

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

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CONSIDERATIONS RELATING TO THE POSSIBLE INTRODUCTION OF SIMULTANEOUS LIMITATIONS IN INTERNATIONAL APPLICATIONS AND OTHER AMENDMENTS TO THE COMMON REGULATIONS

Document prepared by the International Bureau

I. INTRODUCTION

GEOGRAPHICAL EXPANSION OF THE HAGUE SYSTEM TO EXAMINING JURISDICTIONS

1. Since the fourth session of the Working Group on the Legal Development of the Hague System for the International Registration of Industrial Designs (hereinafter “the Working Group”), in June 2014, three new countries have become parties to the Geneva (1999) Act of the Hague Agreement: the Republic of Korea in July 2014; and Japan and the United States of America in May 2015. These new Contracting Parties have an examining system and, according to their respective national laws, may apply different requirements to the substantive examination of an industrial design. With the accession of more Contracting Parties with an “Examining Office”¹ to the 1999 Act, there is an increased risk that given the requirements governing sufficient

¹ Pursuant to Article 1(xvii) of the 1999 Act, an “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”. Based on some declarations which may be made by Contracting Parties whose Offices satisfy the said requirement and on the information regarding examination procedures at various Offices, which the International Bureau has obtained so far, the Offices of Hungary, Japan, Kyrgyzstan, the Republic of Korea, the Republic of Moldova, Romania, the Syrian Arab Republic and the United States of America are deemed to be Examining Offices.

disclosure of an industrial design, protection may not be granted in some jurisdictions, pursuant to Rule 9(4) of the Common Regulations under the 1999 Act and the 1960 Act of the Hague Agreement (hereinafter “the Common Regulations”), on the ground of insufficient disclosure, whereas in other jurisdictions the same disclosure is considered appropriate.

2. To assist users of the Hague System in disclosing an industrial design according to requirements of Examining Offices, in document H/LD/WG/5/4 entitled “Proposal For Recommendations Relating to the Disclosure of an Industrial Design in an International Application”, the fifth session of the Working Group is invited to discuss the recommendations contained in the Annex to the said document. However, the requirements of Offices may sometimes not be the same, or the scope of protection is adversely affected in those jurisdictions which do not require certain elements that are necessary in other jurisdictions. The Hague System should be flexible enough to contemplate those different requirements of the Offices of its Members.

CONCEPT OF SIMULTANEOUS LIMITATIONS IN INTERNATIONAL APPLICATIONS

3. This document sets forth a proposal for the introduction of the concept of “simultaneous limitations” in the international application. It is recalled that the amendments to Sections 402, 403 and 405 of the Administrative Instructions for the Application of the Hague Agreement (hereinafter “the Administrative Instructions”), which entered into force on July 1, 2014, relaxed some formal requirements concerning reproductions and representation of an industrial design and afforded applicants more flexibility in the disclosure of an industrial design. The introduction into the Hague System of the “simultaneous limitations”, i.e., those allowing the applicant to limit the international application in respect of any or some of the designated Contracting Parties to one or some of the industrial designs that are the subject of the international application would enable applicants to fully benefit from the enhanced flexibility of the Hague System.

4. To be precise, an international application could contain designs with dedicated sets of reproductions conforming to the requirements concerning an appropriate disclosure of certain designated Contracting Parties and limit one or more of the designs in respect of those designated Contracting Parties that are likely to refuse the protection of the designs on the ground of insufficient disclosure under Rule 9(4) of the Common Regulations, or those Contracting Parties in which the protection of the design would be adversely affected on account of differences in the standards of disclosure.

5. Furthermore, to reduce the amount of the fees to be paid by the applicant, it is proposed that the applicant would pay the standard/individual designation fee only in respect of those designs that concern a designated Contracting Party. The proposal for amendments to the Schedule of Fees is dealt with in detail in document H/LD/WG/5/6, entitled “Considerations Relating to a Possible Revision of the Schedule of Fees”, also to be discussed during the fifth session of the Working Group.

