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The International
Design System

International Registration

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

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Topics Addressed

- Effects of an international registration
- Refusal and other office actions

■ EFFECTS OF INTERNATIONAL REGISTRATION

Effects of an International Registration

- Horizontally (as many as designations):
 - Same effects as **under the applicable law** (*Article 14(1) and (2)*)
- Vertically (from filing to registration):
 - Effect as **application** (*Article 14(1)*) , plus ?
 - Effect as **grant of protection (registration)** (*Article 14(2)(a) and (b)*)

Effects of an IR under the 1999 Act

- After publication (Article 14(1))
= effects *as application* from the date of IR, *at least*
- If no refusal is notified (Article 14(2)(a))
= effects *as a grant of protection*, in principle, *at the latest from the expiry date of the applicable refusal period (6 or 12 months)*
- If the refusal is withdrawn (Article 14(2)(b))
= effects *as a grant of protection at the latest from the date on which the refusal was withdrawn*

Effects of an IR under the 1999 Act

- “Two exceptions” to Article 14(2)(a)

applicable through an additional declaration by a CP (whose Office is an “Examining Office” or whose law provides for an opposition procedure) opting for 12-month refusal period

- Option 1 (Rule 18(1)(c)(i))

The latest time at which protection must be granted may be extended up to 6 months after the expiry date of the 12-month refusal period

CPs: Spain, Turkey, USA

Effects of an IR under the 1999 Act

- “Two exceptions” to Article 14(2)(a) - *continued*

- Option 2 (Rule 18(1)(c)(ii))

Protection will be granted according to the law of the Contracting Party where a decision regarding the grant of protection was unintentionally not communicated within the applicable refusal period.

= *Protection can be granted even after the refusal period, but only in exceptional circumstances.*

CPs: Japan, Republic of Korea, USA

■ REFUSAL AND OTHER OFFICE ACTIONS

Office Actions

- Refusal
- Withdrawal of Refusal
- Statement of Grant of Protection
- Invalidation

Refusal: Basic principles

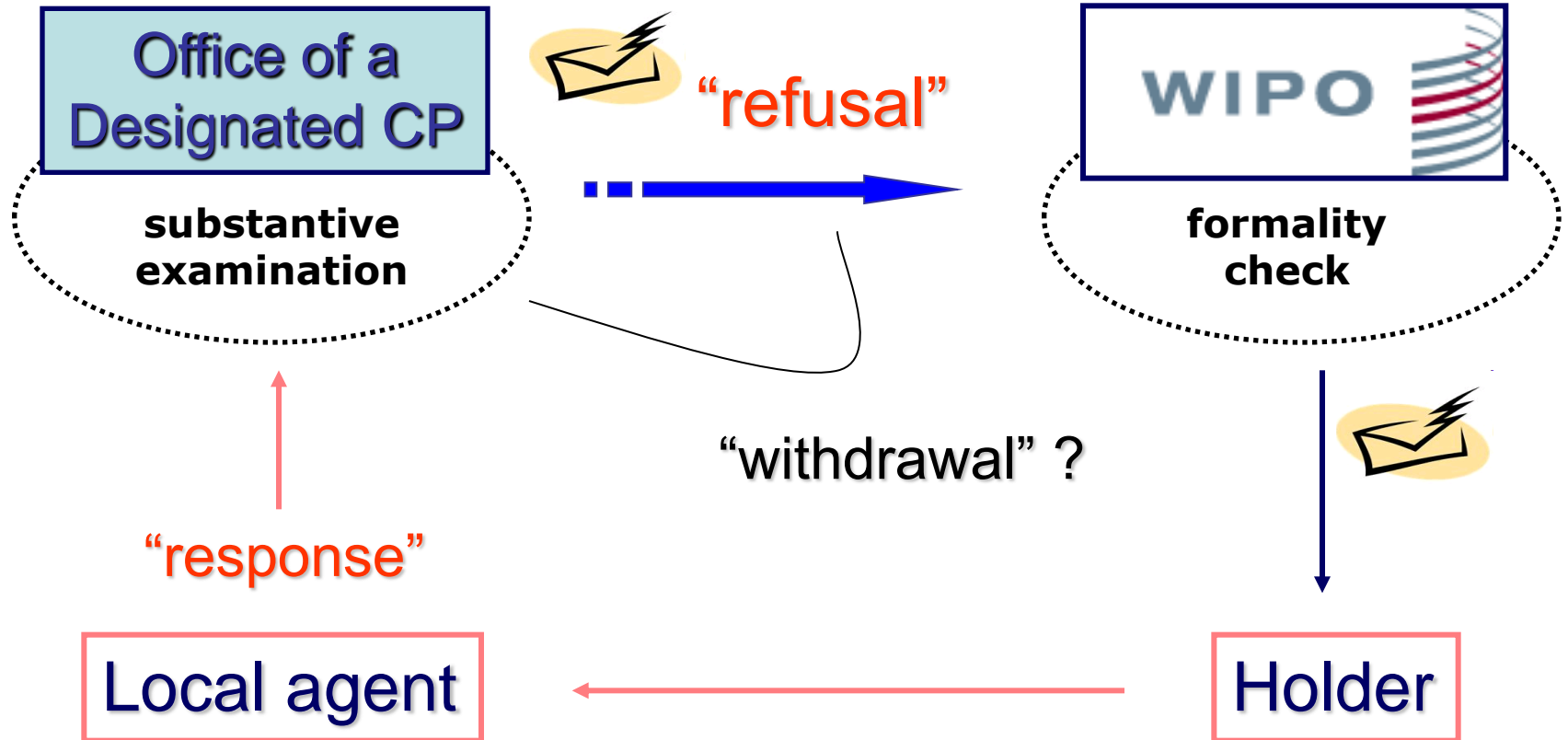
- **Within refusal period:** starting from the date of international publication
- **Provisional objection:** which may become a **final decision**, without further notification
- Languages: English, French or Spanish
- Total (for all the designs) or partial (for some of the designs only)

