

## **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 17 OF THE COMMON REGULATIONS**

*prepared by the International Bureau*

#### **I. BACKGROUND**

1. At its eighth session, held from October 30 to November 1, 2019, 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 extend the six-month period of publication currently provided for in Rule 17(1)(iii) (hereinafter referred to as “standard publication”) of the Common Regulations Under the 1999 Act and the 1960 Act of the Hague Agreement (hereinafter referred to as the “Common Regulations”) to a period of 12 months<sup>1</sup>.
2. Although the above proposal was largely supported by the Working Group, the Working Group further requested that the International Bureau consult user groups on this proposal and to report on its findings at the next session of the Working Group<sup>2</sup>.
3. Accordingly, a Questionnaire entitled “Timing of the Publication of an International Registration under the Hague System for the International Registration of Industrial Designs” (hereinafter referred to as the “Questionnaire”) was prepared by the International Bureau, and sent on June 12, 2020, through Note C. H 143, to non-governmental organizations (NGOs) representing users of the Hague System<sup>3</sup>. The International Bureau also sent a copy of the Questionnaire to the Offices of all Contracting Parties through Note C. H 142, inviting them to reach out to their local and national user groups so that they could take part in the consultation.

<sup>1</sup> See document H/LD/WG/8/6, “Proposal for Amendments to Rule 17 of the Common Regulations”.

<sup>2</sup> See document H/LD/WG/8/8 “Summary by the Chair”, paragraph 20.

<sup>3</sup> See document H/LD/WG/9/Questionnaire.

4. The International Bureau received 17 responses to the Questionnaire from user groups<sup>4</sup>. In addition, the International Bureau received six responses from Offices of Contracting Parties<sup>5</sup> and one response from a private company<sup>6</sup>, although the Questionnaire was addressed to user groups only.

5. The present document sets out a summary of the responses received from the user groups. It also contains a revised proposal to amend the Common Regulations, taking into account the discussion of the Working Group held at the eighth session.

## II. RESPONSES TO THE QUESTIONNAIRE

### EXTENSION OF THE STANDARD PUBLICATION PERIOD

6. In the Questionnaire, user groups were requested to indicate whether their Organization was in favor of extending the standard publication period from six to 12 months.

7. Fifteen user groups responded in favor of the proposed extension of the standard publication period from six to 12 months. One user group did not indicate a preference<sup>7</sup> while one user group indicated not to be in favor unless complementary measures were put in place (refer to paragraph 12, below).

8. Many user groups noted that the extension of the standard publication period to 12 months would provide holders with more time to plan and organize their marketing strategies keeping the design confidential. The proposed extension would provide users with more opportunities to utilize the Hague System.

9. Two user groups stated that users manufacturing products with a long life cycle and requiring a long design development period would welcome this amendment, in particular.

10. One user group noted that the extended publication period could provide holders with more time to consider whether to publish or to withdraw the design (through the renunciation of the international registration). In this regard, one user group added that the extension would be welcomed in view of the upcoming Brexit<sup>8</sup>.

11. Some user groups noted that various jurisdictions, including Contracting Parties prohibiting the deferment of publication under the Hague System, had measures to defer publication under the national procedure. Thus, one user group pointed out that the extension of the standard publication period would correct this imbalance.

12. The one user group that was not in favor of extending the standard publication period stated that the proposed extension might cause unnecessary delay in the entire registration process in designated Contracting Parties. In addition, if the maximum duration of protection was counted from the date of registration or issuance of patent under the law of the designated

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<sup>4</sup> In total, submissions were received from the following user groups: All-China Patent Agents Association (ACPAA), Asian Patent Attorney Association (APAA), Brazilian Association of Intellectual Property (ABPI), *Bundesverband Deutscher Patentanwälte*, Canadian Bar Association (CBA), Chamber of Commerce and Industry of the Russian Federation, European Brands Association (AIM), German Association for the Protection of Industrial Property and Copyright Law (GRUR), Institute of Intellectual Property of Japan (IIP), Intellectual Property Owners Association (IPO), International Trademark Association (INTA), Japan Intellectual Property Association (JIPA), Japan Patent Attorneys Association (JPAA), Korea Patent Attorneys Association (KPAA), MARQUES – Association of European Trademark Owners, *Patentanwaltskammer* and the Ukrainian Chamber of Commerce and Industry.

