

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

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INFORMING OFFICES OF DESIGNATED CONTRACTING PARTIES OF EVENTS RECORDED IN RESPECT OF AN INTERNATIONAL REGISTRATION BEFORE ITS PUBLICATION

Document prepared by the International Bureau

I. INTRODUCTION

1. At its second session, held in Geneva 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 Working Group” and “the Hague system”) considered document H/LD/WG/2/7, entitled “Proposal by the Delegation of Norway”. As a result of the discussion, the Working Group requested the International Bureau to prepare a document analyzing possible ways of informing the designated Offices of events having taken place during the deferment period in respect of an international registration. In that regard, the comments made at that session would be taken into account¹.

2. Accordingly, the International Bureau has prepared the present document. However, instead of only concentrating on events having taken place during the deferment period, the analysis, in Chapter II of the document, addresses the events recorded in respect of an international registration before its publication (i.e. before “standard publication” taking place six months from the date of international registration or publication after the expiry of the requested deferment period), and considers the advantages and consequences of the introduction of a mechanism for transmission of confidential copies and updating the data concerning international registrations. Furthermore, the scope and contents of Article 10(5) of

¹ See paragraphs 91 to 97 of document H/LD/WG/2/9 Prov., entitled “Draft Report”.

the 1999 Act of the Hague Agreement Concerning the International Registration of Industrial Designs (hereinafter referred to as “the 1999 Act”), providing for “confidential copies” of international registrations, are examined.

3. In Chapter III of the document, the establishment of a new Part Nine, consisting of new Sections 901 and 902, in the Administrative Instructions for the Application of the Hague Agreement (hereinafter referred to as “the Administrative Instructions”) is proposed. The proposed new Part Nine of the Administrative Instructions is contained in the Annex to the present document.

4. Finally, it is recalled that pursuant to Rule 34(1)(a) of the Common Regulations Under the 1999 Act and the 1960 Act of the Hague Agreement (hereinafter referred to as “the Common Regulations”), the Director General shall consult the Offices of the Contracting Parties with respect to the proposed Administrative Instructions. The attention of the Working Group is drawn to the fact that, as further addressed in Chapter IV, the present document has been prepared with a view to proceeding to that consultation.

II. ANALYSIS OF THE ISSUES

INFORMATION CONCERNING INTERNATIONAL REGISTRATIONS THAT ARE THE SUBJECT OF “STANDARD PUBLICATION” OR DEFERMENT OF PUBLICATION

Timing of Publication

5. An international registration is notified to the Office of a designated Contracting Party through its publication, in accordance with Article 10(3)(b) of the 1999 Act and Rule 26(1)(i) and (3) of the Common Regulations. In this regard, it is recalled that Rule 17(1) of the Common Regulations provides for three different options for the timing of publication, namely, (i) immediate publication, (ii) deferment of publication and (iii) “standard publication”, which takes place six months after the date of the international registration or as soon as possible thereafter. For 2012, the proportion of international registrations that were the subject of an immediate publication was 48.5 per cent. That of international registrations that were the subject of a deferment of publication or of a standard publication were 9.1 per cent and 42.3 per cent, respectively².

6. Following a review of its publication cycle, the *International Designs Bulletin* (hereinafter referred to as “the Bulletin”) has been published weekly since February 3, 2012³. Consequently, the publication of an international registration which is recorded in the International Register during a given week and in respect of which immediate publication was requested will take place on Friday of the following week.

7. However, if the international registration was the subject of deferment of publication or standard publication, the number of the international registration, which is communicated as part of the crediting of the designation fee, is the only pre-publication information that the Office of a designated Contracting Party will receive concerning the international registration. Furthermore, in the event of renunciation of an international registration recorded in respect of all the designated Contracting Parties before its publication or its cancellation, in accordance with

² See WIPO Publication No. 930E/2013, entitled “2013 Hague Yearly Review International Registrations of Industrial Designs”.

³ See documents H/LD/WG/1/2, entitled “Issues Relating to the Publication and Contents of the International Designs Bulletin” and H/A/30/1, entitled “Matters Concerning the Legal Development of the Hague System”.