Refusal: Time frame

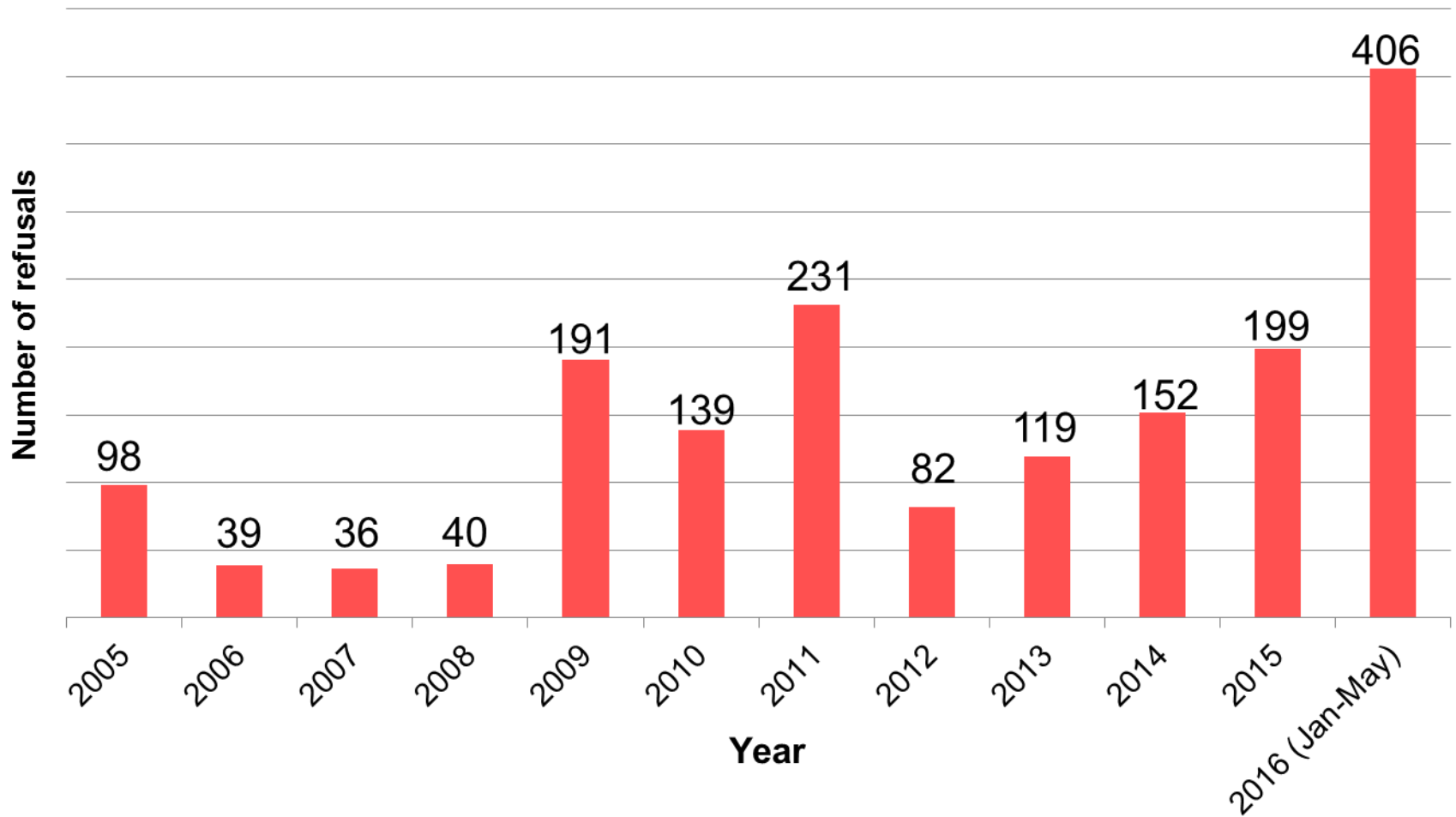
- Principle: **6 months** (Article 8(1) of the 1960 Act, Article 12(2) of the 1999 Act and Rule 18(1)(a))
- Exceptions (**the 1999 Act only**) (Rule 18(1)(b)): (which may be opted for by a Contracting Party whose Office is an “**Examining Office**” or whose law provides for an **opposition procedure**)