<sup>5</sup> In total, submissions were received from the Offices of the following Contracting Parties: Azerbaijan, Estonia, Georgia, Kyrgyzstan, Turkey and Viet Nam.

<sup>6</sup> A submission was received from Samsung.

<sup>7</sup> This user group did not indicate its preference, noting that their country was not a Contracting Party.

<sup>8</sup> This user group referred to Section 3(5) of the Registered Designs Act 1949 of the United Kingdom.

Contracting Party, this would actually shorten the total duration of protection in that Contracting Party. The said user group, however, indicated that the extension was acceptable if other complementary measures were put in place, in particular allowing an earlier publication before the expiry of the standard publication period.

#### POSSIBLE DISADVANTAGES REGARDING THE EXTENSION

13. In the Questionnaire, user groups were requested to indicate whether they saw any disadvantages regarding the extension of the standard publication period to 12 months.

14. Several user groups pointed out that if holders were not provided with the option to request an earlier publication within the extended standard publication period (12 months), they might face difficulties to enforce their design rights during this period or would not be able to react to possible changes of circumstances after filing.

15. Some user groups noted that the extension of the standard publication period would delay the examination and registration procedure in designated Contracting Parties. However, these user groups added that the option to request an earlier publication could alleviate this concern.

16. In relation to effects on third parties, several user groups noted that the extension of the standard publication period would increase the risk of infringing designs of competitors during the period of secrecy. However, these user groups did not consider this aspect as an obstacle, in view of the balance between the interest of applicants and that of competitors. Some of them pointed out that the same risk already existed under the current six-month publication period and that the extension to 12 months would not unduly burden third parties compared to the benefits granted to applicants. In this regard, two user groups referred to the patent system, where publication usually took place 18 months from the filing date or priority date. Two other user groups also noted the existence of the same risk but for a longer term, for instance in Contracting Parties allowing deferment for up to 30 months from the filing date or priority date.

17. Another user group stated that the extension of the standard publication period could potentially increase the risk that the Office of a designated Contracting Party omit prior but unpublished international registrations in the examination of domestic applications and other international registrations. The said user group therefore suggested that Offices should benefit from receiving “confidential copies” of international registrations provided for under Article 10(5) of the 1999 Act.

#### EARLIER PUBLICATION DURING THE STANDARD PUBLICATION PERIOD

18. In the Questionnaire, user groups were requested to indicate whether they were in favor of the introduction of the possibility to request an earlier publication at any time before the expiry of the 12-month standard publication period if the standard publication period were to be so extended.

19. Almost all user groups (except one<sup>9</sup>) responded in favor of introducing the possibility to request an earlier publication at any time before the expiry of the 12-month standard publication period.

20. Several user groups stated that this possibility would make the Hague System more attractive to users, as it would give them a greater flexibility to publish the design at the most advantageous point in time. Some of them added that it could benefit users in cases of new product releases ahead of the planned schedule.

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<sup>9</sup> One user group did not respond to this question, noting that their country was not a Contracting Party.

21. Several user groups pointed out that this possibility would help design owners to enforce their rights *vis-à-vis* with third parties and take measures against infringing products, since the publication of the design was a necessary prerequisite for protection in some jurisdictions.
22. One user group stated that an early publication should also be made possible per design in the case of a multiple design registration. However, it bears recalling that this possibility is currently not offered in respect of deferment.
23. One user group stated that the costs for requesting an early publication should not be too high.

