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**WORLD INTELLECTUAL PROPERTY ORGANIZATION**  
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**DIPLOMATIC CONFERENCE  
FOR THE ADOPTION OF A NEW ACT OF THE HAGUE  
AGREEMENT CONCERNING THE INTERNATIONAL DEPOSIT  
OF INDUSTRIAL DESIGNS**

**Geneva, June 16 to July 6, 1999**

NOTES ON THE BASIC PROPOSAL FOR THE REGULATIONS UNDER THE NEW  
ACT OF THE HAGUE AGREEMENT CONCERNING THE INTERNATIONAL  
REGISTRATION OF INDUSTRIAL DESIGNS

*Document prepared by the International Bureau*

## INTRODUCTION

The present document contains notes on the draft Regulations under the draft new Act contained in document H/DC/4. Where a provision is considered to be self-explanatory, no note has been provided.

The Regulations will eventually contain a Schedule of Fees. No draft of this has been provided at this stage, since it is considered that it is only when one gets close to the entry into force of the new Act that the cost of the procedure can be estimated with some certainty, taking into account, in particular, technologies available to the International Bureau at that time.

*Notes on Rule 1*

R1.01 *Item (iii) of paragraph (2)*. The definition of an “official form” given in this paragraph follows the one contained in Rule 1(xxvii) of the Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement (hereinafter referred to as the “Common Regulations under the Madrid Agreement and Protocol”). Such definition encompasses not only the forms established by the International Bureau but also any other form which has the same contents and format. This will allow applicants and representatives to generate their own forms, while requiring that these be sufficiently similar to the forms established by the International Bureau to enable the data therein to be captured efficiently by the International Bureau. Copies of the forms established by the International Bureau will be made available free of charge. They will be made available not only on paper but, probably, also on-line.

R1.02 *Item (vi) of paragraph (2)*. The wording of this provision is based on that of Section 101(xii) of the present Administrative Instructions, as in force on January 1, 1999. It covers the possibility of an electronic publication of the Bulletin as well as of any other form of publication that may result from the development of new technologies. The provision also covers paper publication of the Bulletin.

*Note on Rule 2*

R2.01 No provision is made for communication by telex or telegram, since these modes are very rarely used nowadays. Nor is any provision made at this stage concerning electronic communications. The technology concerning such communications is evolving so rapidly that it has been considered preferable to leave this subject for possible inclusion in a later version of the Regulations or in the Administrative Instructions.

*Notes on Rule 3*

R3.01 This Rule relates only to representation before the International Bureau. The question of who is entitled to file an international application through an Office, or to represent the holder before an Office in a Contracting Party in the event of a refusal, is a matter for the law of the Contracting Party concerned. With respect to who may be appointed as representative before the International Bureau, this Rule does not provide for any requirement as to professional qualification, nationality or residence.

R3.02 *Paragraphs (2)(a) and (b) and (4)(a)*. Since paragraph (4)(a) refers to the signature of a *recorded* representative, it follows that the signature mentioned in paragraph (2)(a) and (b) must be that of the applicant or holder himself.

*Note on Rule 5*

R5.01 *Item (i) of paragraph (2)*. Although paragraph (1)(i) provides for failure to meet a time limit to be excused where this is due to an interruption of a postal service on account of a strike, this has not been included in paragraph (2)(i), which deals with communications sent through a delivery service. This is because, while a postal service is generally a monopoly, this is not the case with delivery services. Accordingly, when one delivery service is affected by a strike, it will normally be possible to use another delivery service which is not so affected. Allowing a time limit to be excused on the ground that a particular delivery service was affected by a strike could therefore be open to abuse.

*Note on Rule 6*

R6.01 *Paragraph (2)*. The translations required for the purposes of recordal and publication will be undertaken by the International Bureau.

*Notes on Rule 7*

R7.01 Rule 7 states the requirements concerning the presentation and contents of an international application. It distinguishes between the mandatory contents of any international application, listed in paragraph (3), and the additional contents of an international application, listed in paragraph (4). This Rule should be read in conjunction with Rule 8 (which prescribes special requirements concerning the applicant where certain Contracting Parties are designated), Rules 9 and 10 (which relate to the reproductions and specimens of the industrial design that must accompany the application) and Rule 11 (which prescribes further details concerning certain elements which must be included in the international application where certain Contracting Parties are designated).

R7.02 *Paragraph (1)* requires the use of the official international application form. The use of this form ensures that the requirement of Article 5(1)(i), that the international application contain a request for international registration under the new Act, is met (see Rule 1(2)(iii) for the definition of official forms).

R7.03 The provision does not mention the number of copies of the form that must be filed; by implication, therefore, only one copy is required. Under Rule 8.2(a) of the current Regulations under the Hague Agreement, the international application must be filed in two copies. It is expected however that, by the time the new Act and its Regulations come into force, the International Bureau will scan each paper document on receipt, and operate in a paperless manner (as is already the case under the Madrid Agreement and Protocol). A second copy would therefore be redundant, and even inconvenient.

