

# THE INTERNATIONAL REGISTRATION SYSTEMS FOR TRADEMARKS AND INDUSTRIAL DESIGNS: OBJECTIVES, MAIN FEATURES, ADVANTAGES

## INTRODUCTION

1. This presentation covers two international registration systems, one concerning trademarks and the other concerning industrial designs. These two systems provide relatively simple and inexpensive procedures for obtaining and maintaining trademark and design protection in multiple jurisdictions.

### **I: THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS AND THE PROTOCOL RELATING TO THAT AGREEMENT**

2. The Madrid system of international registration of marks is governed by two treaties: the Madrid Agreement Concerning the International Registration of Marks, which dates from 1891, and the Protocol Relating to the Madrid Agreement, which was adopted in 1989, entered into force on December 1, 1995, and came into force on that date. The system is administered by the International Bureau of WIPO, which maintains the International Register and publishes the *WIPO Gazette of International Marks*.

3. Any State which is a party to the Paris Convention for the Protection of Industrial Property may become a party to the Agreement or the Protocol or both. In addition, an intergovernmental organization may become a party to the Protocol (but not the Agreement) where the following conditions are fulfilled: at least one of the Member States of the organization is a party to the Paris Convention and the organization maintains a regional office for the purposes of registering marks with effect in the territory of the organization.

4. States party to the Agreement and/or the Protocol and organizations party to the Protocol are referred to collectively as Contracting Parties. Together, they constitute the Madrid Union, which is a Special Union under Article 19 of the Paris Convention.

5. A list of Contracting Parties is contained in the Annex hereto.

6. Every member of the Madrid Union is a member of its Assembly. Among the most important tasks of the Assembly are the adoption of the program and budget of the Union and the adoption and modification of the implementing regulations, including the fixing of fees connected with the use of the Madrid system.

## **Objectives**

7. The objectives of the system are two-fold. Firstly, it facilitates the obtaining of protection for marks (trademarks and service marks). The registration of a mark in the International Register produces, in the Contracting Parties designated by the applicant, the effects described in paragraph 26, below. Further Contracting Parties may be designated subsequently. Secondly, since an international registration is equivalent to a bundle of national registrations, the subsequent management of that protection is made much easier. There is only one registration to renew, and changes such as a change in ownership or in the name or address of the holder, or a limitation of the list of goods and services, can be recorded in the International Register through a single simple procedural step. On the other hand, if it is desired to transfer the registration for only some of the designated Contracting Parties, or for only some of the goods or services, or to limit the list of goods and services with respect to only some of the designated Contracting Parties, the system is flexible enough to accommodate this.

## **Who May Use the System?**

8. An application for international registration (an “international application”) may be filed only by a natural person or a legal entity which has a real and effective industrial or commercial establishment in, or is domiciled in, or is a national of, a country which is party to the Madrid Agreement or the Madrid, or who has such an establishment in, or is domiciled in, the territory of an intergovernmental organization which is a party to the Protocol, or is a national of a Member State of such an organization.

9. The Madrid system of international registration cannot be used by a person or legal entity which does not have the necessary connection, through establishment, domicile or nationality, with a member of the Madrid Union. Nor can it be used to protect a mark outside the Madrid Union.

## **The International Application**

10. A mark may be the subject of an international application only if it has already been registered (or, where the international application is governed exclusively by the Protocol, if registration has been applied for) in the Trademark Office of the Contracting Party with which the applicant has the necessary connection, as described in paragraph 6, above, to be able to file an international application. This Office is referred to as the Office of origin.

11. An international application must be presented to the International Bureau through the Office of origin. An international application which is presented direct to the International Bureau by the applicant will not be considered as such and will be returned to the sender.

12. The international application must contain, *inter alia*, a reproduction of the mark (which must be identical with that in the basic registration or basic application) and a list of the goods and services for which protection is sought, classified in accordance with the International Classification of Goods and Services (Nice Classification).

13. An international application may claim priority under Article 4 of the Paris Convention, whether from the application with the Office of origin or from a prior application filed with the Office of another country party to the Paris Convention or with the Office of a Member of the World Trade Organization.

