

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

Third Session
Geneva, October 28 to 30, 2013

REPORT

adopted by the Working Group

INTRODUCTION

1. 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”) met in Geneva from October 28 to 30, 2013.
2. The following members of the Hague Union were represented at the session: African Intellectual Property Organization (OAPI), Benin, Bosnia and Herzegovina, Brunei Darussalam, Denmark, Estonia, European Union, Finland, France, Germany, Greece, Hungary, Iceland, Latvia, Lithuania, Luxembourg, Morocco, Norway, Oman, Romania, Spain, Switzerland, Turkey and Ukraine (24).
3. The following States were represented as observers: China, Colombia, Czech Republic, Indonesia, Iraq, Israel, Japan, Jordan, Malaysia, Mexico, Philippines, Republic of Korea, Russian Federation, Saudi Arabia, Thailand, United States of America and Viet Nam (17).
4. Representatives of the following international intergovernmental organizations (IGOs) took part in the session in an observer capacity: African Regional Intellectual Property Organization (ARIPO) and Benelux Office for Intellectual Property (BOIP) (2).
5. Representatives of the following non-governmental organizations (NGOs) took part in the session in an observer capacity: American Intellectual Property Law Association (AIPLA), *Association française des praticiens du droit des marques et des modèles* (APRAM), Association of European Trademark Owners (MARQUES), Centre for International Intellectual Property Studies (CEIPI) and Japan Patent Attorneys Association (JPAA) (5).

6. The list of participants is contained in Annex II to this document.

AGENDA ITEM 1: OPENING OF THE SESSION

7. The Chair, Mr. Mikael Francke Ravn (Denmark), opened the third session of the Working Group, welcomed the participants and invited Mr. Francis Gurry, Director General of the World Intellectual Property Organization (WIPO), to deliver an opening address.

8. Mr. Gurry first recalled that, in 2012, the number of international design registrations had grown by 8.1 per cent over the previous year. A total of 2,440 international registrations were recorded in 2012, containing around 12,000 designs. At the end of 2012, more than 26,000 active international registrations contained around 110,000 designs. By late October 2013, the number of international applications received by the International Bureau showed an 18.8 per cent increase compared to the same period in 2012.

9. Mr. Gurry then welcomed Brunei Darussalam's recent deposit of its instrument of accession to the Geneva (1999) Act of the Hague Agreement Concerning the International Registration of Industrial Designs (hereinafter referred to as "the 1999 Act"). The 1999 Act will come into effect with respect to Brunei Darussalam on December 24, 2013. Mr. Gurry also referred to the instruments of ratification and accession, received from Belgium and Luxembourg respectively, and indicated that the 1999 Act would come into effect with respect to Belgium and Luxembourg once the third Benelux country, the Netherlands, deposited its instrument of ratification of the 1999 Act.

10. Mr. Gurry noted that the membership of the 1999 Act was about to grow tremendously within a very short period. He stated that several accessions were expected in the near future, including from China, Japan, Republic of Korea, Russian Federation and United States of America, as well as six member States of the Association of Southeast Asian Nations (ASEAN), as indicated in its Intellectual Property Rights Action Plan (2012-2015).

11. Mr. Gurry recalled that a main goal achieved in the Diplomatic Conference in 1999 was to permit Contracting Parties with examination systems and those with deposit systems to take advantage of the centralized filing and management of international registrations under the Hague system. Mr. Gurry stressed that the accessions by countries with examination systems would bring a certain complexity into the Hague system. It was important that the Hague system remained responsive to the needs of its users by ensuring its efficiency and simplicity.

12. Ms. Päivi Lähdesmäki (WIPO) acted as Secretary to the Working Group.

AGENDA ITEM 2: ADOPTION OF THE AGENDA

13. The Working Group adopted the draft agenda (document H/LD/WG/3/1 Prov.) without modification.

GENERAL STATEMENTS

14. The Delegation of the Republic of Korea announced that its National Assembly had adopted a revised Design Act in April 2013. The Republic of Korea was expected to accede to the 1999 Act in 2014.

15. The Delegation of China reported that preparatory work concerning the accession to the 1999 Act was under way in China. The Delegation emphasized the need for the Hague system to be customer-oriented and called for the inclusion of a linguistic mechanism into the Hague system allowing the use of the United Nations official languages, including Chinese, to be considered in the future, in view of facilitating the use of the Hague system by customers from China.

16. The Delegation of the United States of America recalled that the implementation Act of the Patent Law Treaty and the Hague Agreement had been approved by Congress and signed by the President in December 2012. Since then, the United States Patent Office (USPTO) had prepared draft rules, which were under review by the Government.

