

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

**Fourth Session
Geneva, June 16 to 18, 2014**

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. At its third session, which convened from October 28 to 30, 2013, 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” respectively) 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 following a procedure before the Office of a designated Contracting Party¹.

2. The Working Group agreed that amendments to an industrial design following a procedure before an Office should be made publicly available in a centralized manner. The Working Group further requested the International Bureau to prepare a document analyzing the possible introduction of a feedback mechanism into the Hague system to this effect (hereinafter referred to as the “Feedback Mechanism” for the purpose of the present document). Accordingly, the

¹ See documents H/LD/WG/3/5, entitled “Public Availability of Information relating to Amendments to an Industrial Design that is the Subject of an International Registration Following a Procedure Before the Office of a Designated Contracting Party” and H/LD/WG/3/8 Prov., entitled “Draft Report”, paragraphs 85 to 102, both available on the WIPO web site at http://www.wipo.int/meetings/en/details.jsp?meeting_id=29704.

comments made at the third session of the Working Group, as well as the mechanism under the Madrid System for the International Registration of Marks (hereinafter referred to as “the Madrid system”) and the information made available in the ROMARIN database, would be taken into account.

3. It is recalled that Article 14(2)(c) of the 1999 Act provides that the effect given to the international registration under Article 14(1), (2)(a) and (b) shall apply to the industrial design as received from the International Bureau by the Office of a designated Contracting Party or, where applicable, “as amended in a procedure before that Office”. The aim of the present document is to establish the Feedback Mechanism for such amendments to be communicated to the International Bureau by the Office of a designated Contracting Party and to be made publicly available in a centralized manner by the International Bureau.

II. MECHANISM ADOPTED UNDER THE MADRID SYSTEM

LEGAL FRAMEWORK

4. In general, the scope of a trademark right is determined by the mark itself and a list of goods and/or services for which the trademark is registered and/or used. Under the Madrid system, protection may be granted to a trademark that is the subject of an international registration for the list of goods and/or services as amended following a procedure before the Office of a designated Contracting Party².

5. Rule 18^{ter} of the Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement (hereinafter referred to as “the Madrid Common Regulations”, “the Madrid Agreement” and the “Madrid Protocol” respectively) provides for a Feedback Mechanism concerning such an amendment to the list of goods and/or services³.

² Under the Madrid system, an amendment to the list of goods and/or services is also possible by presenting to the International Bureau a request for the recording in the International Register of a limitation of the list of goods and/or services, in accordance with Rule 25(1)(a)(ii) of the Madrid Common Regulations. Such a limitation may concern all or some of the designated Contracting Parties at the discretion of the holder of the international registration.

³ Rule 18^{ter}, “Final Disposition on Status of a Mark in a Designated Contracting Party” of the Madrid Common Regulations reads as follows:

(1) [*Statement of Grant of Protection Where No Notification of Provisional Refusal Has Been Communicated*] When, before the expiry of the period applicable under Article 5(2) of the Agreement or Article 5(2)(a), (b) or (c) of the Protocol, all procedures before an Office have been completed and there is no ground for that Office to refuse protection, that Office shall, as soon as possible and before the expiry of that period, send to the International Bureau a statement to the effect that protection is granted to the mark that is the subject of the international registration in the Contracting Party concerned.

(2) [*Statement of Grant of Protection Following a Provisional Refusal*] Except where it sends a statement under paragraph (3), an Office which has communicated a notification of provisional refusal shall, once all procedures before the said Office relating to the protection of the mark have been completed, send to the International Bureau either

(i) a statement to the effect that the provisional refusal is withdrawn and that protection of the mark is granted, in the Contracting Party concerned, for all goods and services for which protection has been requested, or

(ii) a statement indicating the goods and services for which protection of the mark is granted in the Contracting Party concerned.