R7.04 The provision requires that the international application be signed by the applicant. In Rule 3(2) it is proposed that a representative may be appointed either (a) in an international application which is signed by the applicant or (b) in a separate communication which is signed by the applicant or holder. When such a separate communication is attached to the international application, the latter may therefore be validly signed by the representative for the applicant.

R7.05 *Items (i) and (ii) of paragraph (3)*. The previous wording of these provisions followed faithfully the wording of Rule 9(4)(a) of the Common Regulations under the Madrid Agreement and Protocol, which provides details on the manner in which the name and address of the applicant must be indicated. Such details are excluded of the present wording, since it has been considered that they can find a more appropriate place in the Administrative Instructions.

R7.06 *Items (iii) and (iv) of paragraph (3)*. The expressions “applicant’s Contracting Party” and “International Classification” are defined in Article 1(xii) and (xxxii).

R7.07 *Item (iv) of paragraph (3)*. Concerning the words “which constitute the industrial design or in relation to which the industrial design is to be used”, see Note R9.02.

R7.08 *Paragraph (4)* lists additional elements that may be included in an international application, either because they are required by one or more of the Contracting Parties designated or at the option of the applicant.

R7.09 *Paragraph (4)(a)* relates to Article 17, which provides that a Contracting Party whose Office is an Examining Office may notify the Director General that it requires one or more of the following elements: the identity of the creator of the industrial design; a description; a claim. Such notification would only be made by a Contracting Party whose law requires the element concerned as a condition for according a filing date. Where such a Contracting Party is designated and the international application does not contain the required element, the consequence is either that the filing date is affected (where the element is received subsequently) or that the designation of that Contracting Party is disregarded (see Article 8(2)(b)).

R7.10 Further details concerning the elements mentioned in subparagraph (a) are given in Rule 11.

R7.11 *Paragraph (4)(b)* makes clear that indications concerning the identity of the creator and a description may be included in the international application even where it is not required as a consequence of Article 17. This is because the applicant may be aware that a designated Contracting Party that has not made the notification referred to in Article 17 nonetheless requires such an element, though not as a filing date requirement, and he wishes to forestall a refusal by that Contracting Party.

R7.12 *Paragraph (4)(e)*. This provision does not require the submission of a copy of the application on which priority is based. Such priority document is not required under either of the current Acts of the Hague Agreement. This does not however preclude an Office from requesting the holder, in a particular case, to furnish a copy of the priority document to it direct. Such request could be made in the context of a refusal where the Office considers that the priority document is necessary in order to determine novelty, because of a disclosure intervening during the priority period.

R7.13 *Paragraph (4)(h)* lists additional elements that may be included in an international application because they are required by one or more of the Contracting Parties designated in the international application. In contrast to the position concerning the additional elements listed in paragraph (4)(a), the additional elements in this paragraph need not be notified to the Director General. Moreover, the omission of any of these elements does not affect the filing date.

R7.14 *Item (i) of paragraph (4)(h)*. Such a declaration could be part of the official international application form.

R7.15 *Item (ii) of paragraph (4)(h)*. The statement as to where the novelty of the industrial design resides could be part of the official international application form. The statement could read as follows: “the novelty lies in the shape, configuration, pattern or ornament.” It would be up to the applicant to delete the non-applicable terms.

R7.16 *Item (iii) of paragraph (4)(h)*. The indication may for example be a statement that the applicant’s right to file the international application derives from a contract of employment, or that the applicant is the heir or other successor in title of the creator of the industrial design. This indication is required by the law of some potential Contracting Parties. It is not the same as the statement or document, to the effect that the design has been assigned to the applicant, which are mentioned in Rule 8 and may be required where a Contracting Party to which that Rule applies has been designated.

R7.17 *Paragraph (4)(i)* takes account of the requirement under the law of the United States of America to file a statement which describes any relevant prior art known by the applicant. The purpose of this requirement is to avoid the non-enforceability of the right on the industrial design on the ground of non-compliance with the duty of candor.

R7.18 *Paragraph (5)*. This wording follows Rule 8.3(b) of the present Regulations under the Hague Agreement. It allows the International Bureau to dispose of any non-prescribed or non-permitted document accompanying the application—i.e. catalogues, brochures, certified copy of the first filing in support of a priority claim, etc. This does not preclude the possibility for the International Bureau to return to the applicant documents considered of a particular value. The alternative option would have been to provide for the systematic returning to the sender, at the latter’s expense, of any non-required or non-permitted document. Such option would however have entailed unnecessary work for the International Bureau and added to the cost of the procedure.