14. An international application must designate the Contracting Parties in which the mark is to be protected. Where the Contracting Party whose Office is the Office of origin is a party to the Agreement but not the Protocol, only other States which are also party to the Agreement may be designated. Where the Contracting Party whose Office is the Office of origin is a party to the Protocol but not the Agreement, only other Contracting Parties which are also party to the Protocol may be designated. Where the Contracting Party whose Office is the Office of origin is a party to both the Agreement and the Protocol, any other Contracting Party may be designated.

15. The Contracting Party whose Office is the Office of origin cannot be designated in an international application; nor can it be designated subsequently.

16. The designation of a given Contracting Party is made under that treaty (Agreement or Protocol) which is common to the designated Contracting Party and the Contracting Party whose Office is the Office of origin. Where both Contracting Parties are party to both the Agreement and the Protocol, it is the Agreement which governs the designation; this follows from the so-called “safeguard” clause, Article 9sexies of the Protocol.

17. There are therefore three kinds of international application:

- an international application *governed exclusively by the Agreement*; this means that all the designations are made under the Agreement;
- an international application *governed exclusively by the Protocol*; this means that all the designations are made under the Protocol;
- an international application *governed by both the Agreement and the Protocol*; this means that some of the designations are made under the Agreement and some under the Protocol).

18. If the international application is governed exclusively by the Agreement, it must be in French. If it is governed exclusively by the Protocol or by both the Agreement and the Protocol, it may be in either English or French; the Office of origin may however restrict the applicant’s choice to one of these languages.

19. The international application is subject to the payment of the following fees:

- a basic fee;
- a complementary fee in respect of each designated Contracting Party for which no individual fee is payable;
- an individual fee in respect of any Contracting Party which is designated under the Protocol and has declared that it wishes to receive such a fee; (the amount of the individual fee is determined by each Contracting Party; it may not be higher than the amount that would be payable for the registration of a mark in the Office of that Contracting Party; the amounts of the respective individual fees are published in the Gazette);
- a supplementary fee in respect of each class of goods and services beyond the third; no supplementary fee is payable however where all the designations are ones in respect of which an individual fee has to be paid.

20. These fees may be paid direct to the International Bureau or, where the Office of origin accepts to collect and forward such fees, through that Office.

21. The Office of origin must certify that the mark is the same as that in the basic registration or basic application, that any indications such as a description of the mark or a claim to color as a distinctive feature of the mark are the same as those contained in the basic registration or basic application, and that the goods and services indicated in the international application are covered by the list of goods and services in the basic registration or basic application.
22. The Office of origin must also certify the date on which it received the request to present the international application. This date is important; provided the application is received by the International Bureau within two months of that date (and provided that certain crucial elements are not missing), it is that date that will be the date of the international registration.
23. The International Bureau checks that the international application complies with the requirements of the Agreement or Protocol and the Common Regulations, including requirements relating to the indication of goods and services and their classification, and that the required fees have been paid. The Office of origin and the applicant are informed of any irregularities; these must be remedied within three months, otherwise the application will be considered abandoned.
24. Where the international application complies with the applicable requirements, the mark is recorded in the International Register and published in the Gazette. The International Bureau then notifies each Contracting Party in which protection has been requested.

#### **Examination by the Office of a Designated Contracting Party; Refusal of Protection**

25. The Office of a designated Contracting Party examines the international registration in exactly the same way as an application filed directly. If grounds for objection are found during the *ex officio* examination, or if an opposition is filed, the Office has the right declare that protection cannot be granted to the mark in that Contracting Party.
26. Any provisional refusal must be notified to the International Bureau by the Office of the Contracting Party concerned within the time limit specified in the Agreement or Protocol. This time limit is generally 12 months. A contracting Party may however declare that, when it is designated under the Protocol, this time limit shall be replaced by 18 months. A Contracting Party that has made this declaration may further declare that a provisional refusal based on an opposition may be notified even after the expiry of this 18-month period.
27. The Provisional refusal is recorded in the International Register and published in the Gazette and a copy is transmitted to the holder of the international registration.
28. Any procedure subsequent to the refusal, such as review or appeal, is carried out direct between the holder and the administration of the Contracting Party concerned, without any involvement on the part of the International Bureau. The Contracting Party concerned must however notify the International Bureau of the final decision taken in respect of such review or appeal. This decision is also recorded in the International Register and published in the Gazette.
29. When an Office finds no reason for refusing protection, it may, before the expiry of the applicable time limit for provisional refusal, issue a statement of grant of protection. Such statement is recorded in the International Register and published in the Gazette, and a copy is

