Guide to the Hague System

International Registration of Designs Under the Hague Agreement

WIPO | HAGUE
The International Design System

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Introduction

The Guide

This is a Guide to the international registration of industrial designs. The Hague System for international registration of industrial designs is based on the Hague Agreement Concerning the International Registration of Industrial Designs, which is constituted by two different Acts, namely:

- the Geneva Act (1999), hereinafter referred to as the 1999 Act, which was adopted on July 2, 1999, and entered into force on December 23, 2003, and
- the Hague Act (1960), hereinafter referred to as the 1960 Act, which was adopted on November 28, 1960, and entered into force on August 1, 1984.

The London Act (1934) of the Hague Agreement Concerning the International Deposit of Industrial Designs, which was adopted on June 2, 1934, and entered into force in June 1939, was terminated on October 18, 2016, in accordance with the decision taken by the 15 Contracting Parties to that Act, namely, Benin, Côte d'Ivoire, Egypt, France, Germany, Indonesia, Liechtenstein, Monaco, Morocco, the Netherlands, Senegal, Spain, Suriname, Switzerland and Tunisia, at their Extraordinary Meeting on September 24, 2009 (refer to "Termination of the 1934 Act"). This Guide therefore focuses on the 1960 and 1999 Acts.

The application of the 1960 and 1999 Acts is supplemented by the Common Regulations and the Administrative Instructions.

The system for international registration of industrial designs is referred to as the "Hague System".

This Guide is structured as follows:

- The "Introduction" includes explanations as to how a State or an intergovernmental organization may become a Contracting Party to the Hague Agreement and provides an outline of the various declarations and notifications that may be made under the Hague System.
- "General" covers communications with the International Bureau, calculation of time limits, languages, payment of fees to the International Bureau and representation before the International Bureau.
- The "International procedure (1999 and 1960 Acts)" deals with the international registration procedure and other procedures required for the recording of events which may affect an international registration (such as changes in ownership, refusals of protection, etc.).

Wherever possible, the provisions of the 1999 and 1960 Acts, the Common Regulations and the Administrative Instructions that are relevant to a particular paragraph of the Guide are cited underneath that paragraph. Such provisions are cited in the following manner:

- "***99*** *Article xx*" refers to an Article of the 1999 Act;
- "***60*** *Article xx*" refers to an Article of the 1960 Act;
- "*Rule xx*" refers to a Rule of the Common Regulations; and
- *"A.I. Section xx"* refers to a Section of the Administrative Instructions.

The Hague System: general overview

In simple terms, the Hague Agreement offers the possibility of obtaining protection for industrial designs ("design") in several Contracting Parties by means of a single international application filed with the International Bureau of the World Intellectual Property Organization (WIPO) in Geneva, Switzerland. Thus, under the Hague System, one international application replaces a whole series of applications which would otherwise have to be filed with different national offices.

The Hague System is administered by the International Bureau of WIPO. The International Bureau maintains the International Register and publishes the *International Designs Bulletin (I.D.B.)*.

The paragraphs below are intended only to represent a broad outline of the international procedure under the 1999 and the 1960 Acts. For more details concerning each of the matters concerned, refer to "International procedure".

Who may use the System?

The entitlement to file an international application under the Hague Agreement is limited to natural persons or legal entities having a real and effective industrial or commercial establishment, or a domicile, in at least one of the Contracting Parties to the Hague Agreement, or being a national of one of these Contracting Parties, or of a member State of an intergovernmental organization that is a Contracting Party.

***60** Article 3; **99** Article 3*

In addition, but only under the 1999 Act, an international application may be filed on the basis of habitual residence in a Contracting Party.

The Contracting Party with respect to which the applicant fulfills the above condition is referred to as the "State of origin" under the 1960 Act and the "applicant's Contracting Party" under the 1999 Act.

No prior national application or registration

The filing of an international application does not require any prior national application or registration. Protection for a design can therefore be applied for at the international level through the Hague Agreement *for the first time*.

Contents of the application

A single international application may comprise several different designs ("multiple application"), up to a maximum of 100. All designs included in the same application must, however, belong to the same class of the international classification of Locarno. In other words, the international application is "monoclass".

