

## Refusals and Grants of Protection

**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**

Hiroshi Okutomi, Legal Officer  
Legal Section, The Hague Registry

Geneva  
June 19, 2014

# Topics Addressed

- International Publication
- Refusal and other office actions
- Effects of an international registration

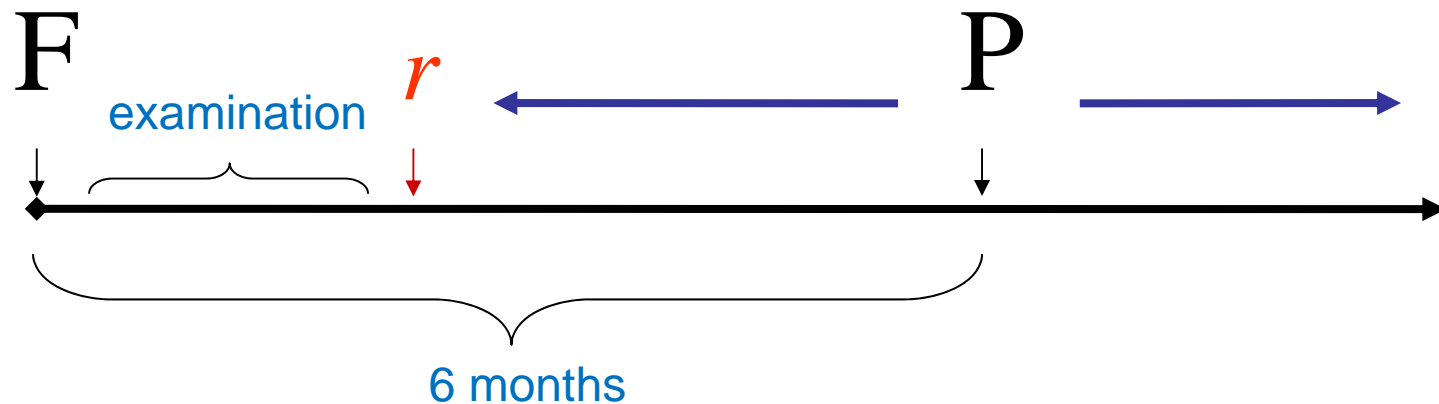
## ■ INTERNATIONAL PUBLICATION

# Publication

## *International Designs Bulletin*

- Published “weekly” on WIPO’s website
- Data is downloadable through WIPO server.
- International publication takes the place of national publication (Article 10(3)(a) of the 1999 Act).
- Refusal period starts from the date of publication (Rules 18(1)(a) and 26(3)).

# Timing of Publication



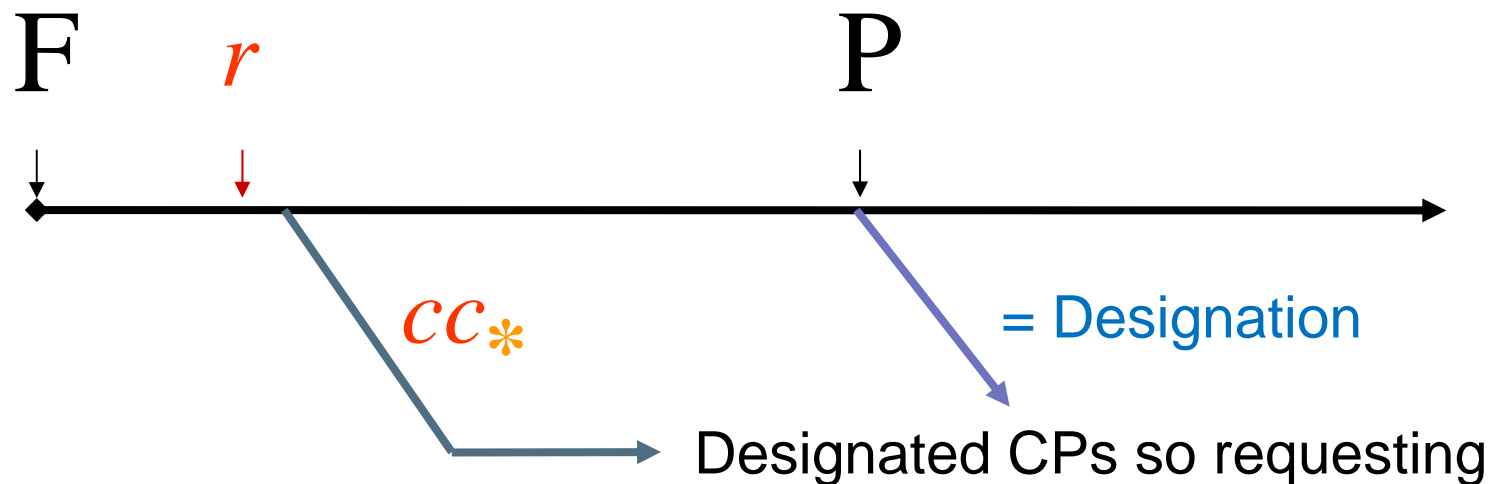
Standard: 6 months

Possibility of immediate publication

Possibility of deferment up to 30 months \*  
(counted from filing date or priority date)

