

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

SUMMARY BY THE CHAIR

adopted by the Working Group

1. 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”) met in Geneva from October 30 to November 1, 2019.
2. The following members of the Hague Union were represented at the session: African Intellectual Property Organization (OAPI), Armenia, Azerbaijan, Canada, Denmark, Estonia, European Union, Finland, France, Germany, Hungary, Israel, Italy, Japan, Lithuania, Morocco, Norway, Oman, Poland, Republic of Korea, Republic of Moldova, Romania, Russian Federation, Serbia, Singapore, Spain, Switzerland, Syrian Arab Republic, Tajikistan, United Kingdom, United States of America, Viet Nam (32).
3. The following States were represented as observers: Belarus, China, Czech Republic, Jordan, Kazakhstan, Lao People’s Democratic Republic, Mauritania, Mexico, Nicaragua, Pakistan, Peru, Portugal, Seychelles, South Africa, Thailand, Trinidad and Tobago, Uganda (17).
4. Representatives of the following international intergovernmental organizations took part in the session in an observer capacity: Eurasian Patent Organization (EAPO) (1).
5. Representatives of the following non-governmental organizations (NGOs) took part in the session in an observer capacity: Centre for International Intellectual Property Studies (CEIPI), European Communities Trade Mark Association (ECTA), International Trademark Association (INTA), Japan Intellectual Property Association (JIPA), Japan Patent Attorneys Association (JPAA) (5).

AGENDA ITEM 1: OPENING OF THE SESSION

6. Ms. Binying Wang, Deputy Director General of the Brands and Designs Sector, World Intellectual Property Organization (WIPO), opened the eighth session of the Working Group and welcomed the participants.

AGENDA ITEM 2: ELECTION OF THE CHAIR AND TWO VICE-CHAIRS

7. Mr. David R. Gerk (United States of America) was unanimously elected as Chair of the Working Group, Mr. Siyoung Park (Republic of Korea) and Ms. Irene Schatzmann (Switzerland) were unanimously elected as Vice-Chairs.

8. Mr. Hiroshi Okutomi (WIPO) acted as Secretary to the Working Group.

AGENDA ITEM 3: ADOPTION OF THE AGENDA

9. The Working Group adopted the draft agenda (document H/LD/WG/8/1 Prov.2) without modification.

AGENDA ITEM 4: ADOPTION OF THE DRAFT REPORT OF THE SEVENTH SESSION OF THE WORKING GROUP ON THE LEGAL DEVELOPMENT OF THE HAGUE SYSTEM FOR THE INTERNATIONAL REGISTRATION OF INDUSTRIAL DESIGNS

10. Discussions were based on document H/LD/WG/7/11 Prov.

11. The Working Group adopted the draft report (document H/LD/WG/7/11 Prov.) without modification.

AGENDA ITEM 5: PROPOSAL FOR AMENDMENTS TO THE COMMON REGULATIONS**PROPOSAL FOR A NEW RULE TO PROVIDE FOR THE ADDITION OF A PRIORITY CLAIM AFTER FILING (DOCUMENT H/LD/WG/8/2)**

12. Discussions were based on document H/LD/WG/8/2.

13. Taking into consideration different views expressed by the delegations and representatives, the Secretariat made a proposal to amend proposed new Rule 22*bis*.

14. The Chair concluded that the Working Group considered favorably a proposal to add a new Rule 22*bis*, as revised during the session, to the Common Regulations, as set out in the Annex to the Summary by the Chair, and to amend Rule 15(2) of the Common Regulations and the Schedule of Fees, as contained in Annex I to document H/LD/WG/8/2, for adoption, to the Assembly of the Hague Union.

15. The Chair also concluded that the Working Group considered it desirable to amend Section 902 of the Administrative Instructions, as set out in the Annex II to document H/LD/WG/8/2.

16. The date of entry into force of new Rule 22*bis*, and amended Rule 15(2), Schedule of Fees and Section 902 of the Administrative Instructions would be determined by the International Bureau.

PROPOSAL FOR AMENDMENTS TO RULE 17 OF THE COMMON REGULATIONS
(DOCUMENT H/LD/WG/8/6)

17. Discussions were based on document H/LD/WG/8/6.
18. In relation to document H/LD/WG/8/6, taking into consideration different views expressed by the delegations and representatives, the Secretariat made a revised proposal to add a new subparagraph to Rule 17(1).
19. The Chair concluded that some delegations were in favor of the proposal as revised, and one delegation was not comfortable with the proposal.
20. The Working Group requested the International Bureau to consult with user groups and report back on the findings at the next session of the Working Group.

PROPOSAL FOR AMENDMENTS TO RULE 21 OF THE COMMON REGULATIONS
(DOCUMENT H/LD/WG/8/7)

21. Discussions were based on document H/LD/WG/8/7.
22. The Chair concluded that the Working Group considered favorably the submission of a proposal to amend the Common Regulations with respect to Rule 21, with a minor editorial correction to the English version thereof, as set out in the Annex to the Summary by the Chair, for adoption, to the Assembly of the Hague Union, with the proposed date of entry into force of January 1, 2021.

AGENDA ITEM 6: SITUATION OF THE 1960 ACT

23. Discussions were based on document H/LD/WG/8/3.
24. The Chair concluded that the Working Group took note of the contents of the document.