The period may be extended up to **12 months**

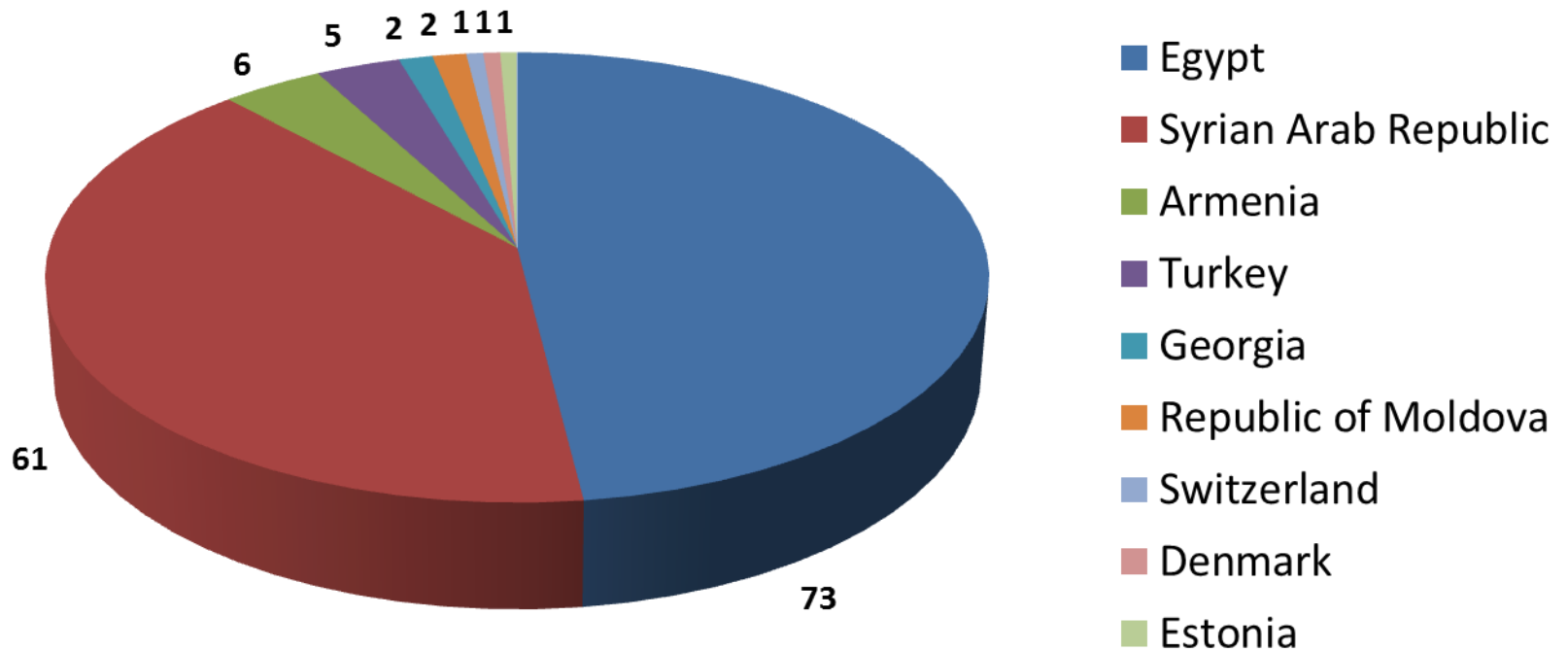
Refusal Mechanism



Statistics – Total number of refusals

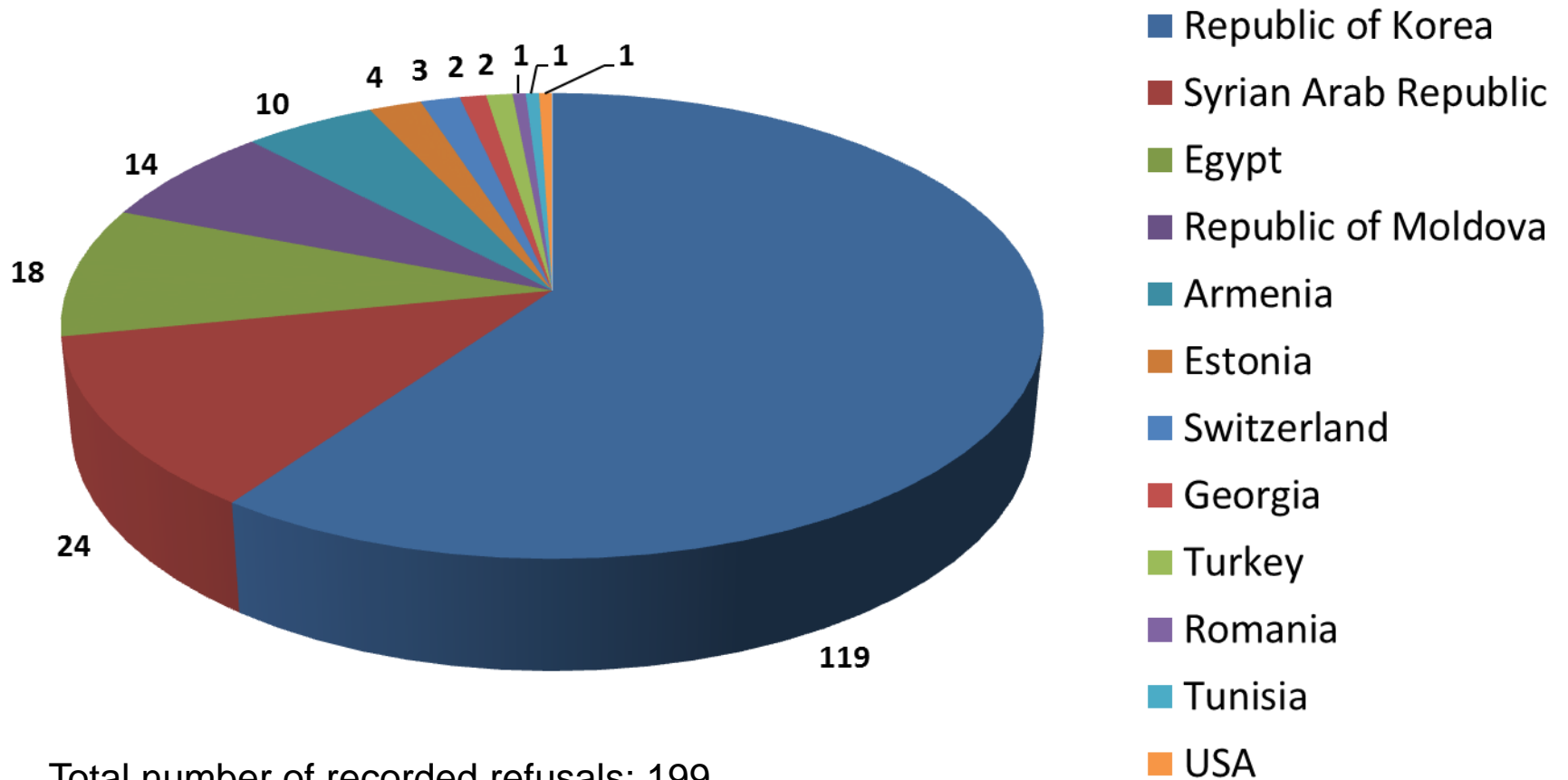


Refusals by the designated CPs recorded in 2014



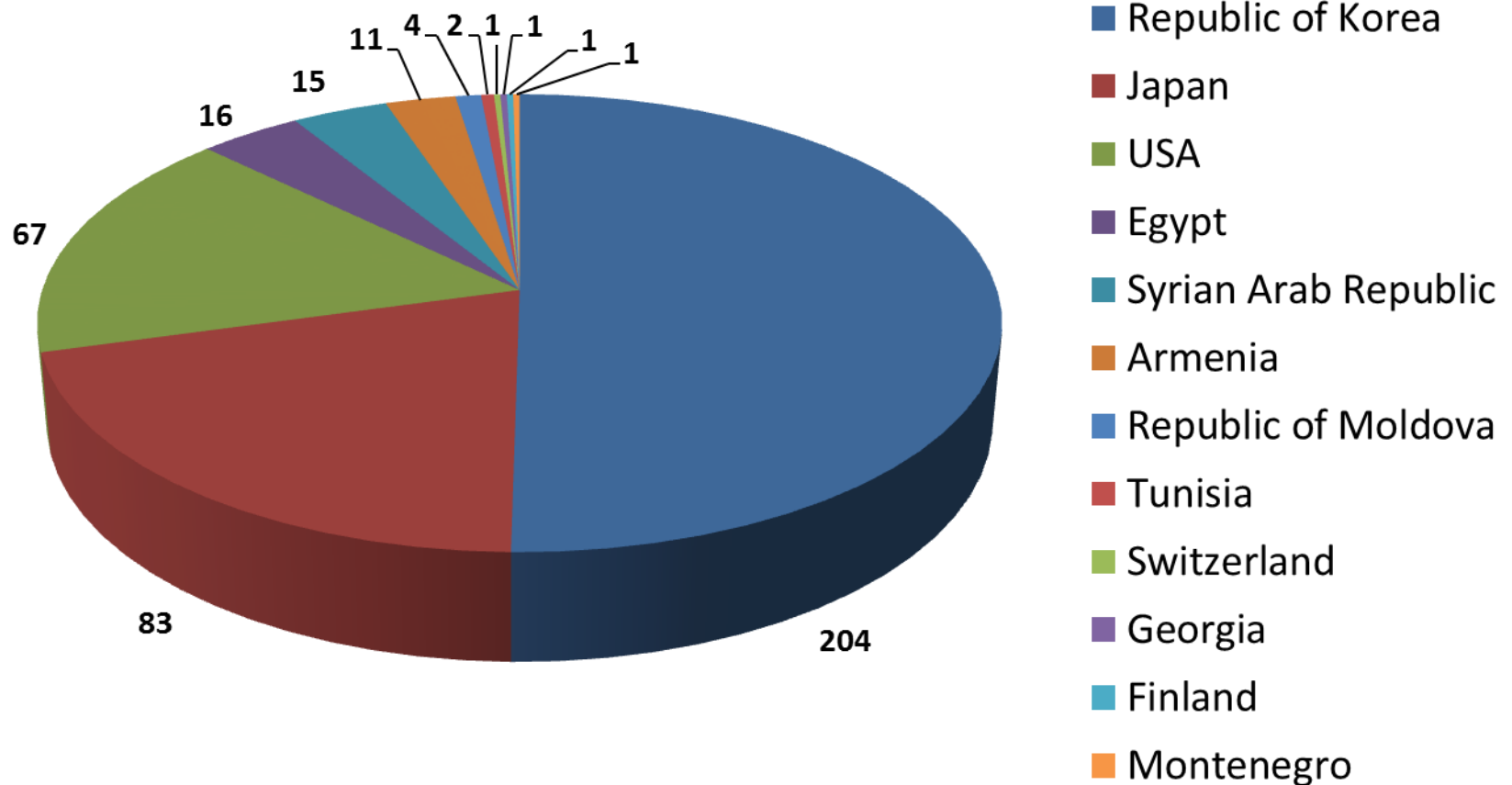
Total number of recorded refusals: 152

Refusals by the designated CPs recorded in 2015



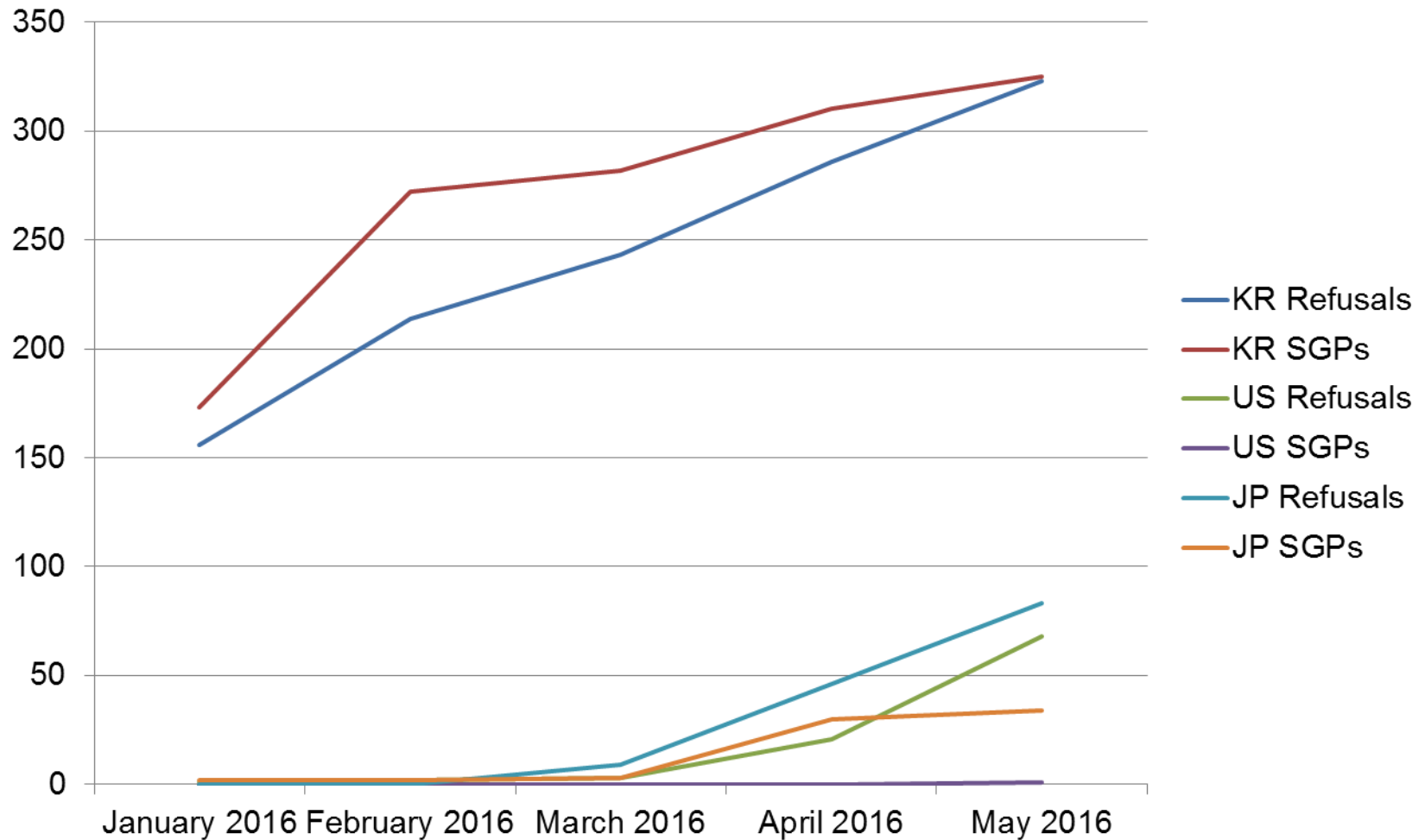