Rule 16(5), due to non-payment of the publication fee or missing reproductions, that data is the only information that the Office will receive, unless it has notified the International Bureau that, pursuant to Article 10(5)(a) of the 1999 Act, it wishes to receive “confidential copies” (see paragraphs 10 and 12, below).

Confidential Copies

8. Article 10(5)(a) of the 1999 Act provides that the International Bureau shall, immediately after the recording of the international registration, send a “confidential copy” of the international registration to each Office of a Contracting Party designated in the international registration that has notified the International Bureau that it wishes to receive such a confidential copy. At the time of preparing the present document, no Office has requested to receive confidential copies. It is, however, likely that the Offices of some prospective Contracting Parties will do so.

9. Pursuant to Article 10(5)(b), an Office that has received a confidential copy must keep the international registration in confidence until its publication in the Bulletin. Subject to that condition, the Office may use the said copy for the purpose of the examination of that international registration and of applications for the protection of industrial designs filed in or for that Contracting Party. Although Article 10(5) establishes these principles, the practical mechanism for the communication of confidential copies has yet to be determined.

Changes, Correction or Cancellation Before Publication of International Registration

10. Rule 21(1)(a) of the Common Regulations provides for various kinds of changes, namely, (i) change in ownership, (ii) change in the name or address of the holder, (iii) renunciation, and (iv) limitation. These changes may be recorded in the International Register upon request from the holder of the international registration even before publication of the international registration concerned, where it is the subject of a deferment of publication or standard publication. Furthermore, when it comes to publication of those changes pursuant to Rule 26(1)(iv), the present practice is that this is delayed to take place at the same time as the publication of the international registration itself. However, if, in accordance with Rule 21(1)(a)(iii) and (iv), the renunciation of the international registration was recorded in respect of “all the designated Contracting Parties”, or a limitation concerning some of the industrial designs was recorded in respect of “all the designated Contracting Parties”, and the request was presented by the time limit, as prescribed in Section 601 of the Administrative Instructions (i.e. not later than three weeks prior to the expiry of the period of deferment), the said international registration or the industrial designs concerned will never be published.

11. Furthermore, Rule 22(1) provides that, where the International Bureau, acting *ex officio* or at the request of the holder, considers that there is an error concerning an international registration, it shall modify the International Register and such a correction will also be published pursuant to Rule 26(1)(v). Such a correction may be effected before the international registration concerned is published. As with changes recorded before publication of the international registration, the publication of the correction takes place at the same time as the publication of the initial international registration.

12. Moreover, where the international registration is the subject of a deferment of publication and the publication fee has not been paid or specimens have been submitted instead of reproductions, pursuant to Rule 16(5), the international registration shall be cancelled if the publication fee is not paid or the proper reproductions are not submitted, in accordance with Rule 16(3). As a result of this cancellation, the international registration shall not be published.

CONSIDERATIONS

Proposal by the Delegation of Norway

13. At the second session of the Working Group, the Delegation of Norway indicated that its Office had a problem with being unable to close its case file if the international registration was renounced before its publication, since the recording of such a renunciation was neither published in the Bulletin nor communicated to the Office of each designated Contracting Party through any other mechanism⁴. The Delegation of Japan, in its observer capacity, commented that it would also be the case in respect of a cancellation of the international registration pursuant to Rule 16(5), as described in paragraph 12 of the present document.

14. As pointed out by the Delegation of Norway, obtaining information concerning events recorded before the publication of the international registration may be useful not only to the Offices carrying out a substantive examination as to prior art, as referred to in paragraph 9 of the present document, but also to Offices, which need this information for practical reasons, such as being able to close pending files, as it is the case before the Office of Norway.

Examination as to Substance Before an Office

15. As envisaged and referred to in Article 10(5)(b) of the 1999 Act, the Office of a designated Contracting Party that has received a confidential copy of an international registration could use it for the purpose of the examination of applications for protection of industrial designs filed in or for that Contracting Party. For instance, if the Office considers that the industrial design that is the subject of a second application is similar to the industrial design that is the subject of the international registration concerned, the Office would need to first examine the latter as to substantive conditions.