AGENDA ITEM 7: FINANCIAL SUSTAINABILITY OF THE HAGUE SYSTEM; POSSIBLE REVISION OF THE SCHEDULE OF FEES

25. Discussions were based on document H/LD/WG/8/4.
26. The Chair concluded that the Working Group considered favorably the submission of a proposal to amend the Schedule of Fees in the Common Regulations, as contained in Annex IV to document H/LD/WG/8/4, for adoption, to the Assembly of the Hague Union, with the proposed date of entry into force of January 1, 2021.
27. The Working Group requested the International Bureau to prepare, for discussion at its next session, a study on the possible increase of the amount of the basic fee for each additional design for the renewal of an international registration, and a broader review of the Schedule of Fees of the Hague System for discussion at a future session.

AGENDA ITEM 8: POSSIBLE OPTIONS FOR THE INTRODUCTION OF NEW LANGUAGES INTO THE HAGUE SYSTEM

28. Discussions were based on document H/LD/WG/8/5.
29. The Working Group requested the International Bureau to prepare, for discussion at its next session, an advanced study of the cost implications and technical feasibility of the introduction of the Chinese and Russian languages into the Hague System.
30. The Working Group also requested the International Bureau to prepare, for discussion at the next session, a paper on criteria for the selection of additional languages for introduction into the Hague System.

AGENDA ITEM 9: OTHER MATTERS

31. The International Bureau provided an update on electronic data exchange with Offices and the transition to Standard ST.96.
32. The Working Group took note of the update.

AGENDA ITEM 10: SUMMARY BY THE CHAIR

33. The Working Group approved the Summary by the Chair, as amended to take into account the interventions of a number of delegations.

AGENDA ITEM 11: CLOSING OF THE SESSION

34. The Chair closed the eighth session on November 1, 2019.

[Annex follows]

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

(as in force on January 1, 2021)

[...]

Rule 21

Recording of a Change

(1) [*Presentation of the Request*] (a) A request for the recording shall be presented to the International Bureau on the relevant official form where the request relates to any of the following:

- (i) a change in the ownership of the international registration in respect of all or some of the industrial designs that are the subject of the international registration;
- (ii) a change in the name or address of the holder;
- (iii) a renunciation of the international registration in respect of any or all of the designated Contracting Parties;
- (iv) a limitation, in respect of any or all of the designated Contracting Parties, to one or some of the industrial designs that are the subject of the international registration.

(b) The request shall be presented by the holder and signed by the holder; however, a request for the recording of a change in ownership may be presented by the new owner, provided that it is

- (i) signed by the holder, or
- (ii) signed by the new owner and accompanied by ~~an attestation from the competent authority of the holder's Contracting Party~~ [document providing evidence](#) that the new owner appears to be the successor in title of the holder.

[...]

(6) [*Recording and Notification of a Change*] (a) The International Bureau shall, provided that the request is in order, promptly record the change in the International Register and shall inform the holder. In the case of a recording of a change in ownership, the International Bureau will inform both the new holder and the previous holder.

(b) The change shall be recorded as of the date of receipt by the International Bureau of the request complying with the applicable requirements. Where however the request indicates that the change should be recorded after another change, or after renewal of the international registration, the International Bureau shall proceed accordingly.

(c) Where a change in ownership is recorded following a request presented by the new owner pursuant to subparagraph (1)(b)(ii) and the previous holder objects to the change in writing to the International Bureau, the change shall be considered as if it had not been recorded. The International Bureau shall inform both parties accordingly.

[...]

Rule 22bis

Addition of Priority Claim

(1) [Request and Time Limit] (a) Prior to completion of technical preparations for publication, the applicant or holder may add a priority claim to the contents of an international application or international registration by submitting a request to the International Bureau within two months from the filing date.

(b) Any request made under subparagraph (a) shall specify the international application or international registration concerned and provide the priority claim in accordance with Rule 7(5)(c). It shall be accompanied by the payment of a fee.

(c) Notwithstanding subparagraph (a), where the international application is filed through an Office, the two-month period referred to in the said subparagraph shall be counted from the date on which the International Bureau receives the international application.

(2) [Addition and Notification] If the request made under subparagraph (1)(a) is in order, the International Bureau shall promptly add the priority claim to the contents of the international application or international registration and notify that fact to the applicant or holder.

(3) [Irregular Request] (a) If the request made under subparagraph (1)(a) is not submitted within the prescribed time limit, the request shall be considered not to have been made. The International Bureau shall notify the applicant or holder accordingly and refund any fee paid pursuant to subparagraph (1)(b).

(b) If the request referred to in subparagraph (1)(a) does not comply with the applicable requirements, the International Bureau shall notify that fact to the applicant or holder. The irregularity may be remedied within one month from the date of the notification of the irregularity by the International Bureau. If the irregularity is not remedied within the said one month, the request shall be considered abandoned and the International Bureau shall notify the applicant or holder accordingly and refund any fee paid pursuant to subparagraph (1)(b).

(4) [Calculation of Period] Where the addition of a priority claim causes a change in the priority date, any period which is computed from the previously applicable priority date and which has not already expired shall be computed from the priority date as so changed.

[End of Annex and of document]