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

**Second Session
Geneva, November 5 to 7, 2012**

MISCELLANEOUS AMENDMENTS TO THE COMMON REGULATIONS UNDER THE 1999 ACT AND THE 1960 ACT OF THE HAGUE AGREEMENT

Document prepared by the International Bureau

I. INTRODUCTION

1. In light of recent changes surrounding the publication of information on the Hague System for the International Registration of Industrial Designs (hereinafter referred to as “the Hague system”), notably, the weekly publication cycle of the *International Designs Bulletin* (hereinafter referred to as “the Bulletin”)¹, and the fact that the WIPO web site itself has become the central source of official information on the Hague system, the publication procedures under the Hague system may be worth a closer look.

2. The purpose of the present document is to review the contents of Rule 26(1) of the Common Regulations under the 1999 Act and the 1960 Act of the Hague Agreement (hereinafter referred to as “the Common Regulations”), which deals with the data published in the Bulletin. Furthermore, given the improved publication techniques, the expiry of the time limit for the payment of the publication fee during the deferment period, as prescribed under Rule 16(3), may be aligned with other provisions relating to events during the deferment period.

¹ The Bulletin is available on the WIPO web site at:
<http://www.wipo.int/hague/en/bulletin/haguebulletin/index.jsp>.

II. PUBLICATION OF INFORMATION CONCERNING INTERNATIONAL REGISTRATIONS

3. Rule 26(1) of the Common Regulations lists recordings of relevant data concerning international registrations, which the International Bureau of WIPO (hereinafter referred to as “the International Bureau”) publishes in the Bulletin. When having an overall view of the legal framework of the Hague system, it appears that the said list is not exhaustive. Since it is in the interest of third parties to be aware of the exact status of the international registrations that they are interested in, the said list should be as complete as possible. The Working Group is invited to consider the proposed amendments to Rule 16(3) to (5) and Rule 26(1) and comment on whether it considers appropriate to also publish the following relevant data in the Bulletin.

MERGERS

4. As prescribed by Rule 21(7) of the Common Regulations, in the event of a partial change in ownership of the international registration, in respect of only some of the industrial designs, or only some of the designated Contracting Parties, the transferred part is cancelled under the original number of the international registration and is recorded as a separate international registration. The separate registration bears the number of the international registration of which a part has been transferred, together with a capital letter.

5. Where the same person becomes the holder of two or more international registrations resulting from a partial change in ownership, the registrations may be merged at the request of such person. Pursuant to Rule 21(8), the international registration resulting from the merger bears the number of the international registration of which part has been transferred, together, where applicable, with a capital letter. Given that Rule 21(8) further prescribes that paragraphs (1) to (6) shall apply *mutatis mutandis* to mergers, it is also proposed to add mergers to Rule 26(1)(iv). Although as a result of a merger, there is no change with regard to the identity of the owner of the rights deriving from the international registrations in question, it would be in the interest of third parties to have clearer information on the ownership of those rights.

6. It is proposed to add mergers to subparagraph (iv) of Rule 26(1), as provided in the draft contained in the Annex to the present document.

DECLARATION THAT A CHANGE IN OWNERSHIP HAS NO EFFECT AND ITS WITHDRAWAL

7. It is recalled that pursuant to Article 16(1)(vii) and (4) of the 1999 Act of the Hague Agreement Concerning the International Registration of Industrial Designs (hereinafter referred to as “the 1999 Act” and the “Hague Agreement”), the International Bureau publishes recordings concerning “any other relevant fact, identified in the Regulations, concerning the rights in any or all of the industrial designs that are the subject of the international registration”.

8. New Rule 21*bis* of the Common Regulations on the refusal of the effects of the recording of a change in ownership in the International Register came into force on January 1, 2012. The said new rule established a mechanism to allow the Offices of designated Contracting Parties to refuse the effects of the recording of a change in ownership, where such recording under their national/regional laws is not allowed².

