



WIPO | HAGUE

The International
Design System

■ Managing in International Registration

**Seminar on the Hague System for the
International Registration of Industrial
Designs: Practical Approach and How to
Use It**

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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)

Types of Changes

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

■ RENEWAL

Article 17 of the 1999 Act

Article 11 of the 1960 Act

Rules 23-25 of the Common Regulations

Renewal

- **Paper form: DM/4**

- **E-renewal service**

- Launched in December 2010

- Easy to use – around 70% of the international registrations are renewed through E-renewal interface

- https://webaccess.wipo.int/erenewal_dm/IndexController?lang=EN

- Automatically calculate the renewal fees

- Online payment (current account or credit card)

Renewal

■ Duration of Protection

- Initial term: five years

- Minimum duration

 - 1960 Act: 10 years (5 + 5)

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

- maximum duration in each CPs:

 - (see declarations of CPs:

 - <http://www.wipo.int/hague/en/declarations/declarations.html>)

Procedure for Renewal

- **Unofficial expiry notice** (6 months before)
- **Contents of the request**
 - international registration number
 - name and address of the holder
 - scope of renewal
 - signature
 - payment of fees
- **Grace period:** within six months after the expiry date (additional surcharge)

Scope of Renewal

- **Total renewal**

- **Partial renewal**

- for SOME of the designated CPs only
- for SOME of the designs only

- **E-renewal:** « tailor-made » renewal

| Designated CPs | Design 1 | Design 2 | Design 3 |
|----------------|----------|----------|----------|
| Designated CPs | Design 1 | Design 2 | Design 3 |
| CH | ✓ | | ✓ |
| EM | | ✓ | |
| TR | | ✓ | ✓ |

Scope of Renewal

- **NOT POSSIBLE** for CPs and/or for designs subject to:
 - a renunciation
 - a limitation
 - an invalidation

- **POSSIBLE** for a CP regardless:
 - maximum period of protection has expired
 - a refusal is recorded

■ CHANGE IN NAME AND/OR ADDRESS OF THE HOLDER

Article 16(1)(ii) of the 1999 Act
Rules 21 of the Common Regulations

Procedure

- **Request form: DM/6 (mandatory)**
 - international registration number
 - name of the holder recorded
 - the change in name and/or address of the holder
 - signature
 - payment of fees

■ APPOINTMENT, CHANGE OR CANCELLATION OF REPRESENTATIVE

Article 16(1)(iii) of the 1999 Act
Rules 3 and 21 of the Common Regulations

Appointment, change or cancellation of representative

■ Request form:

- appoint a representative: DM/7
- change in name and/or address: DM/8
- cancel a recorded representative: DM/9
 - canceled *ex officio* where a new representative has been appointed;
 - canceled *ex officio* where a change of ownership has been recorded

■ No fee applies

■ CHANGE IN OWNERSHIP

Article 16(1)(i) and (2) of the 1999 Act

Article 12 of the 1960 Act

Rules 21-21*bis* of the Common Regulations

Change in Ownership

- **Request form:** DM/2 (mandatory)
- **Who can present the request?**
 - presented and signed by the holder;
 - presented by the *new owner*, provided that:
 - signed by the holder, or
 - signed by the **new owner** + **attestation** from competent authority of the holder's CP that the new owner appears to be the successor in title of the holder

Change in Ownership

- Contents of the request:
 - international registration number
 - name of the holder recorded
 - name and address of the *new* owner
 - entitlement of the *new* owner
 - scope of change
 - must be signed by the holder
 - payment of fees

Entitlement of the new owner

- The *new* owner must be **entitled** to file an international application
 - Nationality
 - Domicile
 - Real and effective industrial or commercial establishment
 - Habitual residence (the 1999 Act only)

- There must be a **common treaty** between the *new* owner's CP(s) and each designated CP

Example 1

■ Can the new owner be recorded as the new holder?

Current holder



1960 Act

a member of EU

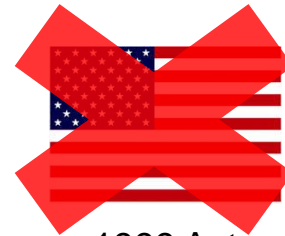


1999 Act

Designated CPs



1960/1999 Acts



1999 Act

New owner



1960 Act



1960 Act



1999 Act

Example 2

■ Can the new owner be recorded as the new holder?

