

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

**Second Session
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PROPOSAL FOR THE ESTABLISHMENT OF MODEL INTERNATIONAL FORMS UNDER THE GENEVA (1999) ACT OF THE HAGUE AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF INDUSTRIAL DESIGNS

Document prepared by the International Bureau

I. INTRODUCTION

1. The possible establishment of Model International Forms for “Certificate of Transfer” and “Transfer Document” was first mentioned during the Diplomatic Conference for the Adoption of a New Act of the Hague Agreement (hereinafter referred to as “the Diplomatic Conference”)¹. The purpose of such forms was to alleviate the burden for holders of international registrations to submit documentation in respect of a transfer by contract of an international registration to the Office of a Contracting Party having made a declaration under Article 16(2) of the Geneva (1999) Act of the Hague Agreement Concerning the International Registration of Industrial Designs (hereinafter referred to as “the 1999 Act” and as “the Hague Agreement” respectively). Pursuant to Article 16(2), a recording of a change in ownership in the International Register shall not have effect in a Contracting Party having made a declaration under that Article, until the Office of that Contracting Party has received the statements or documents specified in that declaration².

¹ See Records of the Diplomatic Conference, paragraphs 811-812, p. 482.

² At the time of preparing the present document, only two Contracting Parties to the 1999 Act, namely, the African Intellectual Property Organization (OAPI) and Denmark, had made a declaration under Article 16(2). The declaration made by OAPI specifies that a copy of a legally valid document which constitutes the change in ownership shall be submitted to its Office. The declaration by Denmark specifies that a document establishing the change in ownership or other documentation showing to the satisfaction of the Office that a change in ownership has taken place shall be submitted.

2. It is recalled that the statements or documents required under Article 16(2) shall be presented directly by the holder of the international registration to the Office of the Contracting Party concerned. In view of the interests, and for the convenience, of both the Office and the holder, there is a need for the contents and form of the required statements or documents to be standardized through the use of forms acceptable to the Office of the Contracting Party concerned. In this context, it should be emphasized that the establishment of the model forms is in the interest, not only of the Offices of the Contracting Parties having made a declaration under Article 16(2), but also of the holders in general, regardless of which Contracting Party they originate from.

3. The *ad hoc* Working Group on the Legal Development of the Hague System for the International Registration of Industrial Designs, which met from May 30 to June 1, 2011, discussed a first draft of possible forms for “Certificate of Transfer” and “Transfer Document”, as prepared and circulated by the Secretariat in the course of the meeting (see documents H/LD/WG/1/3, entitled “Issues Relating to the Effects of the Recording of a Change in Ownership in the International Register”, paragraphs 1 to 6, and 22 to 31, and H/LD/WG/1/6 Prov., entitled “Draft Report”, paragraphs 82 to 93, available on the World Intellectual Property Organization (WIPO) web site at: http://www.wipo.int/meetings/en/topic.jsp?group_id=144).

4. The forms as circulated during the course of the meeting were drafted along the lines of the “Certificate of Transfer” form under the Patent Law Treaty (hereinafter referred to as “the PLT”) and the Singapore Treaty on the Law of Trademarks (hereinafter referred to as “the Singapore Treaty”) and the “Transfer Document” form under the Singapore Treaty (see Annexes II to IV to document H/LD/WG/1/3, entitled “Issues Relating to the Effects of the Recording of a Change in Ownership in the International Register”).

5. At the end of the discussion, the Chair concluded that the *ad hoc* Working Group wanted the International Bureau of WIPO (hereinafter referred to as “the International Bureau”) to pursue the development of possible model forms and that, in that respect, the International Bureau would be taking into account any comments made by Offices and user groups as well as developments in the Digital Access Service environment (see document H/LD/WG/1/5, entitled “Summary by the Chair”, paragraph 18, available on the WIPO web site at: http://www.wipo.int/meetings/en/topic.jsp?group_id=144).

6. The purpose of the present document is to seek further views from the Working Group on the contents and means of transmission of such forms. Given that the contents of the “Certificate of Transfer” and that of the “Transfer Document” under the Singapore Treaty are almost identical, for the sake of simplicity, the International Bureau has prepared a single draft standard form (see Annex I to the present document).

II. PROPOSAL FOR ESTABLISHMENT OF STANDARD FORM

7. The structure of the draft standard form follows that of the Model International Forms under the Singapore Treaty and the PLT. However, due to certain specific features of the Hague system, such as multiple applications (an international registration may contain up to 100 industrial designs), the make-up of those forms has been slightly amended.

