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Working Group on the Legal Development of the Hague System for the International Registration of Industrial Designs

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PROPOSAL FOR AMENDMENTS TO THE ADMINISTRATIVE INSTRUCTIONS

Document prepared by the International Bureau

I. INTRODUCTION

1. Pursuant to Rule 34(1) of the Common Regulations Under the 1999 Act and the 1960 Act of the Hague Agreement (hereinafter referred to as the “Common Regulations”), the Director General of the World Intellectual Property Organization (WIPO) may modify the Administrative Instructions for the Application of the Hague Agreement (hereinafter referred to as the “Administrative Instructions”) after having consulted the Offices of Contracting Parties.

2. The Administrative Instructions were last amended with effect from January 1, 2019. Since then, the International Bureau has enhanced the availability and functions of the Hague System online services; in particular, *Contact Hague* has now become a popular means to securely submit documents to the International Bureau, as an alternative to their submission by postal and delivery services. Furthermore, due to the impact of the COVID-19 pandemic on users of the Hague System as well as the International Bureau, the Assembly of the Hague Union, at its fortieth (18th extraordinary) session held in September 2020, adopted amendments to the Common Regulations, making the indication of an e-mail address a mandatory requirement. These amendments entered into force on February 1, 2021¹.

3. The purpose of the present document is to propose amendments to the Administrative Instructions reflecting these recent developments and resulting practice of the International Bureau. It has been prepared with a view to engaging in the above-mentioned consultation on proposed amendments to Sections 202, 301, 302 and 601 of the Administrative Instructions, thus inviting the Working Group to comment on the proposals.

¹ Refer to documents H/A/40/1 and H/A/40/2.

II. AMENDMENTS TO SECTION 202

SIGNATURE IN “TYPED” FORM AND DELETION OF “SEAL” (SECTION 202)

Signature in “Typed” Form

4. Section 202 of the Administrative Instructions prescribes that a signature shall be hand written, printed or stamped, or may be replaced by the affixing of a seal. Special provisions furthermore apply to electronic communications made pursuant to Sections 204(a) and 205.

5. Nowadays, most communications sent by users of the Hague System to the International Bureau are effected in electronic form. In the *eHague* environment, a signature is applied in electronic form². Documents submitted through *Contact Hague* are often signed by typing the signatory’s name using a computer, without the need for printing, signing by hand and scanning the document. Therefore, it has been the practice under the Hague System to accept this type of signature in order to accommodate users’ preferences. The same practice is also applied under the Madrid System.

6. As far as the Madrid System is concerned, Section 7 of the Administrative Instructions for the Application of the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (hereinafter the “Madrid Administrative Instructions”) was amended with effect from February 1, 2020, in order to clarify that signatures could be effected in “typed” form³.

7. It is thus proposed to align the Administrative Instructions with the current practice of the International Bureau by clarifying in Section 202 that signatures can be provided in “typed” form, as reproduced in the Annex, and as was done in the Madrid Administrative Instructions.

Provision Regarding the Affixing of a Seal

8. As mentioned above, documents submitted in the Hague and Madrid Systems are now often completed electronically, and seals have thus fallen into disuse.

9. As far as the Madrid System is concerned, Section 7 of the Madrid Administrative Instructions was amended and the provision regarding the affixing of a seal was deleted with effect from February 1, 2021⁴.

10. It is proposed to delete the provision regarding the affixing of a seal in Section 202, as reproduced in the Annex, so as to be aligned with the wording of Section 7 of the Madrid Administrative Instructions.

11. It is however to be noted that the purpose of the amendment is a mere simplification of the provision. As in the Madrid System, a seal would, if used, continue to be accepted as a type of stamp.

² *eHague* is the main online system to file international applications and to renew international registrations (and to carry out other transactions in the future).

³ Refer to the Madrid Administrative Instructions, Section 7, as in force since February 1, 2021. A consultation with its members took place through Note C.M 1511 dated December 10, 2020).

