

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

Sixth Session
Geneva, June 20 to 22, 2016

REVISED PROPOSAL FOR AMENDMENTS TO RULES 21 AND 26 OF THE COMMON REGULATIONS

Document prepared by the International Bureau

I. BACKGROUND

DISCUSSION IN THE FIFTH SESSION OF THE WORKING GROUP

1. At its fifth session, the Working Group on the Legal Development of the Hague System for the International Registration of Industrial Designs (hereinafter referred to as the “Working Group” and the “Hague System”) discussed a proposal to amend the Common Regulations Under the 1999 Act and the 1960 Act of the Hague Agreement (hereinafter referred to as the “Common Regulations”) in order to allow the recording in the International Register of a change in the indications concerning the identity of the creator of an industrial design¹.
2. The corresponding procedures in different jurisdictions were explained by delegations, and the proposal was largely supported by the Working Group. Accordingly, the Chair of the Working Group concluded that the Secretariat would prepare a revised document to continue the discussion at the sixth session of the Working Group, taking into account the different positions expressed by the delegations and representatives of user organizations².

¹ Refer to document H/LD/WG/5/3.

² Refer to documents H/LD/WG/5/7, paragraphs 15 to 17, and H/LD/WG/5/8 Prov., paragraphs 36 to 69.

II. LEGAL CONSIDERATIONS

ARTICLE 16 OF THE GENEVA (1999) ACT OF THE HAGUE AGREEMENT AND RULE 21 OF THE COMMON REGULATIONS

3. Article 16 of the Geneva (1999) Act of the Hague Agreement (hereinafter referred to as the “1999 Act”) and Rule 21 of the “Regulations under the Geneva Act” were agreed and adopted at the Diplomatic Conference for the Adoption of a New Act of the Hague Agreement Concerning the International Deposit of Industrial Designs (Geneva Act) (hereinafter referred to as the “Diplomatic Conference”) in 1999. Article 16(1) of the 1999 Act sets out the types of changes that the International Bureau may record in the International Register, while Article 16(2) provides that any recording referred to in paragraph (1) shall have the same effect as if it had been made in the Register of the Office of each of the Contracting Party.

4. The only exception to this principle is where a Contracting Party has made a declaration under paragraph (2) to the effect that a recording of a change in ownership of the international registration shall not have that effect in that Contracting Party until the Office of that Contracting Party has received the statements or documents specified in that declaration³. This exception was not included in the Basic Proposal for the New Act submitted to the Diplomatic Conference. It was eventually introduced during the Diplomatic Conference, but was limited to a recording of a change in ownership and subject to an official declaration⁴.

5. Rule 21(1)(a) of the Common Regulations incorporates the elements referred to in Article 16(1)(i), (ii), (iv) and (v). Furthermore, Article 16(1)(vii) leaves it to the Common Regulations to determine what other relevant facts may be recorded in the International Register. It is recalled that no new item has been added to Rule 21(1)(a) since its adoption at the Diplomatic Conference in 1999⁵.

6. The amendments to Rule 21 that were proposed and discussed in the fifth session are in line with Article 16(1)(vii) and fall within the scope of Article 16(2).

7. In the past three years (2013 to 2015), 406 changes in the name or address of the holder, 376 changes in ownership, 20 limitations and 27 renunciations were recorded in the International Register⁶.

SCOPE OF THE PROPOSED AMENDMENTS TO RULE 21

8. The proposal was largely supported by the Working Group, but there appeared to be some confusion in identifying the scope of the proposed new provision. Thus, it would be worth clarifying the situations for which the proposed rule is intended. Basically, the proposed amendments to Rule 21 aim to introduce the following two types of recordings into the Hague System.

³ At the time of writing, four Contracting Parties to the 1999 Act, namely, the African Intellectual Property Organization (OAPI), Denmark, the Republic of Korea and the United States of America had made a declaration under Article 16(2).

⁴ That proposal was made by the Delegation of the United States of America. Refer to document H/DC/31 and the Records of the Diplomatic Conference at paragraphs 810-812, p. 482.

⁵ Only paragraph (3), as it stands now, was inserted into Rule 21 when the Common Regulations were established in 2003, in order to implement the 1999 Act, the 1960 Act and the 1934 Act through one set of regulations. The Common Regulations entered into force on April 1, 2004, at the same time as the 1999 Act.

⁶ Those figures are based on the number of requests processed. However, certain requests, for instance, a request for the recording of a change in ownership, may concern more than one international registration.

Provision of the Name and Address of the Creator Where None Was Provided in the International Application

9. The proposed amendments introduce the possibility of recording in the International Register the name and address of the creator of any or all of the industrial designs where none was provided in the international application.

10. It should be noted that the proposed amendments in this particular respect would not affect Contracting Parties having made a declaration under Article 5(2) or Rule 8⁷, since pursuant to Rule 7(4)(b) or (c), the name and the address of the creator⁸ are mandatory contents of an international application designating any of them.

