

# WIPO



H/CE/VII/5

ORIGINAL: English

DATE: September 17, 1997

**WORLD INTELLECTUAL PROPERTY ORGANIZATION**  
GENEVA

**COMMITTEE OF EXPERTS  
ON THE DEVELOPMENT OF THE HAGUE AGREEMENT  
CONCERNING THE INTERNATIONAL DEPOSIT  
OF INDUSTRIAL DESIGNS**

**Seventh Session  
Geneva, November 3 to 7, 1997**

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

*prepared by the International Bureau*

## INTRODUCTION

1. The present document contains Notes on the draft Regulations under the draft new Act contained in document H/CE/VII/4. Where a provision is considered to be self-explanatory, no Note has been provided.
2. While preparing the draft Regulations, it has been noted that some of the provisions in the draft Act are of a detailed, procedural nature (for example, those in Articles 7 and 8 relating to irregularities in the international application). It might therefore be considered appropriate to transfer some provisions from the Act to the Regulations. No attempt has been made at doing so for the time being, however, since it has been considered that this would best be done in a subsequent draft of the Act and the Regulations when greater consensus has been reached on the substance of the provisions concerned.
3. As indicated in Rule 25(1)(a), the Regulations will eventually contain a Schedule of Fees. No draft of this has been provided at this stage, since it is considered that it would be premature to venture even approximate figures before the cost of the procedure can be estimated with more certainty.
4. In preparing these Regulations, regard has been had to the existing Regulations under the Hague Agreement, and also to the Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement. In particular, the structure of Rule 7 is similar to that of Rule 9 of those Common Regulations, and it uses some of the wording of that Rule.

### *Note on Rule 1*

1.01 *Paragraph (2)(iii)* provides that “official form” means a form established by the International Bureau or any form having the same contents and format. It follows Rule 1(xxvii) of the Common Regulations under the Madrid Agreement and Protocol. This allows applicants and representatives to generate their own forms, while requiring that these be sufficiently similar to the forms established by the International Bureau to enable the data on them to be captured efficiently by the Designs Registry. Copies of the forms established by the International Bureau will be made available free of charge. They may be made available not only on paper, but also on the Internet.

### *Note on Rule 2*

2.01 No provision is made for communication by telex or telegram, since these modes are very rarely used nowadays. Nor is any provision made at this stage concerning electronic communications. The technology concerning such communications is evolving so rapidly that it has been considered preferable to leave this subject for a later draft of the Regulations or for the Administrative Instructions.

*Note on Rule 3*

3.01 *Paragraph (4)(a).* Since this provision refers to the signature of a *recorded* representative, it follows that the signature mentioned in paragraph (2)(a) and (b) must be that of the applicant or holder himself.

*Note on Rule 5*

5.01 *Item (i) of paragraph (2).* Although paragraph (1)(i) provides for failure to meet a time limit to be excused where this is due to an interruption of a postal service on account of a strike, this has not been included in paragraph (2)(i), which deals with communications sent through a delivery service. This is because, while a postal service is generally a monopoly, this is not the case with delivery services. Accordingly, when one delivery service is affected by a strike, it will normally be possible to use another delivery service which is not so affected. Allowing a time limit to be excused on the ground that a particular delivery service was affected by a strike could therefore be open to abuse.

*Notes on Rule 7*

7.01 Rule 7 states the requirements concerning the presentation and content of an international application. It should be read in conjunction with Rule 8 (which prescribes the reproductions or specimens of the industrial design that must accompany the application) and Rule 10 (which prescribes further details concerning certain elements which must be included in the international application where certain Contracting Parties are designated).

7.02 *Paragraph (1)* requires the use of the official international application form. The use of this form ensures that the requirement of Article 5(1)(a)(i), that the international application contain a request for international registration under the new Act, is met.

7.03 The provision does not mention the number of copies of the form that must be filed; by implication, therefore, only one copy is required. Under Rule 8(2)(a) of the present Regulations, the international application must be filed in two copies. It is expected however that, by the time the new Act and its Regulations come into force, the International Designs Registry will scan each document on receipt, and operate in a paperless manner (as is already the case for the International Trademarks Registry). A second copy would therefore be redundant, and even inconvenient.