⁴ Refer to the Madrid Administrative Instructions, Section 7, as in force on February 1, 2021.

SIGNATURE FOR COMMUNICATIONS IN ELECTRONIC FORM (SECTION 202)

12. In order to enhance the clarity of Section 202, it is further proposed to separate the signature requirements into two paragraphs, a first paragraph to outline the signature requirements for communications not sent in electronic form, and a second paragraph to outline those for communications sent in electronic form.

13. More specifically, it is proposed to move the signature requirements for communications referred to in Sections 204(a)(i) and (ii) and 205, to a new paragraph (b) of Section 202 and to align the wording with that in Section 7 of the Madrid Administrative Instructions, as reproduced in the Annex.

III. AMENDMENTS TO SECTIONS 301 AND 302

NAMES AND ADDRESSES (SECTION 301)

14. It is recalled that Section 203 of the Administrative Instructions was deleted (discontinuation of the use of facsimile for communication with the International Bureau) with effect from January 1, 2019. Since communication with the International Bureau via facsimile is no longer possible, it is proposed to delete the reference to facsimile in Section 301(d), as reproduced in the Annex.

15. The current wording of Section 301(d) provides for an email address as an optional element. However, since February 1, 2021, providing the email address of the applicant, new owner and representative is mandatory under Rules 3, 7 and 21 of the Common Regulations⁵. Moreover, unlike for the provision of the name and address, the Common Regulations do not leave it to the Administrative Instructions to prescribe the manner of the provision of the email address, as it appears to be straightforward⁶. Consequently, it is proposed to delete the reference to an email address in Section 301(d), as reproduced in the Annex.

16. The opportunity is also seized to delete the reference to telephone number in Section 301(d), because a telephone (*i.e.* mobile) is not necessarily associated with the postal address nowadays. The provision of a telephone number is in any case always recommended by the International Bureau, and the official forms continue to provide a section for the indication of a telephone number as an optional element.

17. In relation to the proposed deletion of the reference to the address for correspondence in Section 301(d), refer to the next item (Section 302), below.

EMAIL ADDRESS FOR CORRESPONDENCE (SECTION 302)

18. Provisions regarding a postal address for correspondence are currently contained in Sections 301(d) and 302. Section 301(d) prescribes that a different postal address for correspondence may be indicated as an optional element. Section 302 provides that, where there are multiple applicants or new owners with different addresses and no representative is appointed, one address for correspondence shall be indicated. Where no such address is indicated, the address of the person named first shall be treated as the address for correspondence. Accordingly, the International Bureau will send any postal communications to the address for correspondence.

⁵ Refer to Information Notice No. 41/2020.

⁶ Refer to the exact wordings of Rules 3(2)(c), 7(3)(i) and (ii), 7(5)(b) and 21(2)(iii).

19. In this regard, it serves recalling that, as of February 1, 2021, the Common Regulations require the indication of an email address as a mandatory element. Furthermore, communications sent by the International Bureau are currently sent by email. In other words, the International Bureau no longer sends communications to any postal address, including those provided or considered as an address for correspondence.

20. It is therefore proposed to delete the reference to the address for correspondence in Sections 301(d) and 302 and to amend Section 302, so as to require applicants or new owners to provide one email address as the email address for correspondence, as reproduced in the Annex. If such address is not indicated, the email address of the person named first shall be treated as the email address for correspondence⁷.

IV. AMENDMENTS TO SECTION 601

REQUEST FOR THE RECORDING OF A LIMITATION OR RENUNCIATION (SECTION 601)

21. Section 601 of the Administrative Instructions prescribes the time limit for requesting the recording of a limitation or renunciation when publication is deferred so that the publication would take into account the recording of the requested limitation or renunciation.

22. Pursuant to Rule 17(1)(iii) of the Common Regulations, an international registration is published six months after the date of the international registration or as soon as possible thereafter (so-called “standard publication”), unless the applicant requested immediate publication or a deferment of publication (Rule 17(1)(i) or (ii)). Although Section 601 does not refer to the standard publication, it is the practice of the International Bureau to apply the same time limit in situations where Rule 17(1)(iii) applies.

