

Working Group on the Legal Development of the Hague System for the International Registration of Industrial Designs

Tenth Session
Geneva, December 13 to 15, 2021

PROPOSAL FOR AMENDMENTS TO RULES 21 AND 26 OF THE COMMON REGULATIONS

Document prepared by the International Bureau

I. BACKGROUND

1. Where a representative is appointed at the time of filing or during the pendency of the international application, such appointment is recorded in the International Register and published in the *International Designs Bulletin* (hereinafter referred to as the “Bulletin”) as part of the international registration, pursuant to Rules 15(2)(i), 17(2)(i) and 26(1)(i) of the Common Regulations Under the 1999 Act and the 1960 Act of the Hague Agreement (hereinafter referred to as the “Common Regulations”).
2. The appointment of a representative may also be made at any time subsequent to the international registration, through a separate communication (Rule 3(2)(b)). Such appointment is recorded in the International Register, and notified to both the holder and the representative pursuant to Rule 3(3)(b).
3. Where the appointment of a representative is cancelled (Rule 3(5)(a)), the International Bureau notifies both the holder¹ and the representative pursuant to Rule 3(5)(c). Moreover, as a matter of practice, where the recording of a change in the name or address of the representative is requested by the representative, the International Bureau records the change in the International Register and notifies it to the representative.

¹ The International Bureau notifies the applicant, if the appointment is cancelled during the pendency of the international application.

4. Information concerning representatives, including subsequent updates (*i.e.*, changes and cancellations), are displayed in the Hague Express and the Global Design Databases. This allows third parties to contact the representative rather than the holder concerning a specific international registration (*e.g.* for possible licensing or court action).

5. However, if the representative is appointed subsequent to the international registration, such appointment is not published in the Bulletin. Likewise, the cancellation of an appointment or the change in the name or address of the representative is not published in the Bulletin, if it takes place after the international registration².

II. REPRESENTATIVE INFORMATION FOR OFFICES

ROLE OF THE BULLETIN

6. The Bulletin is currently published on the WIPO website on a weekly basis. Article 10(3)(a) of the 1999 Act provides that *“The international registration shall be published by the International Bureau. Such publication shall be deemed in all Contracting Parties to be sufficient publicity, and no other publicity may be required of the holder”*. Article 6(3)(a) of the 1960 Act provides that *“For each international deposit, the International Bureau shall publish in a periodical bulletin: [...]”*.

7. Rule 26(3) of the Common Regulations further provides that *“The Bulletin shall be published on the web site of the Organization. The publication of each issue of the Bulletin shall be deemed to replace the sending of the Bulletin referred to in Article 10(3)(b) and 16(4) of the 1999 Act and Article 6(3)(b) of the 1960 Act, and, for the purposes of Article 8(2) of the 1960 Act, each issue of the Bulletin shall be deemed to have been received by each Office concerned on the date of its publication on the web site of the Organization”*.

8. Thus, the Bulletin fulfills two legal and practical functions under the Hague System for the International Registration of Industrial Designs: firstly, it is the official and centralized *publication* of international registrations and other relevant recordings, and secondly, it is the official *notification* of such data to the Offices of designated Contracting Parties. In support of the latter function, the Bulletin data are also made available in XML format to Offices for use in their IT systems.

PUBLICATION OF REPRESENTATIVE INFORMATION FOR POSSIBLE USE BY OFFICES

9. As mentioned in Chapter I, however, despite its official nature as the sole authentic publication and notification tool, the Bulletin does not include any information concerning representatives, except when their appointment is published as part of the concerned international registration.

² If the cancellation of an appointment, the change of a representative, or the change in the name or address of the representative takes place before the international registration, the International Bureau publishes in the Bulletin the latest data of the representative at the time of the international registration, as part of the international registration.