***60** Article 5; **99** Article 5; Rule 7*

An international application must be filed either through the eHague interface or by using the official application form (DM/1), made available by the International Bureau or on the website of the Office of a Contracting Party. An international application must contain, *inter alia*, a reproduction of the design concerned, together with the designation of the Contracting Parties in which protection is sought. It must be filed in English, French, or Spanish.

Rule 1(1)(vi); Rule 7

An international application is subject to the payment of three types of fees: a basic fee, a publication fee and, in respect of each Contracting Party where protection is sought, either a standard or an individual designation fee. As regards standard fees, a three-level structure of standard fees applies, reflecting the level of examination carried out by the Office of a Contracting Party.

***60** Article 15; **99** Article 7; **99** Article 5(1)(vi); Rule 12*

Transmitting the international application to the International Bureau

An international application is normally sent directly to the International Bureau by the applicant, in which case either the eHague interface or the official application form (DM/1) may be used. Under the 1960 Act, however, a Contracting Party is entitled to require that, where it is considered to be the State of origin, the application be filed through its national Office. In that case, only form DM/1 may be used.

***99** Article 4(1); **60** Article 4*

Formal examination by the International Bureau

Upon receipt of the international application, and payment of at least the basic fee for one design, the International Bureau checks that it complies with the prescribed formal requirements. The International Bureau does not appraise or concern itself in any way with the novelty of the design and it is therefore not entitled to reject an international application on this or any other substantive ground.

Publication

An international application that complies with the prescribed formal requirements is recorded in the International Register and, in due course, published in the *I.D.B.* This weekly publication takes place electronically on the WIPO website every Friday and contains all the relevant data concerning the international registration, including a reproduction of the designs. The date on which each issue of the Bulletin is made available on the WIPO website is communicated electronically by the International Bureau to the Office of a Contracting Party, if the latter wishes to receive the said communication.

Substantive examination by the Office of each designated Contracting Party: possibility of notifying a refusal of protection

Upon publication of the international registration in the *I.D.B.*, the Office of each designated Contracting Party can proceed with the substantive examination, if any, provided for by its own legislation. As a result of that examination, the Office may notify to the International Bureau a refusal of protection for its territory. However, an international registration may not be refused on grounds of non-compliance with formal requirements, since such requirements must be considered satisfied following the examination carried out by the International Bureau.

***60** Article 8(1); **99** Article 12(1)*

A refusal of protection, if any, must be notified to the International Bureau within six months from the date of publication of the international registration. Under the 1999 Act, however, any Contracting Party whose Office is an Examining Office, or whose law provides for the possibility of opposition to the grant of protection, may declare that the refusal period of six months is replaced by a period of 12 months.

***60** Article 8(2); **99** Article 12(2); Rule 18(1)*

In the event of notification of a refusal, the holder has the same remedies as he/she would have if he/she had filed the application in question directly with the national Office concerned.

***60** Article 8(3); **99** Article 12(3)*

If the holder contests the refusal, the ensuing procedure devolves exclusively at the national level, according to the requirements and procedures provided for by the applicable domestic legislation. The International Bureau is not involved in this procedure. An appeal against a refusal of protection must be submitted to the competent authorities of the Contracting Party concerned within the time limit and in accordance with the conditions laid down in that Contracting Party's own legislation.

Statement of grant of protection

The Office of a designated Contracting Party which has not communicated a notification of refusal may, within the applicable refusal period, send to the International Bureau a statement to the effect that protection is granted to the designs that are the subject of the international registration in the Contracting Party concerned.

Rule 18bis(1)

However, no legal consequences result from the fact that such a statement of grant of protection has not been sent by an Office. It remains the case that the designs that are the subject of the international registration are protected if no notification of refusal has been sent within the applicable refusal period.

Protection governed by domestic law

In each designated Contracting Party, where the Office has not communicated a refusal (or has subsequently withdrawn its refusal), the international registration produces the same effect as a grant of protection for a design under the law of that Contracting Party.

***60** Article 7; **99** Article 14*

Duration of protection

International registrations are valid for an initial period of five years. They can be renewed for one or more additional periods of five years, in respect of each designated Contracting Party, up to the expiry of the total term of protection allowed by those Contracting Parties' respective laws. In other words, the maximum duration of protection in each designated Contracting Party corresponds to the maximum duration provided for by the law of that Contracting Party.