6. The fifth session of the Working Group is invited to discuss the desirability of the implementation of simultaneous limitations in the international applications in the Hague System and comment on possible amendments to Rule 7 and 14 of the Common Regulations and to Part Four of the Administrative Instructions, as explained in Chapter IV hereof. Considering that the IT-environment of the Hague System must be accordingly amended to provide for this new feature of simultaneous limitations, the proposed amendments, if adopted, may take effect in early 2017 at the earliest.

II. CONSIDERATIONS FROM THE LEGAL POINT OF VIEW

CONCEPT OF LIMITATION UNDER THE CURRENT LEGAL FRAMEWORK OF THE HAGUE SYSTEM

7. In accordance with Article 16(1)(v) of the 1999 Act, the limitation of the international registration shall be recorded in the International Register. Pursuant to Rule 21(1)(a)(iv) and (b) of the Common Regulations, the holder may request the recording of a limitation of the international registration to one or some of the industrial designs in respect of one or all of the designated Contracting Parties. Under the current legal framework of the Hague System, to file a request for recording of a limitation, the holder should wait until the international registration has been inscribed.

8. A limitation differs from a renunciation, as prescribed under Rule 21(1)(a)(iii), in that a renunciation concerns all the industrial designs that are the subject of an international registration, but not necessarily all the designated Contracting Parties. Conversely, a limitation necessarily concerns only some of the industrial designs, but never all, in relation to any, or all, of the Contracting Parties.

9. Currently, at the application stage, it may happen that in order to comply with requirements before certain Examining Offices and not narrow the protection in other jurisdictions in an undesirable manner, the applicant includes the “same” (i.e., the gist of the designs is the same) industrial design twice (or even three times or more, as the case may be) in the international application with different sets of reproductions, which conform to the requirements concerning an appropriate disclosure in different jurisdictions. It is likely that, in accordance with Rule 18(2)(b)(v) of the Common Regulations, an Examining Office would issue a refusal for those designs which do not meet to its own requirements for sufficient disclosure.

10. Following partial refusal under Rule 18(2)(b)(v) of the Common Regulations issued by an Examining Office, if the holder of the international registration is not genuinely interested in filing the “same” design twice (or even three times or more, as the case may be), supported by different sets of reproductions, she/he may simply decide not to reply to the partial refusal.

11. Moreover, if the Examining Office considers that two designs in the same application are in fact the same design despite the different sets of reproductions, it may issue a refusal on the ground of prohibition of double patenting, unless under its applicable law those designs may be considered as variants. It is also to be noted that where a notification of a refusal pursuant to Article 13(2) of the 1999 Act is issued by the Office of a Contracting Party that has made a declaration under Article 13(1) of the 1999 Act concerning unity of design, it necessarily concerns the effects of the international registration as a whole. The holder of the international registration may overcome a ground of refusal stated in that notification by dividing the international registration before the Office concerned².

12. Alternatively, the holder may not wish to wait for the anticipated refusal but request the limitation of the international registration before the International Bureau to one/some designs for one/some Contracting Parties, in accordance with Rule 21(1)(a)(iv) of the Common Regulations.

² The declaration concerning unity of design under Article 13(1) of the 1999 Act is made by Estonia, Japan, Kyrgyzstan, Romania, Singapore, the Syrian Arab Republic, Tajikistan and the United States of America. Most of the above-mentioned Contracting Parties do not apply the possibility of issuing a notification of refusal under Article 13(2) of the 1999 Act. However, it is expected that the United States Patent and Trademark Office (USPTO) will start issuing notifications of refusals in November 2015, also on the basis of Article 13(2).

13. The filing strategy described above, in addition to being inconvenient, implies that the applicant has to pay the standard/individual designation fee for each design for all the Contracting Parties. It is recalled that the amount of the standard designation fee depends on the number of designs, as may an individual designation fee, if so declared by a Contracting Party³.