#### OTHER MATTERS RAISED

24. In the Questionnaire, user groups were requested to indicate whether they had any other suggestions or concerns in relation to the timing of publication of international registrations.
25. Several user groups stated that it would be beneficial if the timing of the publication could be determined by the holder.
26. Two user groups stated that it would be beneficial if the deferment period of 30 months could apply in all Contracting Parties.
27. One user group stated that a short deferment period declared by Contracting Parties could discourage users designating such Contracting Parties. This would create additional expenses for filing separate domestic applications.
28. One user group requested to further extend the standard publication period beyond 12 months as in their country a design could be kept confidential for up to three years after registration and no problems had been encountered so far.
29. One user group requested to enable users to change the type of publication after filing, for example from a standard publication to a deferred publication, and to allow users to extend the period of deferment selected at the time of filing.
30. One user group requested that the list of Contracting Parties which have made a notification under Article 10(5)(a) of the 1999 Act should be published on the WIPO website.

#### RESPONSES FROM OFFICES AND PRIVATE COMPANIES

31. Six offices and one private company also submitted comments to the Questionnaire. Since the Questionnaire was directed at user groups, those comments were not included in the present document.

### III. CONSIDERATIONS

#### CONCLUSION ON THE RESPONSES

32. The user groups that responded to the Questionnaire were almost unanimously in favor of both extending the standard publication period from six to 12 months and introducing the possibility to request an earlier publication at any time before the expiry of the 12-month standard publication period. One user group did not indicate a preference. The one user group that was not in favor of extending the standard publication period noted, however, that the extension would be acceptable if the possibility to request an earlier publication before the expiry of the standard publication period was introduced at the same time.

33. One user group noted that the costs for requesting an early publication should not be too high. In this regard, it is to be noted that there is currently no fee payable for requesting an earlier publication.

#### IMMEDIATE AND EARLIER PUBLICATION

34. Further to the discussion of the Working Group held at its eighth session, the responses to the Questionnaire clearly indicate that that users of the Hague System would appreciate greater flexibility, and in particular, the possibility to request an early publication at any time.

35. During the eighth session, the Secretariat explained that the current IT platform had already cleared a technical restriction for carrying out an early publication during the standard publication period that existed before its migration<sup>10</sup>. The Secretariat also clarified that the International Bureau could, at any time, accept a request for an immediate publication pursuant to subparagraph (i) of Rule 17(1) as it currently stood, where the applicant had failed to select that option at the time of filing<sup>11</sup>.

36. Besides, Article 11(4)(a) of the 1999 Act and Article 6(4)(b) of the 1960 Act provide the possibility for the holder to request an earlier publication, at any time during the period of “deferment”<sup>12</sup>. Although such an earlier publication is already possible, it would be preferable to make it clear in Rule 17(1). In this regard, it is recalled that, during the eighth session, the Working Group considered a new subparagraph in Rule 17(1) to clarify that an earlier publication may be requested at any time after the international registration<sup>13</sup>.

#### BACKGROUND INFORMATION

37. For the background of the current issue including practical consequences of the extension of the standard publication period, refer to document H/LD/WG/8/7.

### IV. PROPOSAL

#### AMENDMENTS TO RULE 17

38. It is proposed to amend subparagraph (iii) of Rule 17(1), so as to extend the standard publication period from six to 12 months, as reproduced in Annex II.

39. In addition, it is proposed to introduce a new subparagraph in Rule 17(1) to clarify that an earlier publication may be requested at any time before the expiry of the 12-month standard publication period. To this end, the new subparagraph (*ii bis*) would be inserted between subparagraphs (ii) and (iii), so as to avoid the consequential renumbering of the latter subparagraph.

40. The wording of the proposed subparagraph (*ii bis*) is, in fact, the same as the one that the Working Group considered at the eighth session. The proposed subparagraph would make it clear that the “holder” (as opposed to the “applicant” referred to in subparagraph (i)) can request

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<sup>10</sup> See document H/LD/WG/8/9 Prov. “Draft Report”, paragraph 59.

<sup>11</sup> See document H/LD/WG/8/9 Prov. “Draft Report”, paragraph 80.

<sup>12</sup> See document H/LD/WG/8/6, “Proposal for Amendments to Rule 17 of the Common Regulations”, paragraph 38.

<sup>13</sup> See document H/LD/WG/8/9 Prov. “Draft Report”, paragraph 80.

an earlier publication, if the international registration has not been published. This subparagraph would apply to international registrations which fall under the standard publication scheme (subparagraph (iii)) and to international registrations for which deferment was requested at the time of filing (subparagraph (ii)).