(3) [*Confirmation of Total Provisional Refusal*] An Office which has sent to the International Bureau a notification of a total provisional refusal shall, once all procedures before the said Office relating to the protection of the mark have been completed and the Office has decided to confirm

[Footnote continued on next page]

6. If the Office of a designated Contracting Party has communicated a notification of provisional refusal in accordance with Article 5(1) of the Madrid Agreement or of the Madrid Protocol, the Office must send to the International Bureau either of the following statements, once all procedures before the said Office have been completed:

- statement of grant of protection following a provisional refusal in accordance with Rule 18*ter*(2), or
- confirmation of total provisional refusal in accordance with Rule 18*ter*(3).

7. In the event of an amendment to the list of goods and/or services, a statement of grant of protection must indicate the goods and/or services for which protection is granted in the Contracting Party concerned, pursuant to subparagraph (ii) of Rule 18*ter*(2). Accordingly, any amendment to the list of goods and/or services will be communicated to the International Bureau.

8. For their part, the Madrid Common Regulations do not have a provision requiring an indication of the goods and/or services for which protection is granted in the Contracting Party concerned, where no notification of provisional refusal has been communicated (see Rule 18*ter*(1)). This might be explained by an underlying assumption that an amendment to the list of goods and/or services would normally take place following a provisional refusal.

9. If the International Bureau receives the statement referred to in Rule 18*ter*(2) above, it stores it as a PDF document and makes it available in the Gazette and ROMARIN.

THE MADRID GAZETTE AND ROMARIN

10. The Gazette is the sole official source and facility for publishing relevant data set out in Rule 32(1) of the Madrid Common Regulations. Its purpose is to publish those relevant data in a timely manner, i.e. immediately after a given transaction is recorded in the International Register. The Gazette can be searched by the number of the international registration, the name of the holder, or the name of the trademark. It can also be browsed by chapter; readers are invited to select a transaction of interest to them. If, for instance, “statement of grant of protection following a provisional refusal (Rule 18*ter*(2))” is selected, a list of international registrations with respect to which the said statement is published in a given edition will be displayed. Readers can also view a PDF document of the statement issued by the Office of the designated Contracting Party concerned which should contain an amended list of goods and/or services.

[Footnote continued from previous page]

refusal of the protection of the mark in the Contracting Party concerned for all goods and services, send to the International Bureau a statement to that effect.

(4) *[Further Decision]* Where, following the sending of a statement in accordance with either paragraph (2) or (3), a further decision affects the protection of the mark, the Office shall, to the extent that it is aware of that decision, send to the International Bureau a further statement indicating the goods and services for which the mark is protected in the Contracting Party concerned.

(5) *[Recording, Information to the Holder and Transmittal of Copies]* The International Bureau shall record any statement received under this Rule in the International Register, inform the holder accordingly and, where the statement was communicated, or can be reproduced, in the form of a specific document, transmit a copy of that document to the holder.

11. The Gazette is designed to display only the transactions recorded and processed for publication in a given edition (weekly batch and one-off information). The ROMARIN⁴ database contains information regarding all international registrations that are currently in force in the International Register or have expired within the past six months. It 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. ROMARIN facilitates a search of international registrations by the users of the Madrid system. The users may view a scanned copy of every single notification or statement ever sent to the International Bureau by the Offices of designated Contracting Parties with respect to a given international registration.

III. ANALYSIS

TYPES OF AMENDMENTS OF INDUSTRIAL DESIGNS

12. It is recalled that, in order to foster 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 Union⁵. The purpose of the questionnaire was to gain a better understanding of 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. The International Bureau received replies to the questionnaire from 39 Offices, of which 25 were Offices of the members of the Hague Union⁶.

13. According to the answers received by the International Bureau as regards different types of amendments, 22 Offices allow the amendment of views or the submission of additional views. With respect to the contents of allowable amendments for drawings, under certain conditions some elements might 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 and/or by means of a declaration.

14. The survey further revealed that 10 Offices allow the amendment of the description or the submission of an additional description, including a disclaimer. Six Offices allow the amendment of the type of industrial design; for example, partial, principal or related design. Amendments to an indication of product or a claim were also mentioned.

15. All these types of amendments may concern the scope of the design right under the applicable law of a designated Contracting Party whose Office accepts the respective types of amendments.

⁴ ROMARIN stands for "Read-Only-Memory of Madrid Active Registry INformation". It is available at <http://www.wipo.int/romarin>.

