

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

Eleventh Session
Geneva, December 12 to 14, 2022

UPDATE ON THE SITUATION OF THE 1960 ACT

Document prepared by the International Bureau

I. INTRODUCTION

1. At its eighth session, held from October 30 to November 1, 2019, 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 document H/LD/WG/8/3, entitled “Situation of the 1960 Act”.

2. The document highlighted that, of the 34 States party to the Hague Act (1960) (hereinafter referred to as the “1960 Act”), only 10 had not acceded to the Geneva Act (1999) (hereinafter referred to as the “1999 Act”) as of August 2019. Of those 10 States, eight were member States of either the African Intellectual Property Organization (OAPI) or the European Union, both of which are party to the 1999 Act; the remaining two – Morocco and Suriname – were not members of any intergovernmental organization party to the 1999 Act.

3. Following the recent accessions of Morocco and Suriname to the 1999 Act¹, the present document provides the Working Group with an update on the status of the 1960 Act, for information and, potentially, for the consideration of proactive measures to focus the Hague System solely on the 1999 Act.

¹ The 1999 Act entered into force in Morocco and Suriname on July 22, 2022, and September 10, 2020, respectively.

II. CURRENT MEMBERSHIP OF THE HAGUE AGREEMENT

4. Since the writing of document H/LD/WG/8/3 (August 2019), the number of Contracting Parties to the 1999 Act has increased from 60 to 69. In contrast, with the aforementioned accessions of Suriname and Morocco to the 1999 Act, the number of Contracting Parties exclusively bound by the 1960 Act has decreased to eight². A list of the Hague Union members and a chart presenting the number of Contracting Parties according to both Acts are provided in Annexes I and II to this document, respectively.

5. At the date of this document, the total number of Contracting Parties to the Hague Agreement stands at 77. The overall membership can be categorized as follows:

- 69 States or intergovernmental organizations are party to the 1999 Act.
- 34 States are party to the 1960 Act. Of these 34 States:
 - 26 States are also party to the 1999 Act; and
 - eight States remain party only to the 1960 Act. Of these eight States³:
 - six States, namely Benin, Côte d'Ivoire, Gabon, Mali, Niger and Senegal, are member States of OAPI, which is party to the 1999 Act; and
 - two States, namely Greece and Italy, are member States of the European Union, which is party to the 1999 Act.

6. In other words, following the recent accessions of Morocco and Suriname to the 1999 Act, no Hague Union member State falls outside the remit of the 1999 Act. This means that, taking into account that the designation of the European Union or OAPI has effect in all of their respective member States, at the date of this document, design protection can be obtained through the 1999 Act in 94 countries⁴.

III. DECREASE IN THE USE OF THE 1960 ACT VERSUS EXPANSION OF THE 1999 ACT

7. As stated in document H/LD/WG/8/3 and discussed at the eighth session of the Working Group, registration activities under the 1960 Act have diminished significantly since the entry into force of the 1999 Act, and this trend has been continuing to date. None of the 17,943 international registrations recorded between 2019 and 2021 was exclusively governed by the 1960 Act. Furthermore, of the 26,085 designations in international registrations recorded in 2021, only 415 were made under the 1960 Act, representing only 1.6 per cent of the total. Of those 415 designations, almost 68 per cent concerned Morocco⁵.

² There have been no ratifications of or accessions to the 1960 Act since 2007. The last accession to the 1960 Act was by Albania, with effect from March 19, 2007. Albania also acceded to the 1999 Act, with effect from May 19, 2007.

³ Although these eight States are not bound by the 1999 Act, since they are member States of an intergovernmental organization which is party to the 1999 Act, applicants from these States are entitled to designate Contracting Parties to the 1999 Act in international applications. *Vice versa*, protection for industrial designs in the territories of these States can be secured by designating the intergovernmental organization to which they belong under the 1999 Act.

⁴ Territorial coverage comprises the States party to the 1999 Act and States that have not acceded to the 1999 Act but are member States of the European Union or OAPI.

