acts. Since that Article regulates which procedure is to be applied in respect of an international application, it is desirable that the treatment of several States as a single Contracting Party should apply so as to ensure that a particular international application is the subject of the same treatment according to the provisions of the same Act by each of the States that have made a notification under paragraph (1).

21.03 *Paragraph (2)* establishes the time at which a notification under paragraph (1) may be made. Two situations are distinguished. The first concerns States that have already effected the unification of their domestic legislation before becoming party to the new Act. In such a case, the notification must be made at the time of the deposit of the instruments of ratification or accession by the States concerned. The second situation concerns States that are already party to the new Act when they effect the unification of their domestic legislation. In such a situation, the notification may be made at any time after the unification has been effected.

21.04 *Paragraph (3)* seems to be self-explanatory.

Notes on Article 22

22.01 Article 18 makes it clear that Contracting Parties will belong to the same Union as States that are not Contracting Parties but are party to the 1934 Act or the 1960 Act. There are six States that are party to the 1934 Act without being party to the 1960 Act, namely, Egypt, the Holy See, Indonesia, Morocco, Spain and Tunisia. There are 20 States party to the 1960 Act, namely, Belgium, Benin, Bulgaria, Côte d'Ivoire, Democratic People's Republic of Korea, France, Germany, Hungary, Italy, Liechtenstein, Luxembourg, Monaco, the Netherlands, the Republic of Moldova, Romania, Senegal, Slovenia, Suriname, Switzerland and Yugoslavia.

22.02 The relations between Contracting Parties and States party to the 1934 Act or the 1960 Act are governed by Article 33.

Notes on Article 23

23.01 *Article 23* deals with the Assembly of the Hague Union, which will constitute the forum in which the Contracting Parties will meet to discuss matters relating to the maintenance and development of the Union and the implementation of the new Act.

23.02 The Assembly of the Hague Union was established by the Complementary Act of the Hague Agreement that was signed at Stockholm on July 14, 1967, and amended on September 28, 1979 (see the definition of "Assembly" in Article 1(xxv)). Thus, the composition of the Assembly would comprise not only Contracting Parties, but also those States that are not Contracting Parties but are party to the Complementary Act of 1967. Article 1(xxvii) includes a definition of "member of the Assembly" to that effect. Article 23 regulates the respective rights of Contracting Parties and States that are not Contracting Parties, but are party to the Complementary Act of 1967, in their participation in the Assembly.

23.03 *Paragraph (1)* deals with the composition of the Assembly and confirms that Contracting Parties will be members of the Assembly. Subparagraph (c) empowers the Assembly to decide that the travel expenses and subsistence allowance of one delegate from each Contracting Party be paid from the funds of the Union. Whether the Assembly would exercise that power would depend on the financial condition of the Union.

23.04 Subparagraph (d) of paragraph (1) establishes the position of those States that are party to the Act of 1934 but are neither Contracting Parties nor party to the Complementary Act of 1967. The six States which are presently party to the 1934 Act and not to the Complementary Act of 1967 are Egypt, the Holy See, Indonesia, Morocco, Spain and Tunisia (these are all the States which are party to the 1934 Act and not to the 1960 Act; on the other hand, there are no States which are party to the 1960 Act and not to the Complementary Act of 1967). Since the Act of 1934 did not provide for the establishment of an Assembly of the Union, those six States are not members of the Assembly but, by virtue of subparagraph (d), would have the right to be admitted to meetings of the Assembly as observers.

23.05 *Paragraph (2)* lists the tasks of the Assembly. In general, the provisions of paragraph (2) follow those of corresponding provisions in treaties concluded under the aegis of WIPO that provide for a Union with a budget.

23.06 *Paragraph (3)* seems to be self-explanatory.

23.07 *Paragraph (4)* will establish the voting rights of members of the Assembly. In view of the highly political nature of that question, it is reserved for the Diplomatic Conference which will adopt the new Act.

