

WIPO



H/A/18/1

ORIGINAL: English

DATE: August 20, 1999

WORLD INTELLECTUAL PROPERTY ORGANIZATION

GENEVA

SPECIAL UNION FOR THE INTERNATIONAL DEPOSIT OF INDUSTRIAL DESIGNS (HAGUE UNION)

ASSEMBLY

Eighteenth (12th Ordinary) Session Geneva, September 20 to 29, 1999

CLAIMING PRIORITY UNDER THE HAGUE AGREEMENT: PROPOSED AMENDMENTS TO THE REGULATIONS

Memorandum of the Secretariat

1. Article 2.1 of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement) provides that Members of the World Trade Organization (WTO) shall comply with Articles 1 to 12 and 19 of the Paris Convention for the Protection of Industrial Property. This has been taken to mean that a Member of the WTO is obliged to recognize a claim to priority based on an application for a patent or for the registration of a utility model, industrial design or trademark filed in or for (a) a State which is a party to the Paris Convention or (b) any Member of the WTO even if the latter is not a party to the Paris Convention.

2. Express account of this interpretation is taken by Article 6(1)(a) of the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs, adopted on July 2, 1999, which reads:

“The international application may contain a declaration claiming, under Article 4 of the Paris Convention, the priority of one or more earlier applications filed in or for any country party to that Convention or any Member of the World Trade Organization.”

It is to be noted that, while this provision refers to the possibility of claiming priority from an application filed either in a country party to the Paris Convention or in a Member of the WTO, in either case *the claim is made under Article 4 of the Paris Convention*. In other words, where the earlier application was filed in a Member of the WTO which is not a party to the Paris Convention, the claim to priority is considered to be made under Article 4 of the Paris Convention *as applied by Article 2.1 of the TRIPS Agreement*. It is also to be noted that, as stated in the Notes concerning Article 6(1)(a) as presented to the Diplomatic Conference which adopted the Geneva Act (document H/DC/5, paragraph 6.03), this provision would not oblige a Contracting Party which is not a Member of the WTO to recognize the effects of a priority claim based on an application filed in a State that is not party to the Paris Convention. The Geneva Act is, of course, not yet in force.

3. In contrast, the two Acts of the Hague Agreement that are currently in force (the 1934 Act (Article 4(4)) and the 1960 Act (Article 9)) and their Regulations (Rule 6.2) refer only to the Paris Convention, since they were adopted long before the TRIPS Agreement. The text of the relevant provisions is given in the Annex.

4. Bearing in mind the remarks in paragraph 2, above, to the effect that, whether the earlier application was filed in a country party to the Paris Convention or in a Member of the WTO, the claim to priority is always made under Article 4 of the Paris Convention, it will be seen that Article 4(4) of the 1934 Act, which guarantees the right of priority under the General Convention (that is, the Paris Convention), is not at variance with the notion that, where a contracting country is also a Member of the WTO, it is under an obligation to recognize a claim to priority even where the earlier application was filed in a Member of the WTO which is not party to the Paris Convention. Moreover, while Article 9 of the 1960 Act provides that the priority date shall be the date on which an earlier application was filed in a country which is party to the Paris Convention, the according of a priority date where the earlier application was filed in a member of the WTO which is not a party to the Paris Convention would not conflict with this provision but would rather be complementary to it since priority claims made under the TRIPS Agreement are in fact made under Article 4 of the Paris Convention.

5. In the view of the International Bureau therefore, nothing in the provisions of the 1934 Act or the 1960 Act of the Hague Agreement prevents the recording of a priority date resulting from a first filing in a Member of the WTO which is not a party to the Paris Convention. However the fact that Rule 6.2(a) refers only to an earlier deposit effected in or in respect of a State party to the Paris Convention, coupled with the prescriptions in Rule 8.3 that the application shall not contain any matter other than that prescribed or permitted by the Agreement or the Regulations and that, if it does contain such matter, the International Bureau shall delete it *ex officio*, implies that the International Bureau should not accept, and therefore cannot record and publish, a claim to priority from an earlier deposit effected in a country or other entity that is not a party to the Paris Convention.