transmitted to the holder of the international registration. An Office is however not obliged to issue a positive decision on registration, and no legal consequences result if it does not do so.

### **Effects of the International Registration**

30. From the date of the international registration (or, in the case of a Contracting Party designated subsequently, from the date of that designation), the protection of the mark in each of the designated Contracting Parties is the same as if the mark had been the subject of an application for registration filed direct with the Office of that Contracting Party. If no refusal is notified to the International Bureau within the relevant time limit, the protection of the mark in each designated Contracting Party is the same as if it had been registered by the Office of that Contracting Party.

31. An international registration is therefore equivalent to a bundle of national registrations. Although it is a single registration, protection may be refused by some of the designated Contracting Parties, or the protection may be limited or renounced with respect to only some of the designated Contracting Parties. Likewise an international registration may be transferred to a new owner with respect to only some of the designated Contracting Parties. An international registration may also be invalidated (for example, for non-use) with respect to one or more of the designated Contracting Parties. Moreover, any action for infringement of an international registration must be brought separately in each of the Contracting Parties concerned.

32. This is in contrast to a unitary regional right such as the Community trademark, which cannot be refused, limited or transferred with effect for only a part of the territory covered by the right, and which may be enforced by a single legal action covering infringement occurring anywhere in that territory.

### **Dependence on the Basic Mark**

33. For a period of five years from the date of its registration, an international registration remains dependent on the mark registered or applied for in the Office of origin. If, and to the extent that, the basic registration ceases to have effect, whether through cancellation following a decision of the Office of origin or a court, through voluntary cancellation or through non-renewal, within this five-year period, the international registration will no longer be protected. Similarly, where the international registration was based on an application in the Office of origin, it will be canceled if, and to the extent that, that application is refused or withdrawn within the five-year period, or if, and to the extent that, the registration resulting from that application ceases to have effect within that period.

34. The Office of origin is required to notify the International Bureau of facts and decisions concerning such ceasing of effect or refusal and, where appropriate, to request the cancellation (to the extent applicable) of the international registration. The cancellation is published in the Gazette and notified to the designated Contracting Parties. Such cancellations are relatively infrequent; only about 120 are recorded each year, many of which relate to only some of the goods and services covered by the international registration.

35. If, within three months of such cancellation, the holder files an application for registration with the Office of a Contracting Party that had been designated under the Protocol, that application will be treated as if it had been filed on the date of the international registration or (as the case may be) the subsequent designation of the Contracting Party

concerned. This option is not available in the case of a Contracting Party designated under the Agreement.

36. After the expiry of the period of five years mentioned in paragraph 31, the international registration becomes independent of the basic registration or basic application.

### **Replacement of a National or Regional Registration by an International Registration**

37. An international registration is deemed to replace a national or regional registration for the same mark and the same goods and services recorded in the name of the same person in a designated Contracting Party. The effect of replacement is that, if the national or regional registration is not renewed, the holder of the international registration may continue to benefit from the earlier right acquired by reason of that national or regional registration. Although replacement takes place automatically, the holder of the international registration may request the Office of the Contracting Party in which the national or regional registration is recorded to take note in its register of the international registration.

### **Subsequent Designation**

38. The effects of an international registration can be extended to a Contracting Party not covered by the international application by filing a subsequent designation. Thus the holder of an international registration can expand the geographical scope of the protection of his mark in line with his business needs. Moreover a subsequent designation may be made in order to extend the protection of the mark to a Contracting Party which was not a party to the Agreement or Protocol at the time of the international application. The principles that determine whether such a designation can be made, and whether it is governed by the Agreement or by the Protocol, are as described in paragraphs 14 and 15, above.

