

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

**Third Session
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PUBLIC AVAILABILITY OF INFORMATION RELATING TO AMENDMENTS TO AN INDUSTRIAL DESIGN THAT IS THE SUBJECT OF AN INTERNATIONAL REGISTRATION FOLLOWING A PROCEDURE BEFORE AN OFFICE

Document prepared by the International Bureau

I. INTRODUCTION

1. In its second session, which convened from November 5 to 7, 2012, the Working Group on the Legal Development of the Hague System for the International Registration of Industrial Designs (hereinafter referred to as “the Hague system” and “the Working Group”) discussed the possible introduction into the Hague system of a mechanism to ensure the public availability of information on amendments to an industrial design that is the subject of an international registration further to a procedure before the Office of a designated Contracting Party¹.

2. It is recalled that, in accordance with 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 is/are the subject of the international

¹ See documents H/LD/WG/2/6, entitled “Public Availability of Information on the Amendments to an International Registration Resulting from a Procedure Before the Office of a designated Contracting Party” and H/LD/WG/2/9 Prov., entitled “Draft Report”, paragraphs 83 to 90, both available on the WIPO web site at http://www.wipo.int/meetings/en/details.jsp?meeting_id=25018).

registration as received from the International Bureau of the World Intellectual Property Organization (WIPO) by the Office of a designated Contracting Party or, where applicable, “as amended in the procedure before that Office”. Such amendments may result from the holder of the international registration taking action to overcome a refusal issued by the said Office.

3. Furthermore, pursuant to Article 12(4) of the 1999 Act, the Office that communicated the refusal may withdraw it at any time. The contents of a notification of withdrawal of refusal or a statement of grant of protection following a refusal are prescribed in Rules 18(4)(b) and 18*bis*(2) of the Common Regulations under the 1999 Act and the 1960 Act of the Hague Agreement (hereinafter referred to as “the Common Regulations”), respectively. The notification/statement shall indicate: the Office making the notification; the number of the international registration; where the withdrawal/statement does not relate to all the industrial designs to which the refusal applied, those to which it relates or does not relate; and the date on which the refusal was withdrawn or the date of the statement. In other words, the amendments referred to in Article 14(2)(c) are not communicated as part of such a notification or statement.

4. The Working Group concluded its discussions at the second session by asking the International Bureau to further explore the possible introduction into the Hague system of a mechanism to ensure the public availability of information relating to the above-mentioned amendments. In that respect, the comments made in the meeting would be taken into account. It was further agreed that the discussion would continue at the third session of the Working Group and the delegations were encouraged to send further comments to the International Bureau in due course.

5. To foster the continuation of the discussions at the third session of the Working Group, the International Bureau prepared a questionnaire to collect information on possible amendments before the Offices of current and prospective member States of the Hague Union². The purpose of the questionnaire was to have a better understanding on the types of amendments to an industrial design allowed before the Offices, their frequency, procedures concerning such amendments and how they are made publicly available. Since the questionnaire was also sent to the Offices of non-member States of the Hague Union, those Offices were invited to answer the questions bearing in mind what in their understanding would be the procedure once they became a designated Office under the Hague Agreement. Nevertheless, as an exception, question 2.2 of the questionnaire concerning the quantity of requests for amendments referred to the total number of requests for amendments received, irrespective of whether they related to national applications or international registrations.

6. At the time of preparing the present document, the International Bureau has received replies to the questionnaire from 39 Offices. Out of these 39 Offices, 25 are Offices of the members of the Hague Union and 14 are Offices of non-members. The questionnaire is contained in Annex I and the list of Offices that replied to the questionnaire is contained in Annex II to the present document.

² The questionnaire was annexed to WIPO Circular letter No. C.H 99, of May 3, 2013, addressed to the Industrial Property Offices of Member States of WIPO, the Office for Harmonization in the Internal Market (Trademarks and Designs) (OHIM), the Benelux Office for Intellectual Property (BOIP) and the Regional Office of the African Intellectual Property Organization (OAPI).

