

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

Eighth Session
Geneva, October 30 to November 1, 2019

PROPOSAL FOR AMENDMENTS TO RULE 17 OF THE COMMON REGULATIONS

Document prepared by the International Bureau

I. BACKGROUND

TIMING OF PUBLICATION OF AN INTERNATIONAL REGISTRATION

1. Pursuant to Rule 17(1)(iii) of the Common Regulations Under the 1999 Act and the 1960 Act of the Hague Agreement (hereinafter referred to as the “Common Regulations”), an international registration is published six months after the date of the international registration or as soon as possible thereafter, unless the applicant requested immediate publication or a deferment of publication (Rule 17(1)(i) and (ii) of the Common Regulations).
2. In principle, publication of international registrations can be deferred for up to 12 months under the Hague (1960) Act of the Hague Agreement (hereinafter referred to as the “1960 Act”), or up to 30 months under the Geneva (1999) Act of the Hague Agreement (hereinafter referred to as the “1999 Act”), counted from the filing date or, where priority is claimed, from the priority date.
3. However, if the law of the Contracting Party to the 1999 Act provides for deferment of publication for a period shorter than 30 months, that Contracting Party may specify the allowable deferment period in a declaration under Article 11(1)(a) of the 1999 Act. Furthermore, if the law of the Contracting Party does not provide for deferment of publication, that Contracting Party may prohibit deferment of publication through a declaration under Article 11(1)(b) of the 1999 Act.

4. Consequently, if the international application designates, under the 1999 Act, “one” Contracting Party that has made a declaration under Article 11(1)(b) of the 1999 Act¹, the applicant cannot benefit from deferment of publication at all, in which case the international registration is published six months after the date of the international registration, unless the holder withdraws the designation of that Contracting Party. Either option is unsatisfactory for applicants who wish to use the Hague System to obtain the widest geographical coverage but need to keep their designs secret for a longer period for marketing reasons.

5. This document proposes to extend the six-month period of publication provided for in Rule 17(1)(iii) (hereinafter referred to as “standard publication”) to 12 months.

II. EXTENSION OF THE STANDARD PUBLICATION PERIOD

CURRENT SIX-MONTH PERIOD: HISTORICAL BACKGROUND

6. Rule 17 of the Common Regulations was adopted at the Diplomatic Conference for the Adoption of a New Act of the Hague Agreement Concerning the International Deposit of Industrial Designs (Geneva Act) (hereinafter referred to as the “Diplomatic Conference”) in 1999.

7. The six-month period for standard publication was suggested by the Committee of Experts on the Development of the Hague Agreement Concerning the International Deposit of Industrial Designs. That suggestion took into account the fact that “under some national and regional laws on the protection of industrial designs, a certain period of time lapses before the registration of an industrial design is published. The reason for this delay is that examination (whether it is formal or substantive) of a design application and the technical preparations for publication need time”².

8. The six-month period was chosen to “intend to grant the holder of the international registration the same benefit of *de facto* deferment which he would have enjoyed if he had filed national applications for registration”³.

PUBLICATION OPTIONS AND CURRENT SITUATIONS

Standard Publication

9. Standard publication is the general rule. An international registration is published six months after the date of the international registration (Rule 17(1)(iii) of the Common Regulations). The date of the international registration is usually the filing date⁴. This option is available in all instances. In other words, all Contracting Parties must accept this standard publication period as a *de facto* deferment period. This concept did not exist in the Hague System before the 1999 Act and the Common Regulations came into operation on April 1, 2004.

¹ This is also the case if the Contracting Party has made a declaration for a period of six months or a shorter period in accordance with Article 11(1)(a).

² Refer to document H/CE/VII/3, Notes on Article 7 (paragraph 7.06), and document H/DC/6, Notes on Rule 17 (paragraph R17.01).

³ Refer to document H/DC/6, Notes on Rule 17 (paragraph R17.01).

⁴ Article 10(2)(b) of the 1999 Act provides that (w)here the international application has, on the date on which it is received by the International Bureau, an irregularity which relates to Article 5(2), the date of the international registration shall be the date on which the correction of such irregularity is received by the International Bureau or the filing date of the international application, whichever is the later. Otherwise, the date of the international registration shall be the filing date of the international application (Article 10(2)(a) of the 1999 Act).

Immediate Publication

10. Where the applicant so requests, the international registration is published immediately after registration (Rule 17(1)(i) of the Common Regulations). This option is also available in all instances.