⁵ The remaining 32 per cent of the designations concerned Greece (33 designations), Italy (25 designations), Gabon (22 designations), Côte d'Ivoire and Senegal (15 designations each), Benin (12 designations), and Mali and Niger (six designations each). See Annex III.

8. Annex III to this document provides updated statistics on the designations of all States bound – exclusively or not – by the 1960 Act, as recorded in 2004, 2010, 2018, 2021 and the first three-quarters of 2022⁶, and shows consecutive growth in the proportion of designations made under the 1999 Act. While in 2018 the 1960 Act applied in respect of 12.2 per cent of designations of all States party to the 1960 Act, that percentage fell further to 7.9 per cent in 2021, and to 6.9 per cent only in the first three-quarters of 2022.

9. This can be explained by the rapid growth in the membership of the 1999 Act and the fact that the 1999 Act takes precedence in relations between two member States where both are parties to the 1999 and 1960 Acts (Article 31(1) of the 1999 Act). Further reasons for the decrease of the registration activities under the 1960 Act are set out in document H/LD/WG/8/3, Chapter III.

DESIGNATIONS OF MOROCCO AND SURINAME

10. Since Suriname's accession to the 1999 Act in September 2020, the number of its designations under the 1960 Act has decreased to zero, in favor of designations under the 1999 Act. This has also been the case for Belize, whose accession to the 1999 Act entered into force in February 2019. This development is repeating itself with respect to Morocco: since its accession to the 1999 Act entered into force on July 22, 2022, all designations of Morocco have been made under the 1999 Act. Consequently, the overall number of designations under the 1960 Act will decrease further in the near future.

DESIGNATIONS OF THE EUROPEAN UNION OR OAPI MEMBER STATES PARTY ONLY TO THE 1960 ACT

11. Furthermore, it appears that only a limited number of users currently designate the two European Union or six OAPI member States that are party only to the 1960 Act, instead of designating the intergovernmental organization to which those States belong. Of the 5,755 international registrations recorded in the first three-quarters of 2022:

- only 16 (held by three holders) contained the designation of Benin, Côte d'Ivoire, Niger or Senegal, without OAPI being designated in the same international registration⁷; and,
- only 37 (held by 10 holders) contained the designation of Greece or Italy, without the European Union being designated in the same international registration⁸.

IV. COMPLEXITY DUE TO THE PERSISTENCE OF THE 1960 ACT

12. The coexistence of the 1960 and 1999 Acts adds to the complexity of the Hague System, since, for instance, an international application may be subject to different requirements depending on the Act governing each of the designations contained therein.

13. A number of different conditions are set out in the Common Regulations Under the 1999 Act and the 1960 Act of the Hague Agreement (hereinafter referred to as the "Common Regulations"), in connection with the application of those Acts. A detailed analysis of the application of specific provisions and the complexity of the situation is contained in document H/LD/WG/8/3, Chapter IV.

14. This complexity, resulting from the coexistence of the two Acts, not only causes extra work, thus increasing management costs at the International Bureau, but is also likely to make the Hague System less attractive to users seeking design protection.

⁶ See also Annex IV for the 2022 figures.

⁷ Gabon and Mali were not once designated in an international registration without OAPI being designated in the same international registration.

⁸ It is recalled that the designation of the European Union and OAPI has effect in all of their respective member States.

V. POSSIBLE WAY FORWARD

15. It is recalled that, in order to reduce the complexity of the Hague System, the Contracting States to the London Act (1934) of the Hague Agreement Concerning the International Deposit of Industrial Designs (hereinafter referred to as “the 1934 Act”) decided in an Extraordinary Meeting on September 24, 2009, to freeze the application of the 1934 Act, with effect from January 1, 2010⁹. In this context, the Contracting Parties agreed on the need to center the Hague System around the 1999 Act¹⁰.