⁵ 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).

⁶ See document H/LD/WG/3/5, available on the WIPO web site at http://www.wipo.int/meetings/en/doc_details.jsp?doc_id=247303.

TIMING OF AMENDMENT BEFORE OFFICE

16. A typical reason for requiring an amendment to the industrial design is to overcome refusal grounds. Such an amendment would take place in a procedure before the Office, normally within a set period following a notification of refusal. However, it is known that many jurisdictions allow the applicant to amend the industrial design immediately after the filing, with a view to putting the application document in order and forestalling a possible refusal.

17. Under the Madrid system, the applicant may seek protection in “other Contracting Parties” of a trademark which has already been registered, or whose registration has been applied for, at the Office of the Contracting Party with which the applicant has a certain connection (“Office of origin”). The Office of origin concept does not exist under the Hague system. The applicant may, and quite often does, designate his/her Contracting Party in an international application (“self-designation”)⁷. An international application may often be a first filing within the meaning of Article 4 of the Paris Convention for the Protection of Industrial Property.

18. It follows that, under the Hague system, following international publication, a certain procedure – for instance, *ex officio* examination – may take place in the Contracting Party in which the applicant is resident and with whose national procedure the applicant may be familiar. In some cases therefore, the applicant (the holder of the international registration) may wish to contact the Office of such a Contracting Party with a view to amending the industrial design. Such amendment may be filed in the local language, without appointing a representative. This situation is not envisaged under the Madrid system. However, in theory, an amendment may be requested directly from the Office of any designated Contracting Party which accepts it.

19. If the amendment is accepted by the Office (prior to notifying refusal), and the Office has not found any grounds for refusal, the likely consequence would be that protection is finally granted to the industrial design as amended, in the absence of a notification of refusal to the International Bureau. Thus, the Working Group may wish to consider whether an amendment made in the situations above should also be the subject of the Feedback Mechanism.

COMMUNICATION TO THE INTERNATIONAL BUREAU CONCERNING AMENDMENTS

20. The Feedback Mechanism aims to collect information concerning amendments to the industrial design for which protection is granted by the designated Contracting Party. Thus, such information would only be required by the International Bureau if and when the Office comes to a positive conclusion in the final disposition, i.e. granting protection to the industrial design as amended.

21. Hence, within the legal framework of the Hague system, a proper communication to convey the information concerning amendments would be composed of a statement of grant of protection as provided for in Rule 18*bis*(1) and (2) of the Common Regulations under the 1999 Act and the 1960 Act of the Hague Agreement (hereinafter referred to as the “Common Regulations”) and a notification of withdrawal of refusal as provided for in Rule 18(4).

22. The issuance of a statement of grant of protection under Rule 18*bis*(2) and a notification of withdrawal of refusal under Rule 18(4) is mandatory. In this regard, it is recalled that Article 12(4) of the 1999 Act provides that “any refusal may be withdrawn, in part or in whole, at any time by the Office that communicated it”, and Article 14(2)(b) provides for the effect as grant of protection under the applicable law where the Office has communicated a refusal and has subsequently withdrawn that refusal in part or in whole.

⁷ A Contracting Party whose Office is an examining Office may prohibit such self-designation in accordance with Article 14(3)(a) of the 1999 Act. However, no Contracting Party has made this declaration.

23. Rules 18(4) and 18*bis*(2) are in accordance with the above two provisions of the 1999 Act, intended to reflect in the International Register the final disposition on the status of the industrial design where refusal is withdrawn in part or in whole. The difference between those two Rules is only the “form” of communication⁸. Withdrawal of refusal is not provided for in the Hague (1960) Act. However, as a matter of course, a refusal may be withdrawn under the said Act and Rule 18(4) or 18*bis*(2) would apply accordingly, at the discretion of the Office of a designated Contracting Party.