Deferment under the 1999 Act: Two Possible Declarations

11. As of the date of this document, the following seven Contracting Parties to the 1999 Act have made a declaration to prohibit deferment of publication (Article 11(1)(b)): Hungary, Iceland, Monaco, Poland, the Russian Federation, Ukraine and the United States of America.

12. Furthermore, the following Contracting Parties to the 1999 Act have made a declaration that their national law provides for a deferment period of less than 30 months (Article 11(1)(a)): African Intellectual Property Organization (OAPI) (12 months), Belize (12 months), Benelux (12 months), Brunei Darussalam (12 months), Cambodia (12 months), Croatia (12 months), Denmark (6 months), Estonia (12 months), Finland (6 months), Norway (6 months), Singapore (18 months), Slovenia (12 months), Syrian Arab Republic (12 months) and the United Kingdom (12 months)⁵.

13. Of these Contracting Parties, it is noted that Denmark, Finland and Norway have specified a six-month deferment period in their respective declarations under Article 11(1)(a). Given that this period is equal to the six-month standard publication period, technically, their declarations are considered as if they had been made under Article 11(1)(b) (for prohibition of deferment).

14. All the other Contracting Parties to the 1999 Act accept the maximum deferment period of 30 months from the filing date or, where priority is claimed, from the priority date, if they are designated under the 1999 Act (Rule 16(1)(a) of the Common Regulations).

Deferment under the 1960 Act

15. Under the 1960 Act, the maximum deferment period is 12 months from the filing date or, where priority is claimed, from the priority date (Article 6(4)(a) of the 1960 Act and Rule 16(1)(b) of the Common Regulations). While the maximum deferment period is limited to 12 months (compared to the 1999 Act), a Contracting Party to the 1960 Act may not prohibit deferment of publication or lessen the deferment period. Such possibility does not exist under the 1960 Act.

16. Hence, the designation of a Contracting Party under the 1960 Act has the same effect on the publication process as the designation under the 1999 Act of a Contracting Party which has made a declaration for a deferment period of a maximum of 12 months under Article 11(1)(a) of the 1999 Act.

Deferment Period Applicable for Certain Contracting Parties bound by the 1960 and 1999 Acts

17. Of the seven Contracting Parties prohibiting deferment of publication under the 1999 Act, listed in paragraph 11, above, Hungary, Monaco and Ukraine are bound by both the 1960 and the 1999 Act. Thus, if these Contracting Parties are designated under the 1960 Act, deferment can still be requested up to the statutory maximum of 12 months.

⁵ The maximum deferment period is calculated from the filing date or, where priority is claimed, from the priority date. However, the maximum deferment period for Singapore (18 months) and the United Kingdom (12 months) is calculated from the filing date, even where priority is claimed.

Incompatibility Between Certain Designations and the Request for Deferment

18. If the international application contains a request for deferment of publication and designates, under the 1999 Act, a Contracting Party prohibiting the deferment of publication through a declaration under Article 11(1)(b), the International Bureau sends the applicant a notification for a possible withdrawal of the designation of that Contracting Party. If the designation is not withdrawn within one month from the date of the notification, the International Bureau disregards the request for deferment of publication (Article 11(3)(i) of the 1999 Act and Rule 16(2) of the Common Regulations). As a result, standard publication takes place.

19. Similarly, if the international application contains a request for deferment and designates, under the 1999 Act, a Contracting Party having specified, in a declaration under Article 11(1)(a), a period shorter than the requested deferment period, the International Bureau informs the applicant that the publication of the international registration will take place at the expiry of that shorter period. The same applies if the international application contains a request for a deferment period longer than 12 months and designates a Contracting Party under the 1960 Act.

20. In practice, however, any such situations are rare as eHague (the dedicated e-filing interface devised by the International Bureau and which is relied on for over 90 per cent of the applications) detects these incompatibilities and brings them to the attention of the applicant in real time.

USER CONCERNS WITH THE CURRENT SIX-MONTH PERIOD

21. In general, applicants wish to control the timing of publication of designs as much as possible. The deferment period ensures the applicant's capacity to compete by hiding the design from possible competitors. Yet, only 10 per cent of the publications that took place in 2018 were deferred, whilst 44 per cent were standard. Coincidentally, three of the top 10 designated Contracting Parties in 2018⁶, namely the United States of America, the Russian Federation and Ukraine do not allow deferment of publication. Presumably then, a number of applicants were forced to accept the standard publication that takes place six months after the date of the international registration simply because their choice of designations was a prevailing consideration.

