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

**Ninth Session**  
**Geneva, December 14 to 16, 2020**

### **PROPOSAL FOR AMENDMENTS TO RULE 5 OF THE COMMON REGULATIONS**

*Document prepared by the International Bureau*

#### **INTRODUCTION**

1. The COVID-19 pandemic and measures taken in connection with it have resulted in severe disruptions for the IP community including users of the Hague System for the International Registration of Industrial Designs (hereinafter referred to as “the Hague System”). Although, to the knowledge of the International Bureau, there has been no cases where users have directly lost their rights because the disruption prevented them from performing a relevant action before the International Bureau, the situation made it evident that this was a rather fortunate coincidence and that the safeguards provided for in the Common Regulations Under the 1999 Act and the 1960 Act of the Hague Agreement (hereinafter referred to as “the Common Regulations”) could be improved.

2. To address these deficiencies, this document presents a proposal to amend Rule 5 of the Common Regulations, with a view to providing users of the Hague System with safeguards similar to those in the Regulations under the Patent Cooperation Treaty (hereinafter referred to as “the Regulations under the PCT”) which are broader in nature.

3. In a similar context, a proposal to align the safeguards of the Regulations under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (hereinafter referred to as “the Madrid Regulations”) to those found in the Regulations under the PCT was submitted to the eighteenth session of the Working Group on the Legal Development of the Madrid System for the International Registration of Marks (hereinafter referred to as “the Madrid Working Group”), held from October 12 to 16, 2020. Likewise, a similar proposal to amend the Common Regulations under the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration and the Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications (hereinafter referred to as “the Lisbon Regulations”) was also submitted to the third session of the Working Group on the Development of the Lisbon System (hereinafter referred to as “the Lisbon Working Group”), held on November 2 and 3, 2020.

4. It is to be noted that this document and the specific amendment proposed therein have been revised to take into account the outcomes of both the Madrid and Lisbon Working Groups sessions<sup>1</sup>. More precisely, the Madrid Working Group, at its eighteenth session, agreed to recommend to the Madrid Union Assembly the adoption of the proposed amendments to Rule 5 of the Madrid Regulations, as amended during that session. Consequently, at its third session, the Lisbon Working Group considered a revised proposal, taking into account the updated formulation of Rule 5 of the Madrid Regulations, and recommended to the Lisbon Union Assembly the adoption of a revised new Rule 2 *bis* of the Lisbon Regulations<sup>2</sup>. Thus, the present revised document takes into account the wording of those two provisions, as recommended for adoption in the Madrid and Lisbon Regulations.

## **CURRENT RULE 5 IN COMPARISON WITH THE EQUIVALENT PCT PROVISIONS**

5. Rule 5(1) and (2) of the Common Regulations was first introduced into the Regulations under the Geneva Act, as adopted at the Diplomatic Conference for the Adoption of a New Act of the Hague Agreement Concerning the International Deposit of Industrial Designs in 1999, which became the Common Regulations that entered into force on April 1, 2004.

6. The provision was modeled on Rule 5 of the then Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement, as in force from April 1, 1996, which in turn was modeled on Rule 82 of the Regulations under the PCT, as in force from July 1, 1992<sup>3</sup>. Paragraph (3) was subsequently added to Rule 5 of the Common Regulations, and entered into force on January 1, 2017<sup>4</sup>.

7. From June 19, 1970, to June 30, 2012, Rule 82 of the Regulations under the PCT dealt separately with two distinct situations, namely, delay or loss of a communication sent through mail or delivery services (Rule 82.1), and interruptions in postal or delivery services due to war, revolution, civil disorder, strike, calamity or other like reason (Rule 82.2).

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<sup>1</sup> The original document H/LD/WG/9/3 was published on October 14, 2020.

<sup>2</sup> Refer to documents MMLD/WG/18/2 Rev., MMLD/WG/18/9, LI/WGDV-SYS/3/3 Rev. and LI/WGDV-SYS/3/4.

<sup>3</sup> Refer to document PCT/A/XVII/2, available at the following address:  
[https://www.wipo.int/edocs/mdocs/govbody/en/pct\\_a\\_xviii/pct\\_a\\_xviii\\_2.pdf](https://www.wipo.int/edocs/mdocs/govbody/en/pct_a_xviii/pct_a_xviii_2.pdf).

<sup>4</sup> Refer to document H/A/36/1, available at the following address:  
[https://www.wipo.int/edocs/mdocs/govbody/en/h\\_a\\_36/h\\_a\\_36\\_1.pdf](https://www.wipo.int/edocs/mdocs/govbody/en/h_a_36/h_a_36_1.pdf).