7.04 The provision requires that the international application be signed by the applicant. The report of the Committee of Experts (H/CE/VI/5, paragraph 132) stated that it would be made clear that an appointed representative could sign the application and a power of attorney would have to be furnished. In Rule 3(2) it is proposed that a representative may be appointed either (a) in an international application which is signed by the applicant or (b) in a separate communication which is signed by the applicant or holder. When such a separate communication is attached to the international application, the latter may validly be signed by the representative for the applicant.

7.05 *Paragraph (3)(c) and (d).* The expressions “applicant’s Contracting Party” and “International Classification” are defined in Article 1(xiii) and (xxxv).

7.06 *Paragraph (3)(d).* Concerning the words “which constitute the industrial design or in relation to which the industrial design is to be used”, see Note 8.02.

7.07 *Paragraph (4)* lists additional elements that may be included in an international application, either because they are required by one or more of the Contracting Parties designated or at the option of the applicant.

7.08 Subparagraph (a) of paragraph (4) relates to Article 17, which provides that a Contracting Party whose Office is an Examining Office may notify the Director General that it requires one or more of the following elements: the identity of the creator of the industrial design; a description; a claim. Such notification would only be made by a Contracting Party whose law requires the element concerned as a condition for according a filing date. Where such a Contracting Party is designated and the international application does not contain the required element, the consequence is either that the filing date is affected (where the element is received subsequently) or that the designation of that Contracting Party is disregarded (see Rule 12(2)(a)). The second sentence of subparagraph (a) makes clear that any of these elements may be included in the international application even where it is not required as a consequence of Article 17. This is because the applicant may be aware that a designated Contracting Party that has not made the notification referred to in Article 17 nonetheless requires such an element, though not as a filing date requirement, and he wishes to forestall a refusal by that Contracting Party.

7.09 Further details concerning the elements mentioned in this subparagraph are given in Rule 10.

7.10 *Paragraph (4)(f).* It follows from Article 10(1) that no Contracting Party may refuse the effect of the international registration on the ground that an element is missing from the international application where that element is not required or permitted by the Act, the Regulations or the Administrative Instructions. Moreover, paragraph (5) of this Rule provides that no further element may be included in the international application. The list in paragraph (4)(f) will therefore have to be exhaustive.

7.11 *Item (i) of paragraph (4)(f).* Such a declaration could be printed on the international application form.

7.12 *Item (iii) of paragraph (4)(f).* A pro forma assignment deed, using wording suitable for those countries with this requirement, could be included on the application form.

7.13 *Paragraph (5).* This wording follows the proposal for Rule 8.3(b) of the present Regulations under the Hague Agreement as put to the Assembly of the Hague Union in its ordinary session in September 1997 (see document H/A/XV/1).

*Notes on Rule 8*

8.01 *Paragraph (1).* Article 5(1)(a)(iii) refers to the prescribed number of copies of “a reproduction” of the industrial design. Subparagraph (a) indicates that the reproduction may be a photograph or other graphic representation. This is the same as the requirement under Rule 12.1 of the current Regulations. The photographs or graphic representations may be in black and white or in color. Unlike the current Rule 12.1 however, the draft Rule does not provide for the filing of color transparencies where the industrial design is to be published in color; the International Bureau does not wish to receive such transparencies, and is able to publish in color on the basis of a color photograph. Nor does the draft Rule provide for the filing of samples or models (except in the special case referred to in Rule 9); three-dimensional models are costly to store and are, in any case, very seldom filed.

8.02 *Paragraph (1)(a).* The wording “of the industrial design itself or of the product or products which constitute the industrial design” is intended to allow an applicant to seek protection for a motif to be applied to several different products without being required to provide a reproduction of each product. Of course, as required by Article 5(1)(a)(iv) and Rule 7(3)(d), the products to which it is to be applied would all have to be indicated in the international application. Also, all such products would have to belong to the same class of the Locarno Classification. Moreover, Rule 7(3)(d) provides for the applicant to indicate whether the product or products *constitute* the industrial design or are (as would be the case where protection is sought for a motif) products *in relation to which* the industrial design is to be used.