### **Changes in the International Register; Cancellation**

39. A change in the name or address of the holder or his representative may be recorded in the International Register on request.

40. Likewise a change in the ownership of an international registration may be recorded, in respect of all or some of the goods and services and all or some of the designated Contracting Parties. A person may not however be recorded as the holder of an international registration in respect of a given Contracting Party if he would not be entitled (in accordance with the principles set out in paragraphs 14 and 15, above), to designate that Contracting Party in an international application. Thus, for example, a person who does not have a connection with a country which is a party to the Agreement may not be recorded as the holder of an international registration in respect of a designated Contracting Party which is a party only to the Agreement.

41. The following may also be recorded in the International Register:

- a *limitation* of the list of goods and services in respect of **all or some** of the designated Contracting Parties;
- a *renunciation* in respect of **some** of the designated Contracting Parties for **all** the goods and services;
- a *cancellation* of the international registration in respect of **all** the designated Contracting Parties for **all or some** of the goods or services.

42. concerning such changes and cancellation is published in the Gazette and notified to the designated Contracting Parties.

43. No change may be made in the mark that is the subject of an international registration, either on renewal or at any other time. Nor may the list of goods and services be changed in a way that would extend the scope of protection.

### **Duration of Registration; Renewal**

44. An international registration is effective for 10 years. It may be renewed for further periods of 10 years on payment of the prescribed fees. The International Bureau sends a reminder to the holder and to his representative (if any) six months before renewal is due.

45. The international registration may be renewed in respect of all the designated Contracting Parties or in respect of only some of them. It may not however be renewed in respect of only some of the goods and services recorded in the International Register; if therefore the holder wishes, at the time of renewal, to remove some of the goods and services from the international registration, he must separately request cancellation in respect of those goods and services.

### **Advantages of the System**

46. International registration has several advantages for the owner of the mark. After registering the mark, or filing an application for registration, with the Office of origin, he has only to file one application, in one language, and pay one fee instead of filing separately in the trademark Offices of the various Contracting Parties in different languages and paying a separate fee in each Office. Moreover, the holder does not have to wait for the Office of each Contracting Party in which protection is sought to take a positive decision to register the mark; if no refusal is notified by an Office within the applicable time limit, the mark is protected in the Contracting Party concerned.

47. A further important advantage is that changes subsequent to registration, such as a change in the name or address of the holder, or a change (total or partial) in ownership or a limitation of the list of goods and services may be recorded with effect for several designated Contracting Parties through a single simple procedural step and the payment of a single fee. Moreover, there is only one expiry date and only one registration to renew.

48. International registration is also to the advantage of Trademark Offices. They do not need to examine for compliance with formal requirements, or classify the goods or services, or publish the marks. Moreover, they are compensated for the work that they perform; the individual fees collected by the International Bureau are transferred to the Contracting Parties in respect of which they have been paid, while the complementary and supplementary fees are distributed annually among the Contracting Parties not receiving individual fees, in proportion of the number of designations made of each of them. In 2002, the International Bureau distributed a total of around 64 million Swiss francs resulting from such so-called "designation" fees (complementary, supplementary and individual fees). In addition, if the International Registration Service closes its biennial accounts with a profit, the proceeds are divided among the Contracting Parties.

49. Currently, we account for over 400,000 trademarks recorded on the International Register.

## **II. THE HAGUE AGREEMENT: OBJECTIVES, MAIN FEATURES, ADVANTAGES**

50. The system of international deposit of industrial designs is governed by the Hague Agreement Concerning the International Deposit of Industrial Designs, which dates from 1925, entered into force in 1928, and has been revised at various times, in particular at London (1934 Act) and at The Hague (1960 Act)<sup>1</sup>. The system is administered by the International Bureau of WIPO, which maintains the International Register and publishes the *Bulletin des dessins et modèles internationaux/International Designs Bulletin*.

