

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**

PUBLIC AVAILABILITY OF INFORMATION ON THE AMENDMENTS TO AN INTERNATIONAL REGISTRATION RESULTING FROM A PROCEDURE BEFORE THE OFFICE OF A DESIGNATED CONTRACTING PARTY

Document prepared by the International Bureau

I. INTRODUCTION

1. The centralized publication of an international registration having effect in various designated Contracting Parties is one of the fundamental features of the Hague System for the International Registration of Industrial Designs (hereinafter referred to as “the Hague system”). International registrations are published in the *International Designs Bulletin* (hereinafter referred to as “the Bulletin”) available on the WIPO web site.
2. Pursuant to 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”), relevant data concerning international registrations is published in the Bulletin, namely, international registrations in accordance with Rule 17 (including bibliographic data recorded in the International Register and reproductions of the industrial design), 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 18bis(3) (*i.e.*, withdrawals of refusal and statements of grant of protection), invalidations recorded under Rule 20(2), changes in ownership, changes of name or address of the holder, renunciations and limitations recorded under Rule 21, corrections effected under Rule 22, renewals recorded under Rule 25(1) and

international registrations which have not been renewed. In other words, Rule 26(1) lists the events recorded in the International Register which are to be published in the Bulletin. However, the scope of protection of an international registration may also be affected by events which are not recorded in the International Register.

3. More precisely, as prescribed by Article 14(2)(c) 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 effect given to the international registration shall apply to the industrial design(s) that are the subject of the registration as received from the International Bureau of the World Intellectual Property Organization (WIPO) (hereinafter referred to as “the International Bureau”) by the Office of a designated Contracting Party or, where applicable, “as amended in the procedure before that Office”. Within the legal framework of the Hague system, there is no provision for making such amendments publicly available.

4. In Chapter II of the present document, a closer look is taken at the procedure for issuing a refusal and its withdrawal before the Office of a designated Contracting Party, in which context an international registration may be amended. Finally, in Chapter III of the present document the Working Group is invited to consider the feasibility of the introduction of a mechanism to the Hague system to make information on such amendments publicly available.

II. AMENDMENTS TO AN INTERNATIONAL REGISTRATION RESULTING FROM A PROCEDURE BEFORE THE OFFICE OF A DESIGNATED CONTRACTING PARTY

PROCEDURE FOR ISSUING A REFUSAL AND ITS WITHDRAWAL BEFORE AN OFFICE

5. Upon receipt of the international application, the International Bureau checks that it complies with the prescribed formal requirements. An international application that complies with the prescribed formal requirements is recorded in the International Register and published in the Bulletin. Pursuant to Article 10(3) of the 1999 Act, such publication shall be deemed in all Contracting Parties to be sufficient publicity. In accordance with Article 12(1) of the said Act, where the conditions for the grant of protection under the law of a designated Contracting Party are not met, its Office may refuse, in part or in whole, the effects of the international registration in the territory of the said Contracting Party. It is recalled that an international registration may not be refused on grounds of non-compliance with formal requirements, since such requirements must be considered satisfied following the examination by the International Bureau.

6. In accordance with Rule 18(1), the time limit for the notification of a refusal is either six or 12 months from the date of publication of the international registration. In accordance with Rule 18(2)(b), the notification of refusal must, among other things, contain all the grounds on which the refusal is based, together with a reference to the corresponding essential provisions of the law. An Office which has issued a notification of refusal may, in accordance with Rule 18(4)(a), withdraw the said notification, following, in particular, the lodging of an appeal by the holder. Furthermore, pursuant to Rule 18*bis*(2), a withdrawal of refusal by an Office may also take the form of a statement of grant of protection. However, the withdrawal of refusal or statement of grant of protection only indicate the industrial design(s) concerned but do not state the grounds for withdrawal.