23. In this regard, it bears recalling that a proposal to extend the standard publication period from six to 12 months has been submitted to the forty-first session of the Hague Union Assembly, to be held in October 2021, for adoption, with the proposed date of entry into force of January 1, 2022⁸. This proposed extension would potentially increase the number of cases where holders would request the recording of a limitation or renunciation before the expiry of the standard publication period.

24. It is proposed to amend Section 601, as reproduced in the Annex, so as to explicitly cover the scenario where standard publication applies pursuant to Rule 17(1)(iii).

V. PROPOSED DATE OF ENTRY INTO FORCE

25. In accordance with Rule 34(3)(a) of the Common Regulations, any amendments to the Administrative Instructions are to be published on the website of the Organization. Publication is made through an Information Notice issued by the International Bureau. Furthermore, pursuant to Rule 34(3)(b), each publication shall specify the date on which the published provisions become effective.

26. Should the Working Group agree to the current proposals to amend Sections 202, 301, 302 and 601 of the Administrative Instructions, it may further recommend the date of entry into force. It is proposed that the said amendments should enter into force on April 1, 2022.

⁷ Where a representative is appointed, the International Bureau shall send communications to the representative pursuant to Rule 3(4)(b).

⁸ Refer to document H/A/41/1.

27. The Working Group is invited to comment on the proposals to amend Sections 202, 301, 302 and 601 of the Administrative Instructions, as set out in the Annex, with a date of entry into force of April 1, 2022.

[Annex follows]

Administrative Instructions for the Application of the Hague Agreement

(as in force on [April 1, 2022])

[...]

Part Two Communications with the International Bureau

[...]

Section 202: Signature

(a) A signature shall be hand written, printed, typed or stamped; ~~it may be replaced by the affixing of a seal or, as regards the electronic communication referred to in Section 204(a)(i) or (ii) or communications through a user account referred to in Section 205, by a mode of identification to be determined by the International Bureau or agreed upon between the International Bureau and the Office concerned, as the case may be.~~

(b) With respect to electronic communications referred to in Section 204(a)(i) or communications through a user account referred to in Section 205, a signature may be replaced by a mode of identification to be determined by the International Bureau. With respect to electronic communications referred to in Section 204(a)(ii), a signature may be replaced by a mode of identification agreed upon between the International Bureau and the Office concerned.

[...]

Part Three Requirements Concerning Names and Addresses

Section 301: Names and Addresses

[...]

(d) An address shall be given in such a way as to satisfy the customary requirements for prompt postal delivery and shall consist, at least, of all the relevant administrative units up to, and including, the house number, if any. ~~In addition, telephone and telefacsimile numbers, an e-mail address as well as a different address for correspondence may be indicated.~~

Section 302: Email Address for Correspondence

Where there are two or more applicants or new owners ~~with different addresses~~ and no representative is appointed, one email address for correspondence shall be indicated. Where no such address ~~has been~~ is indicated, the email address of the person named first shall be treated as the email address for correspondence.

[...]

Part Six
Request for the Recording of a Limitation or Renunciation
when Before Publication Deferred

Section 601: Latest Time to Request the Recording of a Limitation or Renunciation

Where ~~the publication of an international registration is deferred~~ Rule 17(1)(ii) or (iii) applies, a request for the recording of a limitation or renunciation concerning that registration, complying with the applicable requirements, must be received by the International Bureau not later than three weeks prior to the expiry of the period ~~of deferment~~ for publication referred to in Rule 17(1)(ii) or (iii), respectively. In default of this, the international registration is published as provided in Rule 17(1)(ii) or (iii), as the case may be, ~~at the expiration of the period of deferment~~ without account being taken of the request for the recording of a limitation or renunciation. Provided that the request for limitation or renunciation complies with the applicable requirements, the limitation or renunciation is however recorded in the International Register.

[End of Annex and of document]