FLEXIBILITY IN REPRESENTATION/REPRODUCTION OF AN INDUSTRIAL DESIGN

14. As already explained above, the current legal framework of the Hague System does not provide for the possibility of simultaneous limitations in the international applications. The proposal for simultaneous limitations would foster the filing of dedicated sets of reproductions of an industrial design, which would entail “solid” protection under the applicable law in the relevant designated Contracting Party. For example, Japan has made a declaration under Rule 9(3)(a) of the Common Regulations whereby, where the product which constitutes the industrial design is three-dimensional, a front view, a back view, a top view, a bottom view, a left side view and a right side view, each made in compliance with the method of orthographic projection, are required. The applicant would normally comply with these requirements so as to forestall a possible refusal. However, the requirements and practices concerning disclosure of an industrial design may be different in other Contracting Parties designated in the same international application, or a fuller disclosure could narrow the protection in an undesirable manner in other designated Contracting Parties; therefore the applicant should be allowed to submit a set of dedicated reproductions only for Japan.

15. If simultaneous limitations were allowed, as set forth herein, a limitation could be requested in respect of any of the designated Contracting Parties to one or some of the industrial designs that are the subject of the application. As a matter of course, a limitation in respect of all the designated Contracting Parties may not be requested in the international application, since a request for protection in at least one Contracting Party must be made for each industrial design.

16. In other words, the applicant could file an international application with two or more “same” designs with different sets of reproductions, and simultaneously limit one or more designs in respect of any or some of the designated Contracting Parties. Accordingly, as further explained in document H/LD/WG/5/6, the applicant would pay the standard/individual designation fees only for those designs that concern a designated Contracting Party.

LIMITATIONS IN AN INTERNATIONAL APPLICATION

17. The contents of an international application are mainly prescribed in Article 5 of the 1999 Act and Rule 7 of the Common Regulations. The mandatory contents, such as the name of the applicant, the product indication or the designated Contracting Parties, are listed under Article 5(1) and Rule 7(3), and shall be included in all the international applications. Furthermore, other additional mandatory contents are provided for in Article 5(2) and Rules 7(4) and 8. Additional mandatory contents, such as an oath by the creator, are required only if a Contracting Party which has made a declaration under Article 5(2) or notified a special requirement under Rule 8 is designated in an international application. Furthermore, an international application may contain a number of optional contents, as listed under Rule 7(5).

³ The declaration of an individual designation fee under Article 7(2) of the 1999 Act or under Rule 36(1) of the Common Regulations is made by the following Contracting Parties: the African Intellectual Property Organization (OAPI), the European Union, Hungary, Japan, Kyrgyzstan, the Republic of Korea, the Republic of Moldova and the United States of America.

18. If filed electronically, the E-filing system automatically ascertains that all the mandatory contents of an international application are included in the application. Where a Contracting Party which has made a declaration under Article 5(2) or Rule 8 is designated in an international application, the E-filing issues an automatic alert to the applicant to comply with the specific requirements for that Contracting Party, such as that a brief description as additional mandatory content must be contained in the application.

19. If simultaneous limitations in the international applications were allowed, additional mandatory contents might apply only in respect of one/some designs that are the subject of the international application.

EXAMINATION BY THE INTERNATIONAL BUREAU

20. In all cases, an examiner of the International Bureau verifies the correctness of the contents of an international application, for example, whether the reproductions meet to the formal requirements under the legal framework of the Hague System, or whether the documents annexed to the international application, such as power of attorney, are correctly presented.

21. In accordance with Article 8(1), if the International Bureau finds that a mandatory or additional mandatory content of an international application is missing or erroneous, it shall invite the applicant to make the required corrections within the prescribed time limit. The general principle, as prescribed by Article 8(2)(a), is that the application is considered abandoned if the applicant does not correct the irregularity within the prescribed time limit. However, pursuant to Article 8(2)(b), in the case of an irregularity which relates to an additional mandatory content, if the applicant does not comply with the invitation within the prescribed time limit, the international application shall be deemed not to contain the designation of that Contracting Party (i.e., the Contracting Party having made a declaration under Article 5(2) or notified a special requirement under Rule 8).

22. Furthermore, pursuant to Rule 14(2), certain irregularities entail postponement of the filing date of the international application, for example, if a reproduction of each design is missing from the application. Finally, pursuant to Article 10(2)(b), where an irregularity relates to Article 5(2), the date of the international registration is the date on which the correction is received by the International Bureau or the filing date of the international application, whichever is the later⁴.