II. SUMMARY OF REPLIES TO THE QUESTIONNAIRE

7. A majority of the Offices that replied to the questionnaire allow the holder of the international registration to amend an industrial design in order to overcome a refusal. Out of a total of 39 Offices, 29 answered “Yes” to question 1 of the questionnaire (“If your Office is the Office of a designated Contracting Party under the 1999 Act of the Hague Agreement and notifies a refusal of protection for an international registration, is it possible for the holder to amend an industrial design in order to overcome the refusal?”). Eight Offices do not allow any amendments and two Offices did not answer this question (see Table I in Annex III to the present document). The percentages indicated subsequently in the present document take into account only the replies of the 29 Offices which answered “Yes” to question 1.

AMENDMENTS TO AN INDUSTRIAL DESIGN

8. Out of the 29 Offices which allow amendments to an industrial design, only 10 indicated that they had actually received requests for such amendments. The variation in the number of requests received was huge, ranging from just one request to several tens of thousands³ (see Table I in Annex III to the present document).

Amendment of the Views or Submission of Additional Views

9. As regards different types of amendments, 22 Offices (76 per cent) allow the amendment of views or the submission of additional views. Regarding the scope of allowable amendments, it was emphasized in many replies that the amendment of views or the submission of additional views was subject to certain conditions under national/regional law, such as “the essential features of the overall impression of the design must be retained”, “new views must not disclose new subject matter”, “the gist of the design must not be changed”, “views that are changing the substance of the industrial design are not taken into account”, or “amendments should not be inconsistent with views of the industrial design that were submitted initially”.

10. Furthermore, with respect to the contents of allowable amendments for drawings, under certain conditions some elements could be removed; for example, if a view included flags or other official symbols or trademarks, they might be removed if this did not alter the overall impression of the design. Certain elements for which protection could not be granted might be disclaimed by presenting them in dotted lines or by means of a declaration⁴.

Amendments of the Description or Submission of an Additional Description

11. Moreover, 10 Offices (34 per cent) allow the amendment of the description or the submission of an additional description. Many Offices allow the addition of a disclaimer to the description. One Office indicated that the substantial identity of the industrial design should be maintained after the amendment of the description.

³ It appears that some Offices also included in the number of requests for amendments the submission of other elements not addressed in the present document, such as priority documents, to overcome a refusal issued by the Office.

⁴ In one reply, it was specified that, under certain circumstances, a disclaimer indicated in the notification of refusal would take effect automatically if the applicant failed to invoke arguments to overcome the refusal.

Amendment of the Type of an Industrial Design

12. Finally, six Offices (21 per cent) allow the amendment of the type of an industrial design, for example, partial, principal or related design.

Any Other Amendment or Addition

13. Regarding any other amendments or additions that are allowed, the division of an application in compliance with a requirement of unity of design and amendments to an indication of product or a claim were mentioned.

PUBLIC AVAILABILITY OF THE AMENDED INDUSTRIAL DESIGN

14. Most Offices – 19 out of 29 (66 per cent) – republish or make publicly available amended industrial design(s) (see Table II in Annex IV to the present document). Out of those 19 Offices, 12 Offices make publicly available amended industrial designs with all corresponding elements, four Offices make publicly available the international registration as a whole (both amended and non-amended industrial designs included) and three Offices make publicly available the amended element(s) only.

15. All 19 Offices publish the amended industrial design electronically and seven of them also publish it in paper format. One Office explained that it keeps a paper file containing all documents and correspondence: the original and any amended applications and drawings. The paper file is open to public inspection after the design has been registered. Currently, this file history is not available to clients electronically.

16. Two Offices explained that they publish on their online databases the most recent data concerning the amended application and drawings that were accepted for registration, for example drawings that were amended to overcome a refusal by the Office. One Office indicated that the data concerning international registrations downloaded from the *International Designs Bulletin* (hereinafter referred to as the “Bulletin”) are recorded in the online “Register of Filed Applications” and then the approved designs are published in the online “Register of Designs”. Finally, one Office explained that the withdrawal of refusal including the amended design, if applicable, is published on its web site.

17. Publication is generally in the national language(s). As regards the working languages of the Hague system, 10 Offices publish the amendments in English, two Offices in Spanish and one in French. However, to the knowledge of the International Bureau, some of these Offices do not use any of the aforementioned languages as the working language of the Office. Furthermore, at certain Offices, only some of the information relating to amendments is translated into another publication language.

