

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

**Third Session  
Geneva, October 28 to 30, 2013**

### **POSSIBLE AMENDMENT OF RULE 5 OF THE COMMON REGULATIONS UNDER THE 1999 ACT AND THE 1960 ACT OF THE HAGUE AGREEMENT**

*Document prepared by the International Bureau*

#### **I. INTRODUCTION**

1. The second session of 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” and “the Hague system”), which met from November 5 to 7, 2012, discussed the failure by an interested party to meet a time limit for a communication addressed to the International Bureau<sup>1</sup>. It was recalled that Rule 5 of the Common Regulations Under the 1999 Act and the 1960 Act of the Hague Agreement (hereinafter referred to as the “Common Regulations”) already provided the interested party with a safeguard in the case of irregularities in postal and delivery services. Under that Rule, failure to meet a time limit shall be excused if the interested party submits evidence showing, to the satisfaction of the International Bureau of the World Intellectual Property Organization (WIPO), that circumstances as described in Rule 5(1) or (2) caused that failure.

2. It is likely that, in the future, all communications between users and the International Bureau will take place in electronic format. At the second session, the delegations shared their experiences about how failure to meet a time limit was handled at the national level, for example, in the case of a natural disaster. As regards electronic communication, it was observed that it was sometimes almost impossible to establish the cause of the interruption.

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<sup>1</sup> See document H/LD/WG/2/9 Prov., entitled “Draft Report”, paragraphs 50 to 58.

3. The Working Group decided to continue its discussion at the third session and the delegations were invited to submit their further observations to the International Bureau in due course. In its observations submitted to the International Bureau after the second session, the Delegation of Spain firstly explained the provisions of its national law and then proposed a revised text for Rule 5(4), concerning electronic communications.

## II. PROPOSAL BY THE DELEGATION OF SPAIN

4. Under the industrial design law of Spain, if an interested party which has demonstrated “due care” required by the circumstances has not been able to meet a time limit, his rights will be reestablished, at his request, if his rights were lost as a direct consequence of the failure to meet the time limit. Furthermore, under the patent law of Spain, a patent which has expired due to non-payment of the annual fee can be reinstated if the holder of the patent can demonstrate that the payment failure happened because of “*force majeure*”. Finally, the Civil Code of Spain makes a general reference to “unforeseen events” and those that “could have been foreseen but were unavoidable”.

5. Under the law of Spain, “*force majeure*” refers to cases that are not only unpredictable but also unavoidable and irresistible (“*vis cui resisti non potest*”), irrespective of whether or not the interested party has demonstrated “due care”. The Delegation considered that the wording for proposed Rule 5(4) of the Common Regulations, contained in Annex I to document H/LD/WG/2/3, discussed at the second session of the Working Group, seemed to mix the scenarios of “*force majeure*” and “due care”.

6. The observations of the Delegation of Spain contained the following proposed wording for Rule 5(4), concerning electronic communications:

*“If an interested party can provide evidence that it has been unable to meet the specified time limit for submitting an electronic communication to the International Bureau, the failure to meet the time limit shall be excused if it is the result of an extraordinary occurrence beyond the control of the interested party which could not have been avoided despite the interested party having exercised the due diligence required by the circumstances. The requirements, time limits and evidence for having the said failure excused shall be established in accordance with the provisions of the Administrative Instructions.”*

7. The Delegation of Spain further referred to the discussions at the fourth session of the PCT Union – Patent Cooperation Treaty Working Group (hereinafter referred to as the “PCT”), in 2011, concerning the gap in the PCT Regulations in respect of “*force majeure*”<sup>2</sup>. According to the meeting documents, the recent natural disasters in Japan had provided a reminder that the PCT legal framework did not contain a general provision for excusing any delay in meeting PCT time limits due to circumstances beyond the control of the applicant. It was thus proposed to amend the PCT Regulations in order to fill this gap, and provide a limited measure of flexibility within the PCT to provide relief to adversely affected PCT

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<sup>2</sup> See document PCT/WG/4/11, entitled “Excuse of Delay in Meeting Certain Time Limits due to Force Majeure”, available on the WIPO web site at [http://www.wipo.int/meetings/en/details.jsp?meeting\\_id=22683](http://www.wipo.int/meetings/en/details.jsp?meeting_id=22683).

applicants in exceptional circumstances. As recommended by the PCT Working Group and adopted by the PCT Union Assembly, in 2011, new Rule 82*quater*.1, “Excuse of Delay in Meeting Time Limits”<sup>3</sup> entered into force on July 1, 2012.