23. Irrespective of whether or not the international application contains any limitations, it may be that an irregularity concerns only one/some designs and/or one/some designated Contracting Parties, for example, if the name of the creator is not indicated for all the designs but only for some of them. In such case, if the international application contains designations of Contracting Parties, for which the name of the creator is an additional mandatory content under Article 5(2)(b)(i) or Rule 8, in addition to other Contracting Parties, for which the name of the creator is an optional content, the irregularity concerns only those designs for which the name of creator is missing and only those Contracting Parties, for which the name of the creator is an additional mandatory content. If not corrected, it would be logical that the international application should be deemed not to contain the designation of that Contracting Party for the design(s) for which the name of the creator was missing, but the designation of that Contracting Party for other designs remains intact.

⁴ For example, a reproduction of each industrial design that is the subject of the international application is still missing from the international application on the date where a correction of an irregularity related to Article 5(2) is received by the International Bureau.

24. Furthermore, if an irregularity, which concerns only one/some designs, for example, reproductions of a design are of bad quality, is not corrected, it would be logical that instead of considering the whole international application as abandoned, a “partial abandonment” of the international application could be possible concerning those designs⁵.

25. “Partial abandonment” of an international application already exists under the Hague System legal framework, namely, as described in paragraph 21, in the case of an irregularity which relates to an additional mandatory content, if the applicant does not comply with the invitation within the prescribed time limit, pursuant to Article 8(2)(b), the international application shall be deemed not to contain the designation of that Contracting Party. If the concept of “partial abandonment” under the Hague System were extended to situations described in paragraphs 23 and 24, the examiner of the International Bureau would continue, as she/he does already today, examining the conformity of the reproductions with the Hague System legal framework as well as the correctness of bibliographic data and of any documentation annexed to the international application. However, there would be less impact if irregularities raised by the examiner were not corrected or were only partially corrected.

INTERNATIONAL REGISTRATION

26. Where the international application conforms to the applicable requirements, the International Bureau will register the industrial design in the International Register and send a certificate of the international registration to the holder. If simultaneous limitations and, consequently, “partial abandonments” of a pending international application in respect of one/some designs and/or one/some designated Contracting Parties, as explained in paragraphs 23 to 25, were allowed under the Hague System legal framework, the international registration might contain bespoke designations of Contracting Parties.

27. In such case, the publication of the international registration in the *International Designs Bulletin* should clearly indicate the designs for which protection is requested in a certain designated Contracting Party. Therefore, the tasks of the Offices would remain the same and there is no need for the Offices to change their procedures or practices to the extent that the uploading of data in their national/regional databases would require amendments to their IT systems.

III. DESIGN INTERNATIONAL REGISTRATION INFORMATION SYSTEM DEPLOYMENT SCHEDULE

28. As reported in document H/A/35/1, entitled “Final Report on the Information Technology Modernization Program (Hague International Registration System)”, presented to the Hague Union Assembly in 2015, the challenges to the Hague Registry when the IT Modernization Program began in 2008 are fundamentally different to the challenges of today⁶. Given the very dynamic and fluid nature of the Hague international registration procedures, it is extremely important that the Design International Registration Information System (DIRIS) is able to address the original, as well as any new challenges, in particular the Hague System

⁵ In practice, the International Bureau accepts a remedy by the applicant requesting the withdrawal of one/some designs from the international application (i.e. normally those designs concerned by an irregularity).

⁶ The accessions of Japan, the Republic of Korea and the United States of America to the Hague System required modifications to the Hague System procedure and therefore to the legacy ICT system (DMAPS). Detailed planning for the testing and deployment of Design International Registration Information System (DIRIS) will take place during autumn 2015. Subject to the final, detailed planning, the technical build of DIRIS is expected to take place between January and April 2016 with the final testing and deployment to follow between May and August 2016.

functionality enhancement initiatives, such as increased granularity of the system (i.e. design-specific and reproduction-specific information). The increased granularity of the data recorded in the International Register may require Offices of Contracting Parties to also adapt their IT systems to more granular data.

29. Modern information technology will enable the recording in the International Register of design-specific data, for example, for each design, one or more designated Contracting Parties. In other words, it is anticipated that the increased granularity of the Hague System is an evolution that would allow simultaneous limitations in international applications and “partial abandonments” of a pending application.