Total number of recorded refusals: 199

Refusals by the designated CPs recorded in 2016 (January-May)



Total number of recorded refusals: 406

KR; JP; US: Total number of refusals and statements of grant of protection (SGPs) recorded



Refusal Ground: No formal ground

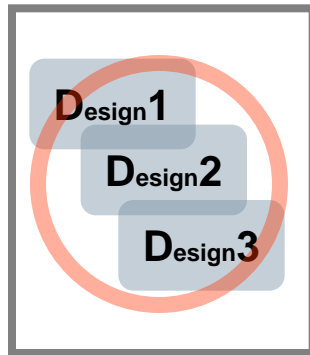
- Principle:
substantive grounds only (incl. opposition)

- Exceptions:
 - requirement as to unity of design (Article 13) *
 - specific views of the design not furnished
(Rule 9(3)(a)) *

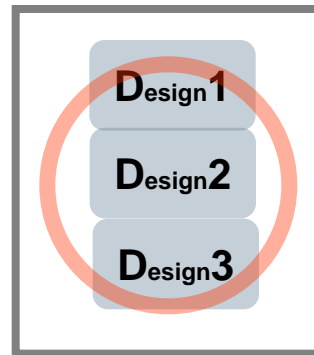
- * Declarations possible only under the 1999 Act

Unity of design: Declaration under Article 13(1)

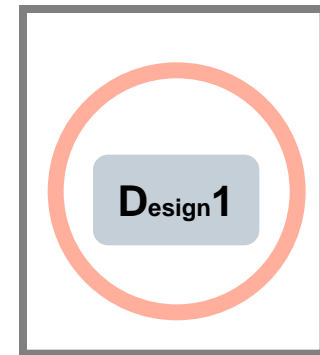
If the applicable law provides for any of the following types of requirement at the time it becomes party to the 1999 Act



Each of the designs must conform to a requirement of **unity of design, unity of production or unity of use** (have a similarity in appearance, production or use of the product)



Each of the designs must **belong to a set of products**



Only one design may be the subject of a single application

The CP may make a declaration under Article 13(1) of the 1999 Act.