24. The issuance of a statement of grant of protection under Rule 18*bis*(1) is optional. The purpose of sending this positive statement within the applicable refusal period is to notify the holder of the international registration that protection has been (or will be) granted in the designated Contracting Party as soon as a certain procedure is completed at the Office. Otherwise, the status of the industrial design in that designated Contracting Party would be determined according to the “tacit acceptance” principle, i.e. that no refusal having been sent within the applicable refusal period, it is considered that the international registration shall have the same effect as a grant of protection for the industrial design under the law of that Contracting Party, at the latest from the expiry date of the refusal period or the time specified in the declaration made under Rule 18(1)(c)(i) or (ii).

25. However, as explained in paragraph 19 above, protection may be granted to the industrial design as amended by the holder of an international registration who has not received a notification of refusal through the International Bureau.

26. Thus, if the Feedback Mechanism were to fully rely on a statement of grant of protection under Rule 18*bis*(1) and (2) and a notification of withdrawal of refusal under Rule 18(4) as communication methods, the International Bureau would need to receive a statement of grant of protection under Rule 18*bis*(1) if there was an amendment in a procedure before the Office.

27. Furthermore, the applicable period within which the above statement could be issued would have to be reviewed for the purposes of designating a Contracting Party which has opted for subparagraph (i) or (ii) of Rule 18(1)(c). If the Contracting Party has made a declaration under either of the above Rules, an international registration may produce the effect referred to in Article 14(2)(a) of the 1999 Act after the expiry date of the applicable refusal period in the territory of that Contracting Party. It follows that, in some cases, the Office would be in a position to confirm that protection was granted to the industrial design as amended, and to communicate the information concerning the amendments, only be after the expiry date of the refusal period.

28. As explained in paragraphs 12 to 15 above, the type of possible amendments varies. This may affect the scope of the design right under the applicable law of the Contracting Party concerned. As long as the amendment affects the scope of the design right, for the sake of a third party, it might be preferable for all amended elements to be included in a communication to the International Bureau.

⁸ When adopting Article 12(4), Article 14(2)(b) and Rule 18(4), the Diplomatic Conference understood that a withdrawal of refusal by an Office that has communicated a notification of refusal could take the form of a statement to the effect that the Office concerned had decided to accept the effects of the international registration in respect of all or some of the industrial designs which were the subject of the notification of refusal. It was also understood that an Office could, within the period allowed for communicating a notification of refusal, send a statement to the effect that it has decided to accept the effects of the international registration even where it had not communicated such a notification of refusal.

29. As to the subject matter of the information concerning amendments, the Office may, in some cases, or according to the applicable law and/or its practice, wish to notify all the information concerning the industrial design as amended, i.e. its reproductions and all other relevant elements, to the International Bureau, rather than indicating the amended element(s) separately. Thus, it might be preferable for the Office to include in its communication either all amended elements or all the information concerning the industrial design as amended, at its discretion.

MAKING INFORMATION CONCERNING AMENDMENTS PUBLICLY AVAILABLE

30. Any withdrawal of refusal issued pursuant to Rule 18(4) and any statement of grant of protection issued pursuant to Rule 18*bis*(1) or (2) shall be recorded in the International Register and published in the *International Designs Bulletin* (hereinafter referred to as “the Bulletin”)⁹. Thus, the information can be accessed not only by the holder of the international registration but also by a third party. However, from the Bulletin, a third party is merely able to know the fact that the refusal was withdrawn, or alternatively, a statement of grant of protection was issued, and, if only some of the industrial designs were accepted, the numbers of the accepted industrial designs. A scanned copy of such a notification or statement received from an Office is not available through the Bulletin at present.

31. As explained in paragraphs 28 and 29 above, different types of amendments might be communicated to the International Bureau. Moreover, the subject matter of the information concerning amendments (either all amended elements or all the information concerning the industrial design as amended) should be at the discretion of the Office communicating them. Consequently, the information concerning amendments that the International Bureau would be receiving might not always be types of data that could easily and systematically be captured and integrated into the database.

32. Thus, the surest and most pragmatic solution to make the information concerning amendments publicly available would be to simply upload a scanned copy of the notification or statement as received from the Office and to make it available through the Bulletin.

