

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

Twelfth Session
Geneva, December 4 to 6, 2023

FREEZE OF THE APPLICATION OF THE 1960 ACT

Document prepared by the International Bureau

SUMMARY

1. As requested by the Working Group on the Legal Development of the Hague System for the International Registration of Industrial Designs (hereinafter referred to as the “Working Group”), at its eleventh session, held from December 12 to 14, 2022, this document proposes a way forward regarding the freeze of the application of the Hague Act (1960), adopted on November 28, 1960, of the Hague Agreement Concerning the International Deposit of Industrial Designs (hereinafter referred to as the “1960 Act”).

BACKGROUND

2. It is recalled that, in order to reduce the complexity of the Hague System, the Contracting Parties to the London Act (1934) of the Hague Agreement Concerning the International Deposit of Industrial Designs (hereinafter referred to as the “1934 Act”) decided in an extraordinary meeting on September 24, 2009, to freeze the application of the 1934 Act, with effect from January 1, 2010¹. In this context, the Contracting Parties agreed on the need to center

¹ During the Forty-seventh Series of the Assemblies of the Member States of WIPO in 2009, an extraordinary meeting was convened for this purpose, because the Hague Union did not comprise all member States of the 1934 Act. The Contracting Parties to the 1934 Act decided to freeze the application of this Act with effect from January 1, 2010 (see document H/EXTR/09/2 “Report”). The freeze decision was immediately reported to the Hague Union Assembly at its twenty-eighth (17th ordinary) session that took place during the same series of the Assemblies (see document H/A/28/4 “Report”). During that session, the Hague Union Assembly took note of the unanimous decision of the Contracting Parties to the 1934 Act to freeze the application of the 1934 Act, and adopted consequential amendments to the Common Regulations under the 1999 Act, the 1960 Act and the 1934 Act of the Hague Agreement, removing all references to the 1934 Act and introducing transitional provisions applicable to designations under that Act recorded before the effective date of its freeze.

the Hague System around the Geneva Act (1999), of the Hague Agreement Concerning the International Registration of Industrial Designs, adopted on July 2, 1999 (hereinafter referred to as the “1999 Act”)².

3. Since January 1, 2010, the Hague Agreement has been operating based on two distinct Acts, namely the 1960 Act and the 1999 Act³.

4. For consideration by the Working Group at its first session in 2011, the International Bureau prepared a document summarizing the situation of the 1934 Act and the 1960 Act (document H/LD/WG/1/4). The document informed the Working Group of the observed decrease of the registration activities under the 1960 Act since the coming into force of the 1999 Act. The International Bureau provided a first update on the situation of the 1960 Act for consideration by the Working Group at its eighth session in 2019 (document H/LD/WG/8/3). The document highlighted the continuing decrease in use of the 1960 Act and the legal and procedural complexity that arose from the coexistence of the two Acts for users of the Hague System as well as Offices of Contracting Parties.

5. The Working Group, at its eleventh session, discussed a document providing a further update on the latest situation of the 1960 Act (document H/LD/WG/11/3). The document highlighted that following the accessions of Morocco and Suriname to the 1999 Act⁴, no Hague Union member fell outside the remit of the 1999 Act. In addition, the document also outlined the continued sharp decline of the registration activities under the 1960 Act⁵. Consequently, the Working Group requested that the International Bureau prepare, for discussion at its next session, a document on the possible freeze of the application of the 1960 Act⁶.

PROCEDURE FOR THE FREEZE OR SUSPENSION OF THE APPLICATION OF A TREATY

VIENNA CONVENTION

6. The Vienna Convention on the Law of Treaties (hereinafter referred to as the “Vienna Convention”) sets out the law and procedure for the suspension of the operation of treaties. According to Article 42(2) of the Vienna Convention, the termination, denunciation or suspension of the operation of a treaty may take place only as a result of the application of the provisions of the concerned treaty or of the Vienna Convention. Article 57 of the Vienna Convention further provides that “the operation of a treaty in regard to all the parties or to a particular party may be suspended: (a) in conformity with the provisions of the treaty; or (b) at any time by consent of all the parties after consultation with the other Contracting States”.

² See documents H/EXTR/09/1 and 2, and H/A/28/3 and 4 (paragraphs 7 to 11). Furthermore, the termination of the 1934 Act became effective on October 18, 2016 (see Information Notice No 10/2016, available at: https://www.wipo.int/edocs/hagdocs/en/2016/hague_2016_10.pdf).

³ It is added that, since that date, it was no longer possible to file international applications under the 1934 Act, or to make any designation governed by that Act in an international application. However, the prolongation (renewal) of designations made under the 1934 Act before that date, and the recording of any changes affecting such designations, remain possible in the International Register up to the maximum duration of protection under the 1934 Act, which is 15 years. Consequently, according to the International Register, the last designations governed by the 1934 Act will expire on December 30, 2024.

⁴ The 1999 Act entered into force in Morocco and Suriname on July 22, 2022, and September 10, 2020, respectively.

⁵ The registration activities under the 1960 Act declined further in 2023. Of the 18,983 designations in international registrations recorded in the first half of 2023, only 61 were made under the 1960 Act, representing only 0.32 per cent of the total.

⁶ See document H/LD/WG/11/5 “Summary by the Chair”, paragraph 14.