17. The Delegation of Morocco reported that proceedings for accession to the 1999 Act were under way in Morocco.

18. The Representatives of CEIPI and JPAA welcomed the geographical expansion of the Hague system, which would bring the system into a new era with big challenges. The Representatives were positive that those challenges would be successfully overcome.

AGENDA ITEM 3: ADOPTION OF THE DRAFT REPORT OF THE SECOND SESSION OF THE WORKING GROUP ON THE LEGAL DEVELOPMENT OF THE HAGUE SYSTEM FOR THE INTERNATIONAL REGISTRATION OF INDUSTRIAL DESIGNS

19. Discussion was based on document H/LD/WG/2/9 Prov.2.

20. The Working Group adopted the draft report (document H/LD/WG/2/9 Prov.2) without modification.

AGENDA ITEM 4: REVISED PROPOSAL FOR THE ESTABLISHMENT OF A STANDARD FORM FOR THE PURPOSE OF ARTICLE 16(2) OF THE 1999 ACT OF THE HAGUE AGREEMENT

21. Discussion was based on document H/LD/WG/3/2.

22. The Secretariat introduced the document. The revised standard form took into account the comments made at the second session and was drafted in three languages. The Secretariat stressed that, once the contents of the standard form were agreed upon, the Working Group should discuss how to officialize the form. For this purpose, three issues were to be addressed by the Working Group, namely, how the form would be made available to users, how a completed form could be submitted to a national Office, and most importantly, how to ensure that holders could effectively rely on the form.

23. The Delegation of the United States of America stated that its country anticipated making a declaration under Article 16(2). For an assignment to take effect, a specific document was required under national law. To protect the interests of the applicants, the document needed to be recorded.

24. The Delegation of the Russian Federation stated that its country would make the declaration under Article 16(2). The Delegation welcomed the adoption of the standard form. As regards the contents of the form, the Delegation suggested that the indication of the effective date of transfer should be mandatory. Moreover, the Delegation explained that the Office of the Russian Federation always required a signature, with or without a seal. Accordingly, the Delegation proposed an additional footnote as follows: "The following Contracting Parties require a signature and do not accept a seal without being accompanied by a signature".

25. To make the standard form more readable, the Representative of CEIPI suggested that the words “signature” and “seal” be in singular only, with an indication that they also include the plural form, as the case might be.

26. The Delegation of China stated that the contents of the draft standard form satisfied the national requirements of China. The Delegation pointed out that the form was different from the transfer document under the Patent Cooperation Treaty (PCT) and suggested adopting a similar style.

27. The Delegation of the European Union expressed its support for any effort to keep the requirements for the validity of a transfer to a minimum.

28. The Delegation of Japan expressed its support for the revised standard form, which was beneficial for both users and Offices.

29. In reply to an intervention by the Representative of JPAA, the Secretariat clarified that the standard form was actually a document and not a form and its purpose was different from the official form DM/2 for requesting the recording of a change in ownership in the International Register. Once a change in ownership was recorded in the International Register and accordingly published, Article 16(2) of the 1999 Act allowed the Office of a Contracting Party having made a declaration under that Article to require a specific document in support of the change in ownership. The Secretariat went on to explain that the aim of the exercise in process was to alleviate the burden of the holder of the international registration, who would not be required to submit different documents to different Offices. To avoid confusion, the Secretariat proposed renaming the standard form as “Certificate of transfer” or “Assignment document”.

PROPOSED REVISED STANDARD FORM

Item 1

30. The Delegation of the United States of America suggested using a more direct wording, such as “I hereby assign...” or “I hereby convey...” in the document.

31. The Delegation of the European Union, referring to a proposal by the Delegation of the Russian Federation concerning the mandatory indication of the effective date of the transfer, suggested that a reference could be made to the Contracting Parties which require this element.

Item 2

32. The Delegation of the United States of America recalled that it would be difficult for applicants or practitioners to constantly revert to the creator to obtain his signature. Therefore, the Delegation suggested that under this item, the application number also be indicated so that the signature could be obtained at the time of filing the application.

33. In reply to an intervention by the Delegation of the United States of America, the Secretariat clarified that under the current legal framework of the Hague system, it was not possible to record a change in ownership before the international registration itself was recorded in the International Register.

Items 3 and 4

34. In reply to an intervention by the Representative of JPAA, the Secretariat explained that a request for the recording in the International Register of a change in the address of the holder could be made to the International Bureau. Moreover, any previous address of the holder could be checked by tracing the history of the international registration, by searching the International Designs Bulletin.

35. The Delegation of the European Union proposed that, for items 3 and 4, where the party is a legal entity, reference should be made to its State of Incorporation.