R7.19 *Paragraph (6)* relates to Article 5(3) of the draft new Act, which provides that an international application may relate to two or more industrial designs, subject to the prescribed conditions. Paragraph (6) prescribes one condition: that all the products which constitute the industrial designs to which the international application relates, or in relation to which the industrial designs are to be used, should belong to the same class of the International Classification. That restriction is considered to be necessary in order to facilitate the task of both Offices and users that perform anticipation searches. This provision is specified in Rule 30 as one which may be amended only by unanimity.

*Notes on Rule 8*

R8.01 Rule 8 takes account of the requirement under certain national laws, notably the law of the United States of America, whereby the application for registration of an industrial design has to be made in the name of the creator. Any Contracting Party whose law provides for such requirement may notify the Director General of that fact. Such notification must specify the form and mandatory content of the statement (required by paragraph (2)(i)) that the person so identified is in fact the creator of the industrial design; for example, it may specify that it must take the form of an oath or declaration and also what other information it must contain and whether it must be signed. The notification must also indicate the mandatory content of any document or statement concerning the assignment of the international application that may be required in accordance with paragraph (2)(ii).

R8.02 *Item (i) of paragraph (2)*. Where a Contracting Party that has made the notification mentioned in paragraph (1) has been designated in the international application, the identity of the creator of the industrial design must be given and the international application must contain a statement that the latter believes himself to be the creator of the industrial design. In order to satisfy the requirement mentioned in Note R8.01, this person is regarded as the applicant for the purposes of that Contracting Party, whether or not the international application was filed in the name of that person.

R8.03 *Item (ii) of paragraph (2)*. Where the person identified as the creator is a person other than that named as the applicant in the international application, this should not result in a person other than the person recorded as the holder of the international registration (that is, upon registration, the person named as the applicant in the international application) being regarded as the holder of the international registration for the purposes of a particular designation. This, it is believed, could only lead to legal uncertainty (for example as to the effects of any request for recordal of a change in the international registration presented to the International Bureau by the recorded holder or his regularly appointed representative). For this reason, paragraph (2)(ii) provides that, in the case at hand, the international application must be accompanied by a statement or document, as may be required by the Contracting Party concerned under paragraph (1)(b), to the effect that the international application has been assigned by the person identified as the creator (the applicant, as far as that Contracting Party is concerned) to the person named as the applicant in the international application (that is, the person that will become the holder for the purposes of all Contracting Parties).

R8.04 Where an international application contains the designation of a Contracting Party to which this Rule applies but the identity of the creator is not given or the statement or document mentioned in paragraph (2)(ii) is missing, the application will be irregular and will be treated in accordance with Article 8(2)(b) of the draft new Act; that is, the applicant will be invited to file the missing elements. If these are not received within the prescribed period (three months), the designation of the Contracting Party concerned will be disregarded.

*Notes on Rule 9*

R9.01 *Paragraph (1)*. Article 5(1)(iii) refers to the prescribed number of copies of “a reproduction” of the industrial design. Subparagraph (a) of Rule 9(1) indicates that the reproduction may be a photograph or other graphic representation. This is the same as the requirement under Rule 12.1 of the current Regulations. The photographs or graphic representations may be in black and white or in color. Unlike the current Rule 12.1 however, draft Rule 9(1) does not provide for the possibility to file samples or models (except in the special case referred to in Rule 10); three-dimensional models are costly to store and are, in any case, very seldom filed.

R9.02 *Paragraph (1)(a)*. The wording “of the industrial design itself or of the product or products which constitute the industrial design” is intended to allow an applicant to seek protection for a motif intended to be applied to several different products without it being necessary to provide a reproduction of each product. Of course, as required by Article 5(1)(iv) and Rule 7(3)(d), the products to which the motif is to be applied would all have to be indicated in the international application. Also, all such products would have to belong to the same class of the Locarno Classification. Moreover, Rule 7(3)(d) provides for the applicant to indicate whether the product or products *constitute* the industrial design or are (as would be the case where protection is sought for a motif) products *in relation to which* the industrial design is to be used. Those countries whose national law does not provide for the protection of a motif itself would, of course, be allowed to refuse the international registration on the ground that a motif itself is not protectable under their law.

R9.03 The wording of the second sentence of paragraph (1)(a) follows Rule 12.1(d) of the current Regulations. As explained in the Notes concerning Article 5(1)(iii), an applicant may choose to submit different views of the same industrial design in order either to illustrate all the characteristic features of a three-dimensional design or to comply with the requirement of the law of a designated Contracting Party, it being understood that such requirement is not a requirement for the according of a filing date. The words “shown from different angles” or “views from different angles” mean that each reproduction shows what would be seen by a person viewing the product from each of those angles. It does not therefore include cross-section or other internal views of the product. However, the International Bureau would not refuse reproductions including cross-section or internal views where an applicant wishes to submit them—for instance, because he considers that such views provide a better understanding of the industrial design (see also Note R9.07).



