



Managing an International Registration

Seminar on the Hague System for the International Registration of Industrial Designs

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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 23-24 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
 - 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 21-21 *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

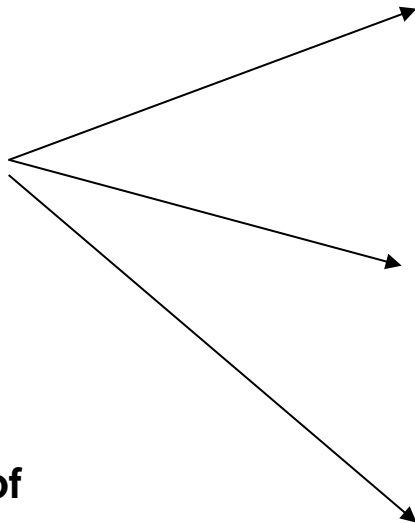
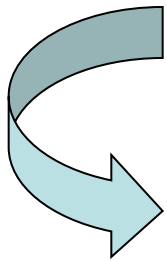


1999 Act

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			
EU			
Turkey			

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

Designated CP	Design 1	Design 2	Design 3
Switzerland			
EU			
Turkey			

■ 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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