

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

Sixth Session
Geneva, June 20 to 22, 2016

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 June 20 to 22, 2016.
2. The following members of the Hague Union were represented at the session: African Intellectual Property Organization (OAPI), Democratic People’s Republic of Korea, Denmark, Estonia, Finland, France, Germany, Ghana, Hungary, Italy, Japan, Lithuania, Norway, Poland, Republic of Korea, Republic of Moldova, Romania, Suriname, Switzerland, Turkey, Turkmenistan and the United States of America (22).
3. The following States were represented as observers: Algeria, Brazil, Cameroon, Canada, China, Czech Republic, Indonesia, Kazakhstan, Madagascar, Mexico, Philippines, Russian Federation, Saudi Arabia, Thailand, United Kingdom and Zimbabwe (16).
4. Representatives of the following non-governmental organizations (NGOs) took part in the session in an observer capacity: *Association française des praticiens du droit des marques et des modèles* (APRAM), European Communities Trade Mark Association (ECTA), International Association for the Protection of Intellectual Property (AIPPI), International Trademark Association (INTA), Japan Patent Attorneys Association (JPAA) and MARQUES – Association of European Trademark Owners (6).

AGENDA ITEM 1: OPENING OF THE SESSION

5. Mr. Francis Gurry, Director General of the World Intellectual Property Organization (WIPO), opened the sixth session of the Working Group and welcomed the participants.

AGENDA ITEM 2: ELECTION OF THE CHAIR AND TWO VICE-CHAIRS

6. Ms. Marie Kraus (Switzerland) was unanimously elected as Chair of the Working Group, and Ms. Sohn Eunmi (Republic of Korea) and Ms. Sengül Kultufan Bilgili (Turkey) were unanimously elected as Vice-Chairs.

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

AGENDA ITEM 3: ADOPTION OF THE AGENDA

8. The Working Group adopted the draft agenda (document H/LD/WG/6/1 Prov.) without modification.

AGENDA ITEM 4: ADOPTION OF THE DRAFT REPORT OF THE FIFTH SESSION OF THE WORKING GROUP ON THE LEGAL DEVELOPMENT OF THE HAGUE SYSTEM FOR THE INTERNATIONAL REGISTRATION OF INDUSTRIAL DESIGNS

9. Discussions were based on document H/LD/WG/5/8 Prov.

10. The Working Group adopted the draft report (document H/LD/WG/5/8 Prov.) without modification.

AGENDA ITEM 5: REVISED PROPOSAL FOR AMENDMENTS TO RULES 21 AND 26 OF THE COMMON REGULATIONS

11. Discussions were based on document H/LD/WG/6/2.

12. Taking into account the concerns expressed by the Delegation of the United States of America, the Secretariat made a proposal to add a new paragraph to Rule 21.

13. The Chair concluded that the Working Group considered favorably the submission of a proposal to amend the Common Regulations with respect to Rules 21 and 26 and to the Schedule of Fees, as contained in the Annex to document H/LD/WG/6/2, with minor amendments, with the addition of a new paragraph (9) to Rule 21, as set out in Annex I to the Summary by the Chair, for adoption, to the Assembly of the Hague Union. The date of entry into force would be determined by the International Bureau.

AGENDA ITEM 6: REVISED PROPOSAL FOR AMENDMENTS TO RULE 14 OF THE COMMON REGULATIONS

14. Discussions were based on document H/LD/WG/6/3.
15. Taking into consideration different views expressed by the delegations and representatives of user groups, the Secretariat made a revised proposal to amend Rule 14.
 16. The Chair concluded that the Working Group considered favorably the submission of a proposal to amend the Common Regulations with respect to Rule 14, as set out in Annex II to the Summary by the Chair, for adoption, to the Assembly of the Hague Union. The date of entry into force would be determined by the International Bureau.

AGENDA ITEM 7: PROJECT ON INCREASED GRANULARITY CONCERNING THE DATA IN THE INTERNATIONAL REGISTER

17. Discussions were based on document H/LD/WG/6/4.
 18. The Chair noted that the Working Group welcomed the proposed information structure of international registrations, as illustrated in Annex II to document H/LD/WG/6/4, and that the Working Group invited the International Bureau to present an analysis on the practical, technical and legal implications of the proposed information structure to be discussed at the seventh session of the Working Group.

AGENDA ITEM 8: RECENT TRENDS UNDER THE HAGUE SYSTEM

19. Discussions were based on document H/LD/WG/6/5.
 20. The Chair concluded that the Working Group took note of the information contained in document H/LD/WG/6/5.

AGENDA ITEM 9: OTHER MATTERS

21. The Secretariat expressed its gratitude for comments received from certain Offices and user groups on the revised version of the *Guidance on Preparing and Providing Reproductions in Order to Forestall Possible Refusals on the Ground of Insufficient Disclosure of an Industrial Design by Examining Offices*. The Secretariat informed the Working Group that the Guidance would be made available on the WIPO website at the beginning of July 2016.
22. The Delegation of the United States of America expressed its interest in using Digital Access Service for Priority Documents (DAS) for the exchange of priority documents for industrial designs and encouraged other delegations to give it consideration.
23. The Delegation of the United States of America proposed that the International Bureau study the concept of reinstatement of rights in the context of the Hague System.