23.08 *Paragraph (5)(a)* establishes that a quorum of the Assembly is constituted by one-half of the members of the Assembly. The words “which have the right to vote” are put within square brackets, in this provision as well as in paragraph (5)(b), because the decision to include them or not will depend on the decision that will be taken in connection with paragraph (4).

23.09 *Paragraph 5(b)* provides that the Assembly may make decisions in the absence of a quorum in certain circumstances. Those circumstances are that the number of members of the Assembly [having the right to vote] is less than one-half but equal to more than one-third of the members of the Assembly [having the right to vote]. Any decision taken by the Assembly in such circumstances, with the exception of decisions concerning the procedure of the Assembly, must, however, be confirmed by the required majority of a quorum attained through voting by correspondence in accordance with the procedure set out in subparagraph (b).

23.10 *Paragraph (6)* establishes as the general rule that decisions of the Assembly require a majority of the votes cast. Two types of decision of the Assembly, however, require a majority of three-fourths of the votes cast, namely, the amendment of the Regulations (Article 26(2)(b)), and the amendment by the Assembly of Articles 24, 25 and 28(1), (2)(a) and (3) (Article 28(2)(b)). One type of decision requires a four-fifths majority, namely, the amendment by the Assembly of Article 23 and Article 28(2)(b) (Article 28(2)(b)). Two further types of decision of the Assembly would require unanimity, namely, the modification of the time limit for refusal (Article 10(3)), on the one hand, and, on the other hand, the amendment of Rules contained in the Regulations which are specified by the Regulations as requiring unanimity for amendment, the deletion of such a unanimity requirement and the inclusion of a requirement of unanimity in respect of the amendment of any Rule to which the requirement does not already apply (Article 26(3)).

23.11 *Paragraph (7)* is in the same form as corresponding provisions contained in treaties concluded under the aegis of WIPO and seems to be self-explanatory.

23.12 *Paragraph (8)* seems to be self-explanatory.

Note on Article 24

24.01 *Article 24* deals with the tasks of the International Bureau and the nature of those tasks. It is, in general, in the same form as the corresponding Article in other treaties concluded under the aegis of WIPO, particularly the treaties dealing with the registration

activities of WIPO, namely, the Patent Cooperation Treaty (PCT), the Madrid Agreement and the Madrid Protocol. The provisions of the Article seem to be self-explanatory.

Notes on Article 25

25.01 *Article 25* deals with the finances of the Union and, in general, follows the provisions of Article 4 of the Complementary Act of 1967. The latter Article is in a form similar to the corresponding financial provisions of other treaties administered by WIPO.

25.02 *Paragraph (1)* provides for the budget of the Union. *Subparagraph (b)* specifies that the budget of the Union will include not only the income and expenses proper to the Union (related to the registration activities of the Union and the meetings of its Assembly and of committees and working groups established by the Assembly), but also the contribution of the Union to the budget of expenses common to the Unions administered by WIPO. Such common expenses include in particular the administrative and financial personnel and services provided by those personnel of the International Bureau that serve all of the Unions. *Subparagraph (c)* establishes the principle that the share of the Hague Union in such common expenses will be in proportion to the interest that that Union has in them.

25.03 *Paragraph (2)* is intended to facilitate the coordination of the budget of the Union with the budgets of the other Unions administered by WIPO.

25.04 *Paragraph (3)* sets forth the sources of the financing of the budget and seems to be self-explanatory.

25.05 *Paragraph (4)* deals with the fixing of fees and charges as well as with the level of the budget. *Subparagraph (a)* provides that the fees relating to international registrations (excluding the individual designation fees referred to in Article 13(2) and (3), which are fixed by the Contracting Party concerned) will be fixed by the Assembly following a proposal of the Director General and that the Director General may, pending a decision by the Assembly, establish amounts for charges due for services rendered by the International Bureau. Naturally, the amount of the fees should be so fixed as to enable the revenues of the Union at least to cover the expenses of the International Bureau concerning the Union, and *subparagraph (b)* makes provision to that effect. As far as the level of the budget is concerned, *subparagraph (c)* provides for it to be at the same level as the budget of the previous year in the event that the budget is not adopted before the beginning of any new financial period.