51. An international deposit may be governed by the provisions of the 1934 Act or those of the 1960 Act or both. The vast majority of international deposits are governed exclusively or partly by the 1960 Act. Unless otherwise specified, this paper reflects the provisions of the 1960 Act.

52. The States party to the Agreement constitute a special union, called the Hague Union. Accession to the Hague Agreement<sup>2</sup> and participation in the Hague Union do not entail any financial obligation for the acceding State since the Union is financed by the fees paid by depositors and owners of international deposits.

53. A list of Contracting Parties is contained in the Annex hereto.

### **Objectives**

54. The objectives of the system are two-fold. Firstly, it offers the possibility of obtaining protection for industrial designs in a number of States through a single deposit made with the International Bureau of WIPO. Secondly, by having a single deposit with effect in several countries, the subsequent management of the protection obtained is also made much easier. For instance, there is only one deposit to renew, and changes such as a change in ownership or in the name or address of the owner can be recorded in the International Register through a single simple procedural step.

### **Who May Use the System?**

55. An international deposit may be made by any natural person or legal entity having a real and effective industrial or commercial establishment or a domicile in, or being a national of, one of the States party to the Hague Agreement.

### **Where Can Protection be Obtained?**

56. Protection can be obtained only in those States which are party to the same Act as the State with which the applicant has a necessary connection to make an international deposit.

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<sup>1</sup> A new Act of the Hague Agreement, which is not yet in force, was adopted in Geneva on July 2, 1999 (see paragraphs 31 to 36).

<sup>2</sup> Accession to the Hague Agreement is open, in respect of the 1934 and 1960 Acts, to any State party to the Paris Convention and, in respect of the Geneva Act (see note 1, above), to any State party to the Convention Establishing WIPO and to certain intergovernmental organizations.



In other words, if the applicant has a connection with a State bound only by the 1934 Act, he will obtain protection only in those States which are bound by the 1934 Act, whether they are also bound by the 1960 Act or not. If the applicant has a connection with a State bound only by the 1960 Act, he will be able to obtain protection, by designating them, in those States which are bound by the 1960 Act, whether they are also bound by the 1934 Act or not. If the applicant has a connection with a State bound by both Acts, he will be able to obtain protection in all member States of the Hague Union.

57. Protection may also be obtained in the State of origin<sup>3</sup> by means of an international deposit, unless the domestic legislation of that State does not permit it<sup>4</sup>.

58. It should be added that, if the applicant has more than one connection in respect of States party to different Acts of the Agreement, he can cumulate the possibilities offered by each Act in the same international deposit. For example, an applicant having the nationality of a State party only to the 1934 Act, but whose domicile is in a State party only to the 1960 Act, could obtain protection in all States of the Hague Union.

### **The International Deposit**

59. An international deposit does not require any prior national deposit. An industrial design can therefore be deposited and protected for the first time at the international level through the Hague Agreement.

60. The international deposit is normally made directly with the International Bureau of WIPO, by the depositor or his representative, on a form provided by the International Bureau. The deposit may also be made through the national Office of a Contracting State if such State so permits<sup>5</sup>. However, a State may require that, where it is considered to be the State of origin, the deposit be made through its national Office<sup>6</sup>.

61. An application for international deposit must contain, *inter alia*, the exact designation of the article or articles in which it is intended to incorporate the designs, and a reproduction (photograph or graphic representation) of each design or each article deposited.

62. An international deposit may include up to 100 designs. All the designs in a deposit must be intended to be incorporated in articles included in the same class of the International Classification of Industrial Designs (Locarno Classification).

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<sup>3</sup> "State of origin" means the Contracting State in which the applicant has a real and effective industrial or commercial establishment or, if the applicant has such establishments in several States, the Contracting State which he has indicated in his application; if the applicant has no such establishment in any Contracting State, the Contracting State in which he has his domicile; if he has no domicile in a Contracting State, the Contracting State of which he is a national.

<sup>4</sup> According to the information available to the International Bureau, Hungary is the only country that does not allow itself to be designated in an international deposit for which it is the State of origin.

<sup>5</sup> According to the information available to the International Bureau, Benin, Bulgaria, Greece, Hungary, Italy, Liechtenstein, Mongolia and Switzerland allow an international deposit to be made through their national Offices.