16. It appears that the relevance of the 1960 Act has diminished to such an extent that Contracting Parties could consider freezing the application of the 1960 Act from a certain time in the future. The effect of such a freeze would be that no new designation under the 1960 Act may be recorded in the International Register; however it would be without prejudice to the continuation of active international registrations recorded in the International Register before the effective date of the freeze¹¹. The freeze would also prevent new countries from ratifying or acceding to the 1960 Act. However, the States party to the 1960 Act would remain bound by it and continue to be members of the Hague Union.

17. The freeze of the application of the 1960 Act would be a further step towards a streamlined modern design protection system that is governed by a single Act.

18. *The Working Group is invited to take note of the content of the present document and discuss the possible way forward.*

[Annexes follow]

⁹ Article 57 of the Vienna Convention on the Law of Treaties provides that “the operation of a treaty in regard to all the parties or to a particular party may be suspended: (a) in conformity with the provisions of the treaty; or (b) at any time by consent of all the parties after consultation with the other contracting States”.

¹⁰ See documents H/EXTR/09/1 and 2, and H/A/28/3 and 4 (paragraphs 7 to 11). Furthermore, the termination of the 1934 Act became effective on October 18, 2016 (see Information Notice No 10/2016, available at https://www.wipo.int/edocs/hagdocs/en/2016/hague_2016_10.pdf).

¹¹ More precisely, the renewal of those designations and any recordings in the International Register provided for under the Common Regulations would remain possible throughout the life of a given international registration up to the maximum duration of protection provided for by the national law of the designated Contracting Party (Article 11(2) of the 1960 Act).

HAGUE UNION MEMBERS¹

Bound by the 1999 Act only

African Intellectual Property Organization (OAPI), Armenia, Azerbaijan, Belarus, Bosnia and Herzegovina, Botswana, Brunei Darussalam, Cambodia, Canada, China, Denmark, Egypt, Estonia, European Union, Finland, Ghana, Iceland, Israel, Jamaica, Japan, Latvia, Lithuania, Mexico, Namibia, Norway, Oman, Poland, Republic of Korea, Russian Federation, Rwanda, Samoa, San Marino, Sao Tome and Principe, Singapore, Spain, Syrian Arab Republic, Tajikistan, Tunisia, Türkiye, Turkmenistan, United Kingdom, United States of America and Viet Nam (43)

Bound by the 1999 and 1960 Acts

Albania, Belgium, Belize, Bulgaria, Croatia, Democratic People's Republic of Korea, France, Georgia, Germany, Hungary, Kyrgyzstan, Liechtenstein, Luxembourg, Monaco, Mongolia, Montenegro, Morocco, Netherlands, North Macedonia, Republic of Moldova, Romania, Serbia, Slovenia, Suriname, Switzerland and Ukraine (26)