25.06 *Paragraph (5)* provides for the establishment of a working capital fund constituted by the excess receipts of the Union. In the event that the excess receipts do not suffice for the purposes for which the Assembly approves, in the program of the Union, expenditure, a single payment has to be made by each member of the Union, which may be increased by the Assembly. Apart from this contribution to the working capital fund, no other contributions are envisaged from the members of the Union.

25.07 *Paragraph (6)* is in the same form as Article 4(7) of the Complementary Act of 1967 and provides for the host State to make advances to the working capital fund in the event of an

insufficiency in that fund. Subparagraph (b) contains provision for the host State to denounce that obligation by written notification.

25.08 *Paragraph (7)* seems to be self-explanatory.

Notes on Article 26

26.01 *Paragraph (1)* provides that the Regulations are annexed to the new Act, which means that they will be adopted by the Diplomatic Conference that will adopt the new Act itself. It contains a general description of the matters to be dealt with in those Regulations. It is to be noted that paragraph (1) envisages that the Regulations will deal only with international registrations under the new Act. It is not intended, therefore, that a common set of Regulations should be adopted to deal with international registrations under the 1934 Act, the 1960 Act and the new Act. This situation may be contrasted with the special case of the Common Regulations under the Madrid Agreement and the Madrid Protocol, where one set of Regulations govern registration under both the Madrid Agreement and the Madrid Protocol. In the present case, a uniform set of Regulations for the various Acts of the Hague Agreement is not considered to be useful, since it is to be hoped that the new Act will enjoy a sufficiently widespread acceptance to lead to the obsolescence of the previous Acts of the Hague Agreement.

26.02 *Paragraph (2)*, in *subparagraph (a)*, empowers the Assembly to amend the Regulations. *Subparagraph (b)* establishes the requirement that, with the exception of those Rules specified by the Regulations as requiring unanimity for amendment (as to which, see the next paragraph), three-fourths of the votes cast in the Assembly are needed for the adoption of amendments to the Regulations.

26.03 *Paragraph (3)*, in *subparagraph (a)*, provides that the Regulations specify Rules which may be amended only by unanimous consent. The draft Regulations do not at present specify that any of the Rules may be amended only by unanimous consent. *Subparagraph (b)* requires unanimity for the deletion of the requirement of unanimity for the amendment of any Rule referred to in subparagraph (a). *Subparagraph (c)* requires unanimity for the establishment of a requirement of unanimity for the amendment of any Rule.

26.04 *Paragraph (4)* establishes the superiority of the provisions contained in the Act over those contained in the Regulations so that, in the event of conflict between the two sets of provisions, the provisions of the Act prevail.

Notes on Article 27

27.01 *Paragraph (1)* confirms the standard rule that a treaty may be revised by a conference of the Contracting Parties. Article 23(2)(iii) provides that the convocation of revision conferences is to be decided by the Assembly.

27.02 *Paragraph (2)* empowers the Assembly to amend certain specified Articles also by the procedure established under Article 28. The Articles that may be so amended are those concerned with the Assembly, the International Bureau, finances and the procedure for the Assembly to amend Articles in the new Act. Those Articles are the same as the Articles of the Complementary Act of 1967 which the Assembly of the Hague Union is, by virtue of Article 5 of the Complementary Act of 1967, empowered to amend. It would seem to be undesirable that the Assembly should not enjoy the same power of amendment with respect to the new Act as it enjoys with respect to the Complementary Act of 1967.

Notes on Article 28

28.01 *Article 28* sets out the procedure, required majorities and conditions of entry into force of amendments made by the Assembly to those Articles which it is competent to amend, namely, Articles 23, 24, 25 and 28.

28.02 *Paragraph (1)* provides that proposals for the amendment of those Articles that the Assembly is competent to amend may be made by either a Contracting Party or the Director General. The proposal must be communicated by the Director General to the Contracting Parties at least six months before the Assembly meets to consider them.