<sup>6</sup> According to the information available to the International Bureau, the Republic of Moldova and Yugoslavia require that, where they are considered to be the State of origin, the international deposit be made through their national Offices.

63. Priority under Article 4 of the Paris Convention for the Protection of Industrial Property may be claimed in an international deposit if the said international deposit is made within six months of a first regular national deposit made in a State party to the Paris Convention or a Member of the World Trade Organization or of a regional or international deposit having the same effect as such a national deposit. Conversely, an international deposit made under the Hague Agreement may serve as basis for priority in a national or regional design application in a State party to the Paris Convention, or a Member of the World Trade Organization even if that State is not a member of the Hague Union.

64. The working languages of the Hague Agreement (1960 Act) are English and French. An international deposit may thus be made in either of these languages.

65. An international deposit is subject to the payment of fees, in Swiss francs. The fees for a deposit governed exclusively or partially by the 1960 Act consist of:

- an international deposit fee (comprising a basic fee for one industrial design and a further fee for each additional design included in the same deposit) which covers the costs of the International Bureau in administering the Designs Registry;
- a publication fee (which is greater where the reproductions of the design are in color);
- fees for each Contracting State designated (State fees).

66. The Agreement provides for two State fees—the ordinary State fee and an additional State fee which is payable for a designated Contracting State that has a novelty examination<sup>7</sup>. The State fees are distributed each year amongst the Contracting States. For the year 2002, 2.2 million Swiss francs were collected and distributed by the International Bureau.

67. The International Bureau checks that the application for international deposits complies with the requirements of the Agreement and the Regulations, including requirements relating to the photographs or graphic representations, and that the required fees have been paid. The depositor is informed of any defects; these must be corrected within three months, otherwise the international deposit will be declined.

68. Where the international deposit complies with the applicable requirements, it will be recorded in the International Register and published in the *International Designs Bulletin*. This publication, which is made on CD-ROM, comprises a reproduction of the deposited photographs or graphic representations. Copies of the Bulletin are sent to the national Office of each Contracting State.

69. The applicant may request that the publication be deferred for a period which may not exceed 12 months as from the date of the international deposit or (where priority is claimed) from the priority date.

### **Possibility of Refusal**

70. Under the 1960 Act, the Office of a Contracting State whose domestic legislation provides for an administrative examination *ex officio* or for opposition by third parties may notify the International Bureau that it refuses to grant protection to an industrial design on the ground that it does not meet the requirements of that domestic law. However, protection may

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<sup>7</sup> At present, the State novelty examination fee is payable in respect of a designation of Bulgaria, Hungary, the Republic of Moldova or Romania.

not be refused on the grounds of non-compliance of the international deposit with formal requirements, since all such requirements must be considered by each Contracting State as having been complied with in the international procedure.

71. Any refusal of protection must be notified to the International Bureau within six months of the date on which the national Office receives the Bulletin in which the international deposit is published. The depositor has the same remedies against the decision of refusal as he would have had if he had deposited the design concerned directly with the national Office that issued the refusal. In fact, refusals are extremely infrequent. Only approximately fifteen are received each year by the International Bureau.

### **Effects of the International Deposit**

72. If no refusal is notified within the prescribed time limit, the international deposit will have effect in that Contracting State as from the date of deposit (however, in the States in which the national legislation provides for a novelty examination, the starting point of the protection may, according to the national legislation, be later than the date of deposit).

73. An industrial design that is the subject of an international deposit enjoys, in each of the States concerned which has not refused protection, the same protection as is conferred on industrial designs by the law of that State.

### **Changes in the International Register; Renunciation**

74. A change in the name or address of the owner or his representative may be recorded in the International Register.

75. Likewise a change in the ownership of an international deposit may be recorded, in respect of all or only some of the States in which the international deposit has effect, and in respect of all or some of the designs included in the deposit. A person may not however be recorded as the owner of an international deposit in respect of a given Contracting State if that person would not be entitled (in accordance with the principles set out in paragraphs 5 to 8, above) to own international deposits. Thus, for example, a person who does not have a connection with a State which is a party to the 1960 Act may not be recorded as the new owner of an international deposit in respect of a State which is a party only to that Act.