\* Under the 1999 Act only

# Confidential Copies – 1999 Act



- \* Confidential Copies to be sent immediately after registration (Article 10(5))

# Confidential Copies – 1999 Act

- Office simply notifies the IB of its wish to receive confidential copies of any IR designating that CP.
- Can only be used for examination purposes.
- However, must be kept in confidence until its publication by the IB.

## ■ REFUSAL AND OTHER OFFICE ACTIONS



# Office Actions

- Refusal
- Withdrawal of Refusal
- Statement of Grant of Protection
- Invalidation

# Refusal: Basic Principles

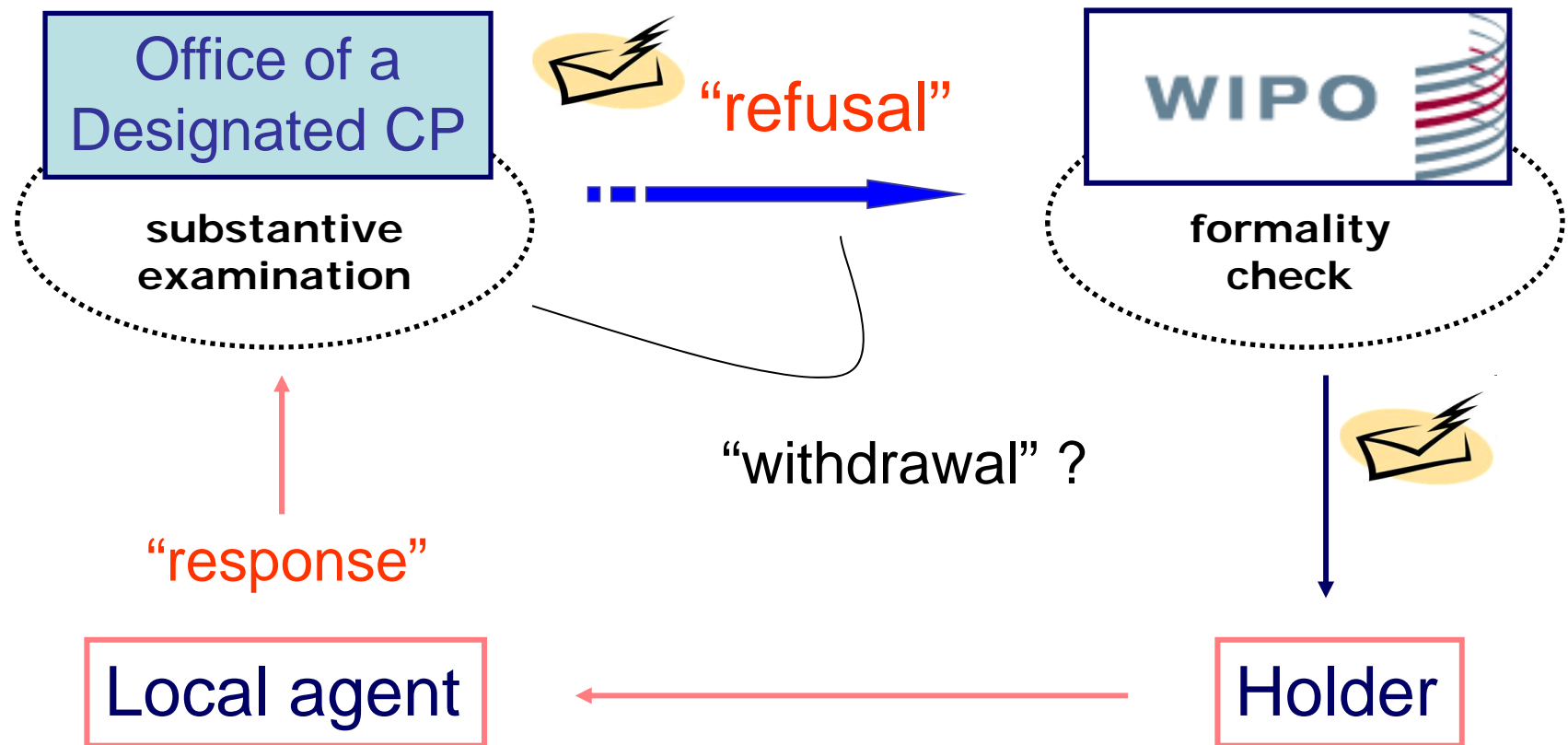
- **Within refusal period:** starting from the date of publication
- **Provisional objection:** which may become a **final decision**, without further notification
- Languages: English, French or Spanish
- Total (for all the designs) or partial (for some of the designs only)