III. SPECIFIC ISSUES RAISED IN REPLIES TO THE QUESTIONNAIRE

18. At the end of the questionnaire, the Offices were requested to provide any comments that they thought would help the Working Group in its consideration of whether a mechanism to make available to the public amendments resulting from a procedure before an Office should be introduced in the Hague system. Some of the replies received to that question proposed measures on how the amended industrial design could be made publicly available.

19. The reason given for incorporating such a mechanism into the Hague system was that it would enhance the transparency of the system. This opinion was expressed both by Offices that publish the amended design and by others that do not. For Offices that carry out a substantive examination of industrial designs, following the amendment of the industrial design to overcome a refusal, the rights deriving from the amended industrial design may have been affected. This would make it necessary for users to check publication of the international registration both in the Bulletin and in the national Gazettes, which was considered extremely complicated. Finally, it was observed that, through such a proposed mechanism, interested parties could more easily find information on the scope of protection of the designs in the designated Contracting Parties.

ESTABLISHMENT OF A LINK TO THE ELECTRONIC PUBLICATION BY THE OFFICE

20. Most replies proposed making a link available on the WIPO web site to the electronic publication by the Office of a designated Contracting Party. It was proposed that the link could be posted in the Bulletin, in the Hague Express Database or in another vehicle on the WIPO web site⁵. It was further proposed to introduce a new provision in the legal framework of the Hague system to request each Office concerned to notify the International Bureau of the internet address (URL) of its electronic publication.

RECORDING AND/OR PUBLICATION OF THE AMENDED INDUSTRIAL DESIGN BY THE INTERNATIONAL BUREAU

21. Regarding other possible measures, it was proposed to record the amended industrial design in the International Register and/or publish it in the Bulletin, the Hague Express Database or in another vehicle on the WIPO web site. It was further proposed to adopt a similar approach to the one used for international trademarks in ROMARIN⁶.

22. Out of the total of 29 Offices, eight Offices (28 per cent) do not republish or make publicly available the amended industrial design and, with respect to international registrations, they simply refer to the internet address of the Bulletin published on the WIPO web site⁷. The establishment of a mechanism in the Hague system to have information on the amended industrial design before those Offices could thus be most important. However, it should be noted here that, to date, most of the 29 Offices which allow amendments to the industrial design have not received any requests to that effect. Furthermore, as regards the 10 Offices which have received such requests, only one Office does not make them available to the public. However, that Office indicated in its reply its willingness to communicate such information to the International Bureau.

⁵ In this context, it is recalled that all Offices that have replied to the questionnaire and are republishing or making publicly available the amended industrial design are undertaking electronic publication (see Table II in Annex IV).

⁶ ROMARIN stands for "Read-Only-Memory of Madrid Active Registry INformation". The ROMARIN database contains information on all international marks recorded under the Madrid system that are currently in force in the International Register or have expired within the past six months. It also includes data relating to notifications of refusal, statements of grant of protection, etc., sent by the Offices of the designated Contracting Parties to the International Bureau, including a scanned copy of the underlying notifications or statements.

⁷ In this regard, reference is made to Article 10(3)(a) of the 1999 Act, pursuant to which the international registration shall be published by the International Bureau. Such publication shall be deemed in all Contracting Parties to be sufficient publicity, and no other publicity may be required of the holder.

IV. CONCLUDING REMARKS

COMMUNICATION BETWEEN THE OFFICES AND THE INTERNATIONAL BUREAU

23. It appears that if some of the proposals put forward in the replies by the Offices, as explained in Chapter III of the present document, were adopted, the Working Group would need to consider further how the Offices would communicate such information to the International Bureau.

PUBLICATION LANGUAGE

24. One of the issues to be addressed is that the languages used in the national publications are not always the same as the working languages of the Hague system. In fact, according to the replies to the questionnaire, seven of the 19 Offices which republish the amended industrial design republish the relevant information only in the national language(s) and not in the working languages of the Hague system. This means that even if information on the amendments published by the Office was linked to a vehicle available on the WIPO web site, users might not understand the text contents, including the description of the industrial design, on account of the language barrier.