60 Article 11; 99 Article 17

Changes in the International Register

The following changes may be recorded in the International Register:

- a change in the name or postal address of the holder or his/her representative (refer to "Change in the name and/or address of the holder" or "Change in the name and/or address of the representative");
- a change in the ownership of an international registration (in respect of all or only some of the designated Contracting Parties and in respect of all or some of the designs included in the registration) (refer to "Change in ownership");
- a renunciation of all the designs that are the subject of the international registration, in respect of any or all of the designated Contracting Parties (refer to "Renunciation");
- a limitation of some of the designs that are the subject of the international registration, in respect of any or all of the designated Contracting Parties (refer to "Limitation").

Requests for such recordings must be presented to the International Bureau on the relevant official forms and must be accompanied by the prescribed fees. The recording of any change concerning the representative is, however, free of charge.

60 Article 12(1); 99 Article 16(1); Rule 21

Advantages of the Hague System

The Hague System arose from a need for simplicity and economy. In effect, it enables design owners originating from a Contracting Party to obtain protection for their designs with a minimum of formality and expense.

In particular, design owners are relieved from the need to make a separate national application in each of the Contracting Parties in which they require protection, thereby avoiding the complexities arising from procedures which may differ from State to State. Thus, they do not have to file documentation in various languages, nor keep a watch on the deadlines for renewal of a whole series of national registrations, varying from one State to the other. In addition, they avoid the need to pay fees in various currencies. Under the Hague Agreement, the same result can be obtained by means of a single international application, in one language, accompanied by the payment of a single set of fees, in one currency and with one Office (the International Bureau).

Moreover, by having a single international registration with effect in several Contracting Parties, the subsequent management of the protection obtained is also considerably facilitated. For instance, a change in ownership, or in the name or address of the holder, can be recorded in the International Register and have effect in all the designated Contracting Parties, by means of one simple procedural step.

Becoming party to the Hague Agreement

The 1999 and the 1960 Acts of the Hague Agreement are autonomous and totally independent of each other. Each Act consists of a fully-fledged international treaty, so that (with the exception of intergovernmental organizations) a potential Contracting Party may decide to become party to either one of the Acts, or to both.

States

To become a Contracting Party to the 1960 Act, a State must be bound by the Paris Convention for the Protection of Industrial Property.

***60** Article 1(2)*

To become a Contracting Party to the 1999 Act, a State must be a member of the Convention Establishing WIPO. While it is not required that the State also be party to the Paris Convention, any State that is a Contracting Party to the 1999 Act is, however, required under Article 2(2) of that Act to comply with the provisions of the Paris Convention which concern designs (even if that State is not bound by the Paris Convention).

***99** Article 27(1)*

Intergovernmental organizations

An intergovernmental organization cannot become party to the 1960 Act, the membership of this treaty being open to States only.

***60** Article 1(2)*

On the other hand, such organization may become party to the 1999 Act, provided the following conditions are fulfilled:

- at least one of the member States of the intergovernmental organization is a member of WIPO, and
- the organization maintains an Office through which protection of designs may be obtained with effect in the territory in which the constituting treaty of the intergovernmental organization applies.

***99** Article 27(1)(ii)*

The expression “Contracting Party” includes any State or intergovernmental organization which is Party to the 1999 Act and/or the 1960 Act.

Instruments of ratification or accession must be deposited with the Director General of WIPO. The Director General notifies all Contracting Parties of any deposits of instruments of ratification of, or accession to, the Act to which they are a party, and of any declarations which are included in such instruments, or made at a later stage.

Entry into force of the 1999 Act and the 1960 Act with respect to a given Contracting Party

As regards the 1960 Act, the accession or ratification of a given Contracting Party enters into force one month after its instrument of ratification or accession has been notified by the Director General of WIPO to the other relevant Contracting Parties, unless a later date is indicated in the instrument.

60 *Article 26(1)*

As far as the 1999 Act is concerned, the accession or ratification of a given Contracting Party becomes effective three months after the date on which its instrument of ratification or accession has been deposited with the Director General of WIPO, or at any later date indicated in that instrument.

