

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

**Seventh Session**  
**Geneva, July 16 to 18, 2018**

### **PROPOSAL FOR AMENDMENTS TO THE ADMINISTRATIVE INSTRUCTIONS**

*Document prepared by the International Bureau*

#### **I. SUMMARY**

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 present document has been prepared with a view to engaging in the above-mentioned consultation on proposed amendments to Sections 203 and 801 of the Administrative Instructions, thus inviting the Working Group to comment on the proposals.

#### **II. DISCONTINUATION OF USE OF FAX AT THE INTERNATIONAL BUREAU**

##### **BACKGROUND**

3. Section 203 of the Administrative Instructions provides for the possibility to submit an international application (DM/1) to the International Bureau by fax, unless any reproduction of the industrial design is to be published in color<sup>1</sup>.

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<sup>1</sup> The core part of Section 203, namely Section 203(a) to (c), remains unchanged since the establishment of the current Administrative Instructions to implement both the 1999 and 1960 Acts. Where the international application is submitted by fax, it shall not have effect unless, prior to the expiration of 20 days counted from the date of its receipt,

[Footnote continued on next page]

4. On January 1, 2018, the telecommunications service provider of the International Bureau of WIPO ceased to provide analog lines. Since then, all fax communications to and from the International Bureau have been transmitted through Voice Over Internet Protocol (VOIP) technology for fax communications (Fax over IP), thus replacing outdated analog fax machines. The resulting incompatibility of old fax technology with the new internet technology can result in data loss without warning to the sender.

5. As far as the Madrid System is concerned, the Circular dated January 24, 2018 (C. M 1462), was sent to its members, containing proposed amendments to the Administrative Instructions for the Application of the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating Thereto (hereinafter the “Madrid Administrative Instructions”), to consult the Offices which have a direct interest in the proposed amendments<sup>2</sup>. As a result of that consultation, the Director General of WIPO amended the Madrid Administrative Instructions to delete the sections concerning fax communications. Accordingly, the use of fax for communication with the International Bureau is no longer possible since April 1, 2018<sup>3</sup>.

6. Under the PCT System, international applications may be filed directly with the International Bureau. Given these environmental changes in fax transmission, the International Bureau has recommended that applicants and Offices cease to send documents to the International Bureau by fax. It has also announced that it will begin consultations on a proposal to discontinue fax services at the end of 2018<sup>4</sup>.

## CONSIDERATIONS

7. The issue of possible discontinuation of the use of fax needs to be considered from the viewpoint of filing an international application, among others. In 2017, the International Bureau received 5,213 international applications, of which 4,809 (92.3 per cent) were filed electronically through the E-filing interface, and 236 (4.5 per cent) were transmitted electronically through the United States Patent and Trademark Office (USPTO) or the Korean Intellectual Property Office (KIPO). Of the remaining 168 applications, 34 were received by fax including three indirect filings (representing only 0.65 per cent of the total filings).

8. Following a slight extension of the period, from January 1, 2016 to March 31, 2018 (27 months), the International Bureau received 68 direct and 11 indirect applications by fax. On a monthly basis, they correspond to approximately 2.5 applications from applicants and 0.4 from Offices. In other words, the filing of applications by fax is very rare.

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[Footnote continued from previous page]

the original of the application along with the reproductions concerned, have been received by the International Bureau.

<sup>2</sup> This consultation is required in accordance with Rule 41(1)(a) of the Madrid Common Regulations.

<sup>3</sup> Refer to Madrid Information Notice No. 4/2018.

<sup>4</sup> Refer to PCT Newsletter No. 12/2017, and documents PCT/MIA/25/6, paragraph 28, and PCT/WG/11/9, paragraph 30.

## Electronic Communications and Rule 5

9. As indicated above, 96.8 per cent of all international applications received in 2017 were filed electronically, either directly or indirectly. In this regard, it is recalled that the amended Rule 5 of the Common Regulations came into force on January 1, 2017<sup>5</sup>. As a result and pursuant to Rule 5(3), a similar safeguard measure for communications sent through a postal service or delivery service (Rule 5(1) and (2)) was extended to communications submitted by electronic means<sup>6</sup>. This change reflected the anticipation that all future communications between users and the International Bureau would take place in electronic format.

