

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

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### ANALYSIS OF THE RETURNS TO THE WIPO QUESTIONNAIRE ON PRIORITY DOCUMENTS

*Document prepared by the International Bureau*

#### I. BACKGROUND

1. A questionnaire on “Issuance and submission of priority documents and restoration of the right of priority within the membership of the Hague System for the International Registration of Industrial Designs” (hereinafter referred to as the “Questionnaire”) was prepared by the International Bureau, and circulated among the members of the Hague System on November 8, 2017 (C. H 130).
2. The Questionnaire was intended to help the International Bureau evaluate its practice and also improve the general questionnaire sent annually to the members of the Hague System and provided to new members at the time of their ratification or accession, with a view to enhancing user information on the dedicated web pages.
3. The International Bureau received 31 replies to the Questionnaire from the Offices of 28 member States and three intergovernmental organizations (IGOs) (hereinafter referred to as “responding Offices”)<sup>1</sup>.

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<sup>1</sup> In total, submissions were received from the following member States: Armenia, Azerbaijan, Bosnia and Herzegovina, Bulgaria, Croatia, Denmark, France, Georgia, Germany, Hungary, Iceland, Japan, Kyrgyzstan, Latvia, Lithuania, Morocco, Norway, Republic of Korea, Republic of Moldova, Romania, Russian Federation, Sao-Tomé and Príncipe, Singapore, Spain, Switzerland, Tajikistan, Turkey, United States of America; and IGOs: African Intellectual Property Organization (OAPI), Benelux Office for Intellectual Property (BOIP) and European Union Intellectual Property Office (EUIPO).

4. A compilation of the replies to the Questionnaire will be provided in a separate document and published on the WIPO website.
5. The present document summarizes the main trends emerging from the replies sent by the responding Offices and is divided into four sections to reflect the structure of the Questionnaire, namely: “Issuance of priority documents by Offices of the members of the Hague System”, “Submission of priority documents to Offices as the Office of a designated Contracting Party”, “Restoration of the right of priority” and “Plans to participate in the WIPO Digital Access Service (DAS)”.
6. The document is supplemented by an Annex, entitled “Quantitative Summary of Replies to the Questionnaire”, containing a table with the number of returns per question.

## **II. ISSUANCE OF PRIORITY DOCUMENTS BY OFFICES OF THE MEMBERS OF THE HAGUE SYSTEM**

7. The Questionnaire results reveal that 30 out of the 31 responding Offices issue “certified” priority documents.
8. One responding Office issues only “non-certified” priority documents.
9. Of the responding Offices issuing “certified” priority documents, 30 issue priority documents in paper format and eight in electronic format.
10. Regarding “non-certified” priority documents, out of a total of 31 responding Offices , seven issue priority documents in paper format, five in electronic format and one in another format.
11. Among the responding Offices which issue “certified” priority documents in electronic format:
  - two indicate that the priority documents contain an Identification code (ID code);
  - three indicate that they do not contain an ID code; and
  - two indicate that they contain another electronic authentication.
12. All the responding Offices which issue “certified” priority documents in electronic format allow for the possibility of issuing priority documents in paper format where the Office of the subsequent filing does not accept priority documents in electronic format.
13. Where a multiple design application is allowed under the national/regional law, 14 out of a total of 28 responding Offices issue priority documents for one or some of the designs only.

## **III. SUBMISSION OF PRIORITY DOCUMENTS TO OFFICES AS THE OFFICE OF A DESIGNATED CONTRACTING PARTY**

14. The Questionnaire results reveal that in over half of the responding Offices (18 out of a total of 31), the submission of priority documents is never required by the Offices of the members of the Hague System.

15. Among the 14 responding Offices which require the submission of priority documents:

- six indicate that the submission of priority documents is mandatory for all international registrations that contain a priority claim;
- five indicate that the submission of priority documents is mandatory only where the Office requests the holder to submit it during the examination process;
- one responds that the submission of a priority document is optional/voluntary; and
- two have another requirement.

16. Where the holder of the international registration is not resident in the country/region of the designated Contracting Party, priority documents must be submitted through a local representative in six out of a total of 14 responding Offices.

17. Where the submission of priority documents is required, eight responding Offices may also require other documents in addition to a copy of the first application, pursuant to Article 4.D.(3) of the Paris Convention.

18. The submission of "original" certified priority documents is required under the legislations of eight responding Offices, whereas 10 Offices accept a copy of the certified priority documents.

19. A privately made PDF of a priority document issued in paper format is admitted by six out of a total of 14 responding Offices.

20. The Questionnaire results reveal that, currently, the requirements under the law of the responding Offices for the submission of priority documents issued in electronic format vary from one another.

21. Indeed, among 12 responding Offices, priority documents issued in electronic format by the Office of the first filing may be submitted as follows to the Office of a designated Contracting Party :

- five accept priority documents in electronic format containing an ID code which allows the Office to verify the authenticity of the document through the website of the Office of the first filing;
- five accept priority documents in electronic format without an ID code;
- two accept priority documents in electronic format with or without an ID code; and
- four accept other types of priority documents in electronic format.