8. The structure of the draft standard form is as follows:

Item 1: *Certification*: The draft standard form only relates to a change in ownership of the international registration(s) by contract. The form does not cover other reasons for change in ownership, such as a court decision, or operation of law, such as an inheritance, bankruptcy, or the merger of two companies.

Item 2: *International Registration(s) Concerned*: The international registration(s) concerned shall be identified by their registration number.

Item 3: *Industrial Design(s) Affected by the Transfer*: Under the Hague system, the change in ownership may be total or partial. In other words, the change in ownership may be recorded for some or all of the designated Contracting Parties in respect of some or all of the industrial designs contained in the international registration. The exact scope of the transfer must be indicated under this item.

Item 4: *Transferor(s)*: The name of the transferor shall be the same as that recorded in the International Register as the holder of the international registration(s) concerned.

Item 5: *Transferee(s)*: The name of the transferee shall be the same as that to be recorded in the International Register as the holder of the international registration(s) concerned.

Item 6: *Signature(s) or seal(s)*: Given that the form relates to change in ownership by contract, signature by both the transferor and the transferee is required.

9. Finally, in order to give the desired effect to the standard form, it is important that the Offices of the Contracting Parties having made the declaration under Article 16(2) and the Offices of any prospective Contracting Parties intending to make that declaration should accept the form established by the International Bureau.

10. The draft standard form is attached to the present document (see Annex I), along with "Instructions on the Completion of the Standard Form" (see Annex II).

11. The Working Group is invited to comment on the feasibility of establishing a standard form for the purpose of Article 16(2) of the 1999 Act and, if considered feasible, on the contents of the proposed form, as reproduced in Annex I to the present document, and on the instructions on the completion of the standard form, as contained in Annex II to the present document.

III. ELECTRONIC DISTRIBUTION OF DOCUMENTS TO THE OFFICES OF DESIGNATED CONTRACTING PARTIES

12. It may be foreseen that in the future communications, on the one hand, between the International Bureau and the applicant/holder and, on the other hand, between the International Bureau and the Office, will mainly take place electronically, through web-based communication services. When developing further electronic tools for use in the administration of the Hague

system, electronic distribution of documents to the Office of a designated Contracting Party may be looked at. Such a service could be used, for example, for the distribution of documents to the Office of a Contracting Party having made a declaration under Article 16(2) of the 1999 Act.

13. Regarding how this service would work, as an *interim* solution, the International Bureau's FTP server (hereinafter referred to as "FTPIRD") could host such documents, which an Office may access and download. In the longer term, the "Hague Office Portal" (hereinafter referred to as the "HOP") could be created and used for such a purpose since Offices using HOP would have full access to the document image database (hereinafter referred to as "IMAPS"). With respect to submission of documents by the holder of an international registration to the International Bureau, as an *interim* solution, those documents could be submitted by electronic means (for example, by fax) or by mail. The documents received would then be stored in IMAPS and made available electronically on FTPIRD or, in the future, on HOP. In the longer term, the Hague Portfolio Manager (hereinafter referred to as the "HPM") would enable such documents to be electronically uploaded by the holder or his representative via the HPM interface. The Working Group is invited to take note of this proposal in its discussions relating to document H/LD/WG/2/3, "Issues Relating to the Legislative Implications of the Introduction of some Information Technology-based Innovations in the Administration of the Hague System".

14. There would be several advantages of introducing a new tool in the Hague system enabling, for example, the electronic distribution of a possible standard form as proposed in paragraph 11 of the present document, to an Office. First of all, pursuant to Article 16(2) of the 1999 Act, the effects of the recording of a change in ownership in the International Register are pending in the Contracting Party having made the declaration under that Article until its Office has received the required documentation concerning the transfer. The new holder of the international registration has to be sure of the receipt of the communication by the Office, otherwise he cannot trust that the change in ownership has been validated in that Contracting Party. If only sending a letter to the Office, the applicant/holder may not receive any acknowledgment of receipt at all.

15. Secondly, although at present only two Contracting Parties have made the declaration under Article 16(2) of the 1999 Act, some prospective Contracting Parties to the treaty are expected to make the said declaration. One of the benefits of a possible electronic distribution is that the holder fills in the standard form only once and makes it available to all the Offices requiring such documentation and for which the scope of transfer is the same.