8.03 The wording of the second sentence of paragraph (1)(a) follows Rule 12.1(d) of the current Regulations. As explained in the Notes concerning Article 5(1)(a)(iii), an applicant may choose to submit different views of the same industrial 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 (see Note 5.04 in document H/CE/VII/3). The words “shown from different angles” or “views from different angles” mean that each reproduction shows what would be seen by a person viewing the product from each of these angles. It does not therefore include a cross-section or other internal view of the product; the International Bureau therefore will not accept such representations accompanying an international application.

8.04 *Paragraph (2)* follows Rule 12.1(c) of the current Regulations. The International Bureau is currently holding consultations regarding the revision of the relevant provisions of the current Administrative Instructions (Sections 403 to 405) which, as amended, would read as follows:

**“Section 403  
Representation of the Article Deposited**

The photographs and other graphic representations shall represent the deposited article alone, to the exclusion of any other object, accessory, person or animal. The deposited article must be represented at least once in the position in which it is normally used.

#### **Section 404**

##### **Requirements for Photographs**

(a) The photographs supplied must be of professional standard and cut at right angles. The articles must be shown against a neutral plain background. Photographs retouched with ink or correcting fluid are not allowed.

(b) Reproductions of photographs that meet the conditions set forth in paragraph (a) and have been produced by means of electronic processes shall be allowed if they are themselves of professional standard, cut at right angles and not retouched.

#### **Section 405**

##### **Requirements for Graphic Representations**

Graphic representations must be either originals of professional standard produced with drawing instruments or by electronic means, on good-quality paper cut at right angles, or prints or photocopies made from such originals and having the same quality. The lines must be even and boldly drawn. The article represented should preferably be in perspective; it may comprise shading and hatching to provide relief; it may be shown against a background provided that it is neutral and plain.

The following shall not be accepted:

- (i) technical drawings showing articles in section or in plan, particularly with axes and dimensions,
- (ii) explanatory texts or wording shown on or adjacent to the articles.”

8.05 The Administrative Instructions will also indicate requirements concerning the dimensions of reproductions.

8.06 As explained in Note 5.04 concerning Article 5(1)(a)(iii) (see document H/CE/VII/3), an Office may not refuse the effect of an international registration on the grounds of non-compliance with requirements concerning the reproduction of industrial designs. In particular, the current Administrative Instructions state that shading and hatching to provide relief are acceptable. The sole relevant test, under paragraph (2)(a) of Rule 8, is whether all the details of the products shown may be clearly distinguished.

8.07 *Paragraph (2)(b).* The Administrative Instructions will provide that a disclaimer may be included in the description of the industrial design or may be indicated by dotted or broken lines in the reproduction of the industrial design. They will indicate the forms of disclaimer which are acceptable to particular Offices, on the basis of information supplied to the International Bureau by those Offices. If therefore the disclaimer has been made in accordance with the Administrative Instructions, a designated Office may not issue a notification of refusal on the ground that the requirements of its law concerning the presentation of disclaimers have not been complied with.

8.08 *Paragraph (3)*. The notification may for instance state that six views (front, rear, top, bottom, left, right) are required; it may also state that a view may be omitted if it is identical to another view or if it is conventional or otherwise not relevant to the industrial design; it may also indicate the circumstances in which these six views are required, or the circumstances in which they are not required—for example, where the product has an axis of symmetry (e.g., a plate) or is spherically symmetrical. For instance, the “Guide to filing a design patent application” of the United States Patent and Trademark Office states that it is not necessary to provide views of surfaces which are shown in a perspective view of the product or are flat and unornamented or are identical with other surfaces. The information in the notification should be clear enough for an applicant to know whether, when designating the Contracting Party concerned, he has complied with the requirements.

8.09 *Paragraph (4)*. A Contracting Party may not, for example, refuse on the ground that a reproduction is not provided with surface shading. It may however refuse on the ground that the reproductions do not sufficiently disclose the appearance of the industrial design.

