

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

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PROPOSAL FOR AMENDMENTS TO PART FOUR OF THE ADMINISTRATIVE INSTRUCTIONS

Document prepared by the International Bureau

I. INTRODUCTION

1. It is foreseen that the membership of the Geneva (1999) Act of the Hague Agreement Concerning the International Registration of Industrial Designs (hereinafter referred to as the “1999 Act”) will grow tremendously in the near future. During the fifty-first series of meetings of the Assemblies of the Member States of WIPO, held from September 23 to October 2, 2013, several delegations stated that their governments were actively considering accession to the 1999 Act. As a result of work carried out at the Diplomatic Conference for the Adoption of a New Act of the Hague Agreement Concerning the International Deposit of Industrial Designs in 1999, Contracting Parties with “examination systems”¹, as well as those with “deposit systems”, were allowed to take advantage of the centralized filing and management of international registrations under the Hague system. This development constituted one of the main goals of the Diplomatic Conference. Many of the prospective Contracting Parties have a national system that provides for the substantive examination of industrial designs.

¹ Pursuant to Article 1(xvii), “Examining Office” is defined as an “Office which *ex officio* examines applications filed with it for the protection of industrial designs at least to determine whether the industrial designs satisfy the condition of novelty”.

2. An appropriate and sufficient disclosure of the industrial design is a fundamental condition for determining the scope of protection of that industrial design. Thus, as provided for in the second sentence of Rule 9(4) of the Common Regulations Under the 1999 Act and the 1960 Act of the Hague Agreement (hereinafter referred to as “the Common Regulations”), an Office may refuse the effects of the international registration on the ground that the reproductions contained in the international registration are not sufficient to disclose fully the industrial design. Such a scenario is entirely plausible, despite the fact that reproductions must be submitted in compliance with the formal requirements of the legal framework of the Hague system. The Offices of current and prospective Contracting Parties may apply different requirements concerning an appropriate disclosure of an industrial design, for example, concerning the representation of the industrial design or the views required for sufficient disclosure. Consequently, as the Hague system expands to integrate more examination systems, there will be an accrued risk of refusals issued under Rule 9(4) of the Common Regulations.

3. The purpose of the present document is to mitigate the aforementioned risk by proposing amendments to Part Four of the Administrative Instructions for the Application of the Hague Agreement (hereinafter referred to as “the Administrative Instructions”), “Requirements Concerning Reproductions and Other Elements of the International Application”. The proposed amendments seek to relax somewhat certain formal requirements regarding the reproductions and representations of the industrial design accompanying the international application and to give applicants more flexibility in terms of providing elements that may be useful with regard to improved disclosure of the industrial design.

4. Furthermore, the International Bureau intends to publish relevant guidelines on the web site of the Organization in order to assist Hague system users. These guidelines are being prepared on the presumption that the Working Group favorably considers the proposed amendments to Part Four of the Administrative Instructions.

5. Finally, it is recalled that, pursuant to Rule 34(1)(a) of the Common Regulations, the Director General shall consult the Offices of the Contracting Parties with regard to the proposed Administrative Instructions. The attention of the Working Group is drawn to the fact that, as further addressed in Chapter III, the present document has been prepared with a view to proceeding to that consultation concerning proposed amendments to Sections 401 to 403 and 405 of the Administrative Instructions.

II. PROPOSED AMENDMENTS TO PART FOUR OF THE ADMINISTRATIVE INSTRUCTIONS

6. The Working Group is invited to consider the proposed amendments annexed to the present document (see Annex) and described below.

SECTION 401: PRESENTATION OF REPRODUCTIONS

7. It is recalled that, during its second session, 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”) discussed future developments of the Hague system and concluded that the issue of moving image files should be included in the future work of the Working Group (see paragraph 71 of document H/LD/WG/2/9, entitled “Report”). The laws of many current and prospective Contracting Parties to the 1999 Act allowed for moving images or other visual representations before the technical solutions had been implemented (see paragraph 65 of document H/LD/WG/2/9).