Current holder



1960 Act

a member of EU



1999 Act

Designated CPs



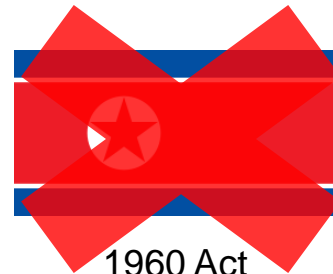
1999 Act



1960/1999 Acts



1999 Act



1960 Act

New owner



1999 Act

Change in Ownership – Scope

■ Total change

■ Partial change

- for SOME of the designated CPs only
- for SOME of the designs only
- « tailor-made » change

| Designated CPs | Design 1 | Design 2 | Design 3 |
|----------------|----------|----------|----------|
| Designated CPs | Design 1 | Design 2 | Design 3 |
| CH | | ✓ | |
| EM | | ✓ | |
| TR | | | |

Change in Ownership has **NO** Effect

■ **Article 16(2) of the 1999 Act**

- has NO effect in a CP until the Office received the statements or documents specified in the declaration

➤ *OAPI, DK, KR, US*

- recording of a partial change in ownership is NOT allowed

■ **Rule 21bis Declaration**

- Declaration must be sent to the IB within 6 months
- IR concerned shall remain in the name of the transferor
- IB records the Declaration and modify the IR
- IB notifies transferor and transferee



6 SCOPE OF THE CHANGE IN OWNERSHIP (check either (a) or (b))

(a) TOTAL CHANGE IN OWNERSHIP (the change in ownership is to be recorded for **all** the Contracting Parties designated in the international registration(s) indicated in item 1, and for **all** the industrial designs included in such international registration(s));

(b) PARTIAL CHANGE IN OWNERSHIP

(i) the change in ownership is to be recorded for the designated Contracting Parties indicated below (if no Contracting Party is indicated, it will be understood that the change in ownership is to be recorded in respect of all the designated Contracting Parties), and/or

.....
.....
.....
.....

(ii) the change in ownership is to be recorded for the designs indicated below (indicate only the number of the designs); if no designs are indicated, it will be understood that the change in ownership is to be recorded in respect of all designs:

.....
.....
.....
.....

7 PREFERRED LANGUAGE FOR CORRESPONDENCE

The new owner (transferee) may choose a preferred language for correspondence:

English French Spanish

8 SIGNATURE AND/OR SEAL
(read note 1 on cover page)

(a) Identify the signatory by checking the appropriate box:

- | | |
|---|--------------------------|
| (i) Holder (transferor) | <input type="checkbox"/> |
| (ii) Representative of the holder (transferor) | <input type="checkbox"/> |
| (iii) New owner (transferee) | <input type="checkbox"/> |
| (iv) Representative of the new owner (transferee) | <input type="checkbox"/> |

(b) Name:

(c) Signature and/or seal:

(d) Date of signature (dd/mm/yyyy):

Name of the person to contact, if necessary:

■ RENUNCIATION

Article 16(1)(iv) of the 1999 Act
Rule 21 of the Common Regulations

Renunciation

- **Request form: DM/5 (mandatory)**
 - international registration number
 - name of the holder recorded
 - concerned designated CP(s)
 - signature
 - payment of fees
- Always concerns **ALL** designs
- May relate to **SOME** or **ALL** designated CPs

Renunciation

- Total renunciation:
 - ALL designated CPs

| Designated CPs | Design 1 | Design 2 | Design 3 |
|----------------|----------|----------|----------|
| CH | ✓ | ✓ | ✓ |
| EM | ✓ | ✓ | ✓ |
| Designated CPs | Design 1 | Design 2 | Design 3 |
| CH | ✓ | ✓ | ✓ |
| EM | ✓ | ✓ | ✓ |
| TR | ✓ | ✓ | ✓ |