16. Thirdly, under the Hague system, the holder of the international registration may not have any contact with the Offices of designated Contracting Parties. One major advantage of using the international registration system is that the holder does not need a representative in the designated Contracting Party unless its Office has issued a notification of refusal of protection. Rather than having to appoint a representative in that Contracting Party, or to send a letter to the Office in a language used by that Office, a possibility of electronic distribution offers a much more user-friendly and secure means of sharing information.

17. The Working Group is invited to discuss the possible advantages of electronic distribution of a standard form, as proposed in paragraph 11 of the present document, in its discussions relating to document H/LD/WG/2/3.

[Annexes follow]

STANDARD FORM

CERTIFICATE OF TRANSFER OF INTERNATIONAL REGISTRATION(S) OF INDUSTRIAL DESIGN(S) IN RESPECT OF A DESIGNATED CONTRACTING PARTY(IES) HAVING MADE A DECLARATION UNDER ARTICLE 16(2) OF THE GENEVA (1999) ACT¹

(List of declarations made by Contracting Parties to the Hague Agreement available at <http://www.wipo.int/hague/en/declarations/declarations.html>)

Submitted to the Office of: _____
(name of the State(s) or intergovernmental organization(s))

FOR USE BY THE OFFICE ONLY

1. Certification

The undersigned transferor(s) and transferee(s) hereby certify that the ownership of the international registration(s) identified below has been transferred by contract.

Effective date of the transfer (this information is not mandatory): ___/___/___
DD/MM/YYYY

2. International Registration(s) Concerned

The present certificate concerns the transfer of the following international registration(s):

If the space under item 2 is not sufficient, check this box and provide the information on an additional sheet.

¹ The details of the transfer by contract shall be given only in respect of the Contracting Party(ies) to the Office of which the present certificate is submitted.

Standard Form, page 2

3. Industrial Design(s) Affected by the Transfer

(a) Check this box where all the industrial designs contained in the international registration(s) referred to in item 2 have been affected by the transfer (total transfer)².

(b) Check this box where item 2 mentions only one international registration and where only some of the industrial designs contained in that international registration have been affected by the transfer. Indicate the number(s) of the industrial design(s) that have been transferred (partial transfer)³:

(c) Check this box where item 2 mentions more than one international registration and if, in respect of at least one of the registrations, only some of the industrial designs listed have been affected by the transfer (partial transfer).

(i) Indicate international registration(s) for which the transfer has been total, if any⁴:

(ii) Indicate international registration(s) for which the transfer has been partial and indicate the number(s) of the industrial design(s) that have been transferred⁵

Number of the international registration	Number(s) of industrial design(s) transferred

² This box shall be checked only if the transfer by contract is total in respect of the Contracting Party(ies) to the Office of which the present certificate is submitted (despite the fact that the transfer by contract may be partial in respect of other Contracting Parties).

³ Only those industrial designs which have been transferred in respect of the Contracting Party(ies) to the Office of which the present certificate is submitted shall be indicated.

⁴ Only those international registrations for which the transfer has been total in respect of the Contracting Party(ies) to the Office of which the present certificate is submitted shall be indicated.

⁵ Only those industrial designs which have been transferred in respect of the Contracting Party(ies) to the Office of which the present certificate is submitted shall be indicated.

Standard Form, page 3

If the space under 3(c) is not sufficient, check this box and provide the information on an additional sheet.

4. Transferor(s)⁶

(a) If the transferor(s) is a natural person, the person's:

(i) family or principal name:

(ii) given or secondary name(s):

(b) If the transferor(s) is a legal entity, the entity's full official designation:

(c) Address (including postal code and country):

(d) Telephone number(s) (with country and area code):

(e) Facsimile number(s) (with country and area code):

(f) E-mail address:

⁶ The names to be indicated under (a) and (b) are those which are recorded in the International Register in respect of the international registration(s) to which the present certificate relates.

Standard Form, page 4

Check this box if there is more than one transferor; in that case, list them on an additional sheet and indicate, in respect of each of them, the data referred to in items 4(a) to 4(f).

5. Transferee(s)⁷

(a) If the transferee(s) is a natural person, the person's:

(i) family or principal name:

(ii) given or secondary name(s):

(b) If the transferee(s) is a legal entity, the entity's full official designation:

(c) Address (including postal code and country):

(d) Telephone number(s) (with country and area code):

(e) Facsimile number(s) (with country and area code):

(f) E-mail address:

⁷ The names to be indicated under (a) and (b) are those which are recorded in the International Register in respect of the international registration(s) to which the present certificate relates.