R9.04 *Paragraph (2)(a)*. The Administrative Instructions will contain detailed requirements concerning the presentation and dimensions of reproductions.

R9.05 *Paragraph (2)(b)*. The Administrative Instructions will provide that a disclaimer may be included in the description of the industrial design or may be indicated by dotted or broken lines in the reproduction of the industrial design. They will indicate the forms of disclaimer which are acceptable to particular Offices, on the basis of information supplied to the International Bureau by those Offices. If therefore the disclaimer has been made in accordance with the Administrative Instructions, a designated Office may not issue a notification of refusal on the ground that the requirements of its law concerning the presentation of disclaimers have not been complied with.

R9.06 *Paragraph (3)*. A notification under this provision should relate to international registrations in general; notifications should not be sent on a case-by-case basis. The notification may for instance state that six views (front, rear, top, bottom, left, right) are required; it may also state that a view may be omitted if it is identical to another view or if it is conventional or otherwise not relevant to the industrial design; it may also indicate the circumstances in which these six views are required, or the circumstances in which they are not required—for example, where the product has an axis of symmetry (e.g., a plate) or is spherically symmetrical. For instance, the “Guide to filing a design patent application” of the United States Patent and Trademark Office states that it is not necessary to provide views of surfaces which are shown in a perspective view of the product or are flat and unornamented or are identical with other surfaces. The information in the notification should be clear enough for an applicant to know whether, when designating the Contracting Party concerned, he has complied with the requirements.

R9.07 The notification mentioned in this Rule applies where a Contracting Party systematically requires certain views. It would therefore not apply in the case of cross-section or internal views. Indeed, although such views may be required by a Contracting Party in those cases where they are considered to be indispensable to the understanding of the design, they may not be required systematically.

R9.08 *Paragraph (4)*. The only ground relating to the form of the reproductions that may be cited as reason for refusal by a Contracting Party is that views notified in accordance with paragraph (3)(a) as being required by that Contracting Party are missing. Thus a Contracting Party may not refuse protection on the ground that other requirements of Rule 9 (for example, the requirement that the reproductions must be of sufficient quality to permit publication) have not been met; it is the responsibility of the International Bureau to satisfy itself, before notifying the international registration to the designated Contracting Parties, that these requirements have been met.

R9.09 A Contracting Party may however refuse on the ground that a reproduction does not sufficiently disclose the appearance of the industrial design. Thus, for example, although it may not refuse protection on the sole ground that a reproduction is not provided with surface shading, it may refuse if the only way to sufficiently disclose the industrial design is to provide surface shading, and that this has not been done. In such a case, the reason for refusal would be the substantive ground that the industrial design is not sufficiently disclosed, *not* the formal ground that the reproduction does not contain surface shading.

*Notes on Rule 11*

R11.01 This Rule should be read in conjunction with Rule 7(4)(a) and Rule 8(2)(i). It prescribes further details concerning certain elements, namely the identity of the creator, a description and a claim, which must be included in the international application where certain Contracting Parties are designated. Where these requirements have been met, an Office may refuse protection only if there is an objection of substance—for example, that the description does not describe in fact the characteristic features of the industrial design.

R11.02 *Paragraph (2)*. The former drafting of this paragraph limited the description to 100 words. However, taking into account that under certain legislations the required description of an industrial design can be very long, and that an international application can include numerous designs which need to be described, the current proposal does not restrict the length of the description to a maximum number of words. The Schedule of Fees may however provide for an additional fee where the description exceeds a limit of 100 words, in order to compensate for the additional translation costs of lengthy descriptions.

R11.03 *Paragraph (3)*. A claim is required under the law of the United States of America. The claim must be in formal terms to the ornamental design for the product (specifying name) as shown, or as shown and described. For example, if the product which constitutes the industrial design is a telephone handset, the claim might read “CLAIM: An ornamental design for a telephone handset substantially as shown and described.” It is understood that, if such a statement is not included in an application in the United States of America, a filing date cannot be accorded. This wording could be made part of the official international application form, so that an international application which contains the designation of the Contracting Party concerned will be deemed to contain the said claim. On the other hand, the applicant could, if he so wished, replace the pre-printed wording by another wording of his choice.

*Note on Rule 12*

R12.01 *Paragraph (1)(a)*. The amount of each of the fees listed in this paragraph, whether fixed in the Schedule of Fees or (in the case of individual designation fees) determined by a Contracting Party, may comprise a basic amount and a supplementary amount which is related to the number of designs or reproductions contained in the international application.

*Notes on Rule 13*

R13.01 *Paragraph (1)*. Pursuant to Article 4(1)(a) of the draft new Act, an international application may be filed direct with the International Bureau or through the Office of the applicant's Contracting Party. In the latter case, such Office is required to notify both the applicant and the International Bureau of the date on which it received the application. The importance of that date is two-fold. On the one hand, that date corresponds to the filing date of the international application, provided that the International Bureau receives the application within one month; on the other hand, that date is the starting point to calculate the aforementioned one-month time limit (see Note R13.05).