Item 5

36. The Delegation of China recommended that under this item, the indication of a legal entity's full official designation should also be indicated. Moreover, according to the practice of the Office of China, if the legal entity did not have an official seal, the full official designation of the legal entity must be indicated, together with an indication of the capacity in which a person signs the document.

37. In reaction to an observation by the Delegation of China, the Secretariat referred to the "Certificate of Transfer" under the Patent Law Treaty (PLT), which stated "Next to each signature or seal, indicate the name of the person signing or sealing, the capacity in which the person signs or seals (if such capacity is not obvious) and the date of signature or of seal", as a possible solution.

Item 6

38. In reply to an intervention by the Delegation of China, the Secretariat clarified that this item was merely intended to refer to any additional sheets and/or attachments if the space in the form itself was not sufficient.

NEXT STEPS

39. The Delegation of the Republic of Korea recommended that the standard document should be made available on the web sites of the Offices of Contracting Parties. In its view, however, a separate document in each of the languages was easier to read than one trilingual document. Moreover, a completed document should be submitted to the Office of its country through a local representative, if the submitting party did not reside in the country. Therefore, it was in the users' interest that the document could also be submitted through the International Bureau.

40. The Delegation of the United States of America recalled that the purpose of a trilingual document was to avoid translation of the document. The Delegation pointed out that the Office of its country required a translation of such a document.

41. In reply to interventions by the Delegations of the Republic of Korea and Mexico, the Secretariat clarified that if the trilingual document was split into different languages, a different document might have to be submitted to different Offices. The standard document was intended to be completed only once and to serve alone as a transfer document for the purpose of Article 16(2), and therefore no additional document was required.

42. In reply to an inquiry raised by the Secretariat, the Delegation of the Republic of Korea affirmed that its Office could accept a completed standard document which was submitted through the International Bureau. A typical situation would be where the holder of the international registration had received a declaration to refuse the effect of the change in ownership pursuant to Rule 21*bis*(1) by its Office, and the holder needed to submit a completed standard document to the Office to overcome the refusal.

43. In reply to an intervention by the Delegation of the Russian Federation, the Secretariat observed that ideally the holder of the international registration should be required to submit a single completed form, which the International Bureau could scan and distribute by electronic means to the Offices of the Contracting Parties concerned. The question, therefore, was whether all those Offices were prepared to accept the electronic communication of a scanned copy for the purpose of their national procedures.

44. The Delegations of OAPI and the United States of America affirmed that their Offices could accept such a copy submitted through the International Bureau.

45. In reply to inquiries by the Delegations of Mexico and Morocco, the Secretariat explained that only the Offices of countries which had made a declaration under Article 16(2) could require the submission of a standard document. The original document would be recorded in the directories of the International Bureau and only the scanned document would be transmitted to the Offices concerned.

46. To ensure that holders could effectively rely on the standard document in the procedures before the Offices of the present and future Contracting Parties concerned, the Chair noted that the Working Group could make a recommendation to the Assembly of the Hague Union to adopt some agreed statement or resolution that would make the standard form an acceptable document in support of a change in ownership resulting from a transfer by contract.

47. The Chair noted that the Working Group invited the International Bureau to review the contents of the proposed standard form taking into account comments made at the session of the Working Group in process. In revising the document, the International Bureau would further consult the Offices of current and prospective Contracting Parties which had made a declaration under Article 16(2) or which intended to do so.

48. The Chair further noted that the International Bureau had been requested to make a proposal on a text that would make the said document acceptable in support of a change in ownership resulting from a transfer by contract for the sake of any declaration made under Article 16(2), which would be submitted to the Assembly of the Hague Union for adoption.

49. The Chair concluded that the Working Group favorably considered the possibility of submitting the document through the International Bureau to the Offices requiring such a document, and requested the International Bureau to explore this possibility further.

AGENDA ITEM 5: POSSIBLE AMENDMENT OF RULE 5 OF THE COMMON REGULATIONS UNDER THE 1999 ACT AND THE 1960 ACT OF THE HAGUE AGREEMENT

50. Discussion was based on document H/LD/WG/3/3.

51. Following the introduction of the document by the Secretariat, the Delegation of Spain explained its proposal as contained in Chapter II of the document.

52. The Representative of JPAA noted that it could be difficult to submit evidence in some cases and that too heavy a burden should not be imposed on the parties. The Representative proposed an amended wording of paragraph (4) to read, for instance, "...if the interested party submits evidence reasonably showing, to the satisfaction of the International Bureau [...]".

53. The Delegation of the United States of America explained that before the Office of its country there were two levels, namely (1) due care and unavoidable standard and (2) unintentional standard. When implementing the Patent Law Treaty the Office was going to exclude the unavoidable standard since applicants had difficulty to meet the criteria of unavoidable standard. The rights of the applicants were not deprived since all excuses falling under unavoidable standard fell back to unintentional standard.