IV. POSSIBLE AMENDMENTS TO THE COMMON REGULATIONS AND ADMINISTRATIVE INSTRUCTIONS

30. In its discussion concerning the desirability of the introduction of the concept of simultaneous limitations in the international applications to the Hague System, the Working Group is also invited to comment on possible amendments to the Common Regulations and the Administrative Instructions. The proposed amendments to Rule 7, and the consequential amendments to Part Four of the Administrative Instructions, concern simultaneous limitations in an international application and the proposed amendments to Rule 14 concern partial withdrawal (“abandonment”) of a pending international application.

CONSIDERATIONS RELATED TO PROPOSED AMENDMENTS TO RULE 7 AND TO PART FOUR OF THE ADMINISTRATIVE INSTRUCTIONS

31. As explained previously in the present document, Rule 7 deals with the contents of the international application. In line with Article 5(4) of the 1999 Act, Rule 7(3)(v) restricts the maximum number of industrial designs that may be included in an international application to 100 designs. Furthermore, pursuant to Rule 7(7), all the products which constitute the industrial designs or in relation to which the industrial designs are to be used, shall belong to the same Locarno class. Otherwise, the legal framework of the Hague System does not contain any constraints as to compiling the industrial designs in an international application⁷.

32. Given that Rule 21(1)(a)(iv) provides for a request for limitation of an international registration, it would be logical and transparent to also have a special provision concerning limitations in an international application⁸. It is proposed that a new paragraph 8 be added to Rule 7 addressing the possibility of limitations in an international application, as follows:

“Rule 7(8) [Limitations in an International Application] The international application may contain limitations, in respect of any or some of the designated Contracting Parties, to one or some of the industrial designs that are the subject of the international application. The limitations in respect of the designated Contracting Parties may be different from each other.”

⁷ The indication of a related design and the principal design under Section 407 of the Administrative Instructions is an optional content of an international application.

⁸ *Records of the Diplomatic Conference for the Adoption of a New Act of the Hague Agreement Concerning the International Deposit of Industrial Designs (Geneva Act)* do not contain any proposal or discussion regarding limitations in an international application.

33. It is pointed out that, as a result of limitations made in an international application, an additional mandatory content, such as the name of the creator (as additional mandatory content,) is required only in respect of the designs which concern a designated Contracting Party that has made a declaration under Article 5(2)(b)(i) and/or (ii) and/ or Rule 8.

34. It is proposed that a new Section 409 be added to the Administrative Instructions to clarify the situation as follows:

“Section 409: Additional Mandatory Contents of an International Application Containing Limitations

“Where Rule 7(4)(b) and/or (c) applies and the international application contains limitations, the required element(s) under Article 5(2)(b)(i) and/or (ii) and/or Rule 8 shall be contained in the application in respect of the industrial design(s), which concern(s) the designated Contracting Party(ies), which has/have made the respective declaration(s).”

35. It should be noted that a declaration under Article 5(2)(b)(iii) concerning a claim is made only by the United States of America, and that a claim cannot be included in an international application unless the United States of America is designated. Furthermore, regardless of the number of designs in an international application and whether or not it contains limitations, only one claim may be contained in an international application (refer to Frequently Asked Questions: Hague System, on the WIPO website at <http://www.wipo.int/hague/en/faqs.html>).

36. Finally, as a matter of course, it is recalled that a short description and the name of creator may also be contained in an international application as optional contents.

CONSIDERATIONS RELATING TO PROPOSED AMENDMENTS TO RULE 14

37. In practice, after having filed an international application, the applicant may request the withdrawal of any industrial design or a designation of any Contracting Party, either at her/his own initiative or in a reply to an invitation to correct an irregularity. It may happen that, as a remedy, the applicant requests the withdrawal of the design or the designated Contracting Party concerned by the irregularity from the international application.

38. The proposed new paragraph (4) to Rule 14 addresses the situation where the irregularity concerns only some of the industrial designs contained and/or some designated Contracting Parties in the international application. In the absence of any action by the applicant, the proposed amendments soften the consequences to the applicant. Instead of considering the international application abandoned, only the designs and/or designated Contracting Parties which are affected by an irregularity are deleted from the application.