R13.02 It is understood that the date of receipt of the international application by an Office is to be determined by the legislation applicable to that Office. In particular, the national or regional law may provide that, where the application is sent by mail to the Office, the date of receipt shall be the date of mailing, as evidenced by the postal mark. It is to be noted, however, that, in such case, the time available to the Office to arrange for the application to reach the International Bureau would be shortened by the time necessary for the application to actually reach the Office.

R13.03 Paragraph (1) also requires the Office to notify the applicant of the fact that it has transmitted the application to the International Bureau. If therefore the applicant does not receive such notification promptly, he may check whether the Office has in fact transmitted the application. This reduces the risk of the application losing its filing date because of inaction by the Office.

R13.04 *Paragraphs (3) and (4)* are new in the draft Regulations. They take over the subject matter of former Article 4(2)(c) and (3)(a) of the draft new Act.

R13.05 *Item (i) of paragraph (3)*. The former draft of Article 4(3)(a) referred to the international application being "transmitted" by the applicant's Office to the International Bureau within one month from the date on which that Office received it. This would however be difficult for the International Bureau to administer, and would lead to uncertainty where an international application is delayed in transmission, or is not received at all by the International Bureau. In order to overcome this difficulty, the proposed wording refers to the international application being "received" by the International Bureau within one month of the date on which it was received by the applicant's Office. This results in a shorter time limit for the Office to send the international application to the International Bureau, but has the advantage of rendering the system more secure and easier to administer. Furthermore, since the onus of those Offices which do not carry out a security clearance is limited to notifying the date of receipt of the international application and to transmitting the said application to the International Bureau, a shorter time limit should not entail any negative consequence for those Offices.

R13.06 *Paragraph (4)(a)*. The period of one month allowed under paragraph (3) for the receipt by the International Bureau of the international application is not sufficient for a Contracting Party whose law requires a security clearance. Paragraph (4)(a) therefore provides for the possibility for such a Contracting Party to notify the replacement of the period of one month by a period of three months.

R13.07 *Paragraph (4)(b)* allows for the aforementioned period of three months to be extended to six months where the law of a Contracting Party requires security clearance, provided that the Office concerned so informs the International Bureau and the applicant within three months from the date on which it received the international application. Notification to the applicant is provided for in order to give the applicant the opportunity to have the security clearance expedited.

R13.08 Rule 13(4) is specified in Rule 30 as one of the provisions which can be amended only by unanimity.

#### *Notes on Rule 14*

R14.01 *Paragraph (2)* sets forth the time limit for correcting irregularities and thus complements Article 8(1) of the draft new Act.

R14.02 *Paragraph (3)*. The list of irregularities which entail a postponement of the date of the international registration is a closed one. Apart from the irregularities listed in this paragraph, only those irregularities which relate to Article 17 affect the date of the international registration.

R14.03 The fact that there is an irregularity under this paragraph means that an essential element of the international application is missing or that a basic rule, namely the rule governing the language of the international application, has not been complied with. The importance of those elements and rule is considered to be such that a date of international registration cannot be granted before all those elements are supplied and the said rule is complied with.

R14.04 *Item (i) of subparagraph (b)*. This irregularity will be avoided by including, as part of the official application form, an indication that international registration is sought under the Act.

R14.05 *Item (ii) of subparagraph (b)*. There is an irregularity affecting the date of international registration only where sufficient indications to enable either the applicant or his representative, if any, to be contacted are lacking.

R14.06 *Paragraph (4)*. The provision for the retention of a certain amount of fees takes account of the expense incurred by the International Bureau in examining an international application and issuing a letter of irregularity. Logically, the amount deducted should correspond to the basic fee since this fee accounts for the work done by the International Bureau in respect of each international application.

*Notes on Rule 15*

R15.01 *Paragraph (1)* provides for a maximum period of deferment of 30 months from the filing date or, where priority is claimed, from the priority date. It complements Article 10(1)(a) of the draft new Act, which simply refers to the “prescribed period”. This period may be changed by a decision of the Assembly, but only by unanimity (see Rule 30).

R15.02 *Paragraphs (3) and (4)*. One of the advantages of deferment of publication is that the payment of the publication fee and the submitting of the reproductions may also be deferred. The payment of the publication fee and the submitting of the reproductions are however preconditions to the publication of the international registration, and should therefore take place before the period of deferment expires. Failure to pay the publication fee or to submit the reproductions before the expiry of the period of deferment results in the cancellation of the international registration. The sanction is more stringent than that concerning the non-payment of the publication fee where the request for deferment has been disregarded by the International Bureau, in accordance with Article 10(3)(i) of the draft new Act (in the latter case, failure to pay the publication fee constitutes an irregularity which is dealt with in the normal way in accordance with Article 8), but provision will be made in the Administrative Instructions for a reminder procedure concerning the furnishing of the reproductions and the payment of the publication fee.