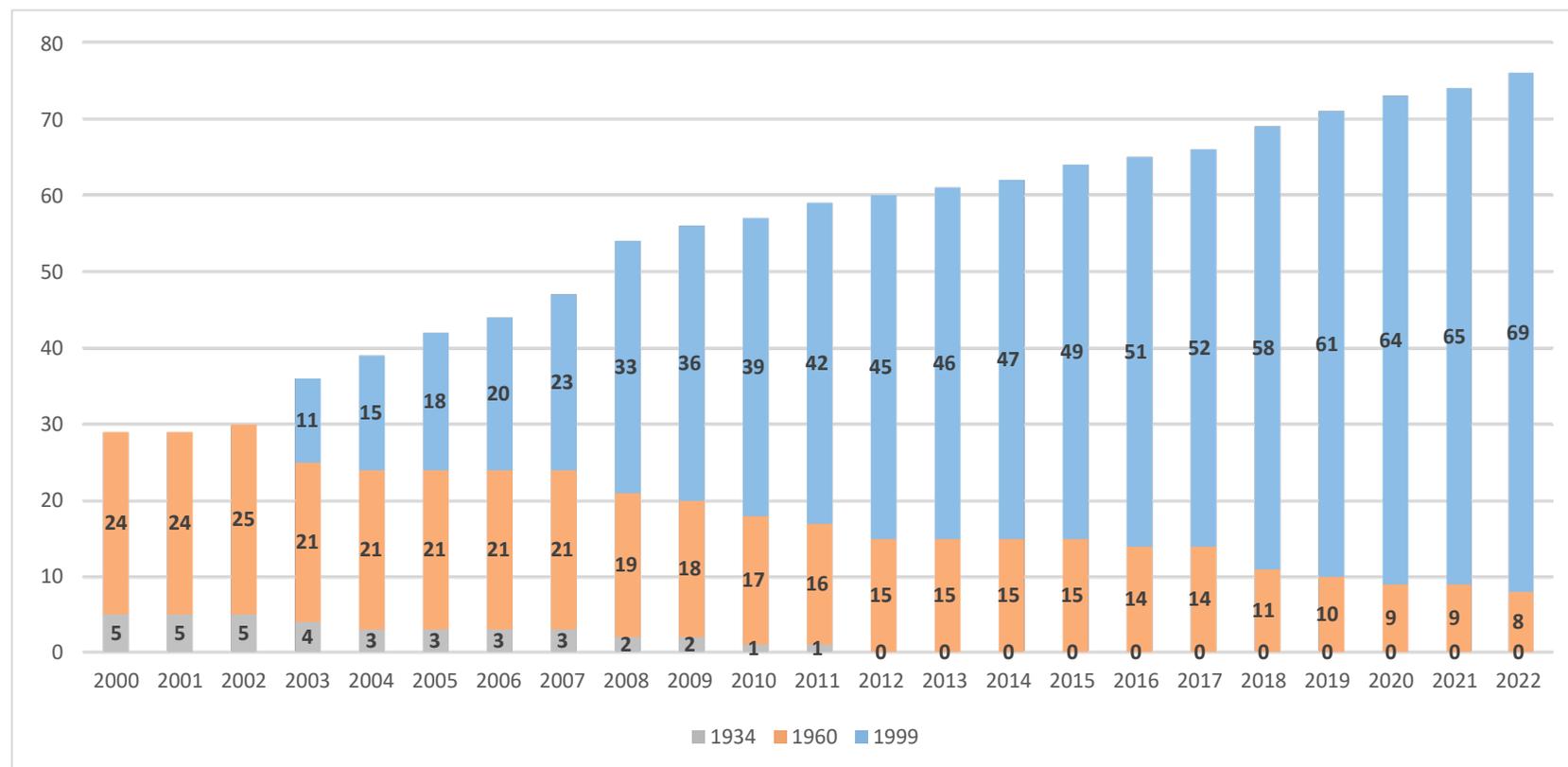
Bound by the 1960 Act only

Benin², Côte d'Ivoire³, Gabon⁴, Greece⁵, Italy⁶, Mali⁷, Niger⁸ and Senegal⁹ (8)

[Annex II follows]

¹ List of members as of October 1, 2022, grouped according to the Act or Acts by which they are bound.
² Member State of OAPI.
³ Member State of OAPI.
⁴ Member State of OAPI.
⁵ Member State of the European Union.
⁶ Member State of the European Union.
⁷ Member State of OAPI.
⁸ Member State of OAPI.
⁹ Member State of OAPI.

DEVELOPMENT OF THE HAGUE UNION MEMBERSHIP FROM 2000 TO 2022 BY ACT *



[Annex III follows]

* List of members as of October 1, 2022.

