Managing in International Registration

Seminar on the Hague System for the International Registration of Industrial Designs: Practical Approach and How to Use It

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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)
Types of Changes

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

Article 17 of the 1999 Act
Article 11 of the 1960 Act
Rules 23-25 of the Common Regulations
Renewal

**Paper form:** DM/4

**E-renewal service**

- Launched in December 2010
- Easy to use – around 70% of the international registrations are renewed through E-renewal interface
  
  ➢ https://webaccess.wipo.int/erenewal_dm/IndexController?lang=EN

- Automatically calculate the renewal fees
- Online payment (current account or credit card)
Renewal

Duration of Protection

- Initial term: five years

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

- Maximum duration in each CPs:
  (see declarations of CPs: http://www.wipo.int/hague/en/declarations/declarations.html)
Procedure for Renewal

- **Unofficial expiry notice** (6 months before)

- **Contents of the request**
  - international registration number
  - name and address of the holder
  - scope of renewal
  - signature
  - payment of fees

- **Grace period**: within six months after the expiry date (additional surcharge)
Scope of Renewal

- **Total renewal**
- **Partial renewal**
  - for SOME of the designated CPs only
  - for SOME of the designs only
- **E-renewal:** « tailor-made » renewal

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Scope of Renewal

- **NOT POSSIBLE** for CPs and/or for designs subject to:
  - a renunciation
  - a limitation
  - an invalidation

- **POSSIBLE** for a CP regardless:
  - maximum period of protection has expired
  - a refusal is recorded
CHANGE IN NAME AND/OR ADDRESS OF THE HOLDER

Article 16(1)(ii) of the 1999 Act
Rules 21 of the Common Regulations
Procedure

- **Request form:** DM/6 (mandatory)
  - international registration number
  - name of the holder recorded
  - the change in name and/or address of the holder
  - signature
  - payment of fees
APPOINTMENT, CHANGE OR CANCELLATION OF REPRESENTATIVE

Article 16(1)(iii) of the 1999 Act
Rules 3 and 21 of the Common Regulations
Appointment, change or cancellation of representative

Request form:

- appoint a representative: DM/7
- change in name and/or address: DM/8
- cancel a recorded representative: DM/9
  - canceled *ex officio* where a new representative has been appointed;
  - canceled *ex officio* where a change of ownership has been recorded

No fee applies
CHANGE IN OWNERSHIP

Article 16(1)(i) and (2) of the 1999 Act
Article 12 of the 1960 Act
Rules 21-21bis of the Common Regulations
Change in Ownership

- **Request form**: DM/2 (mandatory)

- **Who can present the request?**
  - presented and signed by the holder;
  - presented by the *new* owner, provided that:
    - signed by the holder, or
    - signed by the *new owner* + attestation from competent authority of the holder’s CP that the new owner appears to be the successor in title of the holder
Change in Ownership

Contents of the request:

- international registration number
- name of the holder recorded
- name and address of the new owner
- entitlement of the new owner
- scope of change
- must be signed by the holder
- payment of fees
Entitlement of the new owner

- The new owner must be entitled to file an international application
  - Nationality
  - Domicile
  - Real and effective industrial or commercial establishment
  - Habitual residence (the 1999 Act only)

- There must be a common treaty between the new owner’s CP(s) and each designated CP
Example 1

Can the new owner be recorded as the new holder?

Current holder
- Flag of Italy
- Flag of the EU
- 1960 Act
- 1999 Act
- a member of EU

Designated CPs
- Flag of Switzerland
- 1960/1999 Acts
- Flag of the United States
- 1999 Act

New owner
- Flag of Korea
- 1960 Act
- Flag of Algeria
- 1999 Act

1960 Act
1999 Act
1960/1999 Acts
1999 Act
Example 2

Can the new owner be recorded as the new holder?

Current holder
- Italy (1960 Act)
- EU member

Designated CPs
- USA (1999 Act)
- Switzerland (1960/1999 Acts)
- OAPI (1999 Act)

New owner
- Spain (1999 Act)
- North Korea (1960 Act)
## Change in Ownership – Scope

### Total change

### Partial change
- for SOME of the designated CPs only
- for SOME of the designs only
- « tailor-made » change

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Change in Ownership has NO Effect

- **Article 16(2) of the 1999 Act**
  - has NO effect in a CP until the Office received the statements or documents specified in the declaration
    - OAPI, DK, KR, US
  - recording of a partial change in ownership is NOT allowed

- **Rule 21bis Declaration**
  - Declaration must be sent to the IB within 6 months
  - IR concerned shall remain in the name of the transferor
  - IB records the Declaration and modify the IR
  - IB notifies transferor and transferee
6 SCOPE OF THE CHANGE IN OWNERSHIP (check either (a) or (b))

(a) ☐ TOTAL CHANGE IN OWNERSHIP (the change in ownership is to be recorded for all the Contracting Parties designated in the international registration(s) indicated in item 1, and for all the industrial designs included in such international registration(s)).

(b) ☐ PARTIAL CHANGE IN OWNERSHIP
   (i) the change in ownership is to be recorded for the designated Contracting Parties indicated below (if no Contracting Party is indicated, it will be understood that the change in ownership is to be recorded in respect of all the designated Contracting Parties). and/or

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   (ii) the change in ownership is to be recorded for the designs indicated below (indicate only the number of the designs): if no designs are indicated, it will be understood that the change in ownership is to be recorded in respect of all designs:

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7 PREFERRED LANGUAGE FOR CORRESPONDENCE

The new owner (transferee) may choose a preferred language for correspondence:
☐ English ☐ French ☐ Spanish

8 SIGNATURE AND/OR SEAL
(read note 1 on cover page)

(a) Identify the signatory by checking the appropriate box:
   (i) Holder (transferor)
   (ii) Representative of the holder (transferor)
   (iii) New owner (transferee)
   (iv) Representative of the new owner (transferee)

(b) Name: ................................................................................................................

(c) Signature and/or seal: ............................................................................................

(d) Date of signature (dd/mm/yyyy): ............................................................................

Name of the person to contact, if necessary: ................................................................
RENUNCIATION

Article 16(1)(iv) of the 1999 Act
Rule 21 of the Common Regulations
Renunciation

- **Request form:** DM/5 (mandatory)
  - international registration number
  - name of the holder recorded
  - concerned designated CP(s)
  - signature
  - payment of fees

- Always concerns **ALL** designs
- May relate to **SOME** or **ALL** designated CPs
Renunciation

**Total renunciation:**
- **ALL** designated CPs

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LIMITATION

Article 16(1)(v) of the 1999 Act
Rule 21 of the Common Regulations
Limitation

- **Request form:** DM/3 (mandatory)
- Only concerns **SOME** of the designs, **NEVER ALL**
  - **ALL** designated CPs
  - **SOME** of the designated CPs

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Managing IR

- Prolonging rights
  - Renewal
- Transfer rights
  - Change in ownership
  - Renunciation
  - Limitation
  - Holder’s name/address
  - Representation
- Scope Reduction
- Update Info.
- Declaration
Tips

- Link of request forms:
- Request MUST be signed by holder or his representative
- Irregularity shall be remedied within 3 months
- Change is recorded when complying with the requirements
- Fee calculator:
- Schedule and Payment of fees:
THANK YOU!
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