



Seminar on the Hague System for the International Registration of Industrial Designs

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Patrick Cartant Head, Operations Service The Hague Registry

Introduction

Managing an international registration is...

- a major advantage of the Hague system
- easy and centralized:
 - ONE request
 - ONE language
 - ONE payment of ONE set of fees
 - ONE currency (Swiss francs)
 - ONE « Office » (= the International Bureau of WIPO)



What are the Post-Registration Procedures?

- Change in name and/or address of the holder
- Appointment, change or cancellation of representative
- Change in ownership
- Renunciation
- Limitation
- Renewal



Change in name and/or address of the holder

- Article 16(1)(ii) of the Hague Agreement
- Rule 21 of the Common Regulations under the 1999 Act and 1960 Act
 - Form DM/6
 - Request shall be presented and signed by the holder
 - Contents
 - the number of the international registration concerned
 - the name of the holder as recorded
 - the change in name and/or address of the holder



Appointment, change or cancellation of representative

- Article 16(1)(iii) of the Hague Agreement
- Rules 3 and 21 of the Common Regulations under the 1999 Act and 1960 Act
 - Form DM/7; DM/8; DM/9
 - Request shall be signed by the holder

Official forms are not necessary



Requirements

- Rule 3 of the Common Regulations
- The applicant may have a representative before the International Bureau → NOT mandatory
- The rule relates to the representation before the International Bureau → NOT the representation before the Offices
- Who may be appointed as a representative?
 - NO requirement as to professional qualification
 - NO requirement as to nationality
 - NO requirement as to domicile



■ CHANGE IN OWNERSHIP



Article 16(i) of the Hague Agreement Rules 21-21 bis of the Common Regulations

- Form DM/2
- The Hague Agreement deals only with the recording of the change → the validity of an assignment agreement is outside its scope
 - The request can be presented by the holder OR the *new* owner, provided that:
 - the request is signed by the holder, or
 - the request is signed by the new owner and accompanied by an attestation from the competent authority of the holder's CP that the new owner appears to be the successor in title of the holder



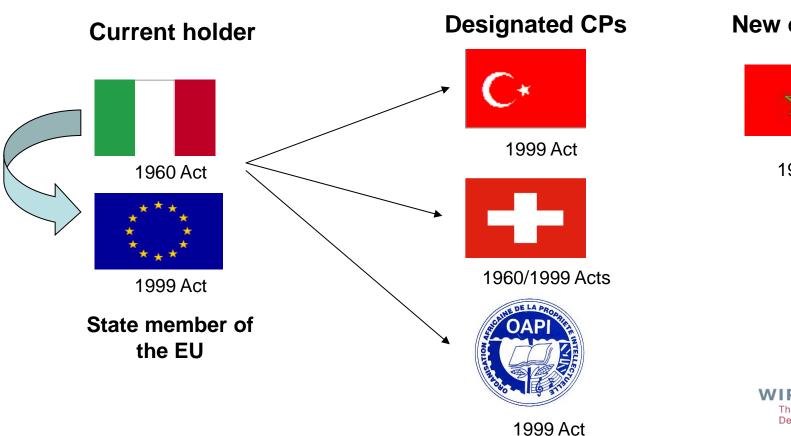
Entitlement

- The new owner must be entitled to file an international application
- There must be a common treaty between the CP(s) of the new owner and each designated CPs
- The new owner needs a connection with a CP through:
 - Nationality
 - Domicile
 - Real and effective industrial or commercial establishment
 - Habitual residence (under the 1999 Act only)



Example No. 1

Is there a problem in this case?



New owner

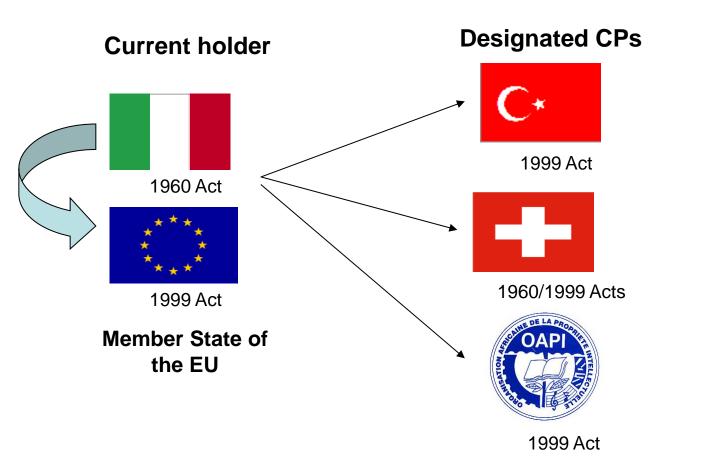


1960 Act



Example No. 2

Is there a problem in this case?