16. In this particular situation, however, the Office is not in a position either to grant or to refuse protection of the industrial design that is the subject of the international registration until it has been published. Pursuant to Article 12(2) of the 1999 Act, the Office of a designated Contracting Party that wishes to refuse the effects of the international registration must communicate to the International Bureau a notification to that effect within the prescribed period. Pursuant to Rule 18(1)(a), the said period shall be six months counted from the publication of the international registration, unless a Contracting Party has made a declaration under Rule 18(1)(b) that the period of six months shall be replaced by a period of 12 months. This is also the case concerning a statement of grant of protection provided for in Rule 18*bis*(1), which may be sent by the Office of a designated Contracting Party, within the applicable refusal period, where the Office has not communicated a notification of refusal.

17. Furthermore, the examination of any second application for an industrial design that is considered similar to an industrial design contained in the prior international registration should remain pending until a decision is made on that international registration.

⁴ See document H/LD/WG/2/7, entitled "Proposal by the Delegation of Norway".

Non-Disclosure Resulting from the Recording of Changes or Cancellation in the International Register

18. As already indicated in paragraph 10 of the present document, it is possible for the holder of the international registration to decide not to proceed to disclosure of all or some of the industrial designs that are contained in the international registration and request the recording of a renunciation of the international registration in respect of “all the designated Contracting Parties”, or the recording of a limitation concerning some of the industrial designs contained in the international registration in respect of “all the designated Contracting Parties” (Rule 21(1)(a)(iii) and (iv)). In both cases, such a request must be presented to the International Bureau within the time limit prescribed in Section 601 of the Administrative Instructions (i.e. not later than three weeks prior to the expiry of the period of deferment). Moreover, as described in paragraph 12 of the present document, a non-disclosure may also result from the publication fee not being paid or the reproductions of the industrial design (where specimens were submitted) not being submitted in time.

19. To the extent that the publication of the international registration does not take place as a result of the recording of a renunciation, limitation or cancellation, immediately updated data concerning the said recording would be beneficial not only to the Office, which may close its file, but also to the filer of the second application since, on the basis of that data, the Office will then be able to resume the examination of that second application.

Updating Data Relating to International Registrations

20. An updated data of those recordings, referred to in the previous paragraphs, may be relevant to all Offices that had received confidential copies or to some of the Offices only. For example, in the case of recording a limitation concerning an industrial design in respect of one Contracting Party only, communication of that recording is relevant to the Office of that Contracting Party. In addition to changes and cancellations recorded in the International Register, it is desirable for the Office concerned to receive information concerning any correction upon the recording of the corresponding modification in the International Register, as this correction may affect a decision on the international registration and further affect the outcome of any second application.

21. It is to be noted that all the Offices might not need updated data relating to the international registration. Such information would mainly be relevant to a Contracting Party whose Office performs *ex officio* examination as to prior designs filed or registered in or for that Contracting Party.

SCOPE OF ARTICLE 10(5) OF THE 1999 ACT

22. For the reasons described in the preceding paragraphs, a mechanism to inform the Offices of designated Contracting Parties of events recorded in respect of an international registration before its publication could be envisaged. In this regard, Article 10(5) of the 1999 Act providing for sending a confidential copy of an international registration to the Office of a designated Contracting Party that has made a request to that effect would be an appropriate legal basis.

23. As indicated in paragraph 9 of the present document, Article 10(5) provides for the fundamentals only, and the details of the mechanism would need to be established. The philosophy underlying the principle of sending a confidential copy to an Office as provided for in Article 10(5) may be understood to include keeping that Office updated with any relevant event concerning the said international registration. Moreover, since confidentiality of the international

registration is one of the key considerations within the framework of Article 10(5), the same consideration should apply in respect of distribution of any data relating to an unpublished international registration.

III. PROPOSAL FOR AMENDMENTS TO THE ADMINISTRATIVE INSTRUCTIONS

24. At present, none of the Contracting Parties to the 1999 Act has asked to receive confidential copies. It is, however, likely that the Offices of a few prospective Contracting Parties whose accessions appear imminent will make that request. For this reason, the manner and format of transmitting confidential copies should be established and the opportunity should be seized to clarify that the communication of any relevant data relating to the international registration recorded in the International Register before its publication will take place through the same mechanism.