*Notes on Rule 16*

R16.01 *Item (i) of paragraph (2)*. Rule 7(4)(i) provides for a statement that identifies information known to be material to the eligibility for protection of the industrial design to *accompany* the international application. Such a statement is therefore not *contained* in the international application; it follows that it will not be included in the international registration, nor will it be published. This is also the case for any statement or document filed in accordance with Rule 8(2)(ii). The Administrative Instructions will provide for such statements or documents to be forwarded by the International Bureau to the Offices of Contracting Parties whose law requires them.

R16.02 *Item (iv) of paragraph (2)*. Although occasionally an article may be classified in more than one class (e.g., radio-alarm-clock), this item refers to the “relevant class”, in the singular, in conformity with the principle laid down by Rule 7(6) whereby several designs may be the subject of the same international application only if they relate to the same class. This, however, does not prevent the International Bureau from applying a multiple classification on the rare occasions that this is appropriate.

*Notes on Rule 17*

R17.01 *Paragraph (1)*. Item (iii) of this paragraph lays down the general rule whereby the international registration is published six months after the date of international registration. The period of six months takes account of the fact that, under some national and regional laws on the protection of industrial designs, a certain period of time elapses before the registration of an industrial design is published since the examination (whether it is formal or substantive) of an application for the registration of an industrial design and the technical preparations for publication need time. By choosing a period of six months, the Regulations 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. Since Rule 17(1)(iii) is mentioned in Rule 30, this period of six months can be changed by the Assembly only by unanimity.

R17.02 There are two exceptions to the general rule that an international registration is published six months after the date of international registration. The first one is set forth in *item (i) of paragraph (1)*; it refers to the situation in which an applicant requests that an international registration be published immediately after registration of the industrial design in the International Register. Indeed, there may be situations in which early publication may be an advantage. This may be the case, for instance, where, under a national or regional law, the right on an industrial design may be enforced only after it has been published. Since, technically speaking, it is feasible for the International Bureau to publish the international registration earlier than six months from the date of the international registration, there is no reason why the applicant should not be given the possibility to request immediate publication.

R17.03 The terms “immediately after the registration” used in item (i) of paragraph (1) should be read as meaning that the publication will take place as soon as the technical preparations are accomplished after the registration of the industrial design. The adverb “immediately” should necessarily take account of the time needed to accomplish the said technical preparations.

R17.04 The second exception is set forth in *item (ii) of paragraph (1)*; it refers to those international registrations for which a deferment of publication has been requested (see Article 10 and Rule 15 and the corresponding Notes).

R17.05 *Item (i) of paragraph (2)*. The statement that identifies information known to be material to the eligibility for protection of the industrial design and the statement or document concerning the assignment or the application which, pursuant to Rule 7(4)(i) and Rule 8(2)(ii) respectively, may *accompany* the international application will not be published in the Bulletin. Since such statements or document are not *contained* in the international application, they are not part of the data recorded in the International Register (see Note R16.01), and therefore will not be part of the publication of the international registration.

*Notes on Rule 18*

R18.01 *Paragraph (1)(a)*. This provision complements Article 11(2)(a) of the draft new Act and stipulates a basic time limit for notifying a refusal of six months from the date on which the International Bureau sends to the Office a copy of the publication of the international registration.

R18.02 *Paragraph (1)(b)*. This provision replaces former Article 20 of the draft new Act. Its purpose is to provide additional time to Contracting Parties whose Offices carry out novelty examination or whose laws provide for opposition proceedings. It gives the possibility to those Contracting Parties to make a declaration whereby the basic time limit of six months for notifying a refusal is replaced by a time limit of 12 months.

R18.03 Under Article 20 of the draft Act submitted to the seventh session of the Committee of Experts, a Contracting Party could replace the six-month period to issue a refusal by a longer period, specified in the declaration, which *could not exceed* 12 months. Under the present Rule 18(1)(b), a Contracting Party may replace the six-month period by a period of 12 months, without it being possible for that Contracting Party to choose intermediate periods ranging from six to 12 months. Although this solution may seem less flexible than the one set forth in previous Article 20, it has the advantage of simplicity and user-friendliness. It is undoubtedly easier for users to manage two time limits rather than many different ones. Furthermore, this does not preclude an Office which completes examination or opposition proceedings before the 12-month time limit from immediately informing the holder that the industrial design is protected in the Contracting Party concerned.

R18.04 The solution of providing a maximum period to which the basic time limit for notifying a refusal could be extended was justified when, as was the case in previous drafts submitted to the Committee of Experts, a maximum period of 30 months was contemplated. The difference between the basic period of six months and the maximum period of 30 months was considerable and it was in the users' interest to allow for intermediate periods to be elected. The period of 30 months was however reduced to a period of 12 months after the sixth session of the Committee of Experts, during which it was noted that, with the exception of two countries, none of the potential Contracting Parties represented at that session required a period for the notification of refusals exceeding 12 months. At present, the difference between the basic period of six months and the extended period of twelve months does not seem to be so significant as to justify the prevailing of flexibility over simplicity.