8. In order to anticipate those discussions in the Working Group and the possible introduction of new or future forms of visual representation, it is proposed that a new subparagraph (a)(ii) to Section 401 be inserted². Proposed new subparagraph 401(a)(ii) would read as follows:

“(ii) Particulars of other visual representations that may accompany the international application shall be published in accordance with Section 204 on the web site of the Organization.”

9. The expression “other visual representation” in proposed subparagraph (a)(ii) could also cover specimens, which are dealt with separately in Section 406. Following the proposed addition of subparagraph 401(a)(ii), current subparagraph (a) becomes subparagraph (a)(i) of Section 401.

SECTION 402: REPRESENTATION OF THE INDUSTRIAL DESIGN

10. Cases sometimes arise in which one or some of the representations of the industrial design are represented before the International Bureau in a scale that differs from that used for other representations. For instance, in the case where a pen is represented in one scale in a side view, a representation showing the head of the pen from the top angle (top view) would be in a larger scale. Such situations are often brought on by the need to comply with the combined size requirements of Section 402(b), whereby the dimensions of the representation of each industrial design may not exceed 16 x 16 centimeters, and one of those dimensions must be at least 3 centimeters.

11. There is, however, a risk that an Examining Office will consider that the inconsistency in terms of scale among those representations is a source of ambiguity and will feel compelled to issue a refusal under Rule 9(4). To prevent that risk, it is proposed to amend paragraph (b) of Section 402 to prescribe that it is sufficient if, in respect of at least one representation of each design, one of the dimensions is of at least 3 centimeters. With regard to the example of a pen contained in the previous paragraph, the proposed amendment to paragraph (b) would allow the representation of the head of the pen (top view) to be in the same scale as the others even if, for example, it would result in this representation being 2 centimeters in diameter. This amendment would thus provide applicants with the flexibility to submit all of the representations in the same scale, without preventing them from submitting representations in different scales if they so desired.

12. Furthermore, it is proposed to specify in Section 402(c)(ii) that explanatory text or legends are not accepted in the representation itself. This specification would be added in the interests of clarity as a result of proposed new paragraph (c) of Section 405, which would allow for the indication of legends in a brief description.

13. Amended Section 402 would read as follows:

“(a) The photographs and other graphic representations shall represent the industrial design alone, or the product in relation to which the industrial design is to be used, to the exclusion of any other object, accessory, person or animal.

² The wording proposed reflects Rule 3(1)(iii) of the draft Regulations concerning the draft Industrial Design Law, as produced in document SCT/31/3, which also refers to “other visual representation”. Pursuant to Note R3.02, the words “any other visual representation” are intended to cover other forms of representation, such as computer-animated representations, or forms which are not currently known, but which may develop in the future, as well as specimens admitted by the Office.

(b) The dimensions of the representation of each industrial design appearing in a photograph or other graphic representation may not exceed 16 x 16 centimeters, and in respect of at least one representation of each design, one of those dimensions must be at least 3 centimeters. With respect to the filing of international applications by electronic means, the International Bureau may establish a data format, the particulars of which shall be published on the web site of the Organization, to ensure compliance with these maximum and minimum dimensions.

(c) The following shall not be accepted:

- (i) technical drawings, particularly with axes and dimensions;
- (ii) explanatory text or legends in the representation.”

SECTION 403: DISCLAIMER

14. In the view of a number of Examining Offices, in order better to understand an industrial design it is necessary to understand the nature of product itself, as well as its purpose and the environment in which it is designed to be used. In order to convey such information to an Office, as a safeguard against a possible refusal on the ground of insufficient disclosure, the applicant may wish to show use or function of the product with representations of the industrial design that include environmental matter. This is, however, currently not permitted under the Hague system.