10. There could, however, be situations where the Office of a designated Contracting Party, in the absence of a local representative or local address for service, may need to contact the holder of an international registration. Examples of such situations are where the Office needs to notify the holder of the due date of the payment of the second part of the individual designation fee with the relevant information for such payment (Rule 12(3))³ or where invalidation actions are initiated by a third party (Rule 20(1))⁴. In those circumstances, it would be helpful for both the holder and the Office concerned if the latter was in the possession of the latest information regarding the appointed representative.

11. While Rule 3 provides for representation *before the International Bureau*, and the requirements regarding the appointment of a representative before the Office of a Contracting Party are outside the scope of the Hague System, some Offices may, in such instances, still wish to contact the representative duly appointed before the International Bureau rather than the holder. Thus, given its official nature as the sole authentic publication and notification tool, it would be useful to publish up-to-date information concerning the representative in the Bulletin.

III. PROPOSAL

12. It is proposed to amend the Common Regulations so as to provide for the publication in the Bulletin also of the appointment of a representative that is recorded in the International Register after the international registration as well as of any update concerning the representative. Accordingly, the Office of a designated Contracting Party would be notified, through publication, of up-to-date information concerning any representative; such information would also be available in XML format for data transmission.

AMENDMENTS TO RULE 21

Change in the Name or Address of the Representative

13. As mentioned in paragraph 3, where a change in the name or address of the representative is requested by the representative, the International Bureau records such change in the International Register, as a matter of practice. To formalize this practice and enable publication of such information in the current legal framework, it is proposed to introduce a new item (v) in subparagraph (1)(a) of Rule 21, as reproduced in the Annex, so as to include a change in the name or address of the representative in the recordings that may be requested under this rule.

14. The proposed manner of introducing this new item in the Common Regulations would be in line with the corresponding item in the Regulations under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (hereinafter referred to as the "Madrid Regulations"), namely Rule 25(1)(a)(vi).

³ In principle, this due date is communicated to the holder through the International Bureau, since the second part of the individual designation fee may also be paid through the International Bureau. Nevertheless, the United States Patent and Trademark Office (USPTO) currently notifies both the International Bureau and the holder.

⁴ The invalidation refers to any decision by a competent authority (whether administrative or judicial) of a designated Contracting Party revoking or canceling the effects of an international registration in the territory of that Contracting Party. In this regard, Article 15(1) of the 1999 Act stipulates that invalidation of the effects, in part or in whole, of the international registration may not be pronounced without the holder having, in good time, been afforded the opportunity of defending his/her rights. Thus, the initiation of an invalidation action would need to be communicated directly to the holder by the Office, since the Office should notify the International Bureau of the invalidation only when the invalidation takes place and is no longer subject to appeal (Rule 20(1)).

15. A minor consequential amendment is also proposed to subparagraph (2)(ii) so as to clarify that a request for this type of recording by its nature should contain the name of the representative (as recorded in the International Register), for verification purposes, instead of the name of the holder.

16. These proposals would not bring any change to the current practice. The recording of a change in the name or address of the representative may be requested free of charge. The current form DM/8 remains available for this purpose.

Appointment Made at the Time of a Change in Ownership

17. A representative may be appointed by a new owner at the time of requesting the recording of a change in ownership. Such appointment is made by submitting the separate communication referred to in Rule 3(2)(b) together with the request for the recording of a change in ownership. If the appointment complies with Rule 3(2)(b) and (c), the effective date of the appointment shall be the date of the recording of the change in ownership.

18. In such case, it would be preferable to publish the representative of the new holder as part of the recorded change in ownership, which would be consistent with a representative appointed at the time of filing or during the pendency of the international application being currently published as part of the international registration pursuant to Rule 26(1)(i), and also with the manner in which a representative of the new holder is published in the *WIPO Gazette of International Marks*.

19. It is thus proposed to introduce a new subparagraph (2)(b) in Rule 21, as reproduced in the Annex, so as to clarify the effective date of the appointment and the manner to publish the appointment where a representative of the new holder is appointed at the time of recording the change in ownership in the International Register.