AGENDA ITEM 10: SUMMARY BY THE CHAIR

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

AGENDA ITEM 11: CLOSING OF THE SESSION

25. The Chair closed the sixth session on June 22, 2016.

[Annexes follow]

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

(as in force on [...])

*Rule 21
Recording of a Change*

(1) [*Presentation of the Request*] (a) A request for the recording shall be presented to the International Bureau on the relevant official form where the request relates to any of the following:

- (i) a change in the ownership of the international registration in respect of all or some of the industrial designs that are the subject of the international registration;
- (ii) a change in the name or address of the holder;
- (iii) a renunciation of the international registration in respect of any or all of the designated Contracting Parties;
- (iv) a limitation, in respect of any or all of the designated Contracting Parties, to one or some of the industrial designs that are the subject of the international registration;
- (v) [the provision of the name and address of the creator, or a change in the name or address of the creator, of any or all of the industrial designs that are the subject of the international registration.](#)

(b) The request shall be presented by the holder and signed by the holder; however, a request for the recording of a change in ownership may be presented by the new owner, provided that it is

- (i) signed by the holder, or
- (ii) signed by the new owner and accompanied by an attestation from the competent authority of the holder's Contracting Party that the new owner appears to be the successor in title of the holder.

(2) [*Contents of the Request*] The request for the recording of a change shall, in addition to the requested change, contain or indicate

- (i) the number of the international registration concerned,
- (ii) the name of the holder, unless the change relates to the name or address of the representative,
- (iii) in case of a change in the ownership of the international registration, the name and address, given in accordance with the Administrative Instructions, of the new owner of the international registration,
- (iv) in case of a change in the ownership of the international registration, the Contracting Party or Parties in respect of which the new owner fulfils the conditions to be the holder of an international registration,
- (v) in case of a change in the ownership of the international registration that does not relate to all the industrial designs and to all the Contracting Parties, the numbers of the industrial designs and the designated Contracting Parties to which the change in ownership relates,
- (vi) [in case of the provision of the name and address of the creator of the industrial design, the numbers of the industrial designs concerned, where the person is not a creator of all the industrial designs that are the subject of the international registration, and](#)
- (vii) the amount of the fees being paid and the method of payment, or instruction to debit the required amount of fees to an account opened with the International Bureau, and the identification of the party effecting the payment or giving the instructions.

[...]

(9) [Recording of a Change in the Name of the Creator] Any recording of a change in the name of the creator under paragraph (1)(a)(v) shall be void *ab initio* if such a recording concerns a change in the person of the creator.

Rule 26
Publication

(1) [*Information Concerning International Registrations*] The International Bureau shall publish in the Bulletin relevant data concerning

- (i) international registrations, in accordance with Rule 17;
- (ii) refusals, with an indication as to whether there is a possibility of review or appeal, but without the grounds for refusal, and other communications recorded under Rules 18(5) and 18*bis*(3);
- (iii) invalidations recorded under Rule 20(2);
- (iv) changes in ownership and mergers, changes of name or address of the holder, renunciations, ~~and~~ limitations, provisions of the name and address of the creator and changes in the name or address of the creator recorded under Rule 21;
- (v) corrections effected under Rule 22;
- (vi) renewals recorded under Rule 25(1);
- (vii) international registrations which have not been renewed;
- (viii) cancellations recorded under Rule 12(3)(d);
- (ix) declarations that a change in ownership has no effect and withdrawals of such declarations recorded under Rule 21*bis*.

[...]

SCHEDULE OF FEES
(as in force on [...])

Swiss francs

[...]

V. *Miscellaneous Recordings*

13.	Change in ownership	144
14.	Change of name and/or address of the holder	
14.1	For one international registration	144
14.2	For each additional international registration of the same holder included in the same request	72
	<u>14<i>bis</i>.Provision of the name and address of the creator, or change in the name and/or address of the creator, of the industrial design</u>	
	<u>14<i>bis</i>.1 For one international registration</u>	<u>144</u>
	<u>14<i>bis</i>.2 For each additional international registration included in the same request</u>	<u>72</u>

[...]

[Annex II follows]

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

(as in force on [...])

*Rule 14
Examination by the International Bureau*

(1) [*Time Limit for Correcting Irregularities*] (a) If the International Bureau finds that the international application does not, at the time of its receipt by the International Bureau, fulfill the applicable requirements, it shall invite the applicant to make the required corrections within three months from the date of the invitation sent by the International Bureau.

(b) Notwithstanding subparagraph (a), where the amount of the fees received at the time of receipt of the international application is less than the amount corresponding to the basic fee for one design, the International Bureau may first invite the applicant to make the payment of at least the amount corresponding to the basic fee for one design within two months from the date of the invitation sent by the International Bureau.

[...]

(3) [*International Application Considered Abandoned; Reimbursement of Fees*] Where an irregularity, other than an irregularity referred to in Article 8(2)(b) of the 1999 Act, is not remedied within the time limits referred to in paragraphs (1)(a) or (b), the international application shall be considered abandoned and the International Bureau shall refund any fees paid in respect of that application after deduction of an amount corresponding to the basic fee.

[End of Annex II and of document]