#### *Notes on Rule 10*

10.01 Rule 10 specifies in more detail what is required in respect of each of the elements that may be required in consequence of a notification under Article 17(1). Where these requirements have been met, an Office may refuse the effect only if there is an objection of substance—for example, that the description does not in fact describe the characteristic features of the industrial design.

10.02 *Paragraph (2)*. Rule 6.3(a)(i) of the current Regulations limits a description to 100 words. The second sentence of the paragraph is taken from Section 406 of the current Administrative Instructions.

10.03 *Paragraph (3)*. A claim has been specified as necessary in the United States of America. The claim must be in formal terms to the ornamental design for the product (specifying name) as shown, or as shown and described. For example, if the product which constitutes the industrial design is a telephone handset, the claim might read “CLAIM: An ornamental design for a telephone handset substantially as shown and described.” It is understood that, if such a statement is not included in an application in the United States of America, a filing date cannot be accorded. This wording could be printed on the international application form, so that an international application which contains the designation of the Contracting Party concerned will be deemed to contain the said claim.

#### *Notes on Rule 12*

12.01 Rule 12 does not deal with the consequences for the date of international registration of the irregularities mentioned in Article 8(3), since these are fully specified in Article 8(2).

12.02 *Paragraph (2)* deals with the case where the international application contains the designation of a Contracting Party that has notified the Director General, in accordance with Article 17(1), that it requires one or more of the following elements: identification of the

creator of the industrial design; a description; a claim; and one or more of the required elements is missing. It implements Article 18. According to subparagraph (a), if the international application does not contain any of the irregularities mentioned in Article 8(3) (that is, irregularities which affect the date of international registration), the applicant will be notified that, in accordance with Article 18(i), the international application is considered not to contain the designation of the Contracting Party in respect of which the element (identification of the creator, description or claim) that is missing is required. Subparagraph (b) deals with the case where the international application does contain irregularities which affect the international registration date. If the missing element (identification of the creator, description or claim) is supplied before, or at the same time as, these irregularities are remedied, the designation of the Contracting Party concerned will not be affected; in accordance with Article 8(2)(ii), the date of the international registration will be the date on which the said irregularities were remedied. If the missing element (identification of the creator, description or claim) is not supplied before this date, the international application will, as under subparagraph (a), be considered not to contain the designation of the Contracting Party concerned.

12.03 *Paragraph (5).* The provision for the retention of a certain amount of fees takes account of the expense incurred by the International Bureau in examining an international application and issuing a letter of irregularity. Whether that amount should correspond to the basic fee, or a part thereof, will have to be determined when the Schedule of Fees is drawn up.

*Note on Rule 13*

13.01 *Item (i) of paragraph (2).* Rule 7(4)(g) provides for a statement of relevant prior art to *accompany* the international application. Such a statement is therefore not *contained* in the international application; it follows that it will not be included in the international registration, nor will it be published. The Administrative Instructions will provide for such statements of prior art to be forwarded by the International Bureau to the Offices of Contracting Parties whose law provides for them.

*Note on Rule 14*

14.01 *Paragraph (1).* A reminder procedure concerning the furnishing of the reproductions will be prescribed in the Administrative Instructions.

*Note on Rule 15*

15.01 *Item (iii).* The Rule says nothing about the timing of the publication, sending the publication to the designated Contracting Parties, or sending a copy of the international registration where publication has been deferred, because there is nothing to add to Articles 7(3), 9 and 19(1).



*Note on Rule 16*

16.01 *Item (iii) of paragraph (2).* It is not sufficient, in a notification of refusal, simply to state that an industrial design may not be protected in the Contracting Party concerned, or simply to refer to the relevant provisions of the applicable law. The grounds for refusal must be clearly explained.