39. It could be argued that if Article 8(2) is interpreted *stricto sensu*, it only allows the abandonment of the international application or, if the irregularity relates to an additional mandatory content, the dropping of the Contracting Party concerned from the international application. On the other hand, there are several provisions in the treaty, which in practice allow for the splitting of the international registration, for example, in a recording of a change in ownership in respect of any or all of the designated Contracting Parties and in respect of any or all the industrial designs under Article 16(1)(i), a renunciation under Article 16(1)(iv) or a limitation under Article 16(1)(v).

40. Moreover, it could be further argued that there is no obligation for the applicant to respond to an invitation by the International Bureau to correct an irregularity. In the event that an irregularity concerning only some designs and/or some designated Contracting Parties is detected by the International Bureau, the passivity of the applicant could be construed as acceptance of the irregularity, as indicated in the said letter by the International Bureau. The letter by the International Bureau could state that if no reply is received from the applicant within

the prescribed time limit, the industrial design and/or Contracting Party concerned is considered to be withdrawn from the international application by the applicant. In other words, the required correction by the applicant could simply be the acceptance of the withdrawal of the industrial design and/or Contracting Party concerned.

41. It is proposed that new paragraph (4) be added to Rule 14 to address the possibility of partial withdrawal of the international application, following an invitation to correct an irregularity. As explained in paragraph 23, above, irrespective of whether or not the international application contains any limitations, an international application may be the subject of an irregularity concerning only some designs and/or designated Contracting Parties.

“Rule 14(4) [*Partial Withdrawal of the International Application*]Where an irregularity, which relates to Article 5(2) or to a special requirement notified to the Director General by a Contracting Party in accordance with Rule 8, which does not concern all the industrial designs that are the subject of the international application, is not remedied within the time limit referred to in paragraph (1), the industrial designs concerned by the irregularity are considered to be withdrawn from the application in respect of the Contracting Party concerned.”

V. CONCLUSIONS

42. The proposed new provision concerning simultaneous limitations in an international application would allow more sophisticated filing strategies to users of the Hague System, and would allow savings in the designation fees to be paid.

43. It is expected that the sixth session of the Working Group will convene in the first half of 2016, where the discussion could continue, and if agreed by the Working Group, the proposed amendments to the Common Regulations and the Administrative Instructions would be submitted to the Hague Union Assembly in 2016, for adoption. As explained in paragraph 6 of the present document, subject to the successful tests and deployment of DIRIS, the proposed amendments may come into effect at the earliest in January 2017.

44. The Working Group is invited to discuss the concept of simultaneous limitations in an international application and, if favorable to the introduction of the said concept into the Hague System, also comment on the proposed amendments to Rules 7 and 14 of the Common Regulations and the proposed new Section 409 of the Administrative Instructions.

[Annex follows]

**Common Regulations
Under the 1999 Act and the 1960 Act
of the Hague Agreement**

(as in force on [DATE])

[...]

Rule 7

Requirements Concerning the International Application

(8) [Limitations in an International Application] The international application may contain limitations, in respect of any or some of the designated Contracting Parties, to one or some of the industrial designs that are the subject of the international application. The limitations in respect of the designated Contracting Parties may be different from each other.

[...]

Rule 14

Examination by the International Bureau

[...]

(4) [Partial Withdrawal of the International Application] Where an irregularity, which relates to Article 5(2) or to a special requirement notified to the Director General by a Contracting Party in accordance with Rule 8, which does not concern all the industrial designs that are the subject of the international application, is not remedied within the time limit referred to in paragraph (1), the industrial designs concerned by the irregularity are considered to be withdrawn from the application in respect of the Contracting Party concerned.

[...]

**Administrative Instructions for the Application
of the Hague Agreement**

(as in force on [DATE])

[...]

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

[...]

Section 409: Additional Mandatory Contents of an International Application Containing Limitations

Where Rule 7(4)(b) and/or (c) applies and the international application contains limitations, the required element(s) under Article 5(2)(b)(i) and/or (ii) and/or Rule 8 shall be contained in the application in respect of the industrial design(s), which concern(s) the designated Contracting Party(ies), which has/have made the respective declaration(s).