28.03 *Paragraph (2)(b)* establishes the requirement of a three-fourths majority for the amendment of Articles 23, 24 and 28(1), (2)(a) and (3), and the requirement of the four-fifths majority for the amendment of Articles 23 and 28(2)(b).

28.04 *Paragraph (3)* sets out the procedure for the entry into force of amendments adopted by the Assembly. It provides, in *subparagraph (a)*, that amendments will enter into force one month after written notification of acceptance, in accordance with their respective constitutional processes, have been received by the Director General from three-fourths of the members of the Assembly who had the right to vote on the amendment when it was adopted. The decision as to the possible inclusion of the words which appear within square brackets will depend on the decision which will be taken concerning the right to vote in the Assembly (Article 23(4)). *Subparagraph (b)* provides for amendments, adopted and accepted in accordance with the procedure established in subparagraph (a), to bind all States and intergovernmental organizations which either were Contracting Parties at the time of the entry into force of the amendment or thereafter become Contracting Parties.

Notes on Article 29

29.01 *Paragraph (1)* specifies the kinds of entities that may become party to the new Act. Those entities are, first, States, which must fulfill two requirements, namely, being member of WIPO and making available protection of industrial designs through their own Office (item (i)), through the Office of another, specified State that is party to the new Act (item (iii)), through the regional Office maintained by an intergovernmental organization of which that State is a member (item (iv)), or through a common Office of a group of States party to the new Act (item (v)); and, secondly, intergovernmental organizations which maintain a regional

Office in which protection of industrial designs may be obtained with effect in all its member States (item (ii)).

29.02 *Item (i)* as well as items (iii), (iv) and (v) obliges a State wishing to become a Contracting Party to be a member of WIPO. The requirement to be a member of WIPO rather than party to the Paris Convention follows the (recent) precedent of the Trademark Law Treaty. However, any Contracting Party will be obliged, even if it is not bound by the Paris Convention, to comply with the provisions of the Paris Convention which concern industrial designs (see Article 2(3)).

29.03 *Item (ii)* establishes the conditions that an intergovernmental organization must satisfy in order to be eligible to become party to the new Act. First, the intergovernmental organization must maintain an Office granting protection for industrial designs with effect in the territory in which the constituting treaty of the intergovernmental organization applies. The African Organization for Intellectual Property (OAPI) is an intergovernmental organization that satisfies this condition, as would be the European Community once the proposed Community Designs Office has been established. Secondly, at least one of the member States of the intergovernmental organization must be a member of WIPO. Thirdly, in order to be eligible to become a Contracting Party, the Office maintained by the intergovernmental organization must not be the subject of a notification under Article 21, which applies to the common Office of several States that, by virtue of Article 21, are treated, for certain purposes, as a single Contracting Party. In other words, it would not be possible for the Benelux Designs Office, if that Office is (as can be expected) the subject of a notification under Article 21, to become a Contracting Party. That third condition is the same as under the Madrid Agreement and the Madrid Protocol.

29.04 *Item (iii)*. An example of a State that is a member of the Hague Union and in respect of which protection for industrial designs may be obtained through another State's Office is the Holy See, since industrial designs are registered for the Holy See by the Italian Office. The provision would mean that the Holy See could not become a Contracting Party before Italy.

29.05 *Item (iv)*. Examples of States that would satisfy this requirement are the member States of OAPI.

29.06 *Item (v)*. Examples of States that would be eligible for membership by virtue of this item are Belgium, Luxembourg and the Netherlands, in which the protection of industrial designs may be obtained only through the Benelux Designs Office.

29.07 *Paragraph (2)* sets out the modes of becoming a party to the new Act. Those modes are applicable to both types of entities (States and intergovernmental organizations) that are eligible to become party to the new Act.

29.08 *Paragraph (3)(a)* establishes the effective date of the deposit of instruments of ratification or accession for the various categories of entities eligible to become party to the new Act. The provisions are so drafted as to ensure that an instrument deposited by an entity will not become effective unless the instrument of any other entity through whose Office protection may be obtained in the former entity is also deposited.

