Managing an International Registration

Seminar on the Hague System for the International Registration of Industrial Designs

Patrick Cartant
Head, Operations Service
The Hague Registry

Geneva, April 9, 2015
Managing an international registration is…

- a major advantage of the Hague system
- easy and centralized:
  - ONE request
  - ONE language
  - ONE payment of ONE set of fees
  - ONE currency (Swiss francs)
  - ONE « Office » (= the International Bureau of WIPO)
What are the Post-Registration Procedures?

- Change in name and/or address of the holder
- Appointment, change or cancellation of representative
- Change in ownership
- Renunciation
- Limitation
- Renewal
Change in name and/or address of the holder

- Article 16(1)(ii) of the Hague Agreement
- Rule 21 of the Common Regulations under the 1999 Act and 1960 Act
  - Form DM/6
    - Request shall be presented and signed by the holder
  - Contents
    - the number of the international registration concerned
    - the name of the holder as recorded
    - the change in name and/or address of the holder
Appointment, change or cancellation of representative

- Article 16(1)(iii) of the Hague Agreement
- Rules 3 and 21 of the Common Regulations under the 1999 Act and 1960 Act
  - Form DM/7; DM/8; DM/9
    - Request shall be signed by the holder

Official forms are not necessary
Requirements

- Rule 3 of the Common Regulations

- The applicant may have a representative before the International Bureau  ➔ **NOT** mandatory

- The rule relates to the representation before the International Bureau  ➔ **NOT** the representation before the Offices

- Who may be appointed as a representative?
  - NO requirement as to professional qualification
  - NO requirement as to nationality
  - NO requirement as to domicile
CHANGE IN OWNERSHIP
Article 16(i) of the Hague Agreement
Rules 21-21bis of the Common Regulations

- Form DM/2

- The Hague Agreement deals only with the recording of the change ➔ the validity of an assignment agreement is outside its scope

  - The request can be presented by the holder OR the new owner, provided that:
    - the request is signed by the holder, or
    - the request is signed by the new owner and accompanied by an attestation from the competent authority of the holder’s CP that the new owner appears to be the successor in title of the holder
Entitlement

- The *new* owner must be *entitled* to file an international application
- There must be a *common treaty* between the CP(s) of the *new* owner and each designated CPs
- The *new* owner needs a *connection* with a CP through:
  - Nationality
  - Domicile
  - Real and effective industrial or commercial establishment
  - Habitual residence (under the 1999 Act only)
Example No. 1

Is there a problem in this case?

Current holder

1960 Act

1999 Act

State member of the EU

Designated CPs

1999 Act

1999 Act

1960/1999 Acts

New owner

1960 Act

1999 Act

1999 Act
Example No. 2

Is there a problem in this case?

Current holder

- Italy (1960 Act)
- EU (1999 Act)

Designated CPs

- Turkey (1999 Act)
- Switzerland (1960/1999 Acts)
- OAPI (1999 Act)

New owner

- Spain (1999 Act)
Change in Ownership – Scope

- **Total:** assignment of the whole IR

- **Partial:** assignment of part of the IR
  - some CPs
  - some designs
  - « tailor-made »
Follow-up Procedure


- Mechanism to allow CP to refuse the effects of the recording of a change in ownership in the International Register, where such a recording is not allowed under their national/regional laws.

- Declaration sent by the Office to the International Bureau will be recorded in the International Register and notified to the previous holder (transferor) and the new holder (transferee) accordingly.

- The part of the international registration which is the subject of the declaration will be recorded as a separate international registration that will “remain” in the name of the previous holder (transferor).
RENUNCIATION
Article 16(iv) of the Hague Agreement
Rule 21 of the Common Regulations

- Form DM/5
- Concerns **ALL** designs
  - May be partial ➔ for only **SOME** of the designated CPs
  
<table>
<thead>
<tr>
<th>Designated CP</th>
<th>Design 1</th>
<th>Design 2</th>
<th>Design 3</th>
</tr>
</thead>
<tbody>
<tr>
<td>Switzerland</td>
<td></td>
<td></td>
<td></td>
</tr>
<tr>
<td>EU</td>
<td></td>
<td></td>
<td></td>
</tr>
<tr>
<td>Turkey</td>
<td></td>
<td></td>
<td></td>
</tr>
</tbody>
</table>

- May be total ➔ for **ALL** designated CPs
LIMITATION
Article 16(v) of the Hague Agreement
Rule 21 of the Common Regulations

Form DM/3

Concerns only SOME of designs
- May concern ALL designated CPs

<table>
<thead>
<tr>
<th>Designated CP</th>
<th>Design 1</th>
<th>Design 2</th>
<th>Design 3</th>
</tr>
</thead>
<tbody>
<tr>
<td>Switzerland</td>
<td></td>
<td></td>
<td></td>
</tr>
<tr>
<td>EU</td>
<td></td>
<td></td>
<td></td>
</tr>
<tr>
<td>Turkey</td>
<td></td>
<td></td>
<td></td>
</tr>
</tbody>
</table>

May concern only SOME of the designated CPs

<table>
<thead>
<tr>
<th>Designated CP</th>
<th>Design 1</th>
<th>Design 2</th>
<th>Design 3</th>
</tr>
</thead>
<tbody>
<tr>
<td>Switzerland</td>
<td></td>
<td></td>
<td></td>
</tr>
<tr>
<td>EU</td>
<td></td>
<td></td>
<td></td>
</tr>
<tr>
<td>Turkey</td>
<td></td>
<td></td>
<td></td>
</tr>
</tbody>
</table>
Article 17 of the Hague Agreement
Rules 23-24 of the Common Regulations

Duration of protection under the 1960 and the 1999 Acts

- Initial term: five years
- Minimum duration:
  - 1960 Act: 10 years (5 + 5)
  - 1999 Act: 15 years (5 + 5 + 5)

May be renewed up to the maximum duration in accordance with the national law (see declarations of CPs)
Procedure

- Unofficial expiry notice sent six months prior to the expiry date to the holder and the recorded representative, if any.

- Payment: by the expiry date (if paid earlier than three months before the expiry date, it shall be considered as having been paid three months before the date).

- Grace period: within six months after the expiry date (+ surcharge of fees to be paid)
Paper Form or Electronic Form

- **Paper form:** form DM/4

- **E-renewal interface:**
  - Online service (launched in December 2010)
  - Easy to use – More than 60% of the international registrations are currently renewed through the E-renewal interface
    - [https://webaccess.wipo.int/erennial_dm/erennial.jsp?lang=EN](https://webaccess.wipo.int/erennial_dm/erennial.jsp?lang=EN)
  - Online payment (current account or credit card)
Renewal **NOT possible** for those CPs and/or for those designs subject to:
- a renunciation recorded in the International Register
- a limitation recorded in the International Register
- an invalidation recorded in the International Register

Renewal **possible** for a CP in case of refusal recorded in the International Register
Scope

May be renewed:
- for SOME of the designated CPs only
- for SOME of the designs only

E-renewal: « tailor-made » renewal
Summary: Post-Registration Procedures

The holder may request:

- reduction of the scope of the IR
- prolongation of the IR
- transfer IR to new owner
- update information about the holder
- representation before the International Bureau

Renunciation

Limitation

Renewal

Change in Ownership

Change in name and/or address of the holder

Appointment, change or cancellation of representative
THANK YOU!

Patrick.Cartant@wipo.int