33. Moreover, the Hague Express¹⁰ Database (hereinafter referred to as “the Hague Express”) is currently being modified to provide users with more information, notably by featuring all transactions affecting international registrations. A scanned copy of any notification of refusal or of its withdrawal, or of any statement of grant of protection received from an Office should also be available through the Hague Express simultaneously with its publication in the Bulletin.

EFFECTIVE DATE OF GRANT OF PROTECTION

34. It is recalled that Article 14(2)(b) provides that where the Office of a designated Contracting Party has communicated a refusal and has subsequently withdrawn, in part or in whole, that refusal, the international registration shall have the same effect in that Contracting Party as a grant of protection under the applicable law at the latest from the date on which the refusal was withdrawn.

⁹ See Rules 18(5), 18*bis*(3) and 26(1)(ii) of the Common Regulations.

¹⁰ The Hague Express Database contains all international registrations that have been recorded in the International Register and published in the Bulletin as of issue No. 1/1999.

35. In this regard, Rules 18(4) and 18*bis*(2) respectively require an indication of “the date on which the refusal was withdrawn” and “the date of the statement”. In accordance with Article 14(2)(b), these dates indicate that the international registration produced the effect as a grant of protection in that Contracting Party on or before those dates. However, the exact date on which the international registration produced the above effect is not clear.

36. Moreover, Article 14(2)(a) provides that, in each designated Contracting Party the Office of which has not communicated a refusal, the international registration shall have the same effect as a grant of protection under the applicable law at the latest from the date of expiration of the refusal period or, where a Contracting Party has made a corresponding declaration under the Regulations, at the latest at the time specified in that declaration. Accordingly, the Common Regulations provide for two options: Rule 18(1)(c) (i) and (ii).

37. The date on which the international registration produces the effect as a grant of protection in the Contracting Party concerned depends on its applicable law, but must be in compliance with Article 14(2)(a). However, within the present legal framework of the Hague system, neither the holder of the international registration nor a third party would be able to know the exact date on which the international registration produced the effect as a grant of protection in a designated Contracting Party whose Office did not issue a refusal. There is no other way but to rely on the “tacit acceptance” principle set out in paragraph 24 of the present document.

38. Furthermore, as it currently stands, Rule 18*bis*(1) does not require the inclusion in the statement of the date on which the international registration produced the effect as a grant of protection under the applicable law. Thus, the uncertainty persists even where a statement of grant of protection is issued in accordance with Rule 18*bis*(1).

39. The date on which the international registration produced the effect as a grant of protection under the applicable law is not the subject matter of an amendment as such, but that date appears to be important not only for the holder of the international registration but also for third parties. Thus, the opportunity may be seized to make it possible for the Office to notify such a date through a notification of withdrawal of refusal issued pursuant to Rule 18(4) or a statement of grant of protection issued pursuant to Rule 18*bis*(1) or (2).

CONSIDERATION FOR CONTRACTING PARTIES OPTING FOR RULE 18(1)(C)(I) OR (II)

40. It should be recalled that, as explained previously in paragraph 27, in order for the Feedback Mechanism to function, it would be necessary to review the applicable period within which a statement of grant of protection could be issued under Rule 18*bis*(1), for the purpose of a designation of a Contracting Party having opted for Rule 18(1)(c)(i) or (ii).

41. In this regard, it is recalled that Rule 18(1)(c)(i) provides for a maximum period of six months with effect from the expiry date of the applicable refusal period. It follows that, in some cases, the international registration could produce the effect as a grant of protection just before the lapse of the 18-month period running from the publication of the international registration on the Bulletin, i.e. the 12-month refusal period plus the six-month period allowable under that Rule.

42. Furthermore, Rule 18(1)(c)(ii) does not specify any time frame, even though its application should be limited to certain exceptional circumstances¹¹.

¹¹ See paragraph 909 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 (Records of the Diplomatic Conference, page 493).

43. In view of the foregoing, it would be appropriate for the applicable period referred to in Rule 18*bis*(1) to be amended in line with Rule 18(1)(c)(i) and (ii), where either of these Rules applies. Otherwise, no information concerning amendments to the industrial design could be communicated to the International Bureau after the applicable refusal period. In contrast, if a notification of refusal has been sent to the International Bureau, then the application of Rule 18(1)(c)(i) or (ii) is moot. Information concerning amendments to the industrial design should be communicated to the International Bureau pursuant to either Rule 18(4) or Rule 18*bis*(2) (provided that these Rules are amended as proposed), both of which are not bound by any time limit.