76. A renunciation of the international deposit, in respect of all or some of the Contracting States and in respect of all or some of the designs, may also be recorded in the International Register.

77. Information concerning such changes and renunciation is recorded in the International Register and (except for changes in the name or address of representatives) is published in the Bulletin.

### **Term of Protection**

78. International deposits governed by the 1960 Act are made for an initial period of five years. They can be renewed for an additional period of five years, for all or some of the designs included in the deposit and for all or only some of the States in which it has effect (the minimum period of protection is therefore 10 years). Furthermore, if the domestic legislation of a Contracting State provides for a term of protection of more than 10 years for

industrial designs that have been the subject of a national deposit, the international deposit may be renewed in respect of that State for additional periods of five years and up to the expiry of the total term of protection allowed for national deposits.

## **International Deposits Governed Exclusively by the 1934 Act**

79. The main differences between an international deposit governed exclusively by the 1934 Act and an international deposit governed exclusively or partially by the 1960 Act can be summarized as follows:

- as regards the *language*, a deposit governed exclusively by the 1934 Act can only be made in French;
- the deposit *extends automatically* to all States party to the 1934 Act, unless protection in any of those States is expressly renounced;
- the deposit may be *opened* or *sealed*;
- *deferment of publication* may not be requested;
- the *publication* does not comprise a reproduction of the designs; it merely states the article or articles in which the designs are to be incorporated;
- the *term of protection* is 15 years, divided into an initial period of five years and, subject to renewal, a second period of 10 years;
- there is no provision for the *notification of a refusal* of protection;
- different *fees* are to be paid.

## **Advantages of the System**

80. The international deposit of industrial designs arose from a need for simplicity and economy. Nationals and residents of, or companies established in a State party to the Hague Agreement are able to obtain protection for their designs in a number of States with a minimum of formalities and expense. In particular, they are relieved of the need to make a separate national deposit in each of the States in which they require protection, thus avoiding the complications arising from procedures which differ from State to State. They do not have to submit the required documents in various languages nor keep a watch on the deadline for renewal of a whole series of national deposits, varying from one State to the other. They also avoid the need to pay a series of fees in various currencies. Under the Hague Agreement, the same result can be obtained by means of a single international deposit, made in one language, on payment of a single set of fees, in one currency and with one Office (i.e., the International Bureau).

81. These benefits do not pass unnoticed by design owners. Indeed, the number of international deposits has significantly increased over the past 10 years. In 2002, the number of international deposits amounted to 4,177. Each deposit comprises, on average, four to five designs.

## **Development of the Hague Agreement: the Geneva Act of 1999**

82. Although the facilities offered by the Hague Agreement have been used for more than 70 years to the satisfaction of design owners, the number of countries party to that Agreement has remained low and their geographical spread limited, mainly because certain States whose laws provide for an examination of deposited industrial designs as to novelty consider that the Agreement as it is does not meet their requirements.

83. For this reason, a Committee of Experts on the Development of the Hague Agreement held a series of meetings since 1991. On July 2, 1999, a Diplomatic Conference which met in Geneva adopted by consensus a new Act of the Hague Agreement. On July 6, 1999, at the

closing of the Diplomatic Conference, the Geneva Act of the Hague Agreement was signed by the plenipotentiaries of 24 States.

84. The purpose of the Geneva Act of 1999 is two-fold:

- on the one hand, to extend the Hague System to new members, particularly those whose Office carries out a novelty examination of industrial designs. For that purpose, the Geneva Act introduced in the Hague System a number of elements aiming at facilitating accession by potential Contracting Parties, such as the possibility of extending the refusal period to 12 months or fixing a higher designation fee;
- on the other hand, to maintain the fundamental simplicity of the Hague System and to render it more attractive to users.

85. The new Act also permits the establishment of a link between the international deposit system and regional systems such as the future European Community design system or the African Intellectual Property Organization (OAPI) system since it provides for certain intergovernmental organizations to become party to the Act.