8. On July 1, 2012, following the experiences with the natural catastrophes in Japan, Rule 82.2 of the Regulations under the PCT was abolished and a new Rule 82*quater* entered into force, excusing delays in meeting a time limit to perform an action due to war, revolution, civil disorder, strike, natural calamity or other like reason<sup>5</sup>. Under Rule 82*quater*, the party concerned is required to perform the relevant action as soon as reasonably possible and provide the relevant evidence to the satisfaction of the International Bureau no later than six months from the date on which the applicable time limit expired.

9. Rule 82*quater* was introduced into the PCT legal framework in order to provide a general provision for excuse of delay in meeting PCT time limits due to circumstances beyond the control of the applicant. On July 1, 2016, an amended version of this provision entered into force, introducing “a general unavailability of electronic communications services” as one of the reasons for excusing a delay in meeting a time limit<sup>6</sup>.

10. In contrast, Rule 5 of the Common Regulations excuses delays in meeting a time limit in very limited circumstances. In relation to *force majeure* events, it only excuses delays in meeting a time limit for a communication addressed to the International Bureau due to irregularities in postal and delivery services resulting from such events, and requires that the interested party meet certain conditions and provide evidence thereof (Rule 5(1) and (2)). Similarly, in respect of communications sent electronically, it only excuses delays where there is a failure in the electronic communication services of the International Bureau or in the locality of the interested party (Rule 5(3)). Other actions, such as the payment of fees through bank services, are not clearly covered.

## PROPOSAL TO AMEND RULE 5

11. It is proposed that Rule 5 of the Common Regulations be amended to give users of the Hague System relief equivalent to that provided for in the Regulations under the PCT. The proposed new paragraph (1) would introduce the general principle that failure to meet a time limit specified in the Common Regulations for performing an action before the International Bureau may be excused where the interested party provides evidence, to the satisfaction of the International Bureau, that such failure was due to a *force majeure* event. Such *force majeure* events would include irregularities in postal, delivery and electronic communication services beyond the control of the interested party.

12. The proposed new paragraph (1) of Rule 5 of the Common Regulations would apply to any action before the International Bureau for which the Common Regulations prescribe a time limit, such as, for example, sending a communication, remedying an irregularity or paying a prescribed fee. As under the current Rule 5, the proposed new provision requires the submission of evidence. However, when there is a widely established instance of *force majeure* affecting the region of the party seeking the application of the rule, the International Bureau could take the position, as it has done in respect of the COVID-19 pandemic<sup>7</sup>, that this in itself would constitute as satisfactory evidence and that no specific details would need to be provided.

13. It is further proposed that current paragraphs (2) and (3) be deleted, as they would no longer be necessary. Consequently, the current paragraphs (4) and (5) would be renumbered to bear paragraphs (2) and (3), respectively.

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<sup>5</sup> Refer to document PCT/A/42/2, available at the following address:  
[https://www.wipo.int/edocs/mdocs/govbody/en/pct\\_a\\_42/pct\\_a\\_42\\_2.pdf](https://www.wipo.int/edocs/mdocs/govbody/en/pct_a_42/pct_a_42_2.pdf).

<sup>6</sup> Refer to document PCT/A/47/4 Rev., available at the following address:  
[https://www.wipo.int/edocs/mdocs/govbody/en/pct\\_a\\_47/pct\\_a\\_47\\_4\\_rev.pdf](https://www.wipo.int/edocs/mdocs/govbody/en/pct_a_47/pct_a_47_4_rev.pdf).

<sup>7</sup> Refer to Information Notice No. 14/2020.

14. The aforementioned proposed amendments would be helpful for users of the Hague System who are facing any *force majeure* situation preventing them from taking the required action within the specified time limit. During the previous decade, for example, the following natural calamities occurred: the eruption of the Eyjafjallajökull volcano in 2010; the earthquake and tsunami in Japan, in 2011; the earthquakes in northern Italy and hurricane Sandy, in 2012; typhoon Hagupit, in 2014; and, hurricane María, in 2017.

15. Finally, the current Rule 5 requires that the party perform the relevant action no later than five days after the postal, delivery or electronic communication service was resumed. This five-day period appears too restrictive and is furthermore a hard criterion to enforce with certainty, and it is proposed to relax this condition by simply requiring the relevant action of the party “as soon as reasonably possible”. This term is taken from Rule 82*quater* of the Regulations under the PCT, which would be contained in the proposed amended paragraph (2). However, as under the current Rule 5 as well as Rule 82*quater* of the Regulations under the PCT, the amended paragraph (2) would remain requiring the submission of evidence and the action no later than six months from the expiry of the time limit concerned.