11. Thus, if the international application contains a designation of at least one Contracting Party having made a declaration under Article 5(2) or Rule 8, the International Bureau makes sure that the name(s) and address(es) of the creator(s) are provided with respect to each of the industrial designs contained in the international application, failing which, pursuant to Article 8(2)(b), the designations of the Contracting Parties having made either of those declarations will be disregarded⁹.

12. In contrast, if the international application does not contain a designation of any of those Contracting Parties, such indications are not mandatory at the international level. The following example illustrates one instance in which the proposed new provision would apply.

Example 1

13. The international application contained designations of the European Union, Japan and the Republic of Korea, none of which have made a declaration under Article 5(2) or Rule 8. The international application did not contain the name and address of the creator, and matured into an international registration. The holder of the international registration later discovered that the name and address of the creator was required under the national laws of Japan and the Republic of Korea and wishes to supplement the international registration with these indications. In such a case, the holder would be able to rely on the proposed new provision.

Recording of a Change in the Name and/or Address of the Creator in the International Register

14. The other feature of the proposal concerns a situation where indications concerning the identity of the creator have been recorded in the International Register.

15. A change in the name or address of the creator 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. The proposed amendments will introduce the possibility of recording in the International Register a change in the name and/or address of the creator, due to a reason that arose subsequent to the international registration. The following examples illustrate instances in which the proposed new provision would apply.

⁷ At present, Romania has made a declaration under Article 5(2) for indications concerning the identity of the creator. Finland, Ghana, Hungary and Iceland have made a declaration under Rule 8(1)(a)(i), while the United States of America has made a declaration under Rule 8(1)(a)(ii).

⁸ As prescribed by Rule 11(1), indications concerning the identity of the creator shall be provided by *the name and address of the creator*.

⁹ This means, for instance, if the international application contains three designs, the International Bureau will make sure that a name and address of a creator is provided for each of the designs.

Example 2

16. The international application contained the name and address of the creator and matured into an international registration. Later, the creator married and changed her name, in accordance with the applicable civil law. She now works as a designer under her new name and would like to update the records in the International Register accordingly.

Example 3

17. The international application contained the name and address of the creator and matured into an international registration. Later, the creator moved to a new address and would like to update the records in the International Register accordingly.

18. It is to be noted that, in these cases, the identity of the creator remains the same; what should be reflected in the International Register is the current name and/or address of the creator for publicity purposes.

INSTANCES NOT COVERED BY THE PROPOSED AMENDMENTS TO RULE 21

19. The following cases will not be covered by the proposed new provision, but fall under the scope of Rule 22 for "Corrections in the International Register".

Example 4

20. The holder of the international registration has discovered an error in the name and/or address of the creator, including a spelling error.

Example 5

21. The holder of the international registration has been made aware that person A indicated as the creator in the application form and recorded as such in the International Register was not actually the creator of the design concerned and has discovered that person B was the true creator.

Example 6

22. The holder of the international registration has been made aware that the design was not created by person A alone, who was indicated as the creator in the application form and recorded as such in the International Register, but that person B was a co-creator of the design.

Example 7

23. In the application form, the applicant indicated persons A, B and C as co-creators of the design; the applicant so assumed, as they often collaborated and were indicated as co-creators in prior design applications. However, the holder has discovered that person C was not a co-creator of that particular design.

24. In examples 5 to 7 above, the creator(s) was/were incorrectly identified or named in the international application form. In accordance with Rule 22(1), upon request by the holder, the International Bureau will correct those errors, as well as in the case of a simple error in the name and/or address of the creator in example 4. This is to ensure that the International Register contains correct information, which will then be communicated to the Offices of designated Contracting Parties and third parties through its publication in the *International Designs Bulletin*.

25. In 2013, 2014 and 2015, 122, 98 and 259 corrections respectively were recorded in the International Register, amounting to 479 in total, of which 61 concerned the name and/or address of the creator.

26. Rule 22 was also agreed and adopted at the Diplomatic Conference in 1999. It is also recalled that, in accordance with Rule 22(2), the Office of a designated Contracting Party may refuse to recognize the effects of the correction¹⁰. The proposed new provision is not intended to make any change to the functions and application of Rule 22, which will continue to be the sole provision under which situations similar to examples 4 to 7, above, will be handled.

III. FURTHER CONSIDERATIONS

PROOF FOR CHANGE

27. At the fifth session of the Working Group, some delegations indicated that their national Offices required a supporting document or proof for a subsequent change in the name and/or address of the creator to be recorded in the national Register¹¹.

28. For instance, the Delegation of Spain explained that, in the case of removing a creator or including a new creator in the national Register, the Office would require consents from all parties involved – not only the creator concerned, but also those who were maintained therein, as well as the holder. However, as explained in paragraphs 20 to 24 above, removal or inclusion of a creator falls within the scope of Rule 22 for correction¹².

