

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

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PROPOSAL FOR A NEW RULE RELATING TO AMENDMENTS TO THE INDICATIONS CONCERNING THE IDENTITY OF THE CREATOR

Document prepared by the International Bureau

I. BACKGROUND

1. The centralized management of an international registration having effect in various designated Contracting Parties is one of the fundamental features of the Hague System for the International Registration of Industrial Designs (hereinafter referred to as the “Hague System”). Various types of changes subsequent to international registration, such as changes in ownership, changes in the name or address of the holder, renunciations and limitations may be recorded in the International Register, in accordance with Rule 21(1) of the Common Regulations Under the 1999 Act and the 1960 Act of the Hague Agreement (hereinafter referred to as the “Common Regulations”). Furthermore, those recorded changes are published in the *International Designs Bulletin* (hereinafter referred to as the “Bulletin”), available on the WIPO website and through which the Offices of designated Contracting Parties will be notified, and third parties will be made aware, pursuant to Rule 26(1) and (3).

2. Indications concerning the identity of the creator of the industrial design may be included in an international application, either as additional mandatory content in accordance with Rule 7(4)(b) or (c), or as optional content in accordance with Rule 7(5)(a). Such indications constitute the full name and address of the creator pursuant to Rule 11(1) and Section 301 of the Administrative Instructions for the Application of the Hague Agreement* (hereinafter referred

* In the case of a natural person, his full name, and, in the case of a legal entity, its full official designation must be provided, in accordance with Section 301 of the Administrative Instructions.

to as the “Administrative Instructions”). This information becomes part of the contents of the international registration pursuant to Rule 15(2)(i), and is published in the Bulletin pursuant to Rules 17(2)(i) and 26(1)(i).

3. Occasionally, the International Bureau receives a request from the holder of an international registration to record a change in the name or address of the creator in the International Register. Such a change may occur as often as a change in the name or address of the holder, for instance, as a result of the creator’s moving to a new address or, in the case of a natural person, a change in marital status. More often, however, the International Bureau receives a similar request after an international application has matured into an international registration where, for instance, it was discovered that the creator was incorrectly identified or named in the international application form.

4. In the latter case, it has been the practice of the International Bureau that it accepts a request to correct the information, and issues a correction in accordance with Rule 22(1). Otherwise, the correct information would not be reflected in the International Register, and such correct information would neither be published nor made aware to the Offices of designated Contracting Parties and third parties. On the other hand, in the former case, there is no mechanism in the Hague System to keep updated the current name and address of the creator. Indications of the identity of the creator provided in the international application remain in the International Register as part of the international registration.

II. ANALYSIS

5. Providing accurate or updated information concerning the creator should be important on the part of the holder and the creator. Article 10(3)(a) of the 1999 Act of the Hague Agreement Concerning the International Registration of Industrial Designs (hereinafter referred to as the “1999 Act” and the “Hague Agreement”) provides that “(t)he international registration shall be published by the International Bureau. Such publication shall be deemed in all Contracting Parties to be sufficient publicity, and no other publicity may be required of the holder”. Moreover, such an international publication takes the place of a notification of an international registration or of a recording of a change to the Office of each designated Contracting Party in accordance with Rule 26(3). Thus, the Bulletin serves as an official notification tool to Offices.

6. Furthermore, all recordings published in the Bulletin are available through the Hague Express Database in a more consolidated manner with efficient search functions. If designers consider it as a useful tool in order to publicize their works and activities all over the world, it would be desirable for their current names and addresses to be kept updated.

7. On the part of the Office of a designated Contracting Party which requires that indications concerning the identity of the creator be provided pursuant to Article 5(2) of the 1999 Act or Rule 8 of the Common Regulations, or otherwise in accordance with the applicable law, to receive accurate information concerning the identity of the creator should be important. As described in paragraphs 3 and 4, above, if, for instance, it was discovered later that the creator was incorrectly identified, or an extra person was identified as a co-creator, the holder may seek a correction under Rule 22(1), and, as a result, the corrected information is notified to the Offices through its publication in the Bulletin. The question is whether those Offices would also need an update of the name and address of the creator, or would find it useful.

