

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

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PROPOSAL FOR AMENDMENTS TO THE ADMINISTRATIVE INSTRUCTIONS

Document prepared by the International Bureau

INTRODUCTION

1. Pursuant to Rule 34(1) of the Common Regulations Under the 1999 Act and the 1960 Act of the Hague Agreement (hereinafter referred to as the “Common Regulations”), the Director General of the World Intellectual Property Organization (WIPO) may modify the Administrative Instructions for the Application of the Hague Agreement (hereinafter referred to as the “Administrative Instructions”) after having consulted the Offices of Contracting Parties.
2. This document has been prepared with a view to engaging in the above-mentioned consultation on a proposed amendment to Section 403 of the Administrative Instructions, thus inviting the Working Group to comment on the proposal.

PROPOSAL

3. Rule 9(2)(b) of the Common Regulations provides that matter which is shown in a reproduction but for which protection is not sought may be indicated as provided for in the Administrative Instructions. Section 403(a) of the Administrative Instructions, which implements Rule 9(2)(b) of the Common Regulations, provides that such disclaimers could be indicated at the applicant’s option, either in the description (i.e., by text) or in a reproduction (by means of dotted or broken lines or coloring). Section 403(b) of the Administrative Instructions provides for the indication of matter that does not form part of the industrial design or the product in relation to which the industrial design is to be used (i.e., environmental matter) with the same means.

4. Accordingly, applicants have the option to indicate a disclaimer (Section 403(a)) or matter that does not form part of the design or product (Section 403(b)) either in the description or in the reproduction (“graphical disclaimer”). The International Bureau as well as several Offices of designated Contracting Parties have noted that it is often not clear whether an indication used in a reproduction represents a graphical disclaimer when it is not explained in a description. This ambiguity often leads to notifications of refusal by Offices of designated Contracting Parties. In order to improve the clarity of graphical disclaimers and thus avoid those office actions, it would be beneficial for applicants and Offices if any graphical disclaimer used in the reproduction be accompanied by a statement in the description supporting such a disclaimer. In this context, it is added that all Offices that contributed to the [“Guidance on Preparing and Providing Reproductions in Order to Forestall Possible Refusals on the Ground of Insufficient Disclosure of an Industrial Design by Examining Offices”](#) indicated that they recommend that a supporting statement be included in the description if a graphical disclaimer is used*.

5. Given the above considerations, it is proposed that Section 403(a)(ii) of the Administrative Instructions be amended to require that a graphical disclaimer be accompanied by a supporting statement in the description. The result would be that in cases where a reproduction contains dotted or broken lines or coloring, and the description contains an explanation that those indications are graphical disclaimers, the Offices of the designated Contracting Parties would be required to consider that indication in the reproduction as a graphical disclaimer. The Office of a designated Contracting Party could still, however, issue a refusal from a substantive point of view, for example, when it is of the opinion that the disclaimer does not clearly indicate the claimed or disclaimed part.

6. At the level of the formality examination by the International Bureau, in cases where a reproduction contains dotted or broken lines or coloring without any supporting statement in the description, two situations may arise. Where the International Bureau believes that the indication is not a disclaimer, it would simply proceed to the recording of the international registration as is. Where, on the contrary, the International Bureau believes that the indication appears to be a disclaimer, it would, in accordance with its practice established for addressing minor issues, inform the applicant accordingly and provide an opportunity to submit a supporting statement in the description, failing which, after the expiry of the provided time limit, the International Bureau would again simply proceed to the recording of the international registration as is. In either situation, the Office of a designated Contracting Party that is of the opinion that it is not clear whether the indication in the reproduction is a graphical disclaimer or forms part of the claimed design, would be in a position to issue a refusal, once again from a substantive point of view.

7. Furthermore, it is noted that the proposed amendment would not affect Section 403(a)(i) of the Administrative Instructions according to which applicants have the option to indicate a disclaimer or matter that does not form part of the design or product in the description only.

8. It is expected that the proposed amendment would decrease the number of refusals issued by designated Offices for lack of clarity or insufficient disclosure.

PROPOSED DATE OF ENTRY INTO FORCE

9. In accordance with Rule 34(3)(a) of the Common Regulations, any amendments to the Administrative Instructions are to be published on the website of the Organization. Publication is made through an Information Notice issued by the International Bureau. Furthermore, pursuant to Rule 34(3)(b), each publication shall specify the date on which the published provisions become effective.

* See Guidance No. 1(c)(i) and (ii), page 17, available at:
https://www.wipo.int/export/sites/www/hague/en/docs/guidance_reproductions.pdf.

10. Should the Working Group agree to the current proposal to amend Section 403 of the Administrative Instructions, it may further recommend the date of entry into force. It is proposed that the said amendment enters into force on January 1, 2025.

11. The Working Group is invited to comment on the proposed amendment to Section 403 of the Administrative Instructions, as set out in the Annex to this document.

[Annex follows]

**Administrative Instructions
for the Application of the Hague Agreement**

(as in force on [XXX])

[...]

**Part Four
Requirements Concerning Reproductions and Other Elements
of the International Application**

*Section 403: Disclaimers and Matter That Does Not Form
Part of the Industrial Design or the Product in Relation to Which the
Industrial Design Is to Be Used*

(a) Matter which is shown in a reproduction but for which protection is not sought may be indicated

(i) in the description referred to in Rule 7(5)(a) ~~and/or~~

(ii) by means of dotted or broken lines or coloring, accompanied by a supporting statement in the description referred to in Rule 7(5)(a).

(b) Notwithstanding Section 402(a), matter that does not form part of the industrial design or the product in relation to which the industrial design is to be used may be shown in a reproduction if it is indicated in accordance with paragraph (a).

[...]

[End of Annex and of document]