R18.05 *Paragraph (1)(c)*. This paragraph complements Article 12(2)(a) of the draft new Act which states that a Contracting Party may make a declaration whereby the international registration will have the same effect as a grant of protection in that Contracting Party at a time later than the date of expiration of the period allowed to notify a refusal. Such declaration will accompany the declaration provided for in paragraph (1)(b).

R18.06 The provision in paragraph (1)(c) takes account of the requirements of those potential Contracting Parties which would need to complete certain procedures such as publication at the national level (albeit not at the expense of the holder of the international registration) before the international registration takes effect.

R18.07 The provision specifies the *latest* time at which an international registration will have the same effect as a grant of protection in a Contracting Party in the case where an Office does not issue a notification of refusal. This does not however preclude an Office from informing the holder, before the time specified in the declaration, that the industrial design is protected in the Contracting Party concerned. Depending on the time when examination takes place, the Office may even be in a position to send such information to the holder before the expiry of the period allowed for that Office to notify a refusal. Such information should however be sent direct to the holder (or his representative) *not* to the International Bureau. In consequence, this information will not be recorded in the International Register or be published by the International Bureau.

R18.08 Since Rule 18(1) is mentioned in Rule 30, any of the periods mentioned in subparagraphs (a), (b) or (c) may be changed by the Assembly only by unanimity.

R18.09 *Item (iii) of paragraph (2)(b)*. It is not sufficient, in a notification of refusal, simply to state that an industrial design may not be protected in the Contracting Party concerned, or simply to refer to the relevant provisions of the applicable law. The grounds for refusal and a reference to the essential provisions of the applicable law must be given.

R18.10 *Paragraph (4)*. The Administrative Instructions will specify the extent of the information that will be recorded (and therefore published).

#### *Notes on Rule 19*

R19.01 *Item (iii) of paragraph (1)(a)*. The Administrative Instructions will deal with the question of notifications of refusal which are sent before the expiry of the relevant period but received by the International Bureau after the expiry of that period. Provision could be made along the lines of Rule 18(1)(a)(iii) of the Common Regulations under the Madrid Agreement and Protocol, which reads as follows:

“In the case of a notification of refusal sent through a postal service, the date of dispatch shall be determined by the postmark. If the postmark is illegible or missing, the International Bureau shall treat such notification as if it was sent 20 days before the date of its receipt by the International Bureau. However, if the date of dispatch thus determined is earlier than the date on which the refusal was pronounced, the International Bureau shall treat such notification as if it had been sent on the latter date. In the case of a notification of refusal sent through a delivery service, the date of dispatch shall be determined by the indication given by such delivery service on the basis of the details of the mailing as recorded by it.”



R19.02 *Paragraph (2)*. The fact that a notification is irregular in the sense of this paragraph does not affect its validity as a notification of refusal.

*Notes on Rule 21*

R21.01 *Paragraph (1)(a)* does not mention a request for recordal of a change in the name or address in the representative, because it will not be necessary to use an official form. Such a request must however comply with paragraph (2); in particular, it must indicate the numbers of all the international registrations concerned.

R21.02 *Paragraph (1)(b)*. The requirements concerning a request for recordal of a change in ownership are based on Rule 19.1(c) of the current Regulations under the Hague Agreement.

R21.03 *Paragraph (5)(b)*. The second sentence of this paragraph is based on Rule 25(2)(c) of the Common Regulations under the Madrid Agreement and Protocol. It may happen that a holder wishes the date of recordal of a change to be linked with the recordal of another change, or the renewal of the same international registration. For example, he may wish a limitation to be recorded after a partial change in ownership, or a renunciation to be recorded before the renewal of the international registration. This provision allows a request to this effect to be made.

R21.04 *Paragraphs (6) and (7)*. These paragraphs are adapted from Rule 27(2) and (3) of the Common Regulations under the Madrid Agreement and Protocol. At present, where there is a partial change in ownership of an international deposit, the resulting deposits continue to have the same number, with a note in the Register and in the file concerning the partial transfer.

*Note on Rule 22*

R22.01 *Paragraph (3)*. The time limit for notifying a refusal of the effect of a correction is to be counted from the date on which the Bulletin in which the correction is published is sent by the International Bureau to the Offices of the designated Contracting Parties.

*Notes on Rule 23*

R23.01 The Administrative Instructions will provide that the notice will indicate those Contracting Parties, and the numbers of those industrial designs, for which, at the date of the notice, renewal of the international registration is possible. This should reduce the risk of error and allow the holder to determine the amount due.