Standard Form, page 5

Check this box if there is more than one transferee; in that case, list them on an additional sheet and indicate, in respect of each of them, the data referred to in items 5(a) to 5(f).

6. Signature(s) or seal(s)

(a) Signature(s) or seal(s) of the transferor(s):

(i) Name(s) of the natural person(s) who signs or whose seal(s) is used:

(ii) Date of signature(s) or of sealing(s):

(iii) Signature(s) or seal(s):

(b) Signature(s) or seal(s) of the transferee(s):

(i) Name(s) of the natural person(s) who signs or whose seal(s) is used:

(ii) Date of signature(s) or of sealing(s):

(iii) Signature(s) or seal(s):

Standard Form, page 6

7. Additional Sheets and Attachments

Check this box if additional sheets and/or attachments are enclosed and indicate the total number of such sheets and/or attachments:

[Annex II follows]

INSTRUCTIONS ON THE COMPLETION OF THE STANDARD FORM

It is recalled that the details of the transfer by contract shall be given ONLY with respect to the Contracting Party(ies) to the Office of which the present document is submitted.

The list of Contracting Parties having made the declaration under Article 16(2) of the Geneva (1999) Act is available on the WIPO web site at:
<http://www.wipo.int/hague/en/declarations/declarations.html>

PRELIMINARY INFORMATION

Indicate the full name of the State(s) or intergovernmental organization(s) to the Office of which the form is being submitted. For example, Denmark or African Intellectual Property Organization (OAPI).

Item 1

Indicate the effective date of transfer in the form dd/mm/yyyy. For example, 26/09/2012.
This information is not mandatory.

Item 2

Indicate the number of the concerned international registration(s), that is the number of the international registration(s) having been transferred with respect to the concerned State(s) or intergovernmental organization(s), in the form: DM/123456 or DM/123456A.

Should the space on the form not be sufficient, an additional sheet should be used.

Item 3

- (a) Check this box if the transfer of the international registration(s) mentioned in item 2 is total, that is if it concerns all the industrial designs contained in the said international registration(s) having been transferred with respect to the concerned State(s) or intergovernmental organization(s).
- (b) Check this box if the transfer concerns one international registration only and if the said transfer was partial, that is, if it was related to some of the industrial designs contained in the international registration.
- (c) Check this box if the following conditions are met: 1) the transfer concerns more than one international registration and; 2) the transfer is partial with respect to at least one international registration. In other words, a transfer concerns several international registrations and the transfer for at least one of them is partial.
 - (i) Indicate the number of the concerned international registration(s), that is the number of the international registration(s) the transfer of which has been total, if any. The international registration number should be indicated in the form: DM/123456 or DM/123456A.

(ii) Indicate the number of the concerned international registration(s), that is the number of the international registration(s), the transfer of which has been partial.

Table:

In column 1: indicate the registration number in the form: DM/123456 or DM/123456A.

In column 2: indicate the number of the industrial design(s) that has/have been transferred in the form: 1, 3, 4, ...

Should the space on the form not be sufficient, an additional sheet should be used.

Item 4

(a)(i) and (ii): It is recalled that the names to be indicated are those recorded in the International Register.

(b) It is recalled that the designation to be indicated is the one recorded in the International Register.

(c) for example, 34, chemin des Colombettes, 1202 Geneva, Switzerland

(d) for example, +41-22-338-9111

(e) for example, +41-22-338-8510

(f) for example, abcde@wipo.int

Should the space on the form not be sufficient, an additional sheet should be used.

Item 5

(a)(i) and (ii): It is recalled that the names to be indicated are those recorded in the International Register.

(b) It is recalled that the designation to be indicated is the one recorded the International Register.

(c) for example, 34, chemin des Colombettes, 1202 Geneva, Switzerland

(d) for example, +41-22-338-9111

(e) for example +41-22-338-8510

(f) for example abcde@wipo.int

Should the space on the form not be sufficient, an additional sheet should be used.

Item 6

- (a) (i) for example, John JOHNSON
- (ii) full date of signature in the form dd/mm/yyyy, for example 26/09/2012
- (iii) handwritten signature or seal
- (b) (i) for example Elizabeth SMITH
- (ii) full date of signature in the form dd/mm/yyyy, for example 26/09/2012
- (iii) handwritten signature or seal

Item 7

Check this box if there are additional sheets and/or attachments and indicate the total number thereof, for example, 2.

[End of Annex II and of document]