10. It should be clarified that Rule 5 ought to apply to the non-delivery of a communication having a time limit. In the context of an international application, it is understood that it may apply only where the six-month priority period under Article 4 of the Paris Convention or the one-month period for an international application governed exclusively by the 1999 Act filed through an Office (Rule 13(3)(i)) has been missed. For the same reason, Rule 5 should also apply to a response to an irregularity notice issued by the International Bureau or a renewal.

11. It is basically understood that fax communications are not included among the communications submitted by electronic means referred to in Rule 5(3)<sup>7</sup>. In any case, the incidental data loss that may result from the incompatibility of fax transmission technology should fall outside the scope of Rule 5.

12. Nowadays, more individual companies and national telecommunications providers are switching off analog services. Currently, faxes are often considered to be lost or corrupted without warning to the sender if any part of the chain of connection has moved to Fax over IP. Fax is simply no longer reliable. The use of the E-filing Interface for preparing, filing and managing applications constitutes a best practice.

## Online submission of documents

13. In November 2017, the Contact Hague service was launched<sup>8</sup>. This service allows users to contact The Hague Registry through an online form. The form guides users to ensure that their queries are received by the appropriate section in The Hague Registry. The form also allows users to submit requests for priority documents or extracts. The Contact Hague service has been well received by users so far.

14. Moreover, in a bid to curb the use of insecure communication by email and fax to submit documents, a new function that will allow users to easily and securely upload documents in PDF format will be added to the E-Filing Portfolio Manager. This feature will also be accessible from the Contact Hague service. To ensure security, users will be required to have a WIPO account to upload documents.

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<sup>5</sup> Refer to documents H/LD/WG/5/2, H/A/36/1, and H/A/36/2.

<sup>6</sup> Pursuant to Rule 5(3), failure by an interested party to meet a time limit for a communication addressed to the International Bureau that was sent electronically would be excused, where the interested party submits satisfactory evidence showing that the time limit was not met because of a failure in the electronic communication with the International Bureau or a failure that affects the locality of the interested party due to extraordinary circumstances. In that case, a new communication should be effected no later than five days after the electronic services are resumed.

<sup>7</sup> In the Administrative Instructions, "Electronic Communications" are handled by Section 204 separately from Section 203 dealing with "Communications by Telefacsimile".

<sup>8</sup> The Contact Hague service, similar in design and functionality to the Contact Madrid service, was developed in response to the closure of the [intreg.mail@wipo.int](mailto:intreg.mail@wipo.int) email address (which was shared with the Madrid Registry) and as a way to move from multiple to a single communication channel for all Hague-related queries and submissions.

15. This new function is expected to be launched in the summer of 2018 and will technically allow for the submission of any document, which may thus include an international application (DM/1), as well as a request for the recording of a change referred to in Rule 21(1)(a) and a response to an irregularity notice issued against an international application filed in paper format.

16. Accordingly, and as concerns international applications, in exceptional circumstances where the E-Filing Interface is down, users will still be able to submit their international applications in PDF format using this document upload function, and will do so in accordance with Section 204(a)(i)<sup>9</sup>.

## PROPOSAL

17. Given the above considerations, it is proposed that the Administrative Instructions be amended by deleting Section 203. The result will be discontinuation of the use of fax for communication with the International Bureau.

18. The aforementioned document upload function will be made available as a modern, reliable and secure alternative to the deleted fax option. However, the International Bureau would still strongly encourage users to file their international applications through the E-Filing Interface. The document upload function should only be used as a last resort.

