Administration of an International Registration

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

Yin WU, Examiner, Operations Service, The Hague Registry
RENEWAL

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

- **Paper form**: DM/4

- **E-renewal**:  
  https://webaccess.wipo.int/erennial_dm/IndexController?lang=EN
  
  - Automatically calculate the renewal fees
  - Online payment (current account or credit card)
International designs E-Renewal System

Please enter your International Registration Number (IRN): [DM/ ]
(for example: 123456, 123456A)

Submit

This application enables you to renew the international registration. Please follow instructions provided on each screen.

Online payment of the renewal fee, either by WIPO Current Account or by credit card, is made on last screen.

In order to pay by WIPO Current Account, you will need to provide the username and password that WIPO provided you when you opened the Current Account. The username and password are the same as those your company uses to consult its WIPO Current Account (please contact your company’s Finance department).
Procedure for Renewal

Contents of the request
- international registration number
- name and address of the holder
- scope of renewal
- payment of fees
  - US: no renewal fees required
- signature

Unofficial expiry notice (6 months before)
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

<table>
<thead>
<tr>
<th>Designated CPs</th>
<th>Bag 1</th>
<th>Bag 2</th>
<th>Bag 3</th>
</tr>
</thead>
<tbody>
<tr>
<td>乌克兰</td>
<td>✔</td>
<td>✔</td>
<td>✔</td>
</tr>
<tr>
<td>日本</td>
<td>✔</td>
<td>✔</td>
<td>✔</td>
</tr>
<tr>
<td>美国</td>
<td>✔</td>
<td>✔</td>
<td>✔</td>
</tr>
<tr>
<td>韩国</td>
<td>✔</td>
<td>✔</td>
<td>✔</td>
</tr>
</tbody>
</table>
Scope of Renewal

- **Total renewal**

- **Partial renewal**
  - for SOME of the designated CPs only
  - for SOME of the designs only

- **E-renewal:** « tailormade » renewal

<table>
<thead>
<tr>
<th>Designated CPs</th>
<th>Bag 1</th>
<th>Bag 2</th>
<th>Bag 3</th>
</tr>
</thead>
<tbody>
<tr>
<td>Ukraine</td>
<td>✔</td>
<td></td>
<td>✔</td>
</tr>
<tr>
<td>Japan</td>
<td></td>
<td></td>
<td>✔</td>
</tr>
<tr>
<td>United States</td>
<td></td>
<td>✔</td>
<td></td>
</tr>
<tr>
<td>South Korea</td>
<td>✔</td>
<td>✔</td>
<td></td>
</tr>
</tbody>
</table>
Conditions for Renewal

Possible
- maximum period expired
- refusal recorded

NOT Possible
- renunciation recorded
- limitation recorded
- invalidation recorded
01 Renewal
Prolonging protection

02 Renunciation;
Limitation
Reducing protection scope

03 Change in Ownership
Transferring rights

04 Holder’s name/address;
Representative
Updating Info.
Renunciation and Limitation
Renunciation and Limitation

- Always ALL the designs

International registration

Design 1
Design 2
Design 3
Design 4
Design 5
Renunciation and Limitation

- Always ALL the designs

Limitation
- only SOME designs, never all

Renunciation

Design 1

International registration

Design 2

Design 3

Design 4

Design 5
RENUNCIATION

Article 16(1)(iv) of the 1999 Act
Article 13 of the 1960 Act
Rule 21 of the Common Regulations
Renunciation

- Always concerns ALL designs
- May relate to SOME or ALL designated CPs
- **Request form:** DM/5 (mandatory)
  - international registration number
  - name of the holder recorded
  - concerned designated CP(s)
  - signature
  - payment of fees
Renunciation

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

<table>
<thead>
<tr>
<th>Designated CPs</th>
<th>Bag 1</th>
<th>Bag 2</th>
<th>Bag 3</th>
</tr>
</thead>
<tbody>
<tr>
<td><img src="image1" alt="Flag" /></td>
<td>✔</td>
<td>✔</td>
<td>✔</td>
</tr>
<tr>
<td><img src="image2" alt="Flag" /></td>
<td>✔</td>
<td>✔</td>
<td>✔</td>
</tr>
<tr>
<td><img src="image3" alt="Flag" /></td>
<td>✔</td>
<td>✔</td>
<td>✔</td>
</tr>
<tr>
<td><img src="image4" alt="Flag" /></td>
<td>✔</td>
<td>✔</td>
<td>✔</td>
</tr>
</tbody>
</table>
## Renunciation

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

- **Partial renunciation:**
  - SOME designated CPs

<table>
<thead>
<tr>
<th>Designated CPs</th>
<th>Bag 1</th>
<th>Bag 2</th>
<th>Bag 3</th>
</tr>
</thead>
<tbody>
<tr>
<td>U A ✔️</td>
<td>✔️</td>
<td>✔️</td>
<td>✔️</td>
</tr>
<tr>
<td>J P ✔️</td>
<td>✔️</td>
<td>✔️</td>
<td>✔️</td>
</tr>
<tr>
<td>U S ✔️</td>
<td>✔️</td>
<td>✔️</td>
<td>✔️</td>
</tr>
<tr>
<td>K R ✔️</td>
<td>✔️</td>
<td>✔️</td>
<td>✔️</td>
</tr>
</tbody>
</table>
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