29. Conversely, the Delegation of Romania indicated that, as regards a change in the name of the creator, the Office would require a certificate of marriage or a court decision of divorce. Such a situation would fall within the scope of the proposed new provision.

30. For such a change to be recorded in the International Register, however, the International Bureau will only require the signature of the holder pursuant to Rule 21(1)(b) as it stands now. In this regard, it is recalled that no proof that the name of the creator corresponds to that recorded in the civil register is required at the time of the international application.

31. Moreover, in this respect there is no particular reason to treat a recording of a change in the name or address of the creator differently from a recording of a change in the name or address of the holder referred to in Rule 21(1)(a)(ii).

¹⁰ A similar correction mechanism also existed in the old Regulations to implement the 1960 Act and the 1934 Act (Rule 22 in the edition in force on January 1, 2002).

¹¹ They include China, Egypt, Indonesia, Romania and Spain. Refer to document H/LD/WG/5/8 Prov., paragraphs 54 to 60. The Delegation of the Czech Republic indicated that the Office would require proof in case of doubt.

¹² The International Bureau will accept and record in the International Register such a correction if the request comes from the holder. In this context, it is recalled that the International Bureau does NOT require any proof (i) that the person indicated as the creator in the international application form is the true creator; and (ii) that the right to file the international application concerned has been assigned by the creator to the applicant, where the applicant is not the creator. As regards point (i) above, the International Bureau verifies an oath or declaration only if the United States of America is designated.

COMPLIANCE WITH ARTICLE 16(2)

32. As mentioned in paragraph 6 above, a recording made in the International Register under the proposed new provision shall have the effects provided for in Article 16(2) of the 1999 Act (“the same effect as if it had been made in the Register of the Office”). This fundamental principle should remain as an advantage of the Hague System, in line with the outcomes of the Diplomatic Conference.

33. However, the applicable legislation in some of Contracting Parties may not have an update mechanism concerning the name and/or address of the creator, or may not allow a submission of the name and address of the creator after registration. In such cases, a recording made in the International Register pursuant to the proposed new provision would be outside the scope of Article 16(2), since such a recording was not possible in their national Registers.

34. Nonetheless, the jurisdiction concerned may rely on the International Register also to the extent of the types of recordings and their contents that may not exist in the national Register, in respect of an international registration effected under the Hague System.

IV. REVISED PROPOSAL

35. Given the widespread support expressed by the Working Group at its fifth session, providing for the possibility of this new type of recording would add benefits for the users of the Hague System.

36. As explained in paragraphs 8 to 18 above, the proposed amendments to Rule 21 comprise two features. Furthermore, following Rule 11(1), direct reference to the *name and address of the creator* would add more clarity, instead of referring to the *indications concerning the identity of the creator*¹³. The wording of proposed subparagraph (1)(a)(v) of Rule 21 is therefore amended to read as follows:

“(v) the provision of the name and address of the creator, or a change in the name or address of the creator of any or all of the industrial designs that are the subject of the international registration.”

37. The wording of proposed Rules 21(2)(vi) and 26(1)(iv) and of the proposed new item in the Schedule of Fees¹⁴ are amended accordingly.

38. Moreover, if desired, Rule 21(1)(a) may be amended to introduce only one of the aforementioned two features, namely:

- provision of the name and address of the creator of any or all of the industrial designs which were not provided in the international application; or
- recording of a change in the name or address of the creator of any or all of the industrial designs recorded in the International Register.

¹³ Rule 7(4)(b) and (5)(b) refers to Article 5(2)(b)(i) of the 1999 Act referring to “Indications concerning the identity of the creator of the industrial design”. Rule 11(1) provides that where the international application contains “indications concerning the identity of the creator of the industrial design”, his *name and address* shall be given in accordance with the Administrative Instructions (Section 301).

¹⁴ Following a suggestion by the Representative of CEIPI, the proposed new item is numbered 14*bis*, in order to avoid renumbering of all the existing subsequent items.

39. As far as the International Bureau is concerned, the proposed amendments to the Common Regulations would require certain modifications to the IT system and the examination procedures. Thus, if the proposal is considered favorably by the Working Group and adopted by the Assembly of the Hague Union, the implementation of the amended provisions would be in mid-2017 at the earliest.

40. *The Working Group is invited to:*

(i) consider the revised 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, and suggest a date for their entry into force.

[Annex follows]

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

(as in force on [....., 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 the name and address of the creator, or a change in the name or address 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 the name and address 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 the name and address of the creator, or changes in the name or address 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

<u>14<i>bis</i>.Provision of the name and address of the creator, or a change in the name and/or address of the creator of the industrial design</u>		
<u>14<i>bis</i>.1</u>	<u>For one international registration</u>	<u>144</u>
<u>14<i>bis</i>.2</u>	<u>For each additional international registration included in the same request</u>	<u>72</u>

[...]

[End of Annex and of document]