# Refusal: Time Frame

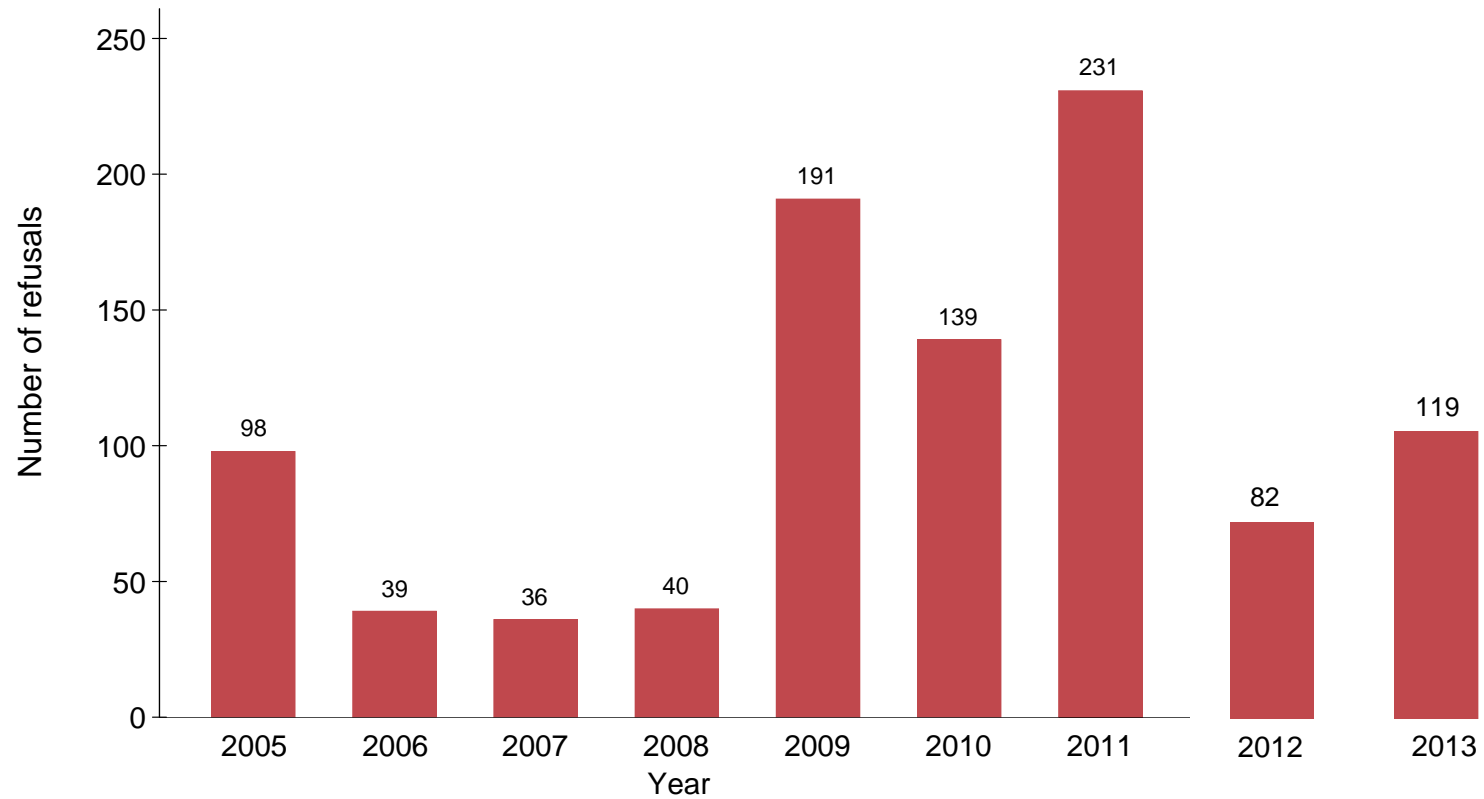
- Principle: **6 months** (Article 8(1) of the 1960 Act, Article 12(2) of the 1999 Act and Rule 18(1)(a))
- Exceptions (**the 1999 Act only**) (Rule 18(1)(b)): (which may be opted for by a Contracting Party whose Office is an “**Examining Office**” or whose law provides for an **opposition procedure**)

