

## Managing an International Registration

International Symposium on the 15<sup>th</sup> Anniversary of the Geneva (1999) Act of the Hague Agreement Concerning the International Registration of Industrial Designs: International Design Registrations Go Global

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# Introduction

Managing an international registration is...

- a major advantage of the Hague system
- easy and centralized:
  - **ONE** request
  - **ONE** language
  - **ONE** payment of **ONE** set of fees
  - **ONE** currency (Swiss francs)
  - **ONE** « Office » (= the International Bureau of WIPO)

# What are the Post-Registration Procedures?

- Change in name and/or address of the holder
- Appointment, change or cancellation of representative
- Renewal
- Change in ownership
- Renunciation
- Limitation

# Change in Name and/or Address of the Holder

- **Article 16(1)(ii) of the Hague Agreement**
- **Rule 21 of the Common Regulations under the 1999 Act and 1960 Act**
  - Form DM/6
    - Request shall be presented and signed by the holder
  - Contents
    - the number of the international registration concerned
    - the name of the holder as recorded
    - the change in name and/or address of the holder
    - the number of the international registration concerned

# Appointment, Change or Cancellation of Representative

- **Article 16(1)(iii) of the Hague Agreement**
- **Rules 3 and 21 of the Common Regulations under the 1999 Act and 1960 Act**
  - Form DM/7; DM/8; DM/9
    - Request shall be signed by the holder

**Official forms are not necessary**

# Requirements

- Rule 3 of the Common Regulations
- The applicant may have a representative before the International Bureau → **NOT** mandatory
- The rule relates to the representation before the International Bureau → **NOT** the representation before the Offices
- Who may be appointed as a representative?
  - NO requirement as to professional qualification
  - NO requirement as to nationality
  - NO requirement as to domicile

# ■ RENEWAL

# Article 17 of the Hague Agreement Rules 23 and 24 of the Common Regulations

## ■ Duration of protection under the 1960 and the 1999 Acts

- Initial term: five years

- Minimum duration:

  - 1960 Act: 10 years (5 + 5)

  - 1999 Act: 15 years (5 + 5 + 5)

- May be renewed up to the maximum duration in accordance with the national law (see declarations of CPs)



# Procedure

- Unofficial expiry notice sent six months prior to the expiry date to the holder and the recorded representative, if any
- Payment: by the expiry date (if paid earlier than three months before the expiry date, it shall be considered as having been paid three months before the date)
- Grace period: within six months after the expiry date (+ surcharge of fees to be paid)

# Paper Form or Electronic Form

- Paper form: form DM/4
- **E-renewal** interface:
  - Online service (launched in December 2010)
  - Easy to use – More than 60% of the international registrations are currently renewed through the E-renewal interface
    - [https://webaccess.wipo.int/erenewal\\_dm/erenewal.jsp?lang=EN](https://webaccess.wipo.int/erenewal_dm/erenewal.jsp?lang=EN)
  - Online payment (current account or credit card)

# Scope

- Renewal **NOT possible** for those CPs and/or for those designs subject to:
  - a renunciation recorded in the International Register
  - a limitation recorded in the International Register
  - an invalidation recorded in the International Register
  
- Renewal **possible** for a CP in case of refusal recorded in the International Register

# Scope

- May be renewed:
  - for SOME of the designated CPs only
  - for SOME of the designs only

Designated CP	Design 1	Design 2	Design 3
Switzerland	√	√	
EU	√	√	
Turkey			

- E-renewal: « tailor-made » renewal

Designated CP	Design 1	Design 2	Design 3
Switzerland	√	√	√
EU	√	√	
Turkey	√		√

## ■ CHANGE IN OWNERSHIP

# Article 16(i) of the Hague Agreement Rules 21 and 21 *bis* of the Common Regulations

- Form DM/2
- The Hague Agreement deals only with the recording of the change → the validity of an assignment agreement is outside its scope
  - The request can be presented by the holder OR the *new* owner, provided that:
    - the request is signed by the holder, or
    - the request is signed by the *new* owner and accompanied by an attestation from the competent authority of the holder's CP that the new owner appears to be the successor in title of the holder

# Entitlement

- The *new owner* must be **entitled** to file an international application
- There must be a **common treaty** between the CP(s) of the *new owner* and each designated CPs
- The *new owner* needs a **connection** with a CP through:
  - Nationality
  - Domicile
  - Real and effective industrial or commercial establishment
  - Habitual residence (under the 1999 Act only)

# Example No. 1

■ Is there a problem in this case?

**Current holder**



1960 Act



1999 Act

**State member of  
the EU**

**Designated CPs**



1999 Act



1960/1999 Acts



1999 Act

**New owner**



1960 Act



# Example No. 2

■ Is there a problem in this case?

**Current holder**



1960 Act



1999 Act

**Member State of  
the EU**

**Designated CPs**



1999 Act



1960/1999 Acts



1999 Act

**New owner**



1999 Act

# Change in Ownership – Scope

■ Total: assignment of the whole IR

■ Partial: assignment of part of the IR

- some CPs

Designated CP	Design 1	Design 2	Design 3
Switzerland			
EU	√	√	√
Turkey			

- some designs

Designated CP	Design 1	Design 2	Design 3
Switzerland			√
EU			√
Turkey			√

- « tailor-made »

Designated CP	Design 1	Design 2	Design 3
Switzerland		√	
EU		√	
Turkey			

# Follow-Up Procedure

- **New Rule 21 *bis*** adopted by the Hague Union Assembly - Entry into force: January 1, 2012.
- Mechanism to allow CP to refuse the effects of the recording of a change in ownership in the International Register, where such a recording is not allowed under their national/regional laws.
- Declaration sent by the Office to the International Bureau will be recorded in the International Register and notified to the previous holder (transferor) and the new holder (transferee) accordingly.
- The part of the international registration which is the subject of the declaration will be recorded as a separate international registration that will “remain” in the name of the previous holder (transferor).

## ■ RENUNCIATION

# Article 16(iv) of the Hague Agreement Rule 21 of the Common Regulations

- Form DM/5
- Concerns **ALL** designs
  - May be partial → for only **SOME** of the designated CPs

Designated CP	Design 1	Design 2	Design 3
Switzerland			
<del>EU</del>			
Turkey			

- May be total → for **ALL** designated CPs

Designated CP	Design 1	Design 2	Design 3
<del>Switzerland</del>			
<del>EU</del>			
<del>Turkey</del>			

■ LIMITATION

# Article 16(v) of the Hague Agreement Rule 21 of the Common Regulations

- Form DM/3
- Concerns only **SOME** of designs
  - May concern **ALL** designated CPs

Designated CP	Design 1	Design 2	Design 3
Switzerland			
EU			
Turkey			

- May concern only **SOME** of the designated CPs

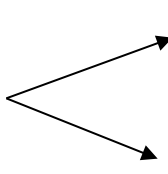
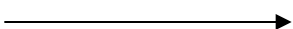
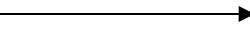
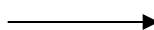
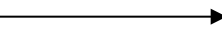
Designated CP	Design 1	Design 2	Design 3
Switzerland			
EU			
Turkey			

## ■ SUMMARY



# Summary: Post-Registration Procedures

The holder may request:

- reduction of the scope of the IR 
  - **Renunciation**
  - **Limitation**
- prolongation of the IR 
  - **Renewal**
- transfer IR to new owner 
  - **Change in Ownership**
- update information about the holder 
  - **Change in name and/or address of the holder**
- representation before the International Bureau 
  - **Appointment, change or cancellation of representative**

**THANK YOU!**

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