15. Under Section 403, matter which is shown in a reproduction but for which protection is not sought may be indicated (disclaimer). However, this provision needs to be read in conjunction with Section 402(a), which provides that the photographs and other graphic representations shall represent the industrial design alone, or the product in relation to which the industrial design is to be used, to the exclusion of any other object, accessory, person or animal. As a result, the only matter that can be included in a representation and in respect of which a disclaimer can be provided is necessarily a part of the industrial design itself or of the product in relation to which it is to be used. For this reason, it is proposed to amend Section 403 in order to allow environmental matter, such as accessories, to be included in the representation, on the condition that a disclaimer is provided in that regard³.

³ See Rule 3(1)(c) and (2)(i) of the draft Regulations concerning the draft Industrial Design Law, as produced in document SCT/31/3, which read as follows:

Rule 3(1) [...]

(c) The industrial design shall be represented alone, to the exclusion of any other matter.
(2)(i) [Particulars Concerning Representation] Notwithstanding paragraph (1)(c), the representation of the industrial design may include:

(i) matter that does not form part of the claimed design if it is identified as such in the description and/or it is shown by means of dotted or broken lines; [...]

According to Note R3.04 on paragraph (2)(i), an applicant may indicate matter in the representation of the industrial design for which no protection is claimed, for example environmental matter.

16. It is proposed to amend the title of Section 403 in order to extend coverage to environmental matter which does not form part of the claimed industrial design. Moreover, it is proposed to insert the phrase “Notwithstanding Section 402(a)” into the first sentence. The aim of this insertion is to make it clear that amended Section 403 is on an equal footing with the requirement under Section 402(a) in the sense that the representation shall represent the industrial design alone, unless the matter that does not form part of the claimed industrial design is indicated as prescribed in paragraphs (i) or (ii) of amended Section 403, i.e., in the description referred to in Rule 7(5)(a) and/or by means of dotted or broken lines.

17. Furthermore, it is proposed to amend Section 403(ii) by including the indication by means of coloring of a matter which is shown in the reproduction but for which protection is not sought. Allowing coloring for disclaimed parts is a long-standing practice of the International Bureau that takes into account the fact that such indication better serves the needs and interests of the users. Thus, the proposed amendment to Section 403(ii) clearly states that disclaimer by coloring is acceptable. It is further proposed that coloring also be applied to the environmental matter in the reproduction for which protection is not claimed.

18. Amended Section 403 would read as follows:

“Section 403: Disclaimers and Matter That Does Not Form Part of the Claimed Design

“Notwithstanding Section 402(a), matter which is shown in a reproduction but for which protection is not sought may be indicated

- (i) in the description referred to in Rule 7(5)(a) and/or
- (ii) by means of dotted or broken lines or coloring.”

SECTION 405: LEGENDS RELATING TO REPRODUCTIONS

19. According to Section 405 of the Administrative Instructions, when the industrial design is represented from different angles, a number shall be given to each reproduction, as follows: “1.1”, “1.2”, “1.3”, etc. for the first design and “2.1”, “2.2”, “2.3”, etc. for the second design. In addition, according to Section 402(c)(ii), legends cannot be included in a representation of the industrial design. However, in the absence of any indication of views (i.e., top view, left view, etc.), it might not be possible to build up a clear picture of the industrial design for which protection is sought.

20. In this regard, according to Article 5(2)(b)(ii) of the 1999 Act, a “brief description of the reproduction” may be contained in the international application. Therefore, it is proposed to amend Section 405 by adding a new paragraph (c) to allow for legends indicating the type of view associated with the numbering of each reproduction to be contained in the brief description, for example, “1.1: top view, 1.2: front view...”.

21. Amended Section 405 would read as follows:

“Section 405: Numbering of Reproductions and Legends

“(a) The numbering stipulated for multiple international applications shall appear in the margin of each photograph or other graphic representation. When the same industrial design is represented from different angles, the numbering shall consist of two separate figures separated by a dot (e.g., 1.1, 1.2, 1.3, etc. for the first design, 2.1, 2.2, 2.3, etc. for the second design, and so on).

(b) The reproductions shall be submitted in ascending numerical order.