9. Pursuant to Rule 21*bis*(4), the International Bureau records in the International Register a declaration by the Office of a designated Contracting Party that a change in ownership has no effect in the said Contracting Party and modifies the International Register accordingly. The International Bureau notifies both the previous holder (transferor) and the new holder (transferee) of the recording. Furthermore, in accordance with Rule 21*bis*(5), the declaration may be withdrawn, in part or whole. In such a case, the International Bureau records the withdrawal of declaration in the International Register, modifies the International Register and notifies both the previous holder (transferor) and the new holder (transferee) of the recording.

10. It is recalled that in paragraph 17 of document H/A/30/1, entitled "Matters Concerning the Legal Development of the Hague System" (available on the WIPO web site at: www.wipo.int/meetings/en/details.jsp?meeting_id=23141), it is said that "such a mechanism would be in the interest of third parties by reducing the uncertainty as to the identity of the holder of the rights deriving from the international registration".

11. As explained in paragraph 3 of the present document, Rule 26(1) of the Common Regulations lists recordings of relevant data concerning international registrations which the International Bureau shall publish. It is contended that a declaration under Rule 21*bis* and its withdrawal are the kind of relevant facts affecting the rights in any or all of the industrial designs foreseen under Article 16(1)(vii) of the 1999 Act and that, therefore, the International Bureau should see to their publication.

12. It is, thus, proposed that a new subparagraph (ix) be added to Rule 26(1) referring to declarations under Rule 21*bis* and their withdrawals, as provided in the draft contained in the Annex to the present document.

CANCELLATIONS RECORDED UNDER RULE 12(3)(D)

13. Rule 12(3) provides that where a Contracting Party has made a declaration under Article 7(2) of the 1999 Act or under Rule 36(1) of the Common Regulations, that declaration may further specify that the individual designation fee to be paid in respect of the Contracting Party comprises two parts, the first part to be paid at the time of filing the international application and the second part to be paid at a later date, which is determined in accordance with the law of the Contracting Party concerned.

14. As of the date of the present document, there is no Contracting Party that has made the said declaration. This having been said, there may be a country intending to do so when it joins the Hague system in the future.

² See document H/LD/WG/1/3, entitled "Issues Relating to the Effects of the Recording of a Change in Ownership in the International Register", available on the WIPO web site at http://www.wipo.int/meetings/en/details.jsp?meeting_id=22702.

15. In the situation where a declaration under Rule 12(3) has been made, Rule 12(3)(d) further provides that where the second part of the individual designation fee is neither paid to the Office of the designated Contracting Party concerned nor to the International Bureau within the applicable period, the International Bureau shall cancel the international registration with respect to the designated Contracting Party concerned following a request to that effect received from the Office.

16. In accordance with Rule 12(3)(d), such a cancellation shall be notified to the holder of the international registration. However, this cancellation will happen unbeknown to third parties as it is not published. It is, thus, proposed that, in the interest of third parties' information, cancellations recorded under Rule 12(3)(d) be added to Rule 26(1), as a result of which this particular type of cancellation will also be published³.

17. It is proposed to add a new subparagraph (viii) to Rule 26(1) referring to cancellations recorded under Rule 12(3)(d), as provided in the draft contained in the Annex to the present document.

III. PAYMENT OF PUBLICATION FEE DURING THE DEFERMENT PERIOD

18. It is recalled that the publication fee for international registrations whose publication has been deferred may be paid at a later stage. It is further recalled that, with a view to reducing the amount of the publication fee in respect of industrial designs for which protection is no longer desired, the holder of the international registration may submit a request for limitation or renunciation before the expiry of the deferment period.

19. In that respect, it is to be noted that following the amendment of Section 601 of the Administrative Instructions for the Application of the Hague Agreement (hereinafter referred to as "the Administrative Instructions"), which came into force on January 1, 2012, a request for the recording of a limitation or renunciation must be received by the International Bureau not later than three weeks prior to the expiry of the period of deferment. It is recalled that, Rule 16(3) prescribes that the publication fee must be paid not later than three months before the expiry of the period of deferment.