44. In relation to reviewing the said applicable period, the Working Group may wish to further consider making it compulsory for the Office of a designated Contracting Party having made a declaration under Rule 18(1)(c)(i) or (ii) to issue a statement of grant of protection under Rule 18*bis*(1), even where there was no amendment to the industrial design.

45. In this regard, Rule 18(1)(c)(ii) refers to the situation “where a decision regarding the grant of protection was unintentionally not communicated within the applicable refusal period”. It is thus assumed that only the Contracting Party willing to send a statement of grant of protection pursuant to Rule 18*bis*(1), would make the above declaration. In other words, systematical sending of the above statement or, if it is not communicated through the International Bureau, of a similar kind directly to the holder of an international registration is *a priori*¹².

46. As regards Rule 18(1)(c)(i), if the Office of a designated Contracting Party having made this declaration did not issue a statement of grant of protection under Rule 18*bis*(1), neither the holder of the international registration nor a third party would be able to know when the international registration had produced or would produce the effect as a grant of protection, even after the expiry of the refusal period. That situation could last until the lapse of the 18-month period counted from the publication of the international registration in total¹³.

SINGLE STATEMENT FOR SINGLE DESIGN

47. It is recalled that one of the major advantages of the Hague system is to be able to include in a single international application up to 100 industrial designs that belong to the same Locarno class. Unlike Rules 18(4) and 18*bis*(2) however, Rule 18*bis*(1) in its current form does not expressly allow the Office to send an individual statement of grant of protection for each of the industrial designs that are the subject of the international registration.

48. The purpose of sending a statement of grant of protection under Rule 18*bis*(1) is to notify the holder of the international registration that protection has been (or will be) granted in the designated Contracting Party as soon as a certain procedure is completed at the Office. Third parties would also be able to know this through the publication of the statement of grant of protection on the Bulletin.

49. The Office of the designated Contracting Party should therefore be able to send a statement of grant of protection as soon as the procedure for any one of the industrial designs is completed.

¹² Only the Republic of Korea has made a declaration under Rule 18(1)(c)(ii). The 1999 Act will come into force on July 1, 2014 in that country.

¹³ Spain and Turkey have made a declaration under Rule 18(1)(c)(i).

IV. PROPOSAL FOR AMENDMENTS TO THE COMMON REGULATIONS

50. The issues described in the foregoing paragraphs require amendments to Rules 18 and 18*bis* of the Common Regulations, as proposed below.

RULE 18(4)

51. Rule 18(4) provides for the notification of a withdrawal of refusal. Subparagraph (b) deals with its contents. Proposed new subparagraph (b)(iv) requires an indication of the date on which the international registration produced the effect as a grant of protection under the applicable law, which may be different from the date on which the refusal was withdrawn.

52. If the Contracting Party is designated under the 1999 Act, the grant of protection date should be the same as, or earlier than, the date of withdrawal of refusal, in accordance with Article 14(2)(b) of the 1999 Act. If the Contracting Party is designated under the 1960 Act, the grant of protection date should be the date of the international registration, in accordance with Article 8(1), second sentence, of the 1960 Act. Otherwise, if the Contracting Party is a State which performs a novelty examination, the grant of protection date may be in accordance with the applicable law but may not be after the expiration of the six-month refusal period, in accordance with Article 8(1), third sentence, of the 1960 Act.

53. Proposed new subparagraph (c) requires that the notification of withdrawal of refusal shall contain or indicate either all the amended elements or the whole information concerning the industrial designs as amended, at the discretion of the Office, if the industrial designs concerned were amended in a procedure before the Office. This subparagraph (c) should serve as the main provision to implement the proposed Feedback Mechanism as outlined in the present document. It refers to the "international registration", as opposed to the "industrial design", since the amendment may pertain to any relevant element concerning the international registration, such as "description", that is not the industrial design itself.