#### **DATE OF ENTRY INTO FORCE**

16. As indicated earlier, the COVID-19 pandemic and measures taken in connection with it have resulted in severe disruptions for users of the Hague System that are likely to continue for some time in several regions of the world. At the time of writing this document, numerous countries still have measures in place to protect the population from the effects of the pandemic; other countries are lifting restrictions, but continued to face a possible second wave of infections and the reintroduction of such restrictions.

17. For the foregoing reason, there is a need for the proposed amendment to enter into force without delay, with a view to protect the interests of the users of the Hague System. Therefore, it is suggested that the Working Group recommend to the Hague Union Assembly that the proposed amendments to Rule 5 enter into force two months following its adoption.

18. *The Working Group is invited to:*
- (i) consider and comment on the proposals made in this document; and*
  - (ii) indicate whether it would recommend to the Assembly of the Hague Union the adoption of the proposed amendments to the Common Regulations with respect to Rule 5, as provided in the draft contained in the Annex hereto, for their entry into force two months following their adoption.*

[Annex follows]

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

(as in force on.....)

[...]

**CHAPTER 1  
GENERAL PROVISIONS**

[...]

*Rule 5*

*Excuse of Delay in Meeting Time Limits*

(1) *[Excuse of Delay in Meeting Time Limits due to Force Majeure Reasons]* Failure by an interested party to meet a time limit specified in the Regulations to perform an action before the International Bureau shall be excused if the interested party submits evidence showing, to the satisfaction of the International Bureau, that such failure was due to war, revolution, civil disorder, strike, natural calamity, irregularities in postal, delivery or electronic communication services owing to circumstances beyond the control of the interested party or other *force majeure* reason.

~~*[Communications Sent Through a Postal Service]*~~ Failure by an interested party to meet a time limit for a communication addressed to the International Bureau and mailed through a postal service shall be excused if the interested party submits evidence showing, to the satisfaction of the International Bureau,

~~(i) that the communication was mailed at least five days prior to the expiry of the time limit, or, where the postal service was, on any of the ten days preceding the day of expiry of the time limit, interrupted on account of war, revolution, civil disorder, strike, natural calamity, or other like reason, that the communication was mailed not later than five days after postal service was resumed,~~

~~(ii) that the mailing of the communication was registered, or details of the mailing were recorded, by the postal service at the time of mailing, and~~

~~(iii) in cases where not all classes of mail normally reach the International Bureau within two days of mailing, that the communication was mailed by a class of mail which normally reaches the International Bureau within two days of mailing or by airmail.~~

~~(2) — *[Communications Sent Through a Delivery Service]*~~ Failure by an interested party to meet a time limit for a communication addressed to the International Bureau and sent through a delivery service shall be excused if the interested party submits evidence showing, to the satisfaction of the International Bureau,

~~(i) that the communication was sent at least five days prior to the expiry of the time limit, or, where the delivery service was, on any of the ten days preceding the day of expiry of the time limit, interrupted on account of war, revolution, civil disorder, natural calamity, or other like reason, that the communication was sent not later than five days after the delivery service was resumed, and~~

~~(ii) that details of the sending of the communication were recorded by the delivery service at the time of sending.~~

~~(3) [Communication Sent Electronically] Failure by an interested party to meet a time limit for a communication addressed to the International Bureau and submitted by electronic means shall be excused if the interested party submits evidence showing, to the satisfaction of the International Bureau, that the time limit was not met because of failure in the electronic communication with the International Bureau, or which affects the locality of the interested party owing to extraordinary circumstances beyond the control of the interested party, and that the communication was effected not later than five days after the electronic communication service was resumed.~~

(4) *[Limitation on Excuse]* Failure to meet a time limit shall be excused under this Rule only if the evidence referred to in paragraph (1), ~~(2) or (3) and the communication or, where applicable, a duplicate thereof are~~ is received by, and the corresponding action is performed before the International Bureau as soon as reasonably possible and not later than six months after the expiry of the time limit concerned.

~~(5)~~ *[Exception]* This rule shall not apply to the payment of the second part of the individual designation fee through the International Bureau as referred to in Rule 12(3)(c).

[...]

[End of Annex and of document]