RELEVANT PRECEDENTS IN WIPO

7. The application of certain WIPO treaties or provisions contained therein has been suspended or frozen in the past. For example, the Assembly of the Trademark Registration Treaty (TRT) Union adopted the decision to freeze the application of the whole treaty, with effect from October 2, 1991⁷. The Assembly of the Treaty on the International Registration of Audiovisual Works (Film Register Treaty) Union decided in an extraordinary session in 1993 to suspend the application of the whole treaty, with effect from May 13, 1993⁸. Moreover, as mentioned above, the Contracting Parties to the 1934 Act decided to freeze the application of the whole treaty in 2009, with effect from January 1, 2010⁹. Lastly, the Madrid Union Assembly decided at its fiftieth (29th extraordinary) session held in 2016 to freeze the application of Article 14(1) and (2)(a) of the Madrid Agreement Concerning the International Registration of Marks, with effect from October 11, 2016¹⁰.

8. Except for one case¹¹, it was the competent Assembly that took the decision to freeze or suspend the application of the whole treaty or some of its provisions. Although the terminology used was different – in one case, it was a decision to “suspend” the application of the treaty; in the others, to “freeze” its application – the legal consequences were the same.

PROPOSAL

FREEZE OF THE APPLICATION OF THE 1960 ACT

9. Like other WIPO treaties, the 1960 Act remains in force without limitation in time. Any Contracting Party may denounce the 1960 Act in accordance with Article 28(1) of that Act, which would take effect one year after the receipt of such notification by the Director General of WIPO. However, such denunciation is a unilateral act by each Contracting Party whereby it terminates its participation in the treaty.

10. As noted by the Working Group at its previous session, and following the aforementioned precedents, the freeze or suspension of the application of the 1960 Act appears to be the most suitable step towards a streamlined modern international design registration system that is governed by a single treaty (the 1999 Act). In this regard, this document proposes the use of the term “freeze”, as it has been the most commonly used term in the relevant precedents in WIPO¹².

11. The 1960 Act has no provision that provides for the freeze of its application. In the absence of such a provision, the application of the 1960 Act may be frozen by consent of all the parties, in accordance with Article 57(b) of the Vienna Convention. Since all Contracting Parties to the 1960 Act are members of the Hague Union Assembly, the decision to freeze the application of the 1960 Act could be taken by the Hague Union Assembly¹³.

⁷ See, respectively, documents TRT/A/VII/1 “Situation of the TRT Union – Memorandum to the Director General” and TRT/A/VII/2 “Report”.

⁸ See document FRT/A/III/3 “Report”.

⁹ See paragraph 2.

¹⁰ See document MM/A/50/5, paragraph 17. For further information, see the Madrid Information Notice No. 34/2016, available at: https://www.wipo.int/edocs/madrdocs/en/2016/madrid_2016_34.pdf.

¹¹ See footnote 1, above, regarding the need to convene an extraordinary meeting for the decision to freeze the application of the 1934 Act, instead of referring it to the Hague Union Assembly for decision.

¹² See paragraphs 7 and 8.

¹³ See Article 2 of the Complementary Act of Stockholm (1967).

EFFECT OF THE FREEZE

12. The main effect of the freeze of the application of the 1960 Act would be that no new designation under the 1960 Act may be recorded in the International Register. Such a freeze would, however, be without prejudice to the continuation of active international registrations and designations recorded in the International Register before the effective date of the freeze¹⁴. The freeze of the application of the 1960 Act would also prevent new countries from ratifying or acceding to the 1960 Act¹⁵. However, the Contracting Parties to the 1960 Act would continue to be members of the Hague Union¹⁶.

13. The freeze of the application of the 1960 Act would require a number of amendments to the Common Regulations that would come into effect at the same time as the date of effect of the freeze of the application of the 1960 Act. A document outlining the proposed amendments has been prepared for consideration by the Working Group (document H/LD/WG/12/4).

PROPOSED DATE OF EFFECT

14. It is recalled that the last designations governed by the 1934 Act will expire on December 30, 2024¹⁷. Accordingly, several legal and information resources will require revision, in addition to some technical adjustments in the internal operating system. This opportunity could be seized to simultaneously implement the necessary amendments resulting from the freeze of the application of the 1960 Act, and thus further streamlining both the legal framework and the management of the Hague System.

15. *The Working Group is invited to:*

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

(ii) recommend to the Hague Union Assembly to freeze the application of the 1960 Act, with a date of effect of January 1, 2025.

[Annex follows]

¹⁴ More precisely, the renewal of those designations made under the 1960 Act and any recordings affecting such designations in the International Register provided for under the Common Regulations remain possible throughout the life of an international registration up to the maximum duration of protection provided for by the national law of the designated Contracting Party (Article 11(2) of the 1960 Act).

¹⁵ The freeze of the application of the whole treaty would also freeze the application of Article 26(2) of the 1960 Act which governs the deposit of instruments of ratification and accession.

¹⁶ Moreover, the freeze could even be reversed by a subsequent decision by the Assembly.

¹⁷ See footnote 3, above.

CONTRACTING STATES OF THE 1960 ACT¹

Bound by the 1999 and 1960 Acts

Albania, Belgium, Belize, Bulgaria, Croatia, Democratic People's Republic of Korea, France, Georgia, Germany, Hungary, Kyrgyzstan, Liechtenstein, Luxembourg, Monaco, Mongolia, Montenegro, Morocco, Netherlands, North Macedonia, Republic of Moldova, Romania, Serbia, Slovenia, Suriname, Switzerland and Ukraine (26)

Bound by the 1960 Act only

Benin², Côte d'Ivoire³, Gabon⁴, Greece⁵, Italy⁶, Mali⁷, Niger⁸ and Senegal⁹ (8)

[End of Annex and of document]

¹ List of Contracting States on September 1, 2023.

² Member State of OAPI.

³ Member State of OAPI.

⁴ Member State of OAPI.

⁵ Member State of the European Union.

⁶ Member State of the European Union.

⁷ Member State of OAPI.

⁸ Member State of OAPI.

⁹ Member State of OAPI.