54. If the information concerning amendments relates to one of the elements in the contents of the international registration, the notification should indicate the element to which the amendment relates. For instance, if one of the reproductions was replaced with a new reproduction in a procedure before the Office, the notification should state the number of the reproduction replaced and include the new reproduction. Alternatively, the Office may include in the notification all the information concerning the industrial design as amended and accepted. For instance, if the whole industrial design as amended and accepted has been published together with all relevant information in the national gazette, the notification may simply contain its extract.

RULE 18*BIS*(2)

55. Rule 18*bis*(2) provides for a statement of grant of protection following a refusal. An Office which has communicated a notification of refusal may send a statement of grant of protection pursuant to this Rule, instead of notifying a withdrawal of refusal in accordance with Rule 18(4). Accordingly, subparagraph (b) of Rule 18*bis*(2) which provides for the contents of the statement echoes subparagraph (b) of Rule 18(4). Thus, the same amendments are proposed to add a new item (iv) in subparagraph (b), in addition to the creation of new subparagraph (c) for the same new requirement.

RULE 18B/S(1)

56. Rule 18*bis*(1) provides for a statement of grant of protection where no notification of refusal has been communicated. New subparagraphs (b)(iv) and (c) are proposed in line with the proposed amendments to Rules 18(4) and 18*bis*(2). The wording of proposed new item (iv) in subparagraph (b) of this Rule is, however, slightly different from the proposed corresponding items in Rule 18(4)(b) and 18*bis*(2)(b) respectively. This comes from the different conditions provided for in Article 14(2)(a) and (b) respectively in the 1999 Act. Article 14(2)(a) provides that the international registration shall have the same effect as a grant of protection under the applicable law at the latest from the date of expiration of the refusal period, while under Rule 18*bis*(1), an Office is supposed to send a statement of grant of protection before the date of expiration of the refusal period, and preferably as soon as it has come to a positive conclusion. This flexibility in the proposed text is also required to be compatible with Article 8(1), third sentence, of the 1960 Act.

57. If, at the time of sending the statement, the international registration has not yet produced the effect as a grant of protection, the Office should indicate the date on which the international registration shall produce the effect as a grant of protection under the applicable law, pursuant to proposed new subparagraphs (b)(iv). Such a date should be, at the latest, the date of expiration of the applicable refusal period, or at the time specified in the declaration under Rule 18(1)(c)(i), if the designation is governed by the 1999 Act, and subject to the declaration.

58. The inclusion of proposed new item (iii) in subparagraph (b), as well as the proposed amendment to subparagraph (a), is intended to clarify that the Office may send a statement of grant of protection which concerns only one or some of the industrial designs that are the subject of the international registration.

59. Besides, both paragraphs (1) and (2) of Rule 18*bis* actually refer to the same notification of refusal. Thus, the opportunity is seized to delete the term “provisional” from the title of Rule 18*bis*(1) in order to avoid any confusion.

60. Proposed new subparagraph (c) corresponds to new subparagraph (c) of Rule 18(4) and of Rule 18*bis*(2) respectively. Unlike the latter two subparagraphs however, this subparagraph refers to “amendments in a procedure before the Office initiated by the holder of the international registration”. Rule 18(4) or Rule 18*bis*(2) applies where the Office has communicated a notification of refusal and has decided to withdraw the refusal in part or in whole. Thus, it is clearly apparent that the holder of the international registration was involved in a procedure which resulted in the amendments in question. In contrast, Rule 18*bis*(1) applies where the Office has not communicated a notification of refusal. The proposed wording is merely to emphasize that the amendments in question should be as a result of the holder’s voluntarily action or consent. The same expression is also used in proposed new subparagraph (d) for the same reason.

61. Proposed new subparagraph (d) aims to make it compulsory for the Office to send a statement of grant of protection if its Contracting Party has made a declaration either under Rule 18(1)(c)(i) or (ii). This new subparagraph also makes it compulsory for the Office to send the statement if protection is granted to the industrial design following amendments in a procedure before the Office. This is to ensure that the proposed Feedback Mechanism fulfills its purpose in all instances.