New owner



1999 Act



Change in Ownership – Scope

- Total: assignment of the whole IR
- Partial: assignment of part of the IR

- some CPs

Designated CP	Design 1	Design 2	Design 3
Switzerland			
EU	√	√	√
Turkey			

- some designs

Designated CP	Design 1	Design 2	Design 3
Switzerland			7
EU			√
Turkey			√

- « tailor-made »

Designated CP	Design 1	Design 2	Design 3
Switzerland		4	
EU		√	
Turkey			



Follow-up Procedure

- **New Rule 21** *bis* adopted by the Hague Union Assembly Entry into force: January 1, 2012.
- Mechanism to allow CP to refuse the effects of the recording of a change in ownership in the International Register, where such a recording is not allowed under their national/regional laws.
- Declaration sent by the Office to the International Bureau will be recorded in the International Register and notified to the previous holder (transferor) and the new holder (transferee) accordingly.
- The part of the international registration which is the subject of the declaration will be recorded as a separate international registration that will "remain" in the name of the previous holder (transferor).



RENUNCIATION



Article 16(iv) of the Hague Agreement Rule 21 of the Common Regulations

- Form DM/5
- Concerns ALL designs
 - May be partial → for only SOME of the designated CPs

Designated CP	Design 1	Design 2	Design 3
Switzerland			
EU			
T1			
Turkey			

■ May be total → for ALL designated CPs

	Designated CP	Design 1	Design 2	Design 3
	Saritzenland			
	S WILZELIALIG			
=	EU			
	Turkey			



LIMITATION



Article 16(v) of the Hague Agreement Rule 21 of the Common Regulations

- Form DM/3
- Concerns only **SOME** of designs
 - May concern ALL designated CPs

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	Designated CP	Design 1	Design 2	Des	ign 3
	Switzerland				
	EU				
	Turkey				

May concern only SOME of the designated CPs

Designated CP	Design 1	Design 2	Design 3	
Switzerland				
EU	_			
Turkey				







Article 17 of the Hague Agreement Rules 23-24 of the Common Regulations

- Duration of protection under the 1960 and the 1999 Acts
 - Initial term: five years
 - Minimum duration:
 - 1960 Act: 10 years (5 + 5)
 - 1999 Act: 15 years (5 + 5 + 5)
 - May be renewed up to the <u>maximum duration</u> in accordance with the national law (see declarations of CPs)



Procedure

- Unofficial expiry notice sent six months prior to the expiry date to the holder and the recorded representative, if any
- Payment: by the expiry date (if paid earlier than three months before the expiry date, it shall be considered as having been paid three months before the date)
- Grace period: within six months after the expiry date (+ surcharge of fees to be paid)



Paper Form or Electronic Form

- Paper form: form DM/4
- **E-renewal** interface:
 - Online service (launched in December 2010)
 - Easy to use More than 60% of the international registrations are currently renewed through the E-renewal interface
 - https://webaccess.wipo.int/erenewal_dm/erenewal.jsp?lang=EN
 - Online payment (current account or credit card)



Scope

- Renewal NOT possible for those CPs and/or for those designs subject to:
 - a renunciation recorded in the International Register
 - a limitation recorded in the International Register
 - an invalidation recorded in the International Register
- Renewal possible for a CP in case of refusal recorded in the International Register



Scope

- May be renewed:
 - for SOME of the designated CPs only
 - for SOME of the designs only

Designated CP	Design 1	Design 2	Des	gn 3
Switzerland	√	√		
EU	√	√		
Tunicar				
Turkey				

E-renewal: « tailor-made » renewal

Designated CP	Design 1	Design 2	Design 3
Switzerland	√	√	√
EU	√	√	
Turkey	√		√



SUMMARY



Summary: Post-Registration Procedures

Renunciation

Limitation

The holder may request:

- reduction of the scope of the IR
- prolongation of the IR Renewal
- update information about the ——— Change in name and/or holder address of the holder
- representation before the ———— Appointment, change or International Bureau cancellation of representative

The International Design System



THANK YOU!

Patrick.Cartant@wipo.int