54. In reply to a question from the Delegation of the Republic of Korea, the Secretariat clarified that, if the electronic communication facility on the WIPO web site was not available, for instance, due to a problem with the server of the International Bureau, such a circumstance would be tantamount to a situation in which the International Bureau was not open to the public as referred to in Rule 4(4).

55. The Delegation of the Republic of Korea, supported by the Representative of CEIPI, emphasized that it would be necessary to have a clear legal basis to provide for situations in which the server of the International Bureau was down.

56. The Delegation of the European Union noted that proposed Rule 5(4) appeared to require more than what was provided for in Article 13 of the draft Design Law Treaty (DLT) and raised the question as to whether those provisions should be aligned. In reply, the Secretariat stated its view that proposed Rule 5(4) did not appear to require more than Article 13 of the draft DLT. The Secretariat further pointed out that the legislative framework of the Hague system did not provide for any measures corresponding to the extension of time limits or continued processing as referred to in Article 12 of the draft DLT.

57. As regards drafting, the Delegation of the European Union proposed aligning the wording of proposed Rule 5(4) with Article 13 of the draft DLT to refer to "due care" instead of "due diligence". The Delegation further pointed out that the notion of "unintentional" was mentioned in the draft Design Law Treaty. If the possibility of extending time limits was not foreseen within the Hague system, it was all the more reason for the approach to "reinstatement" to be lenient.

58. The Delegation also raised the question as to whether the sentence "the communication was submitted as soon as reasonably possible" took into account a situation in which a party was not aware that its communication had failed to reach the International Bureau. In reply, the Secretariat observed that that wording should be understood to be broad enough to make provision for such a situation, and the same wording appeared in Rule 82*quater*.1 of the PCT Regulations.

59. The Delegation of Japan noted that it appeared difficult to determine when a problem occurred in cyberspace and therefore the standard of evidence required in such a case should not be high. In reply, the Chair stated that the International Bureau should be flexible on that point, noting that draft paragraph (4) contained the wording "to the satisfaction of the International Bureau", and that internal instructions would need to be established at the International Bureau.

60. The Representative of JPAA suggested that a certificate issued by a relevant Internet service provider should be acceptable as evidence, for example, in the case of a cyber-attack.

61. The Delegation of Malaysia stated its preference for specific time limits even in the situations referred to in proposed Rule 5(4).

62. The Secretariat observed that there was a six-month time limit provided for in proposed paragraph (5) as the maximum time limit, which already existed for paper communications, as prescribed in paragraph (3).

63. The Chair noted that the International Bureau was requested to revise the wording and scope of proposed Rule 5(4) taking into account comments made at the session of the Working Group in process, notably in the event that the server of the International Bureau was down.

AGENDA ITEM 6: DIGITAL ACCESS SERVICE FOR PRIORITY DOCUMENTS (DAS) AND OTHER MEANS OF TRANSMISSION OF CERTAIN TYPES OF DOCUMENTS UNDER RULES 7(5)(F) AND (G) OF THE COMMON REGULATIONS

64. Discussion was based on document H/LD/WG/3/4.

65. The Delegations of China, Japan, Republic of Korea and United States of America were in support of the proposals contained in the document.

66. The Delegation of the United States of America explained that once its country had acceded to the 1999 Act, its Office anticipated receiving a number of different types of supporting documents electronically from the International Bureau. Those documents could include the inventor's oath or declaration, an information disclosure statement, a certification of status of a micro-entity, an application data sheet and references, such as prior art reference.

67. The Delegation of China proposed that a new section to be incorporated into the Administrative Instructions concerning supporting documents should take into account relevant procedures before the Offices and provisions in the applicable laws of the Contracting Parties concerned.

68. The Delegation of the Republic of Korea stated that its Office would require priority documents and documents concerning disclosure during the grace period. The national law of its country did not require any authentication of priority documents and therefore a digital copy could be considered as sufficient. The Delegation was interested in using Digital Access Service for Priority Documents (DAS) and the Hague Office Portal for the exchange of supporting documents.

69. The Delegation of Japan stated that its Office would require three types of documents, namely, priority documents, statements claiming benefit of a grace period and supporting documents concerning disclosure during the grace period. The Delegation proposed that those elements should be included in the new section of the Administrative Instructions.

70. At the request of the Chair, the Secretariat clarified its view that the Offices of Contracting Parties which would require supporting documents pursuant to Rule 7(5)(f) and/or (g) could not impose on applicants the use of a language other than the working languages, since they would be optional contents of an international application. There should be a balance between an applicant's and an Office's needs. Furthermore, to alleviate the burden on applicants and serve the Offices requiring the same types of documents, the possibility of establishing standard documents might be explored in the future.