## III. ONLINE PAYMENT

### ENHANCING FLEXIBILITY

19. Section 801 of the Administrative Instructions provides for three modes of payment as follows:

- (a) by debit to a current account with the International Bureau,
- (b) by payment into the Swiss postal check account or to any of the specified bank accounts of the International Bureau, or
- (c) by credit card, where, in the context of an electronic communication envisaged in Section 204(a), an electronic interface for online payment has been made available by the International Bureau.

20. In the context of an electronic payment, two types of online payment interfaces are currently provided, namely: "E-Renewal" for paying renewal fees and "E-Payment" for paying fees notified in an irregularity letter, both of which accept American Express, MasterCard and Visa. Section 801(iii) has the reference to an electronic communication envisaged in Section 204(a). However, the currently available possibility of online payment is not actually tied to the electronic communication referred to in Section 204(a). For instance, online payment through "E-Payment" remains an option even where the application is filed on paper.

21. Furthermore, the International Bureau may, in future, consider accepting payments by debit card, or through a widely-recognized digital payment platform, such as PayPal.

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<sup>9</sup> The Contact Hague web application is independent from the E-filing web application. However, in the situation where the Contact Hague web application would also be down, Rule 5(3) would apply also to the submission of a document in this manner, where a time limit applied for the submission of that document.

## PROPOSAL

22. Accordingly, in order to better reflect the current situation and to enhance flexibility in payments, it is proposed that Section 801(iii) be amended by deleting the reference to Section 204(a) and the term “*credit card*”, thus making it read simply as “*through an online payment system made available by the International Bureau*”, as reproduced in Annex to this document.

## IV. ENTRY INTO FORCE OF THE PROPOSED AMENDMENTS TO ADMINISTRATIVE INSTRUCTIONS

23. In accordance with Rule 34(3)(a), 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.

24. Should the Working Group agree to the current proposals to amend Sections 203 and 801 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 January 1, 2019.

*25. The Working Group is invited to comment on the proposals to amend Sections 203 and 801 of the Administrative Instructions, as set out in the Annex, with a date of entry into force of January 1, 2019.*

[Annex follows]

# Administrative Instructions for the Application of the Hague Agreement

(as in force on [January 1, 2019])

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Section 204:	Electronic Communications
Section 205:	Communications Through User Accounts Available on the Web Site of the Organization

[...]

## Part Two Communications with the International Bureau

[...]

### Section 203: ~~Communication by Telefacsimile~~[Deleted]

~~(a) Any communication, other than an international application containing a reproduction to be published in color, may be addressed to the International Bureau by telefacsimile, provided that where the communication must be presented on an official form, the official form is used for the purposes of the telefacsimile communication.~~

~~(b) An international application addressed to the International Bureau by telefacsimile shall not have effect unless, prior to the expiration of 20 days counted from the date of receipt of such communication, the original of the international application bearing the prescribed signature along with the reproductions and/or specimens concerned, have been received by the International Bureau. When so confirmed, the said international application shall have effect as of the date on which it was received by telefacsimile by the International Bureau.~~

~~(c) Where a communication is transmitted to the International Bureau by telefacsimile, the Bureau shall promptly and by telefacsimile inform the sender of the receipt of that communication, and where such telefacsimile communication received by the International Bureau is incomplete or illegible, of that fact also, provided that the sender can be identified and can be reached by telefacsimile.~~

~~(d) Where a communication is transmitted to the International Bureau by telefacsimile and, because of the time difference between the place from where the communication is transmitted and Geneva, the date on which the transmittal started is different from the date of receipt by the International Bureau of the complete communication, the earlier of the two dates shall be considered as the date of receipt by the International Bureau.~~

[...]

## **Part Eight Fees**

### *Section 801: Modes of Payment*

Fees may be paid to the International Bureau

- (i) by debit to a current account with the International Bureau,
- (ii) by payment into the Swiss postal check account or to any of the specified bank accounts of the International Bureau,
- (iii) ~~by credit card, where, in the context of an electronic communication envisaged in Section 204(a),~~ through an ~~electronic interface for~~ online payment system ~~has been~~ made available by the International Bureau.

[...]

[End of Annex and of document]