20. It appears to be reasonable to allow the holder to make the payment of the publication fee within the same time limits as the filing of a request for the recording of a limitation or renunciation. Therefore, it is proposed to align the time limit in Rule 16(3)(a) with the three-week time limit under Section 601. Consequently, the unofficial reminder by the International Bureau of the payment of the publication fee, as provided for by Rule 16(3)(b), could be postponed to be sent three months before the expiry of the period of deferment since this would give enough time for the holder to make the required payment. It is further proposed to delete the reference to the submission of reproductions from this subparagraph (see paragraph 21 of the present document).

21. Furthermore, Rule 16(3)(a) also refers to the rare case where specimens have been submitted instead of reproductions in accordance with Rule 10. Given that this possibility never happens in practice, it is proposed that it is dealt with separately under paragraph (4) of the present rule, which already refers to the recording of reproductions submitted during the deferment period. It is further proposed that the said reproductions shall be submitted not later than three months before the expiry of the period for paying the publication fee.

³ It is to be noted that, although they are of different nature, any other types of recorded events affecting negatively partially or totally an international registration, are published in accordance with Rule 26(1), namely, "refusals", "invalidations", "renunciations", "limitations", and "international registrations which have not been renewed".

22. As it is a precondition for the recording and publication of reproductions of industrial designs that they conform to requirements concerning quality and format as prescribed, it is proposed that a reference to Rule 9(1) and (2) be added to Rule 16(4). This would ensure that the requirements concerning the form and quality of the reproductions are complied with.

23. Finally, Rule 16(5) stipulates that if the requirements concerning the payment of the publication fee and submission of the reproductions are not complied with, the international registration will be cancelled. As a consequence of the proposed amendments to paragraphs (3) and (4) of the present rule, in addition to paragraph (3), a reference to paragraph (4) should be added to paragraph (5).

24. The Working Group is invited to indicate whether it considers favorably the submission for adoption, in due course, of a proposal to amend the Common Regulations with respect to Rule 16(3) to (5) and Rule 26(1), as provided in the draft contained in the Annex hereto, to the Assembly of the Hague Union, and to further comment on the said draft.

[Annex follows]

Rule 16
Deferment of Publication

[...]

(3) [~~Period for Paying Publication Fee and Submitting Reproductions~~] (a) The publication fee referred to in Rule 12(1)(a)(iv) shall be paid, ~~and, where specimens have been submitted instead of reproductions in accordance with Rule 10, those reproductions shall be submitted,~~ not later than three ~~weeks~~ ~~months~~ before the period of deferment applicable under Article 11(2) of the 1999 Act or under Article 6(4)(a) of the 1960 Act expires or not later than three ~~weeks~~ ~~months~~ before the period of deferment is considered to have expired in accordance with Article 11(4)(a) of the 1999 Act or with Article 6(4)(b) of the 1960 Act.

(b) ~~Three~~ ~~Six~~ months before the expiry of the period of deferment of publication referred to in subparagraph (a), the International Bureau shall, by sending an unofficial notice, remind the holder of the international registration, where applicable, of the date by which the publication fee referred to in ~~sub~~paragraph (a~~3~~) shall be paid ~~and the reproductions referred to in paragraph (3) shall be submitted.~~

(4) [Period for Submitting Reproductions and Registration of Reproductions] (a) Where specimens have been submitted instead of reproductions in accordance with Rule 10, those reproductions shall be submitted, not later than three months before the expiry of the period for paying the publication fee set under paragraph 3(a).

(b) The International Bureau shall record in the International Register any reproduction submitted under ~~sub~~paragraph (a~~3~~), provided that the requirements under Rule 9(1) and (2) are complied with.

(5) [Requirements Not Complied With] If the requirements of paragraph (3) ~~and (4)~~ are not complied with, the international registration shall be canceled and shall not be published.

[...]

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;
- (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*.

[End of Annex and of document]