

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

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PROPOSAL FOR AMENDMENTS TO RULE 3 OF THE COMMON REGULATIONS

Document prepared by the International Bureau

I. BACKGROUND

SUBMISSION OF A POWER OF ATTORNEY

1. Pursuant to Rule 3(2)(a) and (b) of the Common Regulations Under the 1999 Act and the 1960 Act of the Hague Agreement (hereinafter referred to as the “Common Regulations”), the appointment of a representative before the International Bureau may be made in the international application form, provided that the application is signed by the applicant, or in a separate communication (“power of attorney”)¹ which may relate to one or more specified international applications of the same applicant, and must be signed by the applicant.

2. Where the international application is filed by a representative, the application form, in electronic or paper format, is normally signed by the representative. In particular, the electronic application is usually filed through the user account of the representative and is, therefore, more likely to bear the signature of that representative. In 2017, 4,809 international applications were filed electronically, of which 4,087 (85 per cent) were filed by representatives. Three hundred and seventy of these applications were not accompanied by a power of attorney.

¹ Form DM/7 may be used for appointing a representative before the International Bureau. However, its use is not mandatory.

II. OVERVIEW OF OTHER MAIN INTERNATIONAL SYSTEMS

PCT SYSTEM

Basic Requirement

3. Under the PCT System, different authorities exist, such as a receiving Office, the International Searching Authority, the Authority specified for supplementary search, the International Preliminary Examination Authority and the International Bureau. The same Office or authority may perform several of these functions in their respective contexts. The International Bureau can act both as a receiving Office and in its own capacity.

4. However, for the purposes of the present document, only the PCT procedures before the International Bureau, in particular the filing of an international application with the International Bureau as a receiving Office, need to and will be considered, unless indicated otherwise.

5. Rule 90 of the Regulations under the PCT (hereinafter referred to as the “PCT Regulations”) provides for a representative, specifying the manner of appointment in Rule 90.4, as supplemented by Rule 90.5². PCT Rule 90.4(a) and (b) is basically similar to Hague Rule 3(2)(a) and (b) in requiring the signature of the applicant on the international application (“request”) or the submission of a separate power of attorney for the appointment of a representative.

6. Furthermore, PCT Rule 90.5(a) provides for the possibility of submitting a “general power of attorney”. If a power of attorney has been deposited with the receiving Office (*i.e.*, the International Bureau as such), the same representative may be appointed to file a subsequent international application, by referring to that power of attorney and attaching a copy thereof without the signature of the applicant. This rule came into effect on July 1, 1992³.

Waiver of the Requirement

7. Where such a “general power of attorney” has been deposited, Rule 90.5(c) provides for the possibility for any relevant authority to waive the requirement of attaching a copy of the deposited general power of attorney.

8. Moreover, Rule 90.4(d) provides for the possibility of waiving the requirement to submit a power of attorney. Accordingly, if the receiving Office has waived this requirement, a representative may file an international application without the signature of the applicant or an attached power of attorney signed by the applicant.

² PCT Rule 90.1 provides for “Appointment as Agent”. In the same context, the Hague System does not have any requirement as to professional qualification, nationality or domicile. PCT Rules 90.2 and 90.3 provide, respectively, for “Common Representative” and “Effects of Acts by or in Relation to Agents and Common Representatives”, while similar issues are handled by Hague Rule 3(1) and (4) and Section 302 of the Administrative Instructions for the Application of the Hague Agreement.

³ Refer to document PCT/A/XVIII/9.

9. Rules 90.4(d) and 90.5(c) came into effect on January 1, 2004, although they were not adopted at the same time⁴. The International Bureau waived the corresponding requirements, in its capacity as receiving Office, effective from January 1, 2004, and in its own capacity (i.e., as the International Bureau), effective from January 1, 2005⁵.

10. These waivers may specify particular instances in which a power of attorney is required. Like many other Offices (or authorities), the International Bureau still requires the submission of a power of attorney for the appointment of a representative who was not originally indicated in the international application. A list of Offices (or authorities) which have notified the International Bureau of waiver(s) of either, or both, of these requirements is available on the PCT website. Thirty-six Offices (or authorities) were listed as of March 2017⁶.

11. In 2017, the International Bureau received and processed 7,023 international applications filed by purported representatives, of which only 1,618 (23 per cent) were accompanied by a power of attorney, or a copy of a general power of attorney, thanks to the effects of the waivers made under Rules 90.4(d) and/or 90.5(c).