8. To the knowledge of the International Bureau, there are some Contracting Parties to the Hague System whose legislations have the mechanism to keep updated the identity of the creator, even after registration or grant of patent, on the basis of a request.

9. The International Bureau is of the view that providing for the possibility of this new type of recording would add more benefits for the users of the Hague System, without bringing any negative impact on the system. Bearing in mind that the centralized management of an international registration having effect in various designated Contracting Parties is one of its fundamental features, extending its services in this regard should rather be encouraged.

10. Moreover, unless Rule 7(4)(b) or (c) is applicable, indications concerning the identity of the creator are not required. Thus, some international registrations are recorded without the identity of the creator. Later, for some reason, however, the holder may realize that the identity of the creator should be added and recorded as part of the international registration. In this particular case, the International Bureau cannot accept such a late addition and treat it as a correction under Rule 22(1), as there was no error to be corrected. Having said that, it is easy to envisage such a situation, and the International Bureau finds no reason not to accept such a request for the late addition of the identity of the creator, if the Common Regulations were to allow a request for the recording of a change in the name or address of the creator.

III. PROPOSAL

11. The issues described in the foregoing paragraphs require amendments to Rules 21 and 26 of the Common Regulations, and to the Schedule of Fees, as proposed below. In this regard, it is recalled that Article 16(1)(vii) of the 1999 Act explicitly leaves it to the Common Regulations to determine what other relevant facts may be recorded in the International Register, in addition to those set out in Article 16(1)(i) to (vi). Article 16(3) further prescribes that any recording made under paragraph (1) may be subject to the payment of a fee.

AMENDMENTS TO RULE 21

12. It is proposed to add a new subparagraph (v) in paragraph (1)(a) in order to provide for the possibility to record in the International Register a change in the indications concerning the creator of an industrial design. This new type of request will not only allow to record a change in the name or address of the creator, but also a provision of indications concerning the identity of the creator which was not provided in the international application.

13. Thus, where the international registration was recorded without the identity of the creator, as described in paragraph 10, the holder will still be able to provide this type of information, subsequent to the registration and at any time. This is also the case, for instance, where the identity of the creator of design No. 1 was only provided in an international application containing two designs. Under the proposed new provision, the identity of the creator of design No. 2 may be added and recorded subsequently in the International Register. This new provision will not, however, apply if, for instance, an extra person was identified as a co-creator of design No. 1. In this particular case, it is considered that the initial indications concerning the creator of design No. 1 were incorrect or insufficient, and therefore should fall under the scope of Rule 22(1) instead.

14. Proposed new subparagraph (2)(vi) will deal with the case of the provision of indications concerning the identity of a creator who is not the creator of all of the industrial designs that are the subject of an international registration. This additional indication is necessary for the International Bureau to be able to associate that creator with the industrial designs created by that same person, and to record and publish that information correctly.

AMENDMENT TO RULE 26

15. As is the case with all other types of recordings of changes, changes in the indications concerning the creator of the industrial design should be published in the Bulletin. It is thus proposed to amend subparagraph (iv) of Rule 26(1) accordingly.

AMENDMENT TO THE SCHEDULE OF FEES

16. For a request to record a change in the indications concerning the creator of the industrial design, it is proposed to apply the same amount of fee payable for a request to record a change in the name or address of the holder, which is 144 Swiss francs for one international registration, and 72 Swiss francs for each additional international registration included in the same request. Following the addition of this new fee item to the Schedule of Fees, the subsequent numbers of all of the existing fee items therein will be renumbered.

DATE OF ENTRY INTO FORCE

17. The proposed amendments to the Common Regulations will not require any course of action by Offices of Contracting Parties but only modifications to the IT system and the examination procedures at the International Bureau. Thus, if the proposal is considered favorably by the Working Group and adopted by the Assembly of the Hague Union, the proposed new rules should be implemented shortly after their adoption.