■ LIMITATION

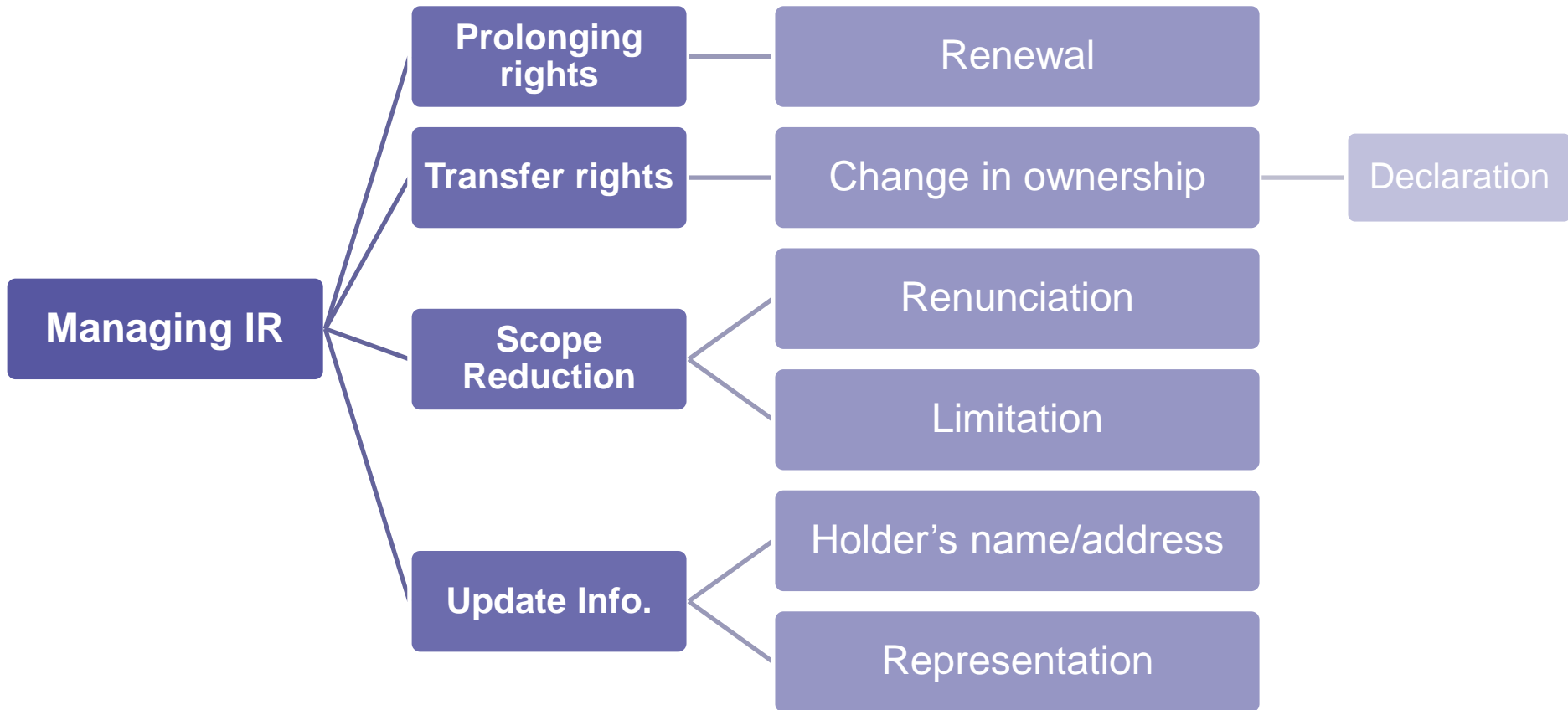
Article 16(1)(v) of the 1999 Act
Rule 21 of the Common Regulations

Limitation

- **Request form: DM/3 (mandatory)**
- Only concerns **SOME** of the designs, **NEVER ALL**
 - **ALL** designated CPs
 - **SOME** of the designated CPs

| Designated CPs | Design 1 | Design 2 | Design 3 |
|----------------|----------|----------|----------|
| CH | ✓ | ✓ | ✓ |
| EM | ✓ | ✓ | ✓ |
| TR | ✓ | ✓ | ✓ |

Summary



Tips

- Link of request forms:

- <http://www.wipo.int/hague/en/forms/>

- Request MUST be signed by holder or his representative

- Irregularity shall be remedied within 3 months

- Change is recorded when complying with the requirements

- Fee calculator:

- <http://www.wipo.int/hague/en/fees/calculator.jsp>

- Schedule and Payment of fees:

- <http://www.wipo.int/about-wipo/en/finance/hague.html>



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THANK YOU!

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