AMENDMENTS TO RULE 26

20. Rule 26(1) provides for the information concerning international registration to be published in the Bulletin. Subparagraph (iv) covers changes recorded under Rule 21, the current wording of which indicates each type of change referred to in Rule 21(1)(a)(i) to (iv).

21. For the purpose of simplification and to cover a change in the name or address of the representative under proposed Rule 21(1)(a)(v), it is proposed to amend Rule 26(1)(iv) to read "changes recorded under Rule 21", as reproduced in the Annex. A similar simplified wording is used for the corresponding item in the Madrid Regulations, namely Rule 32(1)(a)(vii).

22. Furthermore, it is proposed to introduce a new item (ivbis) in Rule 26(1), as reproduced in the Annex, so as to ensure that the appointment of a representative recorded after the international registration under Rule 3(3)(a) and the cancellation of the recording of a representative under Rule 3(5)(a) would be published in the Bulletin. This new item would furthermore exclude the potential overlap of scenarios covered by items (i) and (iv), and thereby achieve the same effect as that of the corresponding item in the Madrid Regulations, namely Rule 32(1)(a)(xiii).

Ex Officio Cancellation

23. Rule 3(1)(b) prescribes that “*Only one representative may be appointed in respect of a given international application or international registration*”. Thus, if a new representative is appointed by the current holder, or by the new holder in the case of a change in ownership, the recording of the previous representative will be cancelled *ex officio* pursuant to Rule 3(5)(a). Furthermore, where a change in ownership is recorded and no representative is appointed by the new holder, the recording of the representative of the previous holder will be cancelled *ex officio* pursuant to Rule 3(5)(a).

24. In the aforementioned instance of the appointment of a new representative by the current holder, the publication of that appointment would indicate that the recording of any previous representative was cancelled *ex officio* pursuant to Rule 3(5)(a). Similarly, in the aforementioned two instances of a change in ownership, the *ex officio* cancellation of the previous appointment under Rule 3(5)(a) would be inferred, depending on the case, from the presence of representative details, or the absence of any representative details, in the publication of the change in ownership concerned. Thus, the term “*cancellations thereof other than ex officio cancellations under Rule 3(5)(a)*” in the proposed new subparagraph (*ivbis*) aims to exclude the publication of these particular types of cancellations.

25. The following illustrates how Rule 26(1) would thus provide for the publication in the Bulletin of the appointment of a representative and of any update concerning the representative:

- where a representative is appointed at the time of filing or during the pendency of the international application, such appointment continues to be published as part of the international registration under the existing Rules 3(3)(a), 15(2)(i), 17(2)(i) and 26(1)(i)⁵;
- where a new representative is appointed at the time of requesting the recording of change in ownership, such appointment would be published as part of the recorded change in ownership under the existing Rule 3(3)(a) and the proposed Rules 21(2)(b) and 26(1)(iv);
- where a representative is appointed subsequent to the international registration, such appointment would be published under the existing Rule 3(3)(a) and the proposed Rule 26(1)(*ivbis*), except where such appointment would be published as part of a recorded change in ownership under the proposed Rule 26(1)(iv);
- where the recording of the appointment of a representative is cancelled subsequent to the international registration, such cancellation would be published under the existing Rule 3(5)(a) and the proposed Rule 26(1)(*ivbis*), except where such cancellation would be inferred from the contents of the published change in ownership (refer to paragraph 24);
- where a change in the name or address of any appointed representative is recorded subsequent to the international registration, such change would be published under the existing Rule 21(6) and the proposed Rules 21(1)(a)(v) and 26(1)(iv).

⁵ For cancellation of appointment, change of representative, or change in the name or address of the representative that takes place before the international registration, see footnote 1.