*Notes on Rule 17*

17.01 *Item (iii) of paragraph (1)(a).* The Administrative Instructions will deal with the question of notifications of refusal which are sent before the expiry of the relevant period but received by the International Bureau after the expiry of that period. Provision could be made along the lines of Rule 18(1)(a)(iii) of the Common Regulations under the Madrid Agreement and Protocol, which reads as follows:

“In the case of a notification of refusal sent through a postal service, the date of dispatch shall be determined by the postmark. If the postmark is illegible or missing, the International Bureau shall treat such notification as if it was sent 20 days before the date of its receipt by the International Bureau. However, if the date of dispatch thus determined is earlier than the date on which the refusal was pronounced, the International Bureau shall treat such notification as if it had been sent on the latter date. In the case of a notification of refusal sent through a delivery service, the date of dispatch shall be determined by the indication given by such delivery service on the basis of the details of the mailing as recorded by it.”

17.02 *Paragraph (2).* The fact that a notification is irregular in the sense of this paragraph does not affect its validity as a notification of refusal.

*Notes on Rule 19*

19.01 *Paragraph (1)(a)* does not mention a request for recordal of a change in the name or address in the representative, because it will not be necessary to use an official form. Such a request must however comply with paragraph (2); in particular, it must indicate the numbers of all the international registrations concerned.

19.02 *Item (ii) of paragraph (1)(b).* The requirements concerning a request for recordal of a change in ownership are based on Rule 19.1(c) of the current Regulations under the Hague Agreement.

19.03 *Paragraphs (6) and (7).* These paragraphs are adapted from Rule 27(2) and (3) of the Common Regulations under the Madrid Agreement and Protocol. At present, where there is a partial change in ownership of an international deposit, the resulting deposits continue to have the same number, with a note in the Register and in the file concerning the partial transfer.

*Note on Rule 20*

20.01 *Paragraph (3)*. The time limit for notifying a refusal of the effect of a correction is to be counted from the date on which the Gazette in which the correction is published is sent by the International Bureau to the Offices of the designated Contracting Parties.

*Notes on Rule 22*

22.01 *Item (iii) of paragraph (1)(a)*. In line with the practice under the Madrid Agreement and Protocol, the unofficial notice of expiry will invite the holder to renew the international registration in respect of those designated Contracting Parties for which no total refusal or invalidation is recorded (but see Note 22.02).

22.02 *Paragraph (2)(b)*. Although the unofficial notice of expiry will refer only to the designated Contracting Parties for which no total refusal or invalidation is recorded, provision is made for the international registration to be renewed, on the specific request of the holder, even though a total refusal or invalidation has been recorded with respect to the Contracting Party concerned. It is for that Contracting Party to determine what (if any) is the effect of such renewal. This provision is based on Rule 30(2)(b) of the Common Regulations under the Madrid Agreement and Protocol.

*Notes on Rule 24*

24.01 *Paragraph (2)*. Publication in accordance with this paragraph would comprise

(i) any declaration made under Article 4(1)(b) or Article 4(3)(b) or notification made under Rule 11(2) (filing of international application through an Office);

(ii) any declaration made under Article 5(4)(b) (unity of invention or design);

(iii) any declaration made under Article 9(1)(a) or (b) (deferment of publication);

(iv) any declaration made under Article 13(2) (individual designation fee);

(v) any declaration made under Article 17(1) (additional conditions);

(vi) any declarations made under Article 20(1) (time period for notification of refusal of effect);

(vii) any notification made under Rule 9(1), (2) or (4) (special requirements concerning reproductions of designs).

24.02 *Paragraph (3)*. The number of free copies of the Gazette to which an Office is entitled could be fixed in a later draft, or it could be made dependent on the number of designations made of the Contracting Party concerned (as is the case under Rule 32(4)(a) of the Common Regulations under the Madrid Agreement and Protocol). Alternatively, this question could be dealt with in the Administrative Instructions.

*Note on Rule 25*

25.01 *Paragraph (4)(a)*. It is to be noted in particular that, where an applicant takes advantage of the facility referred to in paragraph (1)(b) of paying through the Office with which the international application is filed, the fees are nevertheless not considered to have been paid until they have been received by the International Bureau.

*Note on Rule 27*

27.01 This follows Rule 38 of the Common Regulations under the Madrid Agreement and Protocol, which however relates only to individual fees. At present, State fees paid under the Hague Agreement are distributed annually (Rule 28.7).

[End of document]