71. The Delegation of Malaysia indicated its preference for a standard document for priority claim.

72. In reply to a question by the Representative of JPAA, the Secretariat explained that an indication of a request concerning a grace period could be inserted in the form DM/1, as well as in the E-filing interface.

73. The Delegation of China stated that the Office of China already participated in DAS, and that, once China had acceded to the 1999 Act and the Office was technically ready, it would extend the application of DAS to international applications under the Hague system. The current national law of China required that a priority document should be submitted within three months from the date of filing. Thus, the Delegation hoped that the Office of the first filing would provide the document in time.

74. The Delegation of Japan stated that the Office of Japan also participated in DAS, and that, once Japan had acceded to the 1999 Act and was legally and technically prepared, it would extend the application of DAS to international applications under the Hague system.

75. The Delegations of the European Union and Norway expressed their interest in using DAS, also requesting technical guidance from the International Bureau.

76. As requested by the Delegations, the Secretariat introduced the mechanism and implementation of DAS to the Working Group. In reply to a question by the Delegation of the United States of America, the Secretariat clarified that the DAS system was designed to remove the need for certification, which was required for a paper document. In reply to a question by the Delegation of the Russian Federation, the Secretariat confirmed that an Office could participate in DAS, either as the Office of the first filing or that as the Office of the second filing only. In reply to a question by the Delegation of Morocco, the Secretariat explained that the International Bureau did not charge any fees to use DAS, however, participating Offices might charge a fee, as they currently did, for issuing a priority document.

77. In reply to a question by the Delegation of the European Union, the Secretariat clarified that a priority document itself, whether in the form of a scanned copy or DAS code, could be considered as a document within the scope of Rule 7(5)(f), and could be included in the Administrative Instructions.

78. The Chair asked the delegations whose Offices would require supporting documents whether they could allow the applicant to submit such documents even after the filing of the international application or as a response to a refusal and whether they would be willing to accept their submission through the International Bureau.

79. The Delegation of the European Union observed that the *raison d'être* of the International Bureau was the centralization of procedures. The Delegation was in favor of submitting and distributing documents through the International Bureau even subsequent to an international application.

80. The Delegation of the United States of America stated that its Office could possibly accept a supporting document in the context of a refusal procedure but the issue of timing would need to be considered.

81. The Secretariat stated that in light of the comments raised by the Working Group, it would explore further the issue of the submission of supporting documents through the International Bureau. The legal framework, as well as the programming of the future Hague Office Portal, needed to be taken into account.

82. The Chair noted that the Working Group favorably considered the incorporation of a new section into the Administrative Instructions concerning the types of documents and other material that could be required in support of a designation of a Contracting Party, in accordance with Rules 7(5)(f) and (g) of the Common Regulations.

83. The Chair further noted that the Working Group requested the International Bureau to prepare a document containing a proposal for such a new section of the Administrative Instructions and exploring further the possibility of allowing the submission of the said documents and material, also at a later stage, after the filing of an international application. In this regard, the comments made at the session of the Working Group in process would be taken into account.

84. The Chair concluded that at this stage it was premature for the Offices of Contracting Parties to consider committing themselves to the uploading and retrieval of priority documents via DAS.

AGENDA ITEM 7: PUBLIC AVAILABILITY OF INFORMATION RELATING TO AMENDMENTS TO AN INDUSTRIAL DESIGN THAT IS THE SUBJECT OF AN INTERNATIONAL REGISTRATION FOLLOWING A PROCEDURE BEFORE AN OFFICE

85. Discussion was based on document H/LD/WG/3/5.

86. The Secretariat introduced the document. Replies to the questionnaire contained in the document had been received from 39 Offices, of which 25 were Offices of members of the Hague Union. A number of replies proposed the incorporation into the Hague system of a mechanism to ensure the public availability of information on amendments to an industrial design made before Offices.

87. The Delegation of the United States of America expressed its full support for a proposal to establish a mechanism to provide to the public information on the amendments. In case of infringements, it was critical for the public to be able to see the full scope of the rights.

88. The Delegations of Switzerland and the European Union indicated that their Offices did not republish international registrations, but they would be prepared to cooperate by providing the International Bureau with all the necessary data to keep international registrations updated and necessary information available to the public.

89. The Delegation of France expressed its support for the statements by the Delegations of the European Union, Switzerland and the United States of America.

90. The Delegations of Japan and Republic of Korea expressed their support for a proposal to centralize the recording and publication of amendments by the International Bureau. As an alternative, the Delegations of Norway, Russian Federation, Switzerland and the United States of America advanced the publication of updates to an international registration in the database on the WIPO web site.