DIFFERENCES IN THE CONTENTS OF NATIONAL PUBLICATIONS

25. Another issue is the difficulty of finding the corresponding information on amendments in the national publications. As explained in paragraph 14 of the present document, most of the Offices that republish or make publicly available the amended industrial design(s) publish the amended industrial design with all corresponding elements or publish the international registrations as a whole (both amended and non-amended industrial designs). Such publications do not seek to provide the full picture, as provided for in Article 14(2)(c), of the effects of the international registration which apply to the industrial design(s) as amended in the procedure before the Office. It might therefore be difficult for users to clearly identify, in those publications, which industrial design(s) was/were amended among several industrial designs contained in the initial international registration and/or which element(s) of the industrial design was/were amended.

EXTRACTS FROM THE INTERNATIONAL REGISTER

26. Finally, the issue raised by the Delegation of Japan at the second session of the Working Group⁸ requires some consideration. On the assumption that the amendments to the industrial design are not recorded in the International Register, some Offices of the designated Contracting Parties might record the amendments in their respective national Registers. As a result, the rights derived from the amended industrial design protected in the designated Contracting Party would be set forth in two different registers, namely, in the International Register and in the national Register. Consequently, where the holder needs an extract concerning the international registration for enforcement of his rights in the Contracting Party concerned, he would need an extract from the International Register and another one from the

⁸ See paragraph 84 of document H/LD/WG/2/9 Prov.

national Register. On the other hand, if the amendments to the industrial design were recorded only in the International Register, the extract from the International Register would be the only one to be legally effective and would be exempt from any requirement of legalization in each Contracting Party under Rule 32(2) of the Common Regulations.

29. The Working Group is invited to further discuss the possible introduction into the Hague system of a mechanism to ensure the public availability of information on amendments to an industrial design that is the subject of an international registration further to a procedure before an Office, and to suggest a way forward.

[Annexes follow]

QUESTIONNAIRE ON THE POSSIBLE INTRODUCTION IN THE HAGUE SYSTEM OF A MECHANISM TO MAKE PUBLICLY AVAILABLE INFORMATION RELATING TO AMENDMENTS TO AN INDUSTRIAL DESIGN THAT IS THE SUBJECT OF AN INTERNATIONAL REGISTRATION FOLLOWING A PROCEDURE BEFORE AN OFFICE

Name of Office:

- Member
- Non-member (if you are a non-member Office, try to answer the questions below bearing in mind what you understand would be the procedure once you become a member-Office)

1. If your Office is the Office of a designated Contracting Party under the 1999 Act of the Hague Agreement and notifies a refusal of protection for an international registration, is it possible for the holder to amend an industrial design in order to overcome the refusal?

- Yes**
- No**
- Do not know**

2.1. If the answer to question 1 was “**Yes**”, please indicate any types of possible amendments and describe the procedure before your Office. If the space provided below is not sufficient, please use a separate sheet.

- (a) Amendment of the views or submission of additional views
- (b) Amendment of the description or submission of an additional description
- (c) Amendment of the type of an industrial design (for example, partial design, principal or related design)
- (d) Any other amendment or addition (please specify)

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2.2. In average, how many requests for amendments as indicated in subparagraph 2.1. are filed with your Office every year?

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3. If the answer to question 1 was “**Yes**”, does your Office republish or in any other way make publicly available the amended industrial design?

- Yes**
- No**
- Do not know**

4. If the answer to question 3 was “**Yes**”, how are such amendments made publicly available and in which language(s)?

- (a) Contents made publicly available:
 - (i) Amended element(s) only
 - (ii) Amended industrial design(s) with all corresponding elements
 - (iii) International registration as a whole (both amended industrial designs and non-amended included)

- (b) Languages
 - (i) Any of the working languages of the Hague system (please specify)
 - English French Spanish
 - (ii) Another language (please specify)
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- (c) Format
 - (i) Paper publication
 - (ii) Electronic publication

Please expand below as needed. If the space provided below is not sufficient, please use a separate sheet.

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5. Please provide any comments that you think would help the Working Group in its consideration of whether a mechanism to make available to the public amendments resulting from a procedure before an Office should be introduced in the Hague system.