18. *The Working Group is invited to:*

(i) consider the proposal made in this document and comment on it; and

(ii) indicate whether it would recommend to the Assembly of the Hague Union for adoption, the proposed amendments to the Common Regulations with respect to Rules 21 and 26 and to the Schedule of Fees, as provided in the draft contained in the Annex hereto, with a date of entry into force of January 1, 2017.

[Annex follows]

**Common Regulations
Under the 1999 Act and the 1960 Act
of the Hague Agreement**

(as in force on [January 1, 2017])

*Rule 21
Recording of a Change*

(1) [*Presentation of the Request*] (a) A request for the recording shall be presented to the International Bureau on the relevant official form where the request relates to any of the following:

- (i) a change in the ownership of the international registration in respect of all or some of the industrial designs that are the subject of the international registration;
- (ii) a change in the name or address of the holder;
- (iii) a renunciation of the international registration in respect of any or all of the designated Contracting Parties;
- (iv) a limitation, in respect of any or all of the designated Contracting Parties, to one or some of the industrial designs that are the subject of the international registration;
- (v) [the provision of, or a change in the indications concerning the identity of the creator of any or all of the industrial designs that are the subject of the international registration.](#)

(b) The request shall be presented by the holder and signed by the holder; however, a request for the recording of a change in ownership may be presented by the new owner, provided that it is

- (i) signed by the holder, or
- (ii) signed by the new owner and accompanied by an attestation from the competent authority of the holder's Contracting Party that the new owner appears to be the successor in title of the holder.

(2) [*Contents of the Request*] The request for the recording of a change shall, in addition to the requested change, contain or indicate

- (i) the number of the international registration concerned,
- (ii) the name of the holder, unless the change relates to the name or address of the representative,
- (iii) in case of a change in the ownership of the international registration, the name and address, given in accordance with the Administrative Instructions, of the new owner of the international registration,
- (iv) in case of a change in the ownership of the international registration, the Contracting Party or Parties in respect of which the new owner fulfills the conditions to be the holder of an international registration,
- (v) in case of a change in the ownership of the international registration that does not relate to all the industrial designs and to all the Contracting Parties, the numbers of the industrial designs and the designated Contracting Parties to which the change in ownership relates,
- (vi) [in case of the provision of indications concerning the identity of the creator of the industrial design, the numbers of the industrial designs concerned, where the person is not a creator of all the industrial designs that are the subject of the international registration,](#) and
- (vii) the amount of the fees being paid and the method of payment, or instruction to debit the required amount of fees to an account opened with the International Bureau, and the identification of the party effecting the payment or giving the instructions.

[...]

Rule 26
Publication

(1) [*Information Concerning International Registrations*] The International Bureau shall publish in the Bulletin relevant data concerning

- (i) international registrations, in accordance with Rule 17;
- (ii) refusals, with an indication as to whether there is a possibility of review or appeal, but without the grounds for refusal, and other communications recorded under Rules 18(5) and 18*bis*(3);
- (iii) invalidations recorded under Rule 20(2);
- (iv) changes in ownership and mergers, changes of name or address of the holder, renunciations, ~~and~~ limitations, and provisions of, or changes in the indications concerning the identity of the creator of the industrial design recorded under Rule 21;
- (v) corrections effected under Rule 22;
- (vi) renewals recorded under Rule 25(1);
- (vii) international registrations which have not been renewed;
- (viii) cancellations recorded under Rule 12(3)(d);
- (ix) declarations that a change in ownership has no effect and withdrawals of such declarations recorded under Rule 21*bis*.

[...]

SCHEDULE OF FEES
(as in force on [January 1, 2017])

Swiss francs

[...]

V.	Miscellaneous Recordings	
13.	Change in ownership	144
14.	Change of name and/or address of the holder	
14.1	For one international registration	144
14.2	For each additional international registration of the same holder included in the same request	72
15.	Renunciation	144
16.	Limitation	144
17.	<u>Provision of, or change in the indications concerning the identity of the creator of the industrial design</u>	
17.1	<u>For one international registration</u>	<u>144</u>
17.2	<u>For each additional international registration included in the same request</u>	<u>72</u>

[...]

[End of Annex and of document]