The CP may issue a refusal if the specified requirement is not complied.

Specific views: Declaration under Rule 9(3)(a)

International Bureau

No requirement as to the types of views. A single reproduction is enough.

One perspective view

Front view + top view + right side view

Front view + one perspective view

etc.

The law of the CP

If the law provides for certain types of views that must be submitted, **the CP may specify, in the declaration, the views required and the circumstances in which they are required.**

Six orthographic views

(Front view + Top view + Right side view + Left side view + Rear view + Bottom view)

Two perspective views showing a whole appearance of the product

etc.

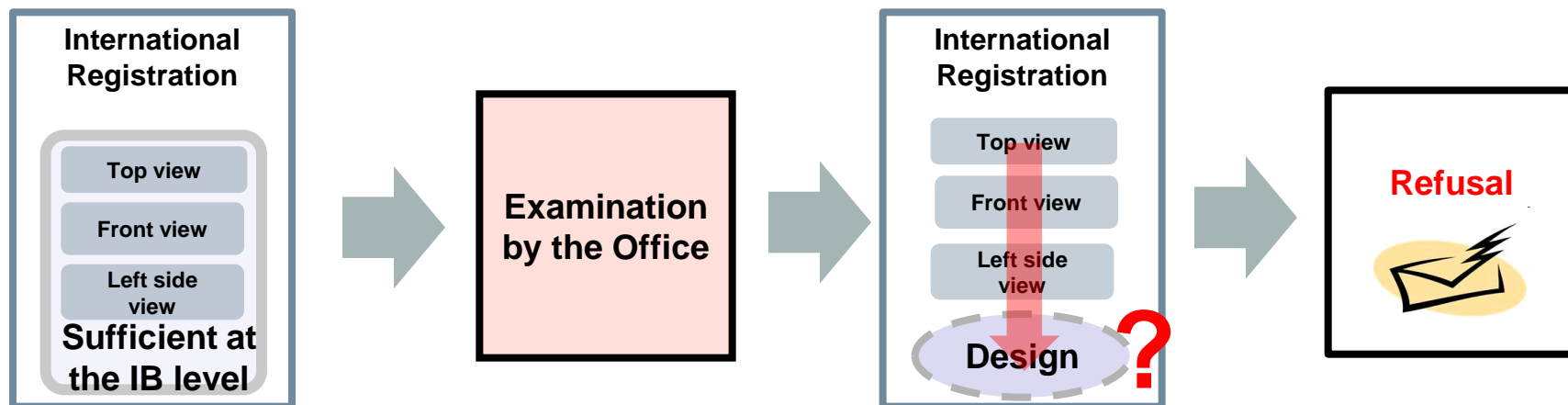


Refusal Ground: Typical substantive grounds

- Definition of an industrial design
 - Type of design not protected (*ex. “logo”*)
 - Disclosure insufficient to figure out the design
- Public order and morality
- Conflict with prior applications / registrations
- Novelty
- Creativity / Non-obviousness

Refusal ground; insufficient disclosure (Rule 9(4))

- A CP **may not issue a refusal** on the ground that requirements relating to the form of the reproduction that are additional to, or different from, those specified in the declaration under Rule 9(3)(a) have not been satisfied.
- However, it **may issue a refusal, on an individual case basis**, on the ground that the reproductions contained in the international registration do not sufficiently disclose the industrial design.