The period may be extended up to **12 months**

# Refusal Mechanism



# Statistics – Total Number of Refusals



Source: WIPO Statistics Database

## Refusal Ground: no formal ground

- Principle:  
substantive grounds only (incl. opposition)
  
  - Exceptions:
    - specific views of the design not furnished  
(Rule 9(3)(a)) \*
    - requirement as to unity of design (Article 13) \*
- \* Declarations possible only under the 1999 Act

# Specific views: Declaration under Rule 9(3)(a)

## International Bureau

**No requirement** as to the types of views. A single reproduction is enough.

One perspective view

Front view + top view + right side view

Front view + one perspective view

etc.

## The law of the CP

If the law provides for certain types of views that must be submitted, **the CP may specify, in the declaration, the views required and the circumstances in which they are required.**

Six orthographic views

(Front view + Top view + Right side view + Left side view + Rear view + Bottom view)

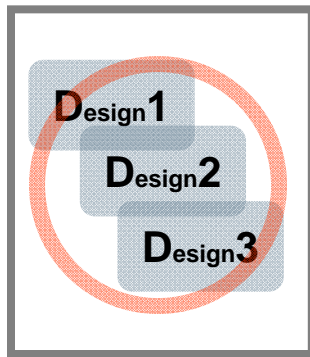
Two perspective views showing a whole appearance of the product

etc.

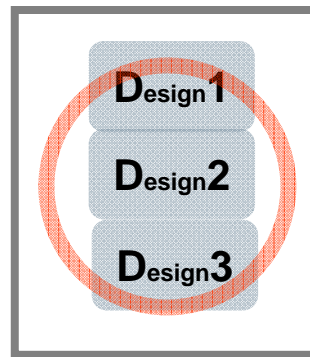


# Unity of design: Declaration under Article 13(1)

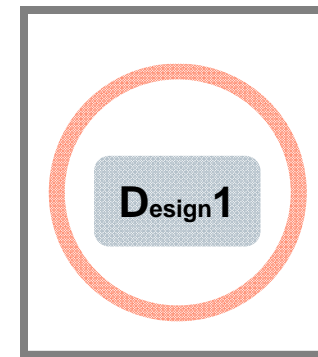
If the applicable law provides for any of the following types of requirement at the time it becomes party to the 1999 Act



Each of the designs must conform to a requirement of **unity of design, unity of production or unity of use** (have a similarity in appearance, production or use of the product)



Each of the designs must **belong to a set of products**



**Only one design** may be the subject of a single application

The CP may make a declaration under Article 13(1) of the 1999 Act.

The CP may issue a refusal if the specified requirement is not complied.