### III. REVISED PROPOSAL FOR RULE 5(4) OF THE COMMON REGULATIONS

8. As regards filling the gap in the legal framework of the Hague system concerning “*force majeure*” in respect of electronic communications, it may be feasible for the provision concerned to be aligned with the wording of Rule 5 of the Common Regulations, as it currently stands. It is recalled that current Rule 5(1)(i) and (2)(i) of the Common Regulations already addresses “*force majeure*” in respect of communications sent through postal and delivery services. The proposed wording for Rule 5(4)(i) concerning electronic communications, contained in the Annex to the present document, follows the structure of Rule 5(1)(i) and (2)(i). It further specifies that the reason considered as “*force majeure*” should take place in the locality where the interested party resides, has his place of business or is staying.

9. Furthermore, as explained by the Delegation of Spain, a distinction should be made between failure to meet a time limit because of “*force majeure*” and failure, on the other hand, because of other occurrences which could not have been avoided despite the interested party having exercised the due diligence required by the circumstances. However, as discussed during the second session of the Working Group with regard to electronic communications, it might sometimes be impossible to find out the cause of the interruption. Apart from being unable to predict all extraordinary events that may cause such an interruption, the rapid developments in the field of IT render it impossible to predict future means of electronic transmission. Therefore, in the proposal for Rule 5(4)(ii), as contained in the Annex to the present document, the reference to the specifications in the Administrative Instructions has been removed.

10. Given that the planned Hague Portfolio Manager (hereinafter referred to as the “HPM”) will be available on the WIPO web site, the International Bureau would normally be aware of any malfunctioning of its own service provider. Therefore an extraordinary event causing the unavailability of the HPM on the WIPO web site would be tantamount to a situation where a time limit expires on a day on which the International Bureau is not open to the public, as prescribed by Rule 4(4) of the Common Regulations. Under that Rule, if a period expires on

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<sup>3</sup> Regulations under the Patent Cooperation Treaty:

*82quater.1 Excuse of Delay in Meeting Time Limits*

(a) *Any interested party may offer evidence that a time limit fixed in the Regulations for performing an action before the receiving Office, the International Searching Authority, the Authority specified for supplementary search, the International Preliminary Examining Authority or the International Bureau was not met due to war, revolution, civil disorder, strike, natural calamity or other like reason in the locality where the interested party resides, has his place of business or is staying, and that the relevant action was taken as soon as reasonably possible.*

b) *Any such evidence shall be addressed to the Office, Authority or the International Bureau, as the case may be, not later than six months after the expiration of the time limit applicable in the given case. If such circumstances are proven to the satisfaction of the addressee, delay in meeting the time limit shall be excused.*

(c) *The excuse of a delay need not be taken into account by any designated or elected Office before which the applicant, at the time the decision to excuse the delay is taken, has already performed the acts referred to in Article 22 or Article 39.*

a day on which the International Bureau is not open to the public, the period shall expire on the first subsequent day on which the International Bureau is open to the public. Once the HPM was available again, a statement concerning the restoration of the HPM would be published on the WIPO web site.

11. Finally, the text of proposed Rule 5(5) is aligned with Rule 5(3), to the extent applicable.

12. A revised proposal for the title of Rule 5, and for Rule 5(3), (4) and (5), taking into account the considerations of the Delegation of Spain, as well as the discussions at the second session of the Working Group, is contained in the Annex to the present document.

*13. The Working Group is invited to comment on the desirability of amending Rule 5, as provided in the draft contained in the Annex to the present document.*

[Annex follows]

[...]

Rule 5

*Irregularities in Postal and Delivery Services* or *Electronic Communications*

[...]

(3) [*Limitation on Excuse Concerning Communications by Postal and Delivery Services*] Failure to meet a time limit shall be excused under ~~this Rule~~ paragraph (1) or (2), as applicable, only if the evidence referred to in paragraph (1) or (2) and the communication or a duplicate thereof are received by the International Bureau not later than six months after the expiry of the time limit.

(4) [*Electronic Communications*] Failure by an interested party to meet a time limit for a communication addressed to the International Bureau and submitted by electronic means shall be excused if the interested party submits evidence showing, to the satisfaction of the International Bureau:

(i) that the time limit for the communication was not met on account of war, revolution, civil disorder, strike, natural calamity or other like reason in the locality where the interested party has his residence, his place of business or is staying, and that the communication was submitted as soon as reasonably possible; or

(ii) that the time limit for the communication was not met because of an extraordinary occurrence beyond the control of the interested party which could not have been avoided despite the interested party having exercised the due diligence required by the circumstances, and that the communication was submitted as soon as reasonably possible.

(5) [*Limitation on Excuse Concerning Electronic Communications*] Failure to meet a time limit shall be excused under paragraph (4) only, if the evidence referred to in that paragraph and the communication concerned are received by the International Bureau not later than six months after the expiry of the time limit.

[...]

[End of Annex and of document]