91. The Delegation of Japan added that the Office of its country would like to provide all the data concerning an amended design and not only the amended part, due to the constraints of its IT system.

92. The Delegation of Japan, supported by the Delegation of the Republic of Korea, further proposed, as a first step, the establishment of a link on the WIPO web site to the electronic publication by the Office of a designated Contracting Party. The Delegation of the Republic of Korea proposed that the electronic publication by the national Office should be provided in at least one of the three working languages of the Hague system.

93. The Delegation of China was in support of the establishment of an electronic link through the WIPO web site.

94. The Delegation of Bosnia and Herzegovina explained that the Office of its country did not republish international registrations on its web site, but expected to do so in the future.

95. The Delegations of Turkey and Finland explained that the Offices of their countries republished international registrations.

96. The Representatives of JPAA and Marques expressed their support for the proposal to centralize the recording and publication of amendments by the International Bureau. The Representative of JPAA further indicated that the establishment of a link on the WIPO web site could be an interim measure. Given the nature of industrial designs, the publication language used by the Offices did not appear to be a serious issue.

97. In reply to a question by the Chair, the Delegations of France, Germany, Greece, the European Union and Switzerland confirmed that the Offices of their countries did not republish international registrations, whether or not they had been amended before their Offices.

98. The Delegation of Switzerland stated that typically refusals before the Office of its country would concern a part of the design. For example, if the "Swiss cross" is a part of a design, protection granted to the industrial design would exclude the "Swiss cross". However, the refusal was not published and therefore the Delegation was in favor of a central mechanism to make amendments publicly available.

99. The Delegation of the Russian Federation stated that the Office of the Russian Federation might consider publishing refusals and republishing amendments concerning international registrations. However, the publication was likely to be in Russian only. The Delegation was in favor of a central mechanism administered by the International Bureau.

100. The Secretariat summarized the statements and proposals made by the Delegations, stating that there was an agreement in the Working Group on the establishment of a centralized mechanism to inform the public of the amendments to an industrial design before Offices. The Secretariat further highlighted the mechanism under the Madrid system, where the information made publicly available in the ROMARIN database contained scanned copies of the notifications of refusals, withdrawals of refusal and statements of grant of protection. Under the Madrid system, a communication, subsequent to a notification of provisional refusal by the Office, might contain an amended list of goods and/or services of which a scanned copy was made publicly available through the ROMARIN database. The amended list of goods and/or services was not recorded as such in the International Register of the Madrid system. The Secretariat expressed a preference for the approach as implemented under the Madrid system instead of merely relying on a link to the national publications. From a legal point of view, the Secretariat noted that Rules 18(4) and 18*bis*(2) could be amended to include extra items. Finally, the Secretariat concluded that the issue should be further explored in a document to be prepared by the Secretariat for the next session of the Working Group.

101. The Delegations of the United States of America and Spain expressed their support for an intervention by the Secretariat. The Delegation of the United States of America referred to PATENTSCOPE and the patent search tool available on the web site of its Office and emphasized the convenience of having "tabs" on the screen which directed the users to the status of the patent in each designated Contracting Party.

102. The Chair concluded that the Working Group agreed that amendments to an industrial design following a procedure before an Office should be made publicly available in a centralized manner. The Chair further concluded that the Working Group requested the International Bureau to prepare a document analyzing the possible introduction of a mechanism into the Hague system to this effect. In this respect, the comments made at the session of the Working Group in process, as well as the mechanism under the Madrid system and the information made available in the ROMARIN database, would be taken into account.

AGENDA ITEM 8: INFORMING OFFICES OF DESIGNATED CONTRACTING PARTIES OF EVENTS RECORDED IN RESPECT OF AN INTERNATIONAL REGISTRATION BEFORE ITS PUBLICATION

103. Discussion was based on document H/LD/WG/3/6.

104. The Delegations of Japan, Norway, Russian Federation, Republic of Korea, Spain and United States of America and the Representative of JPAA expressed their support for the proposal to add a new Part Nine, concerning confidential copies, to the Administrative Instructions as contained in the document.

105. The Delegation of Norway stated that the Office of its country would request to receive confidential copies as soon as it was technically ready. Thus, the Delegation welcomed the proposed date of January 1, 2014, as the date of entry into force of the proposed new sections of the Administrative Instructions.

PROPOSED PART NINE OF THE ADMINISTRATIVE INSTRUCTIONS

106. No comments were made by the Working Group on proposed Sections 901 and 902.

107. The Chair concluded that the Working Group favorably considered the addition of a new Part Nine, consisting of Sections 901 and 902, to the Administrative Instructions, as set out in the Annex to document H/LD/WG/3/6., with a date of entry into force of January 1, 2014.