41. Minor consequential amendments are also proposed to subparagraph (ii). The term “or is considered to have expired” refers to the situation as described in the proposed new subparagraph (ii*bis*)<sup>14</sup>. Thus, this reference would be deleted as it would be redundant. Instead, the term “subject to subparagraph (iii)” would be added to clarify the scopes of both subparagraphs<sup>15</sup>.

#### TRANSITIONAL PROVISION IN RULE 37

42. New paragraph (3) under Rule 37 is proposed to clarify that the current six-month period would continue to apply to international registrations resulting from international applications filed before the date of entry into force of the proposed amendment to Rule 17(1)(iii).

#### DATE OF ENTRY INTO FORCE

43. Since the current IT system can technically adopt the proposed change to the standard publication period, January 1, 2022, is proposed as the date of implementation of the proposed amendments.

44. *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 for adoption, the proposed amendments to the Common Regulations with respect to Rule 17, together with the proposed transitional provision in Rule 37, as provided in the draft contained in Annex II hereto, with a date of entry into force of January 1, 2022.*

[Annexes follow]

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<sup>14</sup> See Article 11(4)(a) of the 1999 Act and Article 6(4)(b) of the 1960 Act.

<sup>15</sup> This amendment was also supported during the eighth session of the Working Group (refer to document H/LD/WG/8/9 Prov. “Draft Report”, paragraphs 80 and 83).

User Groups that Participated in the Questionnaire

NGOs		Members*
ABPI	Brazilian Association of Intellectual Property	200 companies and 550 members
ACPAA	All-China Patent Attorneys Association	2,381 members
AIM	European Brands Association	2,500 businesses ranging from SMEs to multinationals
APAA	Asian Patent Attorney Association	2,353 members
CBA	Canadian Bar Association	36,000 members across Canada
GRUR	German Association for the Protection of Industrial Property and Copyright Law	5,033 members
IIP	Institute of Intellectual Property of Japan	144 members (as of July 2020)
INTA	International Trademark Association	Nearly 6,500 organizations, representing more than 34,350 individuals (trademark owners, professionals, and academics) from 185 countries
IPO	Intellectual Property Owners Association	175 companies and close to 12,000 individuals who are involved in the association either through their companies or as inventor, author, law firm or attorney members
JIPA	Japan Intellectual Property Association	1,326 members (as of August 11, 2020)
JPAA	Japan Patent Attorneys Association	N/A
KPAA	Korea Patent Attorneys Association	5,901 members (as of August 10, 2020)
MARQUES	Association of European Trademark Owners	700 members between corporate and expert members
	<i>Bundesverband Deutscher Patentanwälte</i>	800 members
	Chamber of Commerce and Industry of the Russian Federation	179 chambers of commerce and industry in the subjects of the Russian Federation, more than 52,000 organizations, more than 300 associations of entrepreneurs and commercial organizations at the federal level, more than 500 business associations at the regional level
	<i>Patentanwaltskammer</i>	4,000 members
	Ukrainian Chamber of Commerce and Industry	7,948 members

[Annex II follows]

\* As indicated in the responses to the Questionnaire.

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

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

[...]

*Rule 17*

*Publication of the International Registration*

(1) [*Timing of Publication*] The international registration shall be published

- (i) where the applicant so requests, immediately after the registration,
- (ii) subject to subparagraph (ii bis), where deferment of publication has been requested and the request has not been disregarded, immediately after the date on which the period of deferment expired ~~or is considered to have expired~~,  
(ii bis) where the holder so requests, immediately after the receipt of such request by the International Bureau.
- (iii) in any other case, ~~six~~12 months after the date of the international registration or as soon as possible thereafter.

[...]

*Rule 37*

*Transitional Provisions*

[...]

(3) [*Transitional Provision Concerning Timing of Publication*] Rule 17(1)(iii) as in force before [January 1, 2022], shall continue to apply to any international registration resulting from an international application filed before that date.

[...]

[End of Annex II and document]