(c) Legends to indicate a specific view of the product (e.g., “front view”, “top view”, etc.) may be indicated in association with the numbering of the reproduction.”

22. The proposed amendments to Section 405 would make it possible for an applicant filing an international application on paper to indicate the views corresponding to each reproduction in a new item to be inserted into the DM/1 form. In respect of international applications filed through the electronic filing (E-filing) interface, when uploading reproductions, the applicant could choose an indication of a view corresponding to each reproduction from a pop-up list containing all possible indications. At present, the possibility of compiling a complete list of such possible indications (legends) is being explored by the International Bureau through consultations with some Offices of the present and prospective Contracting Parties which would need such indications.

III. ENTRY INTO FORCE OF THE PROPOSED AMENDMENTS TO ADMINISTRATIVE INSTRUCTIONS

23. Pursuant to Rule 34(1) of the Common Regulations, the Director General of WIPO may modify the Administrative Instructions after having consulted the Offices of Contracting Parties. In accordance with Rule 34(3)(a), any amendments to the Administrative Instructions are to be published on the web site of the Organization. Publication is made through an Information Notice published by the International Bureau.

24. Furthermore, in accordance with Rule 34(3)(b), each publication shall specify the date on which the published provisions become effective. Should the Working Group agree on the current proposal to amend Sections 401 to 403 and 405 of the Administrative Instructions, the Working Group may further recommend the date of entry into force. It is proposed that the said amendments shall enter into force on July 1, 2014, coinciding with the date of entry into force of the accession of the Republic of Korea to the 1999 Act. The Office of the Republic of Korea is considered as an “Examining Office” under Article 1(xvii) of the 1999 Act and some of the proposed amendments take into account the requirements of the said Office.

25. The Working Group is invited to comment on the proposal to amend Sections 401, 402, 403 and 405 of the Administrative Instructions, as set out in the Annex hereto, with a date of entry into force of July 1, 2014.

[Annex follows]

Administrative Instructions for the Application of the Hague Agreement

(as in force on [July 1, 2014])

[...]

Part Four Requirements Concerning Reproductions and Other Elements of the International Application

Section 401: Presentation of Reproductions

(a) (i) One and the same international application may comprise both photographs and other graphic representations, in black and white or in color.

(ii) Particulars of other visual representations that may accompany the international application shall be published in accordance with Section 204 on the web site of the Organization.

[...]

Section 402: Representation of the Industrial Design

(a) The photographs and other graphic representations shall represent the industrial design alone, or the product in relation to which the industrial design is to be used, to the exclusion of any other object, accessory, person or animal.

(b) The dimensions of the representation of each industrial design appearing in a photograph or other graphic representation may not exceed 16 x 16 centimeters, and in respect of at least one representation of each design, one of those dimensions must be at least 3 centimeters. With respect to the filing of international applications by electronic means, the International Bureau may establish a data format, the particulars of which shall be published on the web site of the Organization, to ensure compliance with these maximum and minimum dimensions.

(c) The following shall not be accepted.

(i) technical drawings, particularly with axes and dimensions;

(ii) explanatory text or legends in the representation.

| *Section 403: Disclaimers and Matter That Does Not Form Part of the Claimed Design*

| Notwithstanding Section 402(a), Matter which is shown in a reproduction but for which protection is not sought may be indicated

(i) in the description referred to in Rule 7(5)(a) and/or

| (ii) by means of dotted or broken lines or coloring.

[...]

| *Section 405: Numbering of Reproductions and Legends*

(a) The numbering stipulated for multiple international applications shall appear in the margin of each photograph or other graphic representation. When the same industrial design is represented from different angles, the numbering shall consist of two separate figures separated by a dot (e.g., 1.1, 1.2, 1.3, etc. for the first design, 2.1, 2.2, 2.3, etc. for the second design, and so on).

(b) The reproductions shall be submitted in ascending numerical order.

| (c) Legends to indicate a specific view of the product (e.g., "front view", "top view", etc.) may be indicated in association with the numbering of the reproduction.

[...]

[End of Annex and of document]