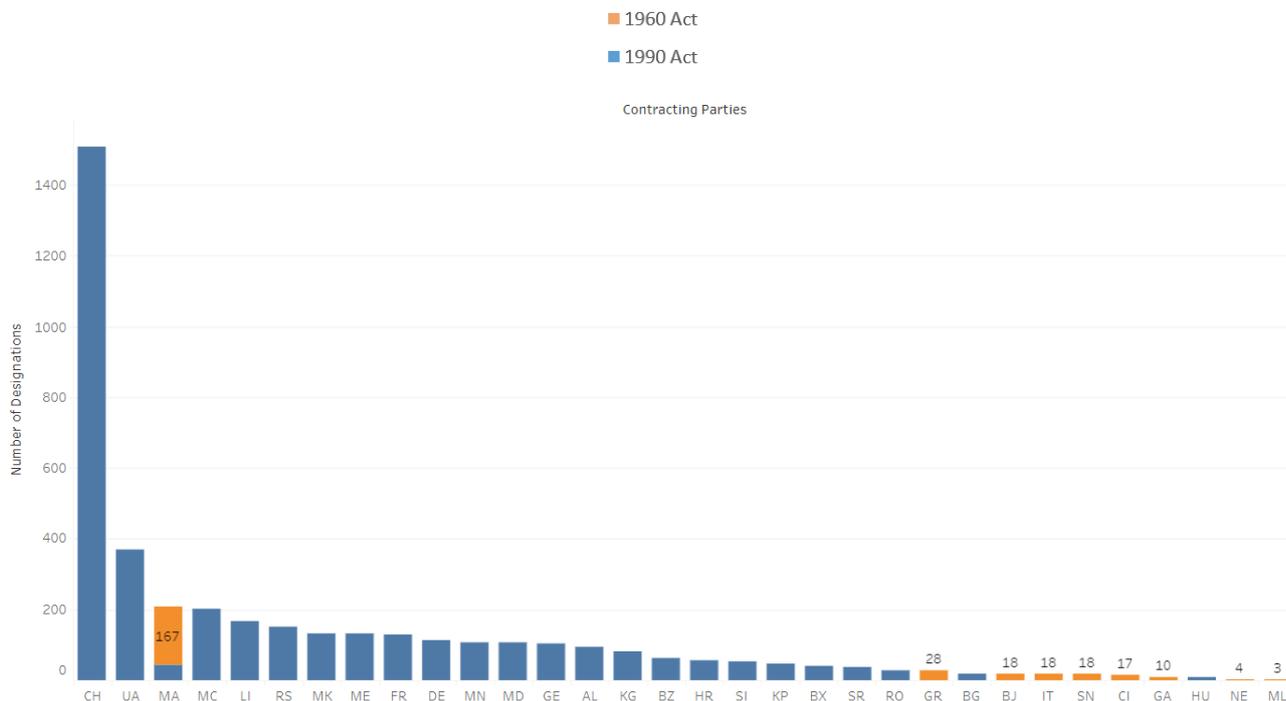
DESIGNATIONS OF CONTRACTING PARTIES TO THE 1960 ACT, AS RECORDED IN 2004, 2010, 2018, 2021 AND THE FIRST THREE-QUARTERS OF 2022, BY APPLICABLE ACT

Number of designations under each Act by Contracting Parties to the 1960 Act										
Designated Contracting Party	2004		2010		2018		2021		2022	
	60	99	60	99	60	99	60	99	60	99
Albania			0	176	0	133	0	137	0	95
Belize	222		98		42		0	79	0	64
Benelux	919		111		55		0	63	0	41
Benin	39		8		13		12		18	
Bulgaria	472		0	23	0	63	0	34	0	19
Côte d'Ivoire	65		13		16		15		17	
Croatia	111	142	1	463	0	57	0	84	0	57
Dem. People's Rep. of Korea	385		69		0	43	0	45	0	46
France	931		7	145	1	173	0	211	0	131
Gabon	112		11		14		22		10	
Georgia	57	223	0	203	0	111	0	135	0	105
Germany	956		28	116	1	163	0	154	0	114
Greece	582		55		51		33		28	
Hungary	301		0	39	0	23	0	19	0	9
Italy	963		115		54		25		18	
Kyrgyzstan	23	214	0	132	0	77	0	107	0	83
Liechtenstein	131	330	1	303	0	194	0	180	0	169
Mali			8		4		6		3	
Monaco	476		317		0	227	0	235	0	201
Mongolia	240		1	165	0	82	0	101	0	109
Montenegro			251		0	168	0	182	0	133
Morocco*	443		323		318		281		167	43
Niger	1		5		3		6		4	
North Macedonia	440		0	325	0	161	0	161	0	134
Republic of Moldova	143	231	0	184	0	102	0	125	0	107
Romania	302	243	0	25	1	92	0	93	0	29
Senegal	59		11		14		15		18	
Serbia	510		0	225	0	192	0	205	0	153
Slovenia	225	253	0	69	0	60	0	79	0	53
Suriname	50		14		16		0	29	0	38
Switzerland	785	416	3	1,508	2	1,705	0	1,835	0	1,507
Ukraine	208	258	0	509	0	521	0	522	0	371
Total	10,151	2,310	1,450	4,610	605	4,347	415	4,815	283	3,811
Total number of designations (both Acts)	12,461		6,060		4,952		5,230		4,094	
Distribution by Act	81.5%	18.5%	23.9%	76.1%	12.2%	87.8%	7.9%	92.1%	6.9%	93.1%