7. Finally, where a refusal has been notified and subsequently withdrawn by the Office of a designated Contracting Party, in part or in whole, Article 14(2)(b) of the 1999 Act states that the effect of the international registration shall be the same as a grant of protection for the industrial design under the law of the said Contracting Party, at the latest from the date on which the refusal was withdrawn.

AMENDMENTS TO AN INTERNATIONAL REGISTRATION

8. The constraints as to the form and number of reproductions of the industrial design are defined in Rule 9(1) and (2) and further specified in the Administrative Instructions for the Application of the Hague Agreement (hereinafter referred to as “the Administrative Instructions”). Furthermore, in accordance with Rule 9(3), a Contracting Party bound by the 1999 Act which requires certain specified views of the product or products which constitute the industrial design or in relation to which the industrial design is to be used, shall make a declaration to that effect. At the time of preparing this document, none of the Contracting Parties to the 1999 Act has made such a declaration. It is recalled that, pursuant to Rule 9(4), the effects of the international registration may not be refused on the ground that requirements relating to the form of the reproductions that are additional to, or different from, those notified by that Contracting Party in such a declaration have not been satisfied under its law.

9. In accordance with Rule 9(4), a Contracting Party may, however, refuse the effects of the international registration on the ground that the reproductions contained in the international registration are not sufficient to disclose fully the industrial design. To overcome such refusal, the holder would presumably submit further views or an amended or supplementary description to the Office, all of which may, as a consequence, impact on the scope of protection in that Contracting Party. Within the Hague system, there is no mechanism to make such further views or description submitted to an Office publicly available.

10. Furthermore, the Office of a Contracting Party having made a declaration under Article 13(1) of the 1999 Act concerning unity of design, may refuse the effects of the international registration pending compliance with the requirements notified by that Contracting Party in the said declaration. Pursuant to Rule 18(3), where, following such a notification of refusal an international registration is divided before the Office concerned in order to overcome the ground of refusal stated in the notification, that Office must notify the International Bureau of such data concerning the division. Section 502 of the Administrative Instructions further prescribes that the Office shall notify the International Bureau of the division of an international registration before that Office, together with the following information: the Office making the notification; the number of the international registration concerned; the numbers of the industrial designs which have been the subject of the division with the Office concerned; and, the resulting national or regional application/registration numbers. However, this information is not recorded in the International Register and, within the Hague system, there is no mechanism to make such information publicly available.

III. PUBLIC AVAILABILITY OF INFORMATION ON THE AMENDMENTS TO AN INTERNATIONAL REGISTRATION

11. The Working Group is invited to discuss the desirability of the introduction of a mechanism to the international registration system to make amendments to an international registration made in a procedure before an Office publicly available. One option could be that a link to the web site of the Office of a designated Contracting Party be made available in the Hague Express Database, or in some more specific vehicle on the WIPO web site. By clicking the link, third parties would be able to view the said amendments to an international registration on the web site of the Office concerned. On the other hand, if such information is not available on the web site of the Office concerned, maybe such an Office could consider other possible ways of giving access to the file held by it concerning amendments to an international registration.

12. In the event that the Working Group considers feasible the introduction of a mechanism to the Hague system to make such information publicly available, a new paragraph dealing with additional information concerning published international registrations could be inserted into Rule 32. Further details of such a mechanism may be specified in the Administrative Instructions.

13. The proposed new paragraph to Rule 32 could read as follows:

“The International Bureau may make publicly available, by means specified in the Administrative Instructions, additional information regarding data which may affect the scope of protection of the international registrations in a designated Contracting Party. The extent of such additional information may be further specified in the Administrative Instructions.”

14. Finally, if the Working Group favorably considers the introduction of the above-mentioned mechanism to the Hague system, it is invited to discuss how the Offices concerned could make such information publicly available, either on their web site or otherwise.

15. The Working Group is invited to comment on whether it would favorably consider the introduction to the Hague system of a mechanism to make publicly available information on the amendments to an international registration having taken place in a procedure before the Office of a designated Contracting Party.

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