6. At present, the practice of the International Bureau is to check that the first filing whose priority is claimed was effected in or for a State party to the Paris Convention. However, although the International Bureau is not aware of an instance so far of an international application containing a claim to priority from an application filed in a Member of the WTO which is not a

party to the Paris Convention, if the International Bureau were, in accordance with its present practice, to decline to record such a claim, a State in which the international deposit has effect and which is a Member of the WTO would be hindered from fulfilling its obligation to recognize the priority claim.

7. In order to obviate this situation, it is proposed to amend both paragraphs (a) and (b) of Rule 6.2 of the present Regulations to read:

“(a) Any application may contain a declaration claiming, under the Paris Convention for the Protection of Industrial Property, the priority of one or more earlier deposits _.

(b) The declaration claiming the priority of an earlier deposit shall indicate:

(i) the date of the earlier deposit;

(ii) the number of the earlier deposit;

(iii) the name of the Office where the earlier deposit was made or, if this is the case, the fact that the earlier deposit was effected under the Agreement.”

8. In view of the fact that most of the Members of the WTO that are not yet bound by Article 2.1 of the TRIPS Agreement will become bound by that Article on January 1, 2000, it is proposed that the above amendments enter into force on that date.

9. It should be noted that these amendments will not oblige a Member of the Hague Union that is not a Member of the WTO to recognize the effects of a priority claim based on an application filed in a Member of the WTO that is not party to the Paris Convention.

10. The Assembly of the Hague Union is invited to adopt the amendments to Rule 6.2(a) and (b) proposed in paragraph 7, above, and to decide that those amendments shall enter into force on January 1, 2000.

[Annex follows]

ANNEX

PROVISIONS OF THE HAGUE AGREEMENT AND ITS REGULATIONS THAT
CONCERN PRIORITY

Article 4(4) of the 1934 Act

The right of priority established by Article 4 of the General Convention shall be guaranteed to every design which has been the subject of an international deposit, without requiring compliance with any of the formalities prescribed in the said Article.

Article 9 of the 1960 Act

If the international deposit of a design is made within six months of the first deposit of the same design in a State member of the International Union for the Protection of Industrial Property, and if priority is claimed for the international deposit, the priority date shall be that of the first deposit.

Rule 6.2 of the Regulations as in force on January 1, 1999

(a) Any application may contain a declaration claiming the priority of one or more earlier deposits effected in or in respect of one or more States party to the Paris Convention for the Protection of Industrial Property.

(b) The declaration claiming the priority of an earlier deposit shall indicate:

(i) the date of the earlier deposit;

(ii) the number of the earlier deposit;

(iii) the State in which the earlier deposit was effected; where the deposit was effected under a regional treaty, the Office at which it was effected and at least one State in respect of which it was effected; where the earlier deposit was effected under a special agreement within the meaning of Article 19 of the Paris Convention, the title of such agreement.

(c) If the declaration does not contain the indications referred to in paragraphs (b)(i) and (iii), the International Bureau shall treat the declaration as if it had not been made.

(d) If the earlier deposit number referred to in paragraph (b)(ii) is not indicated in the declaration but is furnished by the depositor or the owner to the International Bureau prior to the expiration of the tenth month from the date of the earlier deposit, it shall be considered to have been included in the declaration and shall be published by the International Bureau.

(e) If the date of the earlier deposit as indicated in the declaration precedes the date of the international deposit by more than six months, the International Bureau shall treat the declaration as if it had not been made.

(f) If the declaration claims the priority of more than one earlier deposit, the provisions of paragraphs (b) to (e) shall apply to each of them.

(g) Any application may contain an indication to the effect that the article or articles in which the designs are incorporated have been shown at an official or officially recognized international exhibition, together with the place where the exhibition was held and the date on which the article or articles were first exhibited there.

Article 6(1)(a) of the Geneva Act

The international application may contain a declaration claiming, under Article 4 of the Paris Convention, the priority of one or more earlier applications filed in or for any country party to that Convention or any Member of the World Trade Organization.

Rule 7(4)(e) of the Regulations under the Geneva Act

Where the applicant wishes, under Article 4 of the Paris Convention, to take advantage of the priority of an earlier filing, the international application shall contain a declaration claiming the priority of that earlier filing, together with an indication of the name of the Office where such filing was made and of the date and, where available, the number of that filing and, where the priority claim relates to less than all the industrial designs contained in the international application, the indication of those industrial designs to which the priority claim relates or does not relate.

[End of Annex and of document]