22. Submission of a printout of the electronic priority document instead of its original electronic version is admitted by nine out of a total of 14 responding Offices.

23. As regards the consequence of the holder's failure to comply with time limit requirements for submission of priority documents, the Questionnaire results reveal that, out of a total of 12 responding Offices:

- nine indicate that the right of priority is lost;
- three state that protection may be refused on the ground of lack of novelty if the first filing on which the priority is based was published prior to the filing date of the international application;

- three reply that protection may be refused on the ground of lack of novelty if the first filing on which the priority is based was published prior to the international registration date;
- one applies “another” consequence.

24. Five responding Offices indicate that a relief measure is available in case of failure to comply with the time limit.

#### **IV. RESTORATION OF THE RIGHT OF PRIORITY**

25. Where, pursuant to Article 10(2)(b) of the 1999 Act, the date of the international registration is the date on which the correction of an irregularity pertaining to Article 5(2) is received by the International Bureau (i.e., the international registration date is later than the filing date of the international application), the national/regional legislation of 16 out of a total of 31 responding Offices provides that the right of priority shall be valid if the filing date falls within the six-month priority period but the international registration date comes more than six months after the date of the first filing (i.e., beyond the priority period).

26. However, where an international registration has a filing date which comes more than six months after the date of the first filing, a large majority of the respondents (23 out of a total of 29 responding Offices) do not provide the holder with the possibility of requesting the restoration of the right of priority.

#### **V. PLANS TO PARTICIPATE IN THE WIPO DIGITAL ACCESS SERVICE (DAS)**

27. Regarding participation in the WIPO Digital Access Service (DAS), a large majority of responding Offices does not currently participate in DAS (only four participants out of a total of 31 responding Offices).

28. However, 20 responding Offices indicated their interest in participating in DAS in the future according to the following time frame:

- four plan to participate within two to three years;
- three plan to participate within four to five years; and
- 14 are interested in participating in DAS but have not yet set a time frame.

29. The questions on participation in DAS and future participation plans specified neither the status of respondents as “depositing Office” and/or “accessing Office” nor the coverage of document types, such as patent and/or design priority documents.

30. According to additional explanations provided by the four DAS participants among the responding Offices, one of them currently participates as a “depositing Office” and an “accessing Office” with respect to priority documents for design applications. The remaining three indicate that they seek to achieve the same full status as regards design priority documents in the near future.

#### **VI. CONCLUSION**

31. Although this survey is intended to enable the International Bureau to evaluate its practices, the results do not seem conclusive enough to consider any immediate change to current practices.

32. However, considering Sections II and III and noting that the current practices of the responding Offices vary, the International Bureau may, in the future, consider the issuance of certified priority documents in an electronic format that is widely accepted by members of the Hague System.

33. As regards Section IV, noting that the restoration of the right of priority is an issue under the legislation of each designated Contracting Party, over half of the responding Offices indicate that the right of priority will be valid in the case where the filing date falls within the six-month priority period even though the international registration date may be more than six months after the date of the first filing. This survey result corroborates the text of Rule 15(2)(i) of the Common Regulations Under the 1999 Act and the 1960 Act of the Hague Agreement, under which a given priority claim shall be included in the international registration as long as the filing date of the international application – as opposed to the international registration date – falls within six months from the date of the first filing.

34. In the context of Sections III and V, considering that some of the Offices of designated Contracting Parties require the submission of priority documents in various circumstances, there is a need to facilitate the exchange of priority documents among the members of the Hague System. In this regard, the survey results clearly encourage expansion of the use of DAS among the members of the Hague System<sup>2</sup>.

35. *The Working Group is invited to consider the contents of the present document.*

[Annex follows]

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<sup>2</sup> Responding to recent developments on DAS participation among members of the Hague System, since February 28, 2018, the E-filing interface and international application form DM/1 have an item to allow the provision of an access code via DAS, pursuant to Section 408(a) of the Administrative Instructions for the Application of the Hague Agreement.

Quantitative Summary of Replies to the Questionnaire

Questions			Total number of replies	Number of replies per option
<b>PART I. ISSUANCE OF PRIORITY DOCUMENTS (COPIES OF THE FIRST FILING) BY YOUR OFFICE</b>				
1(a): Does your Office issue certified/non-certified priority documents on the following formats:	Certified priority documents	No issuance of certified priority documents	31	1
		Paper format	31	30
		Electronic format	31	8
	Non-certified priority documents	Other format	31	0
		Paper Format	31	7
		Electronic format	31	5
	Possible expeditive delivery	Other format	31	1
1(b): In the case that your Office issues certified priority documents in electronic format, do they contain an Identification code (ID code) which allows the Offices of any subsequent filings to verify the authenticity of the priority documents through the website of your Office?	Possible expeditive delivery		31	7
	Yes		7	2
	No		7	3
1(c): In the case that your Office issues priority documents in electronic format, does it allow for the possibility of issuing priority documents in paper, where the Office of the subsequent filing does not allow priority documents in electronic format?	Other electronic authentication used by your Office		7	2
	Yes		7	7
1(d): In the case that multiple design application is allowed under the national/regional law, does your Office issue priority documents for one/some designs only, if so requested?	No		7	0
	Yes		28	14
		No	28	14