R23.02 The expression “renewal of the international registration is possible” used in the preceding paragraph should be interpreted broadly, i.e., it should include those Contracting Parties for which a refusal has been recorded or for which the maximum term has expired, but for which a renewal of the international registration could be made in accordance with Rule 24(2)(b) or (c).

R23.03 It is understood that the fact that the notice of expiry is not received covers also the case where it is not sent.

*Notes on Rule 24*

R24.01 *Paragraph (1)*. As in the case of the fees payable in connection with an international application (see Note R12.01), the amounts of the basic fee and the standard designation fee or individual designation fee may depend on the number of industrial designs for which renewal is effected.

R24.02 *Items (ii) and (iii) of paragraph (1)(a)*. In line with the practice under the Madrid Agreement and Protocol, the unofficial notice of expiry will invite the holder to renew the international registration in respect of those designated Contracting Parties for which no total refusal or invalidation is recorded (but see Note R24.03).

R24.03 *Paragraph (2)(b)*. Although the unofficial notice of expiry will refer to all designated Contracting Parties for which no total refusal or invalidation is recorded, provision is made for the international registration to be renewed, on the specific request of the holder, even though the maximum term of protection for industrial designs in that Contracting Party has expired. It has been considered that the holder of the international registration is the best judge to assess the opportunity to renew an international registration. Even though Article 15(3)(c) provides for Contracting Parties to notify the International Bureau of the maximum period of protection under their law, the holder may have relevant information not yet available to the International Bureau. It is for the Contracting Party concerned to determine what (if any) is the effect of such renewal.

R24.04 *Paragraph (2)(c)*. Similarly, provision is made for the international registration to be renewed in respect of a designated Contracting Party, on the specific request of the holder, even though a total refusal has been recorded with respect to that Contracting Party. Once again, the renewal is effected under the holder’s responsibility and the latter is the best judge to assess the opportunity to renew an international registration in respect of a given Contracting Party. In the case at hand, the grounds for refusal may have ceased to exist in the Contracting Party concerned, and the holder may be aware thereof. As in the previous case, it is for that Contracting Party to determine what (if any) is the effect of such renewal. This provision is based on Rule 30.2(b) of the Common Regulations under the Madrid Agreement and Protocol.

*Notes on Rule 26*

R26.01 *Paragraph (2)*. Publication in accordance with this paragraph will comprise

(i) any declaration made under Article 4(1)(b) or notification made under Rule 13(4) (filing of international application through an Office);

(ii) any declaration made under Article 7(2) (individual designation fee);

(iii) any declaration made under Article 10(1)(a) or (b) (deferment of publication);

(iv) any declaration made under Article 15(3)(c) (maximum period of protection provided for by the national law);

(v) any declaration made under Article 17(1) (additional elements);

(vi) any declarations made under Article 18(1) (special requirements concerning unity of design);

(vii) any declaration made under Rule 8(1)(a) (special requirements concerning the applicant);

(viii) any declaration made under Rule 18(1)(b) (time period for notification of refusal of effect);

(ix) any notification made under Rule 9(3)(a) (views required);

(x) any notification made under Rule 27(1)(c) (Office which accepts to collect fees).

R26.02 *Paragraph (3)(a)*. This provision is based on Rule 32(4) of the Common Regulations under the Madrid Agreement and Protocol. The number of designations taken into account as a basis for sending additional copies, namely 500 designations, has been considered to be appropriate in the context of the international registration of industrial designs.

R26.03 *Paragraph (3)(b)*. At present, reproductions of industrial designs are published in the form of a CD-ROM. The wording in this paragraph leaves the possibility open to publication in any form which may result from the development of new technologies.

*Notes on Rule 27*

R27.01 *Paragraph (3)*. If the name of the applicant or holder is missing but the international application or registration concerned can be identified by the International Bureau beyond any doubt, the payment will be accepted.

R27.02 *Paragraph (4)(a)*. It is to be noted in particular that, where an applicant takes advantage of the facility referred to in paragraph (1)(b) of paying through the Office with which the international application is filed, the fees are nevertheless not considered to have been paid until they have been received by the International Bureau.

*Notes on Rule 29*

R29.01 This follows Rule 38 of the Common Regulations under the Madrid Agreement and Protocol, which however relates only to individual fees. At present, State fees paid under the Hague Agreement are distributed annually (Rule 28.7).

R29.02 The fees that fall within the scope of this provision are the standard designation fees and the individual designation fees. Any further fees payable on division of registration referred to in Article 18(3) would have to be paid by the holder direct to the Office concerned.

*Note on Rule 30*

R30.01 Article 25(2)(a) states that the Rules which may be amended only by unanimity will be specified in the Regulations. Rule 30 specifies those Rules which, because of their particular importance, require unanimity in order to be amended. Most of them prescribe time periods which were, in earlier drafts, specified in the Act itself.

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