MADRID SYSTEM

12. Rule 3 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 Regulations”) provides for representation before the International Bureau.

13. When it comes to the appointment of a representative in an international application, Madrid Rule 3(2)(a) provides that such appointment may be made in the international application. In this regard, it is recalled that, pursuant to Madrid Rule 9(1), an international application must be presented to the International Bureau by the Office of origin. The application must be signed by the Office of origin and, where that Office so requires, also by the applicant (Madrid Rule 9(2)(b)).

14. Accordingly, the International Bureau does not handle powers of attorney for the appointment of a representative in an international application. However, the appointment of a representative not originally indicated as such in the application form has to be made in a separate communication (power of attorney), in accordance with Madrid Rule 3(2)(b).

III. CONSIDERATIONS

RELAXING THE REQUIREMENT AT THE TIME OF FILING

15. The requirement to submit a power of attorney duly signed by the applicant at the time of filing of the international application is often challenging for both representatives and applicants, especially when they have to meet strict deadlines to safeguard the applicant’s rights and interests. Where the international application, signed by a representative, is not accompanied by a power of attorney, the International Bureau sends an irregularity letter.

⁴ Refer to documents PCT/A/31/6 and PCT/A/32/4. Precisely speaking, the International Bureau waived the requirements pursuant to Rules 90.4(d) both in its capacity as receiving Office and in its own capacity, and the requirement pursuant to Rule 90.5(c) in its capacity as receiving Office.

⁵ Refer to PCT Newsletters No.1/2004 and No.12/2004. Refer also to the PCT Applicant’s Guide – International Phase – Annex B2.

⁶ Refer to the list of Offices (or authorities) which have notified WIPO of waiver(s) of the power of attorney requirement under PCT Rule 90.4(b) and/or 90.5(a)(ii).

16. The International Bureau received 5,213 international applications in 2017. In the same year, it sent 405 irregularity letters to representatives requiring them to submit a power of attorney, with 123 of those letters sent for that sole reason. All these irregularity cases were eventually resolved, showing that the formal sending of irregularity letters by the International Bureau served little purpose other than to satisfy the formal requirement of including a power of attorney in the file.

17. Furthermore, in the E-filing interface, a signature is provided simply by typing the full name of the applicant or representative. Thus, the manner of providing a signature has already and pragmatically been simplified. Yet, the possibility that somebody would file an application in the name of another person is deemed to be highly unlikely, and no such abuse has been reported to The Hague Registry so far.

18. All considered, relaxing the requirement to submit a power of attorney at the time of filing may be worth considering to alleviate the burden for users of the Hague System.

POSSIBLE APPROACHES

General Power of Attorney

19. Under the PCT System, a general power of attorney may be deposited with a receiving Office (PCT Rule 90.5(b)). The Hague System does not have the concept of a general power of attorney. Accordingly, the International Bureau does not have a depository function under the Hague System to store such documents. However, it has been a long-standing practice for the International Bureau to accept that a power of attorney attached to an international application need not be specific to that particular application (*i.e.*, accepting a copy of a *de facto* general power of attorney).

20. Thus, introducing the concept of a general power of attorney would not change the current practice, as long as the International Bureau continues to require the submission of its copy.

Waiver of the Requirement to Submit a Power of Attorney for Filing

21. As indicated above, under the PCT System, the International Bureau waived the requirement of a submission of a power of attorney in accordance with PCT Rule 90.4(d). The merit of a waiver lies in its optional nature, which gives each of the authorities a choice in the matter.

22. Rule 3 of the Hague Common Regulations provides only for representation before the International Bureau, excluding representation before the Office of a designated Contracting Party. In this regard, the waiver provided for in PCT Rule 90.4(d) is not an option for a designated Office to consider.

23. Under the Hague System, an international application is filed “with” the International Bureau. This is also the case with an indirect filing, since the Office of the applicant’s Contracting Party⁷ neither performs formal examination nor accords a filing date, leaving all such functions to the International Bureau⁸. In contrast, a Contracting Party may prohibit the

⁷ Article 1(xiv) of the 1999 Act provides that “applicant’s Contracting Party” means the Contracting Party or one of the Contracting Parties from which the applicant derives its entitlement to file an international application by virtue of satisfying, in relation to that Contracting Party, at least one of the conditions in Article 3.