62. The inclusion of new subparagraph (e) is proposed to clarify that the applicable period within which the statement of grant of protection may be sent shall be extended, where either Rule 18(1)(c)(i) or (ii) applies, as the case may be. This amendment would be necessary in conjunction with the proposal to establish new subparagraph (d).

63. *The Working Group is invited to indicate whether it considers favorably the method of making amendments publicly available set forth in paragraphs 32 and 33.*

64. *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 18(4), and Rule 18bis(1) and (2), as provided in the draft contained in the Annex hereto, with a date of entry into force of January 1, 2015, to the Assembly of the Hague Union and to further comment on the said draft.*

[Annex follows]

**Common Regulations
Under the 1999 Act and the 1960 Act
of the Hague Agreement**

(as in force on [January 1, 2015])

*Rule 18
Notification of Refusal*

[...]

(4) [*Notification of Withdrawal of Refusal*] (a) The notification of any withdrawal of refusal shall relate to one international registration, shall be dated and shall be signed by the Office making the notification.

(b) The notification shall contain or indicate

- (i) the Office making the notification,
- (ii) the number of the international registration,
- (iii) where the withdrawal does not relate to all the industrial designs to

which the refusal applied, those to which it relates or does not relate, ~~and~~
(iv) the date on which the international registration produced the effect as a grant of protection under the applicable law, and

~~(iv)~~ the date on which the refusal was withdrawn.

(c) Where the international registration was amended in a procedure before the Office, the notification shall also contain or indicate all amendments.

[...]

*Rule 18bis
Statement of Grant of Protection*

(1) [*Statement of Grant of Protection Where No Notification of Provisional Refusal Has Been Communicated*] (a) An Office which has not communicated a notification of refusal may, within the period applicable under Rule 18(1)(a) or (b), send to the International Bureau a statement to the effect that protection is granted to the industrial designs, or some of the industrial designs, as the case may be, that are the subject of the international registration in the Contracting Party concerned, it being understood that, where Rule 12(3) applies, the grant of protection will be subject to the payment of the second part of the individual designation fee.

(b) The statement shall indicate

- (i) the Office making the statement,
- (ii) the number of the international registration, ~~and~~
- (iii) where the statement does not relate to all the industrial designs that are the subject of the international registration, those to which it relates,

(iv) the date on which the international registration produced or shall produce the effect as a grant of protection under the applicable law, and

(v) the date of the statement.

(c) Where the international registration was amended in a procedure before the Office initiated by the holder of the international registration, the statement shall also contain or indicate all amendments.

(d) Notwithstanding subparagraph (a), where Rule 18(1)(c)(i) or (ii) applies, as the case may be, or where protection is granted to the industrial designs following amendments in a procedure before the Office initiated by the holder of the international registration, the said Office must send to the International Bureau the statement referred to in subparagraph (a).

(e) The applicable period referred to in subparagraph (a) shall be the period allowed pursuant to Rule 18(1)(c)(i) or (ii), as the case may be, to produce the effect as a grant of protection under the applicable law, with respect to a designation of Contracting Party having made a declaration under either of the aforementioned Rules.

(2) [*Statement of Grant of Protection Following a Refusal*] (a) An Office which has communicated a notification of refusal and which has decided to either partially or totally withdraw such refusal, may, instead of notifying a withdrawal of refusal in accordance with Rule 18(4)(a), send to the International Bureau a statement to the effect that protection is granted to the industrial designs, or some of the industrial designs, as the case may be, that are the subject of the international registration in the Contracting Party concerned, it being understood that, where Rule 12(3) applies, the grant of protection will be subject to the payment of the second part of the individual designation fee.

(b) The statement shall indicate

(i) the Office making the notification,

(ii) the number of the international registration,

(iii) where the statement does not relate to all the industrial designs that are the subject of the international registration, those to which it relates or does not relate, ~~and~~

(iv) the date on which the international registration produced the effect as a grant of protection under the applicable law, and

(v) the date of the statement.

(c) Where the international registration was amended in a procedure before the Office, the statement shall also contain or indicate all amendments.

[...]

[End of Annex and of document]