AGENDA ITEM 9: OTHER MATTERS

108. No comments were made by the Working Group under this item.

AGENDA ITEM 10: SUMMARY BY THE CHAIR

109. The Working Group approved the Summary by the Chair as contained in Annex I to the present document.

AGENDA ITEM 11: CLOSING OF THE SESSION

110. The Chair closed the session on October 30, 2013.

[Annexes follow]



H/LD/WG/3/7
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Working Group on the Legal Development of the Hague System for the International Registration of Industrial Designs

Third Session
Geneva, October 28 to 30, 2013

SUMMARY BY THE CHAIR

approved by the Working Group

1. 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”) met in Geneva from October 28 to 30, 2013.
2. The following members of the Hague Union were represented at the session: African Intellectual Property Organization (OAPI), Benin, Bosnia and Herzegovina, Brunei Darussalam, Denmark, Estonia, European Union, Finland, France, Germany, Greece, Hungary, Iceland, Latvia, Lithuania, Luxembourg, Morocco, Norway, Oman, Romania, Spain, Switzerland, Turkey and Ukraine (24).
3. The following States were represented as observers: China, Czech Republic, Indonesia, Iraq, Israel, Japan, Jordan, Malaysia, Mexico, Philippines, Republic of Korea, Russian Federation, Saudi Arabia, Thailand, United States of America and Viet Nam (16).
4. Representatives of the following international intergovernmental organizations (IGOs) took part in the session in an observer capacity: African Regional Intellectual Property Organization (ARIPO) and Benelux Office for Intellectual Property (BOIP) (2).
5. Representatives of the following non-governmental organizations (NGOs) took part in the session in an observer capacity: American Intellectual Property Law Association (AIPLA), *Association française des praticiens du droit des marques et des modèles* (APRAM), Association of European Trademark Owners (MARQUES), Centre for International Intellectual Property Studies (CEIPI) and Japan Patent Attorneys Association (JPAA) (5).

AGENDA ITEM 1: OPENING OF THE SESSION

6. The Chair, Mr. Mikael Francke Ravn (Denmark), opened the session of the Working Group and welcomed the participants. Mr. Francis Gurry, Director General of the World Intellectual Property Organization (WIPO) made an opening address.
7. Ms. Päivi Lähdesmäki (WIPO) acted as Secretary to the Working Group.

AGENDA ITEM 2: ADOPTION OF THE AGENDA

8. The Working Group adopted the draft agenda (document H/LD/WG/3/1 Prov.) without modification.

AGENDA ITEM 3: ADOPTION OF THE DRAFT REPORT OF THE SECOND SESSION OF THE WORKING GROUP ON THE LEGAL DEVELOPMENT OF THE HAGUE SYSTEM FOR THE INTERNATIONAL REGISTRATION OF INDUSTRIAL DESIGNS

9. Discussion was based on document H/LD/WG/2/9 Prov.2
10. The Working Group adopted the revised draft report (document H/LD/WG/2/9 Prov.2) without modification.

AGENDA ITEM 4: REVISED PROPOSAL FOR THE ESTABLISHMENT OF A STANDARD FORM FOR THE PURPOSE OF ARTICLE 16(2) OF THE 1999 ACT OF THE HAGUE AGREEMENT

11. Discussion was based on document H/LD/WG/3/2.
12. The Chair noted that the Working Group invited the International Bureau to review the contents of the proposed standard form taking into account comments made at the present session of the Working Group. In revising the document, the International Bureau would further consult the Offices of current and prospective Contracting Parties, which had made a declaration under Article 16(2) or which intended to do so.
13. The Chair concluded that the International Bureau was requested to make a proposal on an agreed statement or a resolution that would make the said document an acceptable document in support of a change in ownership resulting from a transfer by contract for the sake of any declaration made under Article 16(2), which would be submitted to the Assembly of the Hague Union, for approval.
14. The Chair noted that the Working Group favorably considered the possible submission of the document through the intermediary of the International Bureau to the Offices requiring such a document, and requested the International Bureau to explore this possibility further.

AGENDA ITEM 5: POSSIBLE AMENDMENT OF RULE 5 OF THE COMMON REGULATIONS UNDER THE 1999 ACT AND THE 1960 ACT OF THE HAGUE AGREEMENT

15. Discussion was based on document H/LD/WG/3/3.

16. The Chair noted that the International Bureau was requested to revise the wording and scope of proposed Rule 5(4) taking into account comments made at the present session of the Working Group, notably in respect of the situation where the server of the International Bureau would be down.