Questions		Total number of replies	Number of replies per option
<b>PART II: SUBMISSION OF PRIORITY DOCUMENTS TO YOUR OFFICE AS THE OFFICE OF A DESIGNATED CONTRACTING PARTY IN AN INTERNATIONAL REGISTRATION</b>			
2: Does your Office require the submission of priority documents in support of the priority claim?	Never	31	18
	Submission of a priority document is mandatory for all international registrations that contain a priority claim	31	6
	Submission of a priority document is mandatory only where your Office requests the holder to submit it during the examination process	31	5
	Submission of a priority document is optional/voluntary	31	1
	Other	31	2
3: If the holder of the international registration is not a resident in your country/region, must priority documents be submitted to your Office through a local representative?	Yes	14	6
	No	14	2
	Other	14	6
4: Under Article 4.D.(3) of the Paris Convention, the Office may require other documents in addition to a copy of the first application. Is it the case at your Office:	Yes	8	8
	No	8	0

Questions			Total number of replies	Number of replies per option
5: In what form may the priority documents which are issued in paper format by the Office of first filing, be submitted to your Office?	Certified priority documents	Original	15	8
		Copies of the original documents	15	10
		Other	15	0
	Non-certified priority documents	Original	2	0
		Copies of the original documents	2	2
		Other	2	0
6: Does your Office allow the submission of a privately made PDF (or other electronic copy) (e.g. by a scanner) of a priority document originally issued in paper format?	Yes	14	6	
	No	14	8	
7: In what form may the priority documents, which are issued in electronic format by the Office of first filing, be submitted to your Office?	Electronic priority documents containing an ID code which allows your Office to verify the authenticity of the document through the website of the Office of the first filing	12	5	
	Electronic priority documents without an ID code	12	5	
	Other types of electronic priority documents	12	4	



Questions	Total number of replies	Number of replies per option	
Question 8: Does your Office accept the submission of a printout of the electronic priority document instead of its original electronic version?	Yes	14	9
	No	14	5
Question 9: When answers 2(b) to (e), above, apply, by when should the holders of the international registrations submit the priority documents to your Office?	Refer to the compilation document for detailed answers.		
Question 10: Where the holder has failed to comply with the above requirements concerning the time limit, what are the consequences under the national/regional law and is there any relief measure?	No consequences since the priority documents may be submitted at a later stage (for example, during an invalidation process)	12	0
	The right of priority is lost	12	9
	The protection may be refused on the ground of lack of novelty if the first filing on which the priority is based was published prior to the filing date of the international application	12	3
	The protection may be refused on the ground of lack of novelty if the first filing on which the priority is based was published prior to the international	12	3

Questions		Total number of replies	Number of replies per option
	registration date		
	Other	12	1
	Relief measure (late filing)	12	5
<b>PART III: RESTORATION OF THE RIGHT OF PRIORITY AND ACCESSION PLANS TO THE DIGITAL ACCESS SERVICE FOR PRIORITY DOCUMENTS (DAS)</b>			
11: Where, pursuant to Article 10(2)(b) of the 1999 Act, the date of the international registration is the date on which the correction of the irregularity which relates to Article 5(2) is received by the International Bureau (i.e., the international registration date is later than the filing date of the international application), according to your national/regional legislation, would the right of priority be valid in the case where the filing date is within the six-month priority period but the international registration date is more than six months from the date of the first filing (i.e., beyond the priority period)?	Yes	31	16
	No	31	15
12: Where an international registration has a filing date, which is more than six months from the date of the first filing (i.e., beyond the priority period), is there any possibility for the holder of the international registration to make a request for restoration of the right of priority at your Office?	Yes	29	6
	No	29	23

Questions	Total number of replies	Number of replies per option	
13: By when after the expiry of the six-month priority period may the holder of the international registration make a request for restoration of the right of priority at your Office?	Refer to the compilation document for detailed answers.		
14: Does your Office participate in the WIPO Digital Access Service for Priority Documents (DAS)?	Yes, as both a Depositing Office and an Accessing Office	31	3
	Yes, as a Depositing Office	31	0
	Yes, as an Accessing Office	31	1
	No	31	27
15: If "no" was selected in the above question, does your Office have plans to participate in the DAS in the future?	Yes, within one year	28	0
	Yes, within two to three years	28	4
	Yes, within four to five years	28	3
	Yes, but no time frame or other (please specify):	28	14
	No	28	7

[End of Annex and of document]