26. Finally, the opportunity is seized to add a reference to Article 17(5) of the 1999 Act in Rule 26(3), in order to clarify that the publication of each issue of the Bulletin is deemed to replace the sending of the Bulletin referred to in the former provision to notify recordings of renewal to the Office of each of the Contracting Parties concerned. This would not bring any change to the current system, as renewals recorded are published in the Bulletin pursuant to Rule 26(1)(vi).

DATE OF ENTRY INTO FORCE AND NOTE ON EFFECTIVE DATE

27. It is suggested that the proposed amendments to Rules 21 and 26 enter into force on April 1, 2023. Accordingly, the amendments would apply to the appointments, cancellations and changes in the name or address of a representative recorded on and after the date of their entry into force.

28. The effective date of such appointments or cancellations thereof, or of the recording of changes in the name or address of a representative shall be the date of receipt by the International Bureau of the corresponding request complying with the applicable requirements, pursuant to Rules 3(3)(a) and (5)(b) and 21(6)(b) as well as proposed Rule 21(2)(b).

29. *The Working Group is invited to:*

(i) consider and comment on the proposals made in this document; and

(ii) indicate whether it would recommend to the Assembly of the Hague Union for adoption, the proposed amendments to the Common Regulations with respect to Rules 21 and 26, as provided in the draft contained in the Annex to this document, with a date of entry into force of April 1, 2023.

[Annex follows]

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

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

[...]

**CHAPTER 4
CHANGES AND CORRECTIONS**

Rule 21

Recording of a Change

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

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

[...]

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

- (i) the number of the international registration concerned,
- (ii) the name of the holder, ~~unless~~ [or the name of the representative where](#) the change relates to the name or address of the representative,
- (iii) in case of a change in the ownership of the international registration, the name and address, given in accordance with the Administrative Instructions, and email address of the new owner of the international registration,
- (iv) in case of a change in the ownership of the international registration, the Contracting Party or Parties in respect of which the new owner fulfills the conditions to be the holder of an international registration,
- (v) in case of a change in the ownership of the international registration that does not relate to all the industrial designs and to all the Contracting Parties, the numbers of the industrial designs and the designated Contracting Parties to which the change in ownership relates, and
- (vi) the amount of the fees being paid and the method of payment, or instruction to debit the required amount of fees to an account opened with the International Bureau, and the identification of the party effecting the payment or giving the instructions.

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

[...]

CHAPTER 6 PUBLICATION

Rule 26

Publication

(1) [*Information Concerning International Registrations*] The International Bureau shall publish in the Bulletin relevant data concerning

(i) international registrations, in accordance with Rule 17;
(ii) refusals, with an indication as to whether there is a possibility of review or appeal, but without the grounds for refusal, and other communications recorded under Rules 18(5) and 18*bis*(3);

(iii) invalidations recorded under Rule 20(2);

(iv) changes ~~in ownership and mergers, changes of name or address of the holder, renunciations and limitations~~ recorded under Rule 21;

(ivbis) appointments of representatives recorded under Rule 3(3)(a), unless published under items (i) or (iv), and cancellations thereof other than *ex officio* cancellations under Rule 3(5)(a);

(v) corrections effected under Rule 22;

(vi) renewals recorded under Rule 25(1);

(vii) international registrations which have not been renewed;

(viii) cancellations recorded under Rule 12(3)(d);

(ix) declarations that a change in ownership has no effect and withdrawals of such declarations recorded under Rule 21*bis*.

[...]

(3) [*Mode of Publishing the Bulletin*] The Bulletin shall be published on the web site of the Organization. The publication of each issue of the Bulletin shall be deemed to replace the sending of the Bulletin referred to in Article 10(3)(b), ~~and~~ 16(4) and 17(5) of the 1999 Act and Article 6(3)(b) of the 1960 Act, and, for the purposes of Article 8(2) of the 1960 Act, each issue of the Bulletin shall be deemed to have been received by each Office concerned on the date of its publication on the web site of the Organization.

[...]

[End of Annex and of document]