86. The new Act of the Hague Agreement has not yet entered into force. The Geneva Act will enter into force three months after six States have deposited their instruments of ratification or accession, provided that at least three of those States have a certain level of activity in the field of industrial designs, as defined in Article 28 of the treaty. This provision aims to ensure that the international registration procedure provided by the 1999 Act will be used to a large extent from its entry into force.

87. The main innovations introduced by the Geneva Act of 1999 in respect of the current system, as it results from the 1934 Act and the 1960 Act, are the subject of a WIPO publication (No. 453 (E)).

(Annex follows)

**MEMBERS OF THE MADRID UNION**

Albania (A&P)	Liechtenstein (A&P)
Algeria (A)	Lithuania (P)
Antigua and Barbuda (P)	Luxembourg* (A&P)
Armenia (A&P)	Monaco (A&P)
Australia (P)	Mongolia (A&P)
Austria (A&P)	Morocco (A&P)
Azerbaijan (A)	Mozambique (A&P)
Belarus (A&P)	Netherlands* (A&P)
Belgium* (A&P)	Norway (P)
Bhutan (A&P)	Poland (A&P)
Bosnia and Herzegovina (A)	Portugal (A&P)
Bulgaria (A&P)	Republic of Korea (P)
China (A&P)	Republic of Moldova (A&P)
Croatia (A)	Romania (A&P)
Cyprus (A&P)	Russian Federation (A&P)
Cuba (A&P)	San Marino (A)
Czech Republic (A&P)	Serbia and Montenegro (A&P)
Democratic People's Republic of Korea (A&P)	Sierra Leone (A&P)
Denmark (P)	Singapore (P)
Egypt (A)	Slovakia (A&P)
Estonia (P)	Slovenia (A&P)
Finland (P)	Spain (A&P)
France (A&P)	Sudan (A)
Georgia (P)	Swaziland (A&P)
Germany (A&P)	Sweden (P)
Greece (P)	Switzerland (A&P)
Hungary (A&P)	Tajikistan (A)
Iceland (P)	The Former Yugoslav Republic of Macedonia (A&P)
Ireland (P)	Turkey (P)
Italy (A&P)	Turkmenistan (P)
Japan (P)	Ukraine (A&P)
Kazakhstan (A)	United Kingdom (P)
Kenya (A&P)	United States of America (P)
Kyrgyzstan (A)	Uzbekistan (A)
Latvia (A&P)	Viet Nam (A)
Lesotho (A&P)	Zambia (P)
Liberia (A)	
	(Total 73)

(A): indicates a State party only to the Agreement (13)

(P): indicates a State party only to the Protocol (20)

(A&P): indicates a State party to both the Agreement and Protocol (40)

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\* Protection may not be requested separately for Belgium, Luxembourg or the Netherlands, but only for all three countries as a whole (Benelux), subject to payment of a single complementary or individual fee.

**Annex (cont.)**

August 2003

**MEMBER COUNTRIES OF THE HAGUE UNION**

Belgium (60)	Liechtenstein (34 & 60)
Belize (60)	Luxembourg (60)
Benin (34 & 60)	Monaco (34 & 60)
Bulgaria (60)	Mongolia (60)
Côte d'Ivoire (34 & 60)	Morocco (34 & 60)
Democratic People's Republic of Korea (60)	Netherlands (60)
Egypt (34)	Republic of Moldova (60)
France (34 & 60)	Romania (60)
Gabon (60)	Senegal (34 & 60)
Georgia (60)	Serbia and Montenegro (60)
Germany (34 & 60)	Slovenia (60)
Greece (60)	Spain (34)
Holy See (34)	Suriname (34 & 60)
Hungary (34 & 60)	Switzerland (34 & 60)
Indonesia (34)	The former Yugoslav Republic of Macedonia (60)
Italy (60)	Tunisia (34)
Kyrgyzstan (60)	Ukraine (60)
	(Total 34)

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(60) Indicates a State party to the 1960 Act.

(34) Indicates a State party to the 1934 Act.

[End of annex and of document]