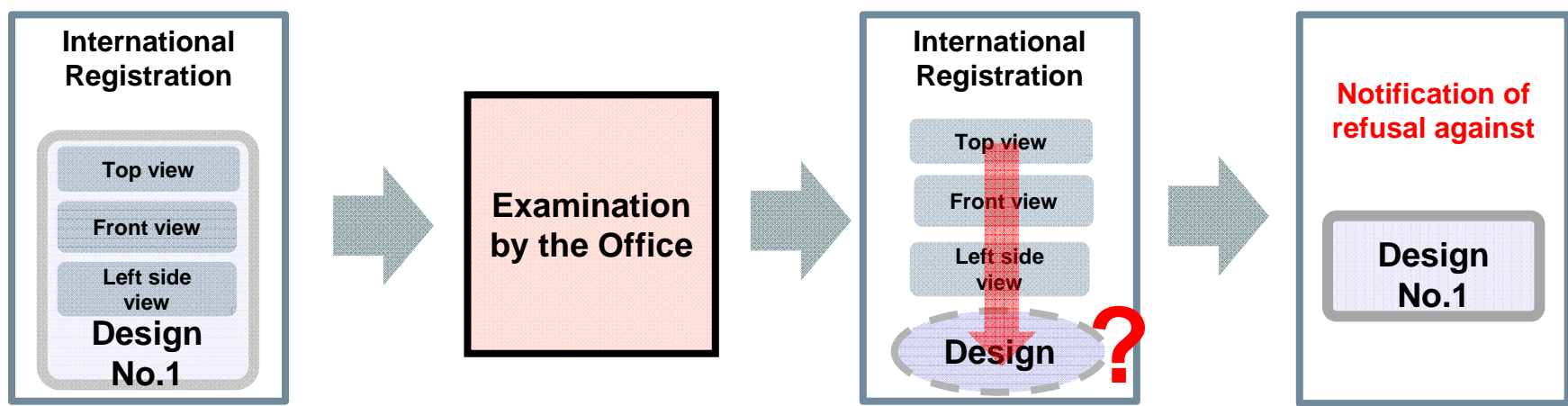


## Refusal Ground: typical substantive grounds

- Definition of an industrial design
  - Type of design not protected (*ex. “logo”*)
  - Disclosure insufficient to figure out the design
- Public order and morality
- Creativity / Non-obviousness
- Conflict with prior applications / registrations
- Novelty

# Refusal ground; insufficient disclosure (Rule 9(4))

- A CP **may not issue a refusal** on the ground that requirements relating to the form of the reproduction that are additional to, or different from, those specified in the declaration under Rule 9(3)(a) have not been satisfied.
- However, it **may issue a refusal** on the ground that the reproductions contained in the international registration do not sufficiently disclose the industrial design.



## Withdrawal of Refusal / SGP

- Refusal may be withdrawn, totally or partially.  
Notification of withdrawal of refusal (Rule 18(4))
  
- Withdrawal of refusal may take the form of:  
Statement of grant of protection (Rule 18bis (2))
  
- Statement of grant of protection may be issued even where no refusal (Rule 18bis (1)).
  - *within the applicable refusal period*
  - *optional but recommended*

## Withdrawal of refusal / SGP: under new rules

Subject to adoption by the Hague Assembly (change from January 1, 2015)

■ Where [amendments](#) are made to the design in a procedure before the Office, and the design as amended is accepted, a statement of grant of protection (or notification of withdrawal of refusal) [must](#) be sent, with [the information concerning the amendments](#) (proposed new Rules 18(4) and 18*bis* (1) and (2)).

■ Information concerning the amendments will be made [publicly available by the IB](#), through the Bulletin.

## Withdrawal of refusal / SGP: under new rules

Subject to adoption by the Hague Assembly (change from January 1, 2015)

- Where the Contracting Party has made [a declaration under Rule 18\(1\)\(c\)\(i\) or \(ii\)](#), a statement of grant of protection must always be sent (proposed new Rule 18*bis* (1)).
- SGP (or notification of withdrawal of refusal) shall contain “[the date on which the IR produced \(or shall produce\) the effect as a grant of protection](#)” (proposed new Rules 18(4) and 18*bis* (1) and (2)).

# Invalidation

- **Office or court decision** which is made after producing protection (Rule 19)
- Remarks:
  - Outside the “Refusal” mechanism
  - “Post-grant opposition” included
  - Opportunity to defend the right
  - Only the **final decision**

## ■ EFFECTS OF INTERNATIONAL REGISTRATION

# Effects of an International Registration

- Horizontally (as many as designations):
  - Same effects as **under the applicable law** (*Article 14(1) and (2)*)
  
- Vertically (from filing to registration):
  - Effect as **application** (*Article 14(1)*) , plus ?
  - Effect as **grant of protection (registration)** (*Article 14(2)(a) and (b)*)



# Effects of an IR under the 1999 Act

- After publication (Article 14(1))  
= effects *as application* from the date of IR, *at least*
- If no refusal is notified (Article 14(2)(a))  
= effects *as a grant of protection*, in principle, *at the latest from the expiry date of the applicable refusal period (6 or 12 months)*
- If the refusal is withdrawn (Article 14(2)(b))  
= effects *as a grant of protection at the latest from the date on which the refusal was withdrawn*

# Effects of an IR under the 1999 Act

- “Two exceptions” to Article 14(2)(a)

*applicable through an additional declaration by a CP (whose Office is an “Examining Office” or whose law provides for an opposition procedure) opting for 12-month refusal period*

- Option 1 (Rule 18(1)(c)(i))

*The latest time at which protection must be granted may be extended up to 6 months after the expiry date of the 12-month refusal period*

# Effects of an IR under the 1999 Act

- “Two exceptions” to Article 14(2)(a) - *continued*

- Option 2 (Rule 18(1)(c)(ii))

Protection will be granted according to the law of the Contracting Party where a decision regarding the grant of protection was unintentionally not communicated within the applicable refusal period.

= *Protection can be granted even after the refusal period, but only in limited circumstances.*



**WIPO | HAGUE**

The International  
Design System

**THANK YOU!**