29.09 *Paragraph (3)(b)* has been inserted as a means of allowing a potential Contracting Party to ensure that it will become bound by the new Act only if another potential Contracting Party also becomes bound by it. The provision allows a conditional ratification or accession, that is, a ratification or accession that takes effect only if instruments of ratification or accession are deposited by up to two other specified potential Contracting Parties.

29.10 The instrument of ratification or accession containing the declaration making it conditional upon the deposit of an instrument by another potential Contracting Party is considered to have been deposited on the day on which the condition becomes fulfilled (that is, the day on which the instrument of ratification or accession is deposited by the other specified potential Contracting Party). In cases where the deposit of an instrument of ratification or accession (“the first instrument”) is made conditional on the deposit of a second such instrument (“the second instrument”) the deposit of which, in turn, is declared to be conditional on the deposit of a third such instrument (“the third instrument”), the second instrument is considered, by the last sentence of paragraph (3)(b), to be deposited on the day on which the third instrument is deposited. Thus, the first instrument could not be considered to be deposited until the third instrument is deposited.

29.11 *Paragraph (3)(c)* seems to be self-explanatory.

Notes on Article 30

30.01 *Article 30* is directed at determining the initial entry into force of the new Act, as well as the date of entry into force of ratifications and accessions subsequent to the entry into force of the new Act. *Paragraph (1)* confirms that only instruments of ratification or accession that have been deposited by eligible entities (those described in Article 29(1)) and that have an effective date according to Article 29(3) may be taken into consideration in determining the entry into force of the new Act and of subsequent ratifications and accessions. The latter safeguard (the effective date according to Article 29(3)) is necessary in order to ensure that there is no unfulfilled condition attached to the deposit of an instrument and to ensure that international registrations will be able to be given effect in the whole territory of the entity depositing the instrument.

30.02 *Paragraph (2)* establishes the conditions for the entry into force of the new Act. It contains a provision which is directed at giving an assurance that it is likely that the procedure for international registration provided under the new Act will receive considerable use following the entry into force of the new Act. The mechanism adopted for providing that assurance in paragraph (2) is modeled on the provisions of Article 63(1) of the Patent Cooperation Treaty (PCT). It requires that, of the six States or intergovernmental organizations whose instruments of ratification or accession are required for the entry into force of the new Act, at least three of those each satisfy any one of three conditions. Those three conditions basically relate to the level of activity in industrial design applications in the Contracting Party and the extent of foreign exposure in that activity. The conditions are:

- (i) that the number of applications for the protection of industrial designs in the Contracting Party exceeded 3,000 in the latest year;

- (ii) that the nationals or residents of the State, or the nationals or residents of States members of the intergovernmental organization, have filed at least 200 applications for the protection of industrial designs in one foreign State or in one other intergovernmental organization in the latest year;
- (iii) that the Office of the Contracting Party received at least 1,000 applications from foreign nationals or residents in the latest year.

The statistics to be used for the evaluation of the fulfillment of those conditions are the most recent annual statistics collected by the International Bureau.

30.03 The figures chosen in respect of the three conditions set out in the preceding paragraph have been based on the statistics for three of the States party to the 1934 Act and/or the 1960 Act in the latest year for which annual statistics published by the International Bureau are available (namely, 1995). Those statistics are as follows:

	Total No. of applications (Article 30(2)(i))	Highest No. of applications filed in one foreign State (Article 30(2)(ii))	No. of foreign applications received (Article 30(2)(iii))
France	10,057	832 (in Germany)	3,664
Germany	12,391	1,988 (in Austria)	4,015
Spain *	5,284	151 (in France)	3,693

30.04 *Paragraph (3)* provides that, in respect of any State or intergovernmental organization that deposits an instrument of ratification or accession and that is not amongst the Contracting Parties on the date of the initial entry into force of the new Act, the Act will take effect with respect to that entity three months after the date on which it has deposited its instrument.