Withdrawal of Refusal / Statement of grant of protection

■ After refusal

- Notification of withdrawal of refusal (Rule 18(4))
- Statement of grant of protection (Rule 18bis(2))

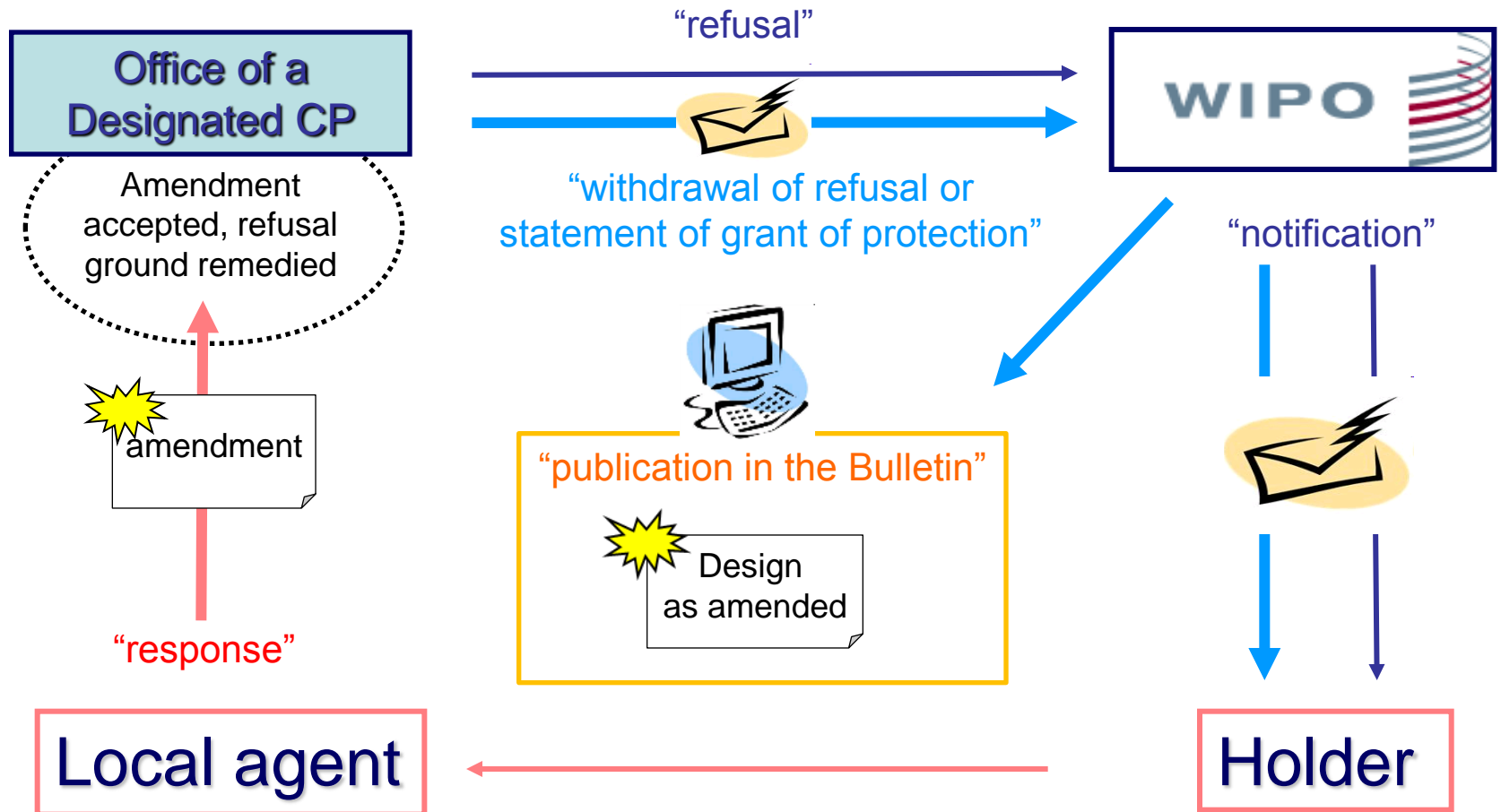
■ Where no refusal

- Statement of grant of protection (Rule 18bis(1))
 - *within the applicable refusal period*
 - *optional but recommended*

Withdrawal of Refusal / Statement of grant of protection: Amendments of design

- Where [amendments](#) are made to the design in a procedure before the Office, and the design as amended is accepted, a statement of grant of protection (or notification of withdrawal of refusal) [must](#) be sent, with [the information concerning the amendments](#) (new Rules 18(4) and 18*bis*(1) and (2)).
- Information concerning the amendments will be made [publicly available by the IB](#), through the Bulletin.

Withdrawal of Refusal / Statement of grant of protection: Amendments of design



Invalidation

- **Office or court decision** which is made after producing protection (Rule 19)
- Remarks:
 - Outside the “Refusal” mechanism
 - “Post-grant opposition” included
 - Opportunity to defend the right
 - Only the **final decision**



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THANK YOU !