⁸ To the knowledge of the International Bureau, however, “security clearance” is required by the laws of the Russian Federation and the United States of America. The security clearance is performed by their respective Offices, namely, the Federal Service for Intellectual Property (ROSPATENT) and the United States Patent and

[Footnote continued on next page]

filing of an international application through its Office, pursuant to Article 4(1)(b) of the 1999 Act⁹. Given this background, 95 per cent of international applications were filed directly with the International Bureau in 2017.

Amending the Rule in Order Not to Require a Power of Attorney for Filing

24. Given the above considerations, the requirement for appointing a representative in an international application may be reduced, to the same extent the International Bureau currently does in its capacity as receiving Office under the PCT System, through a waiver made under PCT Rule 90.4(d).

25. Furthermore, as it concerns only the International Bureau, this may be achieved by simply amending Hague Rule 3(2) in order not to require a power of attorney for appointing a representative in an international application.

IV. PROPOSAL

AMENDMENT TO RULE 3

26. It is proposed to amend the wording of subparagraph (2)(a) of Rule 3, as reproduced in the Annex to this document, as follows: “The appointment of a representative may be made in the international application. The representative named in the international application is deemed to be appointed by the applicant for all purposes relating to that application, including signing the application for the purpose of Rule 7(1).”

27. This proposed amendment will enable the International Bureau, pursuant to subparagraph (3)(a), to record the representative in the International Register, if his/her name and address are provided in the application form in accordance with Section 301 of the Administrative Instructions for the Application of the Hague Agreement, even if it is not signed by the applicant. Specifically, the phrase “including signing the application for the purpose of Rule 7(1)” is intended to clarify that the application may be signed by the representative.

28. Consequently, the International Bureau will consider that that person has been authorized by the applicant to file the application and to be recorded as the representative for subsequent procedures and the resulting international registration.

29. However, subparagraph (2)(b) of Rule 3 would remain unchanged so that, notwithstanding the above amendment, a power of attorney may accompany the international application if it is so preferred. More importantly, the appointment of a representative not initially indicated as such in the application form at the time of filing would need to be made in a separate communication (power of attorney), in accordance with this rule. This is in line with the particular instances in which the International Bureau requires a power of attorney or a copy of a general power of attorney, as the case may be, under the PCT System (refer to paragraph 10) and also with the Madrid System (Rule 3(2)(b)) (refer to paragraph 14).

[Footnote continued from previous page]

Trademark Office (USPTO). It is understood that the duty of security clearance is normally fulfilled by filing through the Office, but not necessarily.

⁹ As of this document, those Contracting Parties are: African Intellectual Property Organization (OAPI), Croatia, European Union, France, Latvia, Monaco, Montenegro, Slovenia, the former Yugoslav Republic of Macedonia, Ukraine, and the United Kingdom.

30. Finally, the proposed amendment only concerns the appointment of a representative in an international application. The appointment of a representative may also be made in the relevant official form to request the recording of a change (such as a change in ownership, a change in the name and/or address of the holder, or a limitation) or to request a renewal. In such cases, however, the form must be signed by the holder, or accompanied by a power of attorney (or form DM/7), and no change is proposed in this respect.

31. *The Working Group is invited to:*

(i) consider and comment on the proposal made in this document; and

(ii) indicate whether it would recommend to the Assembly of the Hague Union for adoption, the proposed amendments to the Common Regulations with respect to Rule 3 as provided in the draft contained in the Annex hereto, and suggest a date for its entry into force.

[Annex follows]

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

(as in force on [....., 2019])

[...]

Rule 3

Representation Before the International Bureau

[...]

(2) [*Appointment of the Representative*] (a) The appointment of a representative may be made in the international application, ~~provided that the application is signed by the applicant.~~ The representative named in the international application is deemed to be appointed by the applicant for all purposes relating to that application, including signing the application for the purpose of Rule 7(1).

(b) The appointment of a representative may also be made in a separate communication which may relate to one or more specified international applications or international registrations of the same applicant or holder. The said communication shall be signed by the applicant or the holder.

(c) Where the International Bureau considers that the appointment of a representative is irregular, it shall notify accordingly the applicant or holder and the purported representative.

[...]

[End of Annex and of document]