MANNER AND FORMAT OF TRANSMITTING CONFIDENTIAL COPIES

25. Section 204(a)(ii) of the Administrative Instructions prescribes that electronic communications between an Office and the International Bureau may take place in a way agreed upon between the International Bureau and the Office concerned. The proposed new Section 901(a) provides that a confidential copy shall be transmitted to each Office by electronic means established *vis-à-vis* each Office, in accordance with Section 204(a)(ii). The only exception shall be the transmission of a specimen submitted to the International Bureau by the applicant (paragraph (b) of proposed Section 901). The transmission of such a specimen to each Office must take place in an appropriate manner.

26. It is recalled that concerns regarding possible additional costs involved in the transmission of confidential copies were raised during the Diplomatic Conference for the Adoption of a New Act of the Hague Agreement Concerning the International Deposit of Industrial Designs in 1999, and it was suggested that their transmission should take place through a foreseeable electronic communication method⁵.

UPDATING OF DATA CONCERNING AN INTERNATIONAL REGISTRATION

27. The proposed new Section 902 provides that updated data concerning an international registration shall be communicated to each Office that has received a confidential copy of the international registration through the mechanism to be established for confidential copies.

Cancellation Before Publication of the International Registration

28. As explained in paragraph 12 of the present document, if the international registration is cancelled in accordance with Rule 16(5), the international registration will not be published in the Bulletin. The purpose of proposed new Section 902(a) is to inform the Offices of all the designated Contracting Parties which have received a confidential copy of the international registration of such a cancellation.

⁵ See paragraphs 408 and 409 of the Summary Minutes of the Diplomatic Conference for the Adoption of a New Act of the Hague Agreement Concerning the International Deposit of Industrial Designs.

Change Before Publication of the International Registration

29. Furthermore, as explained in paragraph 10 of the present document, if the international registration has been the subject of any change recorded in the International Register pursuant to Rule 21(1)(a) before the publication of the international registration, the recording of such a change will only be published at the same time as the publication of the international registration. Thus, the purpose of paragraph (b) of proposed new Section 902 is to inform the Office of a designated Contracting Party that has received a confidential copy of the international registration of any change relevant to that Contracting Party upon its recording in the International Register.

30. Rule 21(1)(a) provides for the recording in the International Register of (i) a change in ownership, (ii) a change in the name or address of the holder, (iii) a renunciation, and (iv) a limitation. If the recorded renunciation concerns one or more of the designated Contracting Parties, that recording will be communicated to the Offices of those Contracting Parties whose designations have been renounced. This is also the case where the recorded limitation concerns one or more of the designated Contracting Parties. Likewise, if the international registration has been transferred in respect of one or more of the designated Contracting Parties, the recording of such a partial change in ownership will be communicated only to the Offices of those Contracting Parties whose designations have been the subject of transfer.

Correction Before Publication of the International Registration

31. Finally, as explained in paragraph 11 of the present document, the purpose of proposed new Section 902(c) is to inform the Offices of designated Contracting Parties that have received a confidential copy of the international registration of any correction effected before the publication of the international registration, unless the correction only concerns the designations of other Contracting Parties. For instance, if the name of the holder is corrected, such a correction would normally be communicated to the Offices of all the designated Contracting Parties. On the other hand, the correction of a limitation is only relevant to the Contracting Parties that were originally concerned by that limitation. In such a case, the correction will be communicated only to the Offices concerned that have already received an update concerning the recording of a limitation following the receipt of a confidential copy.

32. The proposed new Section 902(d) is to ensure that the communication of any relevant data relating to the international registration provided for in Section 902 takes place in the same manner and format as provided for in Section 901(a).

PROPOSAL FOR COMMUNICATION MECHANISMS

Hague Office Portal (HOP)

33. An international registration and relevant data relating to the international registration are notified to the Office of a designated Contracting Party through their publication. This principle is enshrined in Articles 10(3)(b), 16(4) and 17(5) of the 1999 Act and in Rule 26(1)(i) and (3) of the Common Regulations and should remain. From a technical point of view, however, with a view to facilitating individual and interactive communications, it is foreseen that communications between the International Bureau and the Office of a Contracting Party will mainly take place electronically, namely, through the "Hague Office Portal" (hereinafter referred to as the "HOP").