Notes on Article 31

31.01 This Article prohibits any reservation to the new Act.

* Party to the 1934 Act only

Notes on Article 32

32.01 *Article 32* deals with the manner in which the various declarations that may be made by Contracting Parties under provisions of the draft new Act must be made, and the date on which such declarations become effective.

32.02 *Paragraph (1)*. Any of the declarations specified in Article 32(1) may be made either at the time of the deposit of an instrument of accession to the draft new Act, or at any time after the deposit of such an instrument. Where the declaration is made at the time of the deposit of an instrument of accession, it becomes effective on the same date as the date on which the State or intergovernmental organization becomes bound by the new Act. Where the declaration is lodged after the deposit of an instrument of accession, the declaration becomes effective three months after the date of its receipt by the Director General or on any later date indicated in the declaration, but it applies only in respect of international registrations whose date of international registration is the same as, or later than, the date on which the declaration becomes effective.

32.03 *Paragraph (2)* applies to declarations made by States that have notified the Director General under Article 21(1) of the unification of their domestic legislation on industrial designs and of the substitution of a common Office for each of their national Offices. In order to ensure that the new Act is applied uniformly in such States, it provides that any declaration made by such a State will become effective only if the other State or States that have made the notification under Article 21(1) make a corresponding declaration.

32.04 *Paragraph (3)* seems to be self-explanatory.

Notes on Article 33

33.01 *Article 33* regulates the relations between the various members of the Union. It is modeled on Article 31 of the 1960 Act.

33.02 *Paragraph (1)* deals with the relations between States that are party to both the new Act and the 1934 Act or the 1960 Act. It establishes the principle that, as regards the relations between such States, the new Act alone applies. Thus, nationals or residents of such States wishing to obtain international registration would be able to proceed only according to the provisions of the new Act for the purposes of extending the effect of the protection from such international registration to other States party both to the new Act and to the 1934 Act or the 1960 Act. According to that principle, as more and more States presently party to the 1934 Act or the 1960 Act ratify or accede to the new Act, the 1934 Act and the 1960 Act will fall into desuetude.

33.03 The second sentence of paragraph (1) safeguards the application of the 1934 Act or the 1960 Act, as the case may be, to industrial designs deposited prior to the date on which the new Act becomes applicable to the mutual relations between States party to either of those Acts and to the new Act.

33.04 *Paragraph (2)* deals with the relations between States party to both the new Act and the 1934 Act or the 1960 Act, on the one hand, and States party only to the 1934 or 1960 Acts, without being party to the new Act, on the other hand.

33.05 *Subparagraph (a)* ensures the continued application of the 1934 Act by a State party to both the new Act and the 1934 Act in its relations with States party to the 1934 Act without being party to the 1960 Act or the new Act. *Subparagraph (b)* ensures the continued application of the 1960 Act by a State party to both the new Act and the 1960 Act in its relations with States party to the 1960 Act without being party to the new Act.

Note on Article 34

34.01 This is an Article of the usual kind. In order to allow those relying on adherence to the new Act by a Contracting Party to adjust their affairs in the event that such a Contracting Party should denounce the new Act, a period of one year is provided in paragraph (2) before a denunciation takes effect. In addition, paragraph (2) preserves the rights accorded by the new Act to any international application pending or any international registration in force in respect of the denouncing Contracting Party prior to the expiration of the one-year period provided for the denunciation to take effect.

Note on Article 35

35.01 This is also an Article of the usual kind. It seems to be self-explanatory.

Note on Article 36

36.01 *Article 36* provides for the Director General to be the depository of the new Act. The nature of the functions of the depository of a treaty and a list of those functions are set out in Articles 76 and 77 of the Vienna Convention on the Law of Treaties. Those functions relate, in particular, to the custody of the original text of the new Act, the preparation of certified copies of the original text, the receipt of the deposit of instruments of ratification or accession and of notifications, and the communication of notifications to the Contracting Parties.

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