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[Annex II follows]

LIST OF OFFICES THAT REPLIED TO THE QUESTIONNAIRE

By Contracting Parties (25):

Benelux
Bosnia and Herzegovina
Bulgaria
Croatia
Denmark
Estonia
European Union
Finland
Georgia
Hungary
Iceland
Kyrgyzstan
Latvia
Lithuania
Norway
Poland
Republic of Moldova
Romania
Serbia
Singapore
Slovenia
Spain
Switzerland
Turkey
Ukraine

By Non-Member States (14):

Argentina
Austria
Belarus
Canada
China
Greece
Japan
Jordan
Mexico
Portugal
Republic of Korea
Russian Federation
The former Yugoslav Republic of Macedonia
Uzbekistan

Total: 39

[Annex III follows]

TABLE I

REPLIES TO THE “QUESTIONNAIRE ON THE POSSIBLE INTRODUCTION IN THE HAGUE SYSTEM OF A MECHANISM TO MAKE PUBLICLY AVAILABLE INFORMATION RELATING TO AMENDMENTS TO AN INDUSTRIAL DESIGN THAT IS THE SUBJECT OF AN INTERNATIONAL REGISTRATION FOLLOWING A PROCEDURE BEFORE AN OFFICE”

Q1 (answered by 39 Offices) 1)			Q2 (answered by 29 Offices that replied "Yes" to Q1)						
If your Office is the Office of a designated Contracting Party under the 1999 Act of the Hague Agreement and notifies a refusal of protection for an international registration, is it possible for the holder to amend an industrial design in order to overcome the refusal?			2.1 If the answer to question 1 was “Yes”, please indicate any types of possible amendments and describe the procedure before your Office.			2.2 In average, how many requests for amendments as indicated in subparagraph 2.1. are filed with your Office every year?			
			Options	The number of replies	% of total replies (39)	Options (several choices are possible)	The number of replies	% of total replies (29)	The number of requests 2)
Yes			(a) Amendment of the views or submission of additional views			The Offices that have not received any requests			
	29	74%		22	76%		17	59%	
No			(b) Amendment of the description or submission of an additional description			The Offices that have received 1 to 25 requests			
	8	21%		10	34%		7	24%	
Do not know			(c) Amendment of the type of an industrial design (for example, partial design, principal or related design)			The Offices that have received 3000 to 6000 requests			
	0	0%		6	21%		1	3%	
No answer			(d) Any other amendment or addition			The Office that have received 20000 to 100000 requests			
	2	5%		21	72%		2	7%	

1) Out of 39 Offices that returned the reply, 25 are Offices of members of the Hague Union, and 14 are Offices of non-members.
2) It appears that some Offices also considered in the number of requests for amendments the submission of other elements, such as priority documents.

[Annex IV follows]

TABLE II

REPLIES TO THE “QUESTIONNAIRE ON THE POSSIBLE INTRODUCTION IN THE HAGUE SYSTEM OF A MECHANISM TO MAKE PUBLICLY AVAILABLE INFORMATION RELATING TO AMENDMENTS TO AN INDUSTRIAL DESIGN THAT IS THE SUBJECT OF AN INTERNATIONAL REGISTRATION FOLLOWING A PROCEDURE BEFORE AN OFFICE”

Q3 (answers by 29 Offices that replied "Yes" to Q1)			Q4 (answers by 19 Offices that replied "Yes" to Q3)							
If the answer to question 1 was “Yes”, does your Office republish or in any other way make publicly available the amended industrial design?			If the answer to question 3 was “Yes”, how are such amendments made publicly available and in which language(s)?							
			(a) Contents made publicly available			(b) Languages			(c) Format	
Options	The number of replies	% of total replies (29)	Options	The number of replies	% of total replies (19)	Options (several choices are possible)	The number of replies	% of total replies (19)	Options (several choices are possible)	The number of replies
Yes	19	66%	(i) amended element(s) only	3	16%	English	10	53%	(i) Paper publication	
No	8	28%	(ii) Amended industrial design(s) with all corresponding elements	12	63%	French	1	5%		7
Do not know	2	7%	(iii) International registration as a whole (both amended industrial designs and non-amended included)	4	21%	Spanish	2	11%	(ii) Electronic publication	
						another language	13	68%		
						Another language ONLY	7	37%		19