34. This web-based communication service could be used to distribute a confidential copy of an international registration to the Office of a designated Contracting Party that has expressed a wish to receive such a copy, and to keep the Office updated regarding any relevant event in respect of the international registration concerned before its publication. Indeed, the HOP is intended to serve as a main communication tool between the International Bureau and an Office throughout the life of an international registration, thus both before and after its publication in the Bulletin.

Secure FTP Server

35. The International Bureau's Secure FTP server (SFTP), would offer a tailored solution for the distribution of confidential copies and subsequent updates. The access to the data of the SFTP would be tailored for each Office, consisting only of international registrations designating its Contracting Party. The service would allow for the automatic downloading of all the information concerning the said international registrations (including confidential copies and their updates) into the IT system of that Office on a weekly basis. The data format for the confidential copies would be the same as that being used for the notification of published international registrations and their subsequent modifications. The SFTP service and the HOP are envisioned as complementary distribution channels⁶.

36. *The Working Group is invited to comment on the above, indicate whether it considers favorably a proposal to add a new Part Nine, consisting of Sections 901 and 902, to the Administrative Instructions, and comment on the text as provided in the draft contained in the Annex hereto.*

IV. NEXT STEPS: ENTRY INTO FORCE OF THE PROPOSED AMENDMENTS TO THE ADMINISTRATIVE INSTRUCTIONS

37. Pursuant to Rule 34(3)(a), any amendments to the Administrative Instructions are to be published on the web site of the Organization. Publication is made through an Information Notice published by the International Bureau. Furthermore, in accordance with Rule 34(3)(b), each publication shall specify the date on which the published provisions become effective. In that regard, it is recalled that document H/A/32/2, entitled "Matters Concerning the Legal Development of the Hague System", to be discussed in the Hague Union Assembly in 2013, already contains proposals, considered desirable by the second session of the Working Group, to amend Section 202 of the Administrative Instructions and add new Section 205 thereto, the proposed date of entry into force being January 1, 2014. Should the Working Group agree on the current proposal to add a new Part Nine to the Administrative Instructions, the Working Group may further recommend that its date of entry into force be aligned with the proposed date of entry into force of proposed Sections 202 and 205 of the Administrative Instructions, i.e. January 1, 2014.

⁶ See document H/LD/WG/3/4, entitled "Digital Access Service for Priority Documents and Other Means of Transmission of Certain Types of Documents Under Rule 7(5)(f) and (g) of the Common Regulations", paragraphs 8 to 10.

38. If the Working Group considers favorably the proposal in paragraph 36 of the present document, it is further invited to comment on the proposed date of January 1, 2014, when Part Nine of the Administrative Instructions, consisting of Sections 901 and 902, would become effective.

[Annex follows]

[...]

Part Nine Confidential Copies

Section 901: Transmission of Confidential Copies

(a) The confidential copy of an international registration provided for under Article 10(5) of the 1999 Act shall be transmitted to any Office concerned by electronic means in accordance with Section 204(a)(ii).

(b) Notwithstanding paragraph (a) above, a specimen submitted to the International Bureau pursuant to Rule 10(1)(ii) shall be transmitted in an appropriate manner.

Section 902: Updating of Data Concerning the International Registration

(a) Where the international registration referred to in Section 901(a) is cancelled pursuant to Rule 16(5), that cancellation shall be communicated to any Office that has received a confidential copy of the said international registration.

(b) Where, with respect to the international registration referred to in Section 901(a), a change is recorded in the International Register pursuant to Rule 21(1)(a) before the publication of the said international registration, that change shall be communicated to any Office that has received a confidential copy of the international registration, except where the change is specific to the designations of other Contracting Parties.

(c) Paragraph (b) shall apply to any correction effected under Rule 22(1) before the publication of the international registration.

(d) Any cancellation, change or correction referred to in this section shall be communicated in the same manner as provided for in Section 901(a).

[End of Annex and of document]