22. To mitigate that inconvenience, applicants may revert to alternative strategies such as:

- making a first filing outside the Hague System, from which an international application filed at the very end of the priority period would be based, so as to *de facto* preserve secrecy for up to 12 months; or
- omitting these designations from the international application, knowing that by filing domestically they will benefit from a longer period of secrecy than that allowed by the standard publication scheme. This benefit may result either from the average pendency time in the Offices concerned or from the possibility to delay the examination procedure.

23. In addition to the first alternative coming with a number of risks, both alternatives represent extra costs for users of the Hague System in so far as they have to prepare more applications than necessary and end up with several independent rights that cannot be managed centrally under a single international registration.

⁶ Refer to Hague Yearly Review 2019.

POSSIBLE EXTENSION AND MATTERS FOR CONSIDERATION

24. In view of the above, the International Bureau considers that the current period of six months may be too short for the concept of standard publication to fulfill its intended purpose, as recalled in paragraph 8, above, and that a longer period would help applicants make the most of the Hague System.

Contracting Parties Prohibiting Deferment or Accepting a Six-month Deferment Period under the 1999 Act

25. Reference is made to paragraphs 11 to 13, above. Several Contracting Parties to the 1999 Act prohibit deferment of publication (under Article 11(1)(b)) or limit the deferment period to six months (under Article 11(1)(a)). Excluding Hungary, Monaco and Ukraine which are bound also by the 1960 Act, those Contracting Parties are Denmark, Finland, Iceland, Norway, Poland, Russian Federation and the United States of America. They would be concerned by a possible extension of the standard publication period to any period longer than the current six months.

Contracting Parties Accepting a 12-month Deferment Period under the 1999 Act and Contracting Parties to the 1960 Act

26. Reference is made to paragraph 12, above. Belize, Benelux, Brunei Darussalam, Cambodia, Croatia, Estonia, OAPI, Slovenia, Syrian Arab Republic and the United Kingdom limit the deferment period to 12 months under Article 11(1)(a) of the 1999 Act. In addition, all Contracting Parties to the 1960 Act accept the 12-month deferment period as the maximum period when they are designated under that Act.

27. In all these cases, except for the United Kingdom, the requested deferment period (up to 12 months) is calculated from the priority date if priority is claimed. Thus, if the six-month priority period was taken into account, these Contracting Parties would also be concerned by a possible extension of the current six-month period. If the international application contained a priority claim and opted for standard publication, the international registration would be published after the 12-month period calculated from the date of the international registration, but not the priority date. In 2018, 45.7 per cent of the international applications filed contained priority claims⁷.

Philosophy of the Hague System

28. The Hague System provides a mechanism for acquiring, maintaining and managing design registrations or patents in its members through a “single” international application filed with the International Bureau.

29. It is not an ideal situation for applicants to be forced to file a domestic application in “one member” and to file an international application for designating “other members”, aiming to gain a longer period of secrecy for the design by exhausting the six-month priority period. Although Article 14(3) of the 1999 Act provides for the possibility to prohibit a so-called “self-designation”, no Contracting Party has made this declaration, respecting this philosophy⁸.

⁷ Refer to Hague Yearly Review 2019.

⁸ Article 14(3) of the 1999 Act provides that (a)ny Contracting Party whose Office is an Examining Office may, in a declaration, notify the Director General that, where it is the applicant’s Contracting Party, the designation of that Contracting Party in an international application shall have no effect.

Standard Publication Scheme Versus Various National/Regional Systems

30. As mentioned in paragraphs 7 and 8, above, the standard publication period should be set to intend to grant the holder of the international registration the same benefit of *de facto* deferment which the same person would have enjoyed if the same person had filed national applications for registration. However, as the membership of the 1999 Act grows with a variety of national and regional systems, it is becoming difficult to ensure this seminal purpose of the standard publication scheme.

31. For instance, Denmark, Finland, Iceland and Norway have declared a six-month deferment period to be aligned with their national systems. It is presumed that their respective average publication timings for domestic design registrations is shorter than six months from the filing date.

32. In contrast, the Federal Service for Intellectual Property (ROSPATENT) and the United States Patent and Trademark Office (USPTO) carry out the examination as to novelty, among other requirements. Designs are published only after the issuance of a design patent. Depending on cases, publication of domestic design patents may take place much later than 12 months from the filing date. In fact, both the Russian Federation and the United States of America have made a declaration under Rule 18(1)(b) for the 12-month refusal period and an additional declaration under Rule 18(1)(c)(ii) under which the latest time at which protection must be granted may be delayed up to six months counted from the expiry date of the refusal period.