<table>
<thead>
<tr>
<th>Designated CPs</th>
<th>Bag 1</th>
<th>Bag 2</th>
<th>Bag 3</th>
</tr>
</thead>
<tbody>
<tr>
<td>Ukraine</td>
<td>✔️</td>
<td>✔️</td>
<td>✔️</td>
</tr>
<tr>
<td>Japan</td>
<td>✔️</td>
<td>✔️</td>
<td>✔️</td>
</tr>
<tr>
<td>USA</td>
<td>✔️</td>
<td>✔️</td>
<td>✔️</td>
</tr>
<tr>
<td>South Korea</td>
<td>✔️</td>
<td>✔️</td>
<td>✔️</td>
</tr>
</tbody>
</table>
Administration of an IR

01 Renewal
Prolonging protection

02 Renunciation;
Limitation
Reducing protection scope

03 Change in Ownership
Transferring rights

04 Holder’s name/address;
Representative
Updating Info.
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
Present the Request

- **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](https://en.wikipedia.org/wiki/Attestation) from competent authority of the holder’s CP that the new owner appears to be the successor in title of the holder
Contents of the Request

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*](https://www.dictionary.com/browse/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*](https://en.wikipedia.org/wiki/Treaty) between the *new* owner’s CP(s) and each designated CP
Can Morocco be recorded as the new holder?
Can Morocco be recorded as the new holder?

**New owner**

1960 Act

**Designated CPs**

1960/1999 Act

1999 Act

1999 Act

1999 Act

**Note:** The diagram illustrates the flag of Morocco and flags of other countries, each marked with the 1960 Act, 1999 Act, and 1960/1999 Act.
Result of change in ownership

**Previous holders**

- [Flag of Italy]
  - 1960 Act
- [Flag of Spain]
  - 1999 Act
- [Flag of Austria]

**Designated Countries**

- [Flag of Japan]
  - 1999 Act
- [Flag of the United States]
  - 1999 Act
- [Flag of South Korea]
  - 1999 Act

**New holder**

- [Flag of Morocco]
  - 1960 Act
- [Flag of Ukraine]
  - 1960/1999 Act
New Owner from Switzerland and Egypt?

Current holders
- 1960 Act
- 1999 Act

New owners
- 1960/1999 Act
- 1999 Act

Designated CPs
- 1960/1999 Act
- 1999 Act
- 1999 Act
- 1999 Act
- 1999 Act

members of EU
- 1999 Act

The International Design System
Result of change in ownership

New owners

- Egypt (1999 Act)
- Switzerland (1960/1999 Act)

Designated Countries

- Ukraine (1960/1999 Act)
- Japan (1999 Act)
- United States (1999 Act)
- South Korea (1999 Act)
Scope of Change in Ownership

- **Total change**
- **Partial change**
  - for SOME of the designated CPs only
  - for SOME of the designs only

<table>
<thead>
<tr>
<th>Designated CPs</th>
<th>Bag 1</th>
<th>Bag 2</th>
<th>Bag 3</th>
</tr>
</thead>
<tbody>
<tr>
<td>Ukrainian</td>
<td>✔</td>
<td>✔</td>
<td>✔</td>
</tr>
<tr>
<td>Japanese</td>
<td>✔</td>
<td>✔</td>
<td>✔</td>
</tr>
<tr>
<td>US</td>
<td>✔</td>
<td>✔</td>
<td>✔</td>
</tr>
<tr>
<td>Korean</td>
<td>✔</td>
<td>✔</td>
<td>✔</td>
</tr>
</tbody>
</table>
## Scope of Change in Ownership

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

<table>
<thead>
<tr>
<th>Designated CPs</th>
<th>Bag 1</th>
<th>Bag 2</th>
<th>Bag 3</th>
</tr>
</thead>
<tbody>
<tr>
<td>🇺🇦 ユーラシア</td>
<td>✔</td>
<td>✔</td>
<td>✔</td>
</tr>
<tr>
<td>🇰🇷 ソウル</td>
<td>✔</td>
<td>✔</td>
<td>✔</td>
</tr>
<tr>
<td>🇺🇸 アメリカ</td>
<td>✔</td>
<td>✔</td>
<td>✔</td>
</tr>
</tbody>
</table>
DM/2 Item 6 - Scope

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

(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:
DM/2 Item 8 - Signature

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: .................................................................
DM/2 Item 8 – Signature NOT Accepted
Change in Ownership has **NO** Effect

- **Article 16(2) of the 1999 Act**
  - **has NO effect** 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**
Administration of an IR

01 Renewal
Prolonging protection

02 Renunciation;
Limitation
Reducing protection scope

03 Change in Ownership
Transferring rights

04 Holder’s name/address;
Representative
Updating Info.
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
Change in Ownership & Change in Name

**Change in Ownership**

The holders will be changed
Change in Ownership & Change in Name

*Change in Name of holder*

the SAME holders
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**
Tips

■ Link of request forms:

■ Fee calculator:

■ Schedule and Payment of fees:

■ Handwriting NOT allowed

■ MUST signed by holder or representative recorded

■ Irregularity shall be remedied within 3 months

■ Change is recorded when complying with the requirements
THANK YOU!

yin.wu@wipo.int