AGENDA ITEM 6: DIGITAL ACCESS SERVICE FOR PRIORITY DOCUMENTS (DAS) AND OTHER MEANS OF TRANSMISSION OF CERTAIN TYPES OF DOCUMENTS UNDER RULE 7(5)(F) AND (G) OF THE COMMON REGULATIONS

17. Discussion was based on document H/LD/WG/3/4.

18. The Chair noted that the Working Group favorably considered the incorporation of a new section into the Administrative Instructions concerning the types of documents and other material that could be required in support of a designation of a Contracting Party, in accordance with Rule 7(5)(f) and (g) of the Common Regulations.

19. The Chair concluded that the Working Group requested the International Bureau to prepare a document containing a proposal for such a new section of the Administrative Instructions and exploring further the possibility of allowing the submission of the said documents and material also at a later stage, after the filing of an international application. In this regard, the comments made at the present session of the Working Group would be taken into account.

20. The Chair further noted that at this stage it was premature for the Offices of the Contracting Parties to consider committing themselves to the uploading and retrieval of priority documents via the Digital Access Service for Priority Documents (DAS).

AGENDA ITEM 7: PUBLIC AVAILABILITY OF INFORMATION RELATING TO AMENDMENTS TO AN INDUSTRIAL DESIGN THAT IS THE SUBJECT OF AN INTERNATIONAL REGISTRATION FOLLOWING A PROCEDURE BEFORE AN OFFICE

21. Discussion was based on document H/LD/WG/3/5.

22. The Chair concluded that the Working Group agreed that amendments to an industrial design following a procedure before an Office should be made publicly available in a centralized manner. The Chair further concluded that the Working Group requested the International Bureau to prepare a document analyzing a possible introduction of a mechanism into the Hague system to this effect. In this respect, the comments made at the present session of the Working Group, as well as the mechanism under the Madrid system and the information made available in the ROMARIN database, would be taken into account.

AGENDA ITEM 8: INFORMING OFFICES OF DESIGNATED CONTRACTING PARTIES OF EVENTS RECORDED IN RESPECT OF AN INTERNATIONAL REGISTRATION BEFORE ITS PUBLICATION

23. Discussion was based on document H/LD/WG/3/6.

24. The Chair concluded that the Working Group favorably considered the addition of a new Part Nine, consisting of Sections 901 and 902, to the Administrative Instructions, as set out in the Annex to document H/LD/WG/3/6., with a date of entry into force of January 1, 2014.

AGENDA ITEM 9: OTHER MATTERS

25. No comments were made by the Working Group under this item.

AGENDA ITEM 10: SUMMARY BY THE CHAIR

26. The Working Group approved the Summary by the Chair, as contained in the present document.

AGENDA ITEM 11: CLOSING OF THE SESSION

27. The Chair closed the session on October 30, 2013.

[Annex II follows]



H/LD/WG/3/INF/1
ORIGINAL: FRANÇAIS/ANGLAIS
DATE: 16 JUIN 2014/JUNE 16, 2014

**Groupe de travail sur le développement juridique du système de
La Haye concernant l'enregistrement international des dessins
et modèles industriels**

Troisième session
Genève, 28 – 30 octobre 2013

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

Third Session
Geneva, October 28 to 30, 2013

LISTE DES PARTICIPANTS
LIST OF PARTICIPANTS

établie par le Secrétariat
prepared by the Secretariat

I. MEMBRES/MEMBERS

(dans l'ordre alphabétique des noms français des parties contractantes)
(in the alphabetical order of the names in French of the Contracting Parties)

ALLEMAGNE/GERMANY

Isabell KAPPL (Ms.), Local Court Judge, Federal Ministry of Justice, Berlin

Marcus KÜHNE, Senior Government Official, German Patent and Trade Mark Office (DPMA), Jena

Pamela WILLE (Ms.), Counsellor, Permanent Mission, Geneva

BÉNIN/BENIN

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DANEMARK/DENMARK

Mikael Francke RAVN, Chief Legal Adviser, Danish Patent and Trademark Office, Ministry of Business and Growth, Taastrup

¹ Le 24 septembre 2013, le Gouvernement du Brunéi Darussalam a déposé auprès du Directeur général de l'Organisation Mondiale de la Propriété Intellectuelle (OMPI) son instrument d'adhésion à l'Acte de Genève (1999) de l'Arrangement de La Haye concernant l'enregistrement international des dessins et modèles industriels. L'Acte de 1999 entrera en vigueur, à l'égard du Brunéi Darussalam le 24 décembre 2013.

² On September 24, 2013, the Government of Brunei Darussalam deposited with the Director General of the World Intellectual Property Organization (WIPO) its instrument of accession to the Geneva (1999) Act of the Hague Agreement Concerning the International Registration of Industrial Designs. The 1999 Act will enter into force, with respect to Brunei Darussalam on December 24, 2013.

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[End of Annex II and of document]