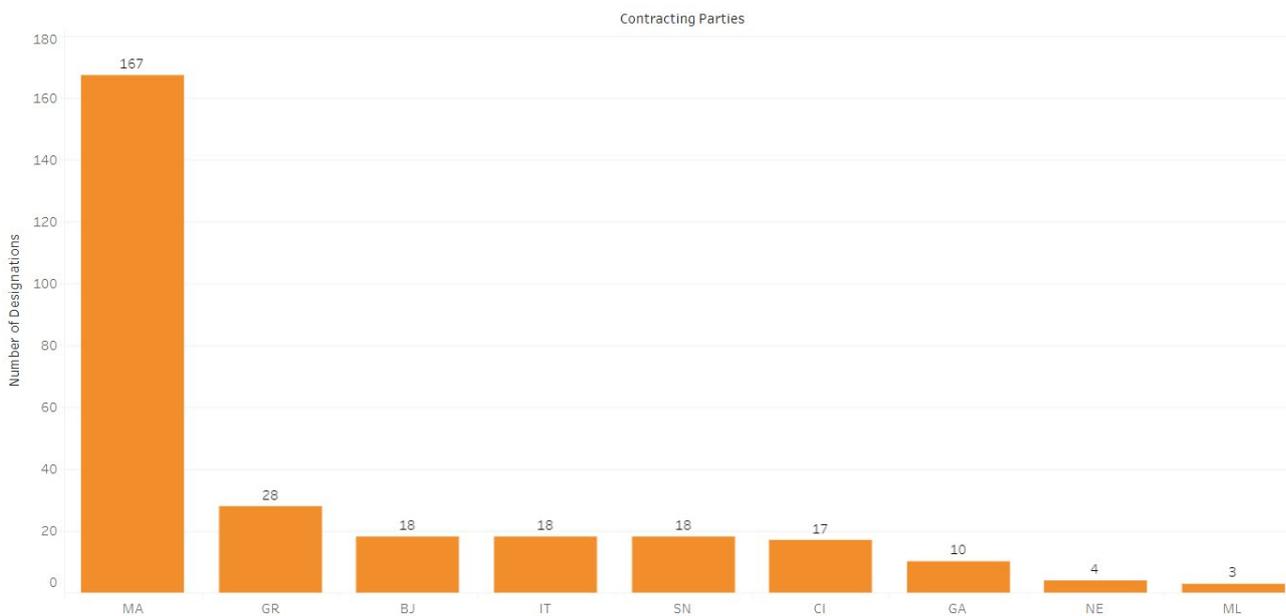
[Annex IV follows]

* The 1999 Act entered into force with respect to Morocco on July 22, 2022.

**DESIGNATIONS OF CONTRACTING PARTIES TO THE 1960 ACT,
AS RECORDED IN THE FIRST THREE-QUARTERS OF 2022, BY APPLICABLE ACT**



**DESIGNATIONS OF CONTRACTING PARTIES UNDER THE 1960 ACT ONLY,
AS RECORDED IN THE FIRST THREE-QUARTERS OF 2022**



[End of Annex IV and of document]