PRACTICAL CONSEQUENCES OF AN EXTENSION

33. Noting the aforementioned discrepancy within the national and regional systems of the members, the present document proposes a possible extension of the current six-month period to a period of 12 months. The International Bureau believes that the extension to 12 months is worth considering for the benefit of users and could be implemented in the following manner:

Timing of Publication

34. An international registration would be published 12 months after the date of the international registration unless the applicant has requested immediate publication or deferment of publication.

Confidential Copies

35. As a general principle, the International Bureau keeps in confidence each international application and international registration until its publication in the *International Designs Bulletin* (Article 6(4)(d) of the 1960 Act; Article 10(4) of the 1999 Act). However, under Article 10(5) of the 1999 Act, the International Bureau provides "confidential copies" to each Office that has notified the International Bureau that it wishes to receive such a copy when it is designated in an international application.

36. A confidential copy is sent immediately after registration. Pursuant to Section 901(a) of the Administrative Instructions for the Application of the Hague Agreement, confidential copies are currently transmitted to each Office by electronic means. The change of the standard publication period would not affect the sending of confidential copies to the Offices concerned.

Request for Deferment of Publication

37. Pursuant to Rule 7(5)(e) of the Common Regulations, the international application may contain a request for deferment of publication. This would remain unchanged. Thus, subject to the Contracting Parties designated under the 1960 or 1999 Act, the applicant could request deferment of publication up to the allowable maximum period which is calculated from the filing date or, where priority is claimed, from the priority date (Article 6(4)(a) of the 1960 Act; Article 11(1) of the 1999 Act; Rule 16(1) of the Common Regulations). This could lead to situations where publication would take place at an earlier time than if standard publication had been relied on at the time of filing the international application.

Request for Earlier Publication

38. At any time during the period of deferment, the holder may request earlier publication in respect of any or all of the designs contained in the international registration. The deferment period is then considered to have expired on the date of receipt of such request by the International Bureau. Consequently, the international registration will be published thereafter (Article 11(4)(a) of the 1999 Act; Article 6(4)(b) of the 1960 Act).

39. This would remain unchanged. It is, however, to be noted that such earlier publication could be requested only when publication is being deferred.

Transitional Situation

40. The current six-month period would continue to apply to international registrations resulting from international applications filed before the introduction of the proposed change.

41. Accordingly, for a certain period from the date of the introduction of the new period, the International Bureau would operate the two different periods for standard publication, according to the filing date.

III. PROPOSAL

AMENDMENTS TO RULE 17

42. It is proposed to amend the standard publication period from six to 12 months, as reproduced in the Annex to this document. To this end, a new period of 12 months would replace six months currently referred to in subparagraph (1)(iii) of Rule 17 of the Common Regulations.

TRANSITIONAL PROVISION IN RULE 37

43. New paragraph (3) under Rule 37 is proposed to clarify that the current six-month period would continue to apply to international registrations resulting from international applications filed before the date of entry into force of the proposed amendment to Rule 17(1)(iii).

DATE OF ENTRY INTO FORCE

44. Since the current IT system can technically adopt the proposed change to the standard publication period, January 1, 2021, is proposed as the date of implementation of the proposed 12-month standard publication period.

45. *The Working Group is invited to:*

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

(ii) indicate whether it would recommend to the Assembly of the Hague Union for adoption, the proposed amendment to the Common Regulations with respect to Rule 17, together with the proposed transitional provision in Rule 37, as provided in the draft contained in the Annex hereto, with a date of entry into force of January 1, 2021.

[Annex follows]

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

(as in force on [January 1, 2021])

[...]

Rule 17

Publication of the International Registration

- (1) [*Timing of Publication*] The international registration shall be published
- (i) where the applicant so requests, immediately after the registration,
 - (ii) where deferment of publication has been requested and the request has not been disregarded, immediately after the date on which the period of deferment expired or is considered to have expired,
 - (iii) in any other case, ~~six~~12 months after the date of the international registration or as soon as possible thereafter.

[...]

Rule 37

Transitional Provisions

[...]

(3) [*Transitional Provision Concerning Timing of Publication*] Rule 17(1)(iii) as in force before [January 1, 2021], shall continue to apply to any international registration resulting from an international application filed before that date.

[...]

[End of Annex and of document]