99 *Article 28(3)(b)*

However:

- in respect of States for which protection of designs can be obtained *solely* through the Office maintained by an intergovernmental organization[1], the deposit of an instrument of ratification or accession cannot become effective before the date of deposit of the instrument of the intergovernmental organization to which those States belong, and

99 *Article 27(3)(b)*

- with regard to States which have made a declaration to the effect that a common Office will act as national Office for all of them[2], the 1999 Act and/or the 1960 Act enters into force three months or one month, as the case may be, from the date on which the last instrument of the Member States of that group of States has been deposited.

99 *Article 27(3)(c)*

A prospective Contracting Party wishing to ensure that it will not be bound by the 1999 Act unless one or several other Contracting Parties are also bound by that Act, may conditionally ratify or accede to that Act. In such case, the ratification or accession takes effect only if, and when, one or several other Contracting Parties, expressly designated, also deposit their instruments of ratification or accession. The conditional instrument of ratification or accession is then deemed to have been deposited on the day on which that condition is satisfied (namely, the day on which the other Contracting Party(ies) concerned deposit(s) its (their) instrument(s) of ratification or accession).

99 *Article 27(3)(d)*

The date on which each Contracting Party became bound by the 1999 Act and/or the 1960 Act can be found in the list of members of the Hague Agreement[3].

Determination of which Act is applicable in respect of the designation of a given Contracting Party

To the extent that one and the same Contracting Party may be bound by either one or both Acts of the Hague Agreement (the 1960 Act and/or the 1999 Act), the question arises as to which of these Acts applies in respect of a given Contracting Party designated in an international application.

The Act applicable to a designated Contracting Party depends on the Act(s) to which are bound, on the one hand, the Contracting Party *of the applicant* and, on the other, the given *designated* Contracting Party. The applicable principles may be summarized as follows:

- where there is only *one* common Act between the two Contracting Parties concerned, it is such Act which governs the designation of a given Contracting Party. For example, if an applicant originates from a Contracting Party bound by both the 1999 and the 1960 Acts and designates a Contracting Party bound exclusively by the 1960 Act, such designation is governed by the single common Act (the 1960 Act);

***60** Article 31(2); **99** Article 31(2)*

- where both Contracting Parties concerned are bound by *more* than one common Act, it is the *most recent* Act which applies with respect to the designated Contracting Party. For example, if an applicant originates from a Contracting Party bound by both the 1960 and the 1999 Acts and designates a Contracting Party also bound by both the 1960 and the 1999 Acts, such designation is governed by the more recent Act (the 1999 Act).

***60** Article 31(1); **99** Article 31(1)*

It should be noted that, in line with the aforementioned principles, the designation of a Contracting Party bound by several Acts will also be governed by the most recent of these Acts where the applicant enjoyed cumulative but *independent* entitlement connections under each of the same Acts (refer to "Entitlement to file"). For example, if an applicant originates from Contracting Party A, bound by the 1960 Act, but Contracting Party A is also a State member of an intergovernmental organization bound by the 1999 Act (Contracting Party B), the designation of a Contracting Party C that is bound by both the 1960 and the 1999 Acts is governed by the most recent of these two Acts, that is, the 1999 Act.

The determination of the applicable Act is to be made on the date of filing of the international application concerned. It cannot be reviewed afterwards, should one of the Contracting Parties concerned accede to another Act of the Hague Agreement subsequent-to the filing of the international application.

Determination of the Act or Acts which govern an international application as a whole

While the *designation of a Contracting Party* can only be governed by one Act, several Acts may, however, apply in respect of a single *international application*. This depends on whether, in respect of any given international application, Contracting Parties have been designated under the 1999 Act and/or the 1960 Act.

It is important for an applicant to know which Act or Acts govern(s) the international application, since this will determine such matters as the possibility of requesting deferment of publication, and the fees which are payable.

In all, three kinds of international application will be possible. An international application may be governed:

- exclusively by the 1999 Act, i.e., all the Contracting Parties designated in the international application have been designated under the 1999 Act;

Rule 1(1)(xii)

- exclusively by the 1960 Act, i.e., all the Contracting Parties designated in the international application have been designated under the 1960 Act;

Rule 1(1)(xiii)

- by both the 1999 and the 1960 Acts, i.e., the Contracting Parties designated in the international application include
  - at least one Contracting Party designated under the 1999 Act, and
  - at least one Contracting Party designated under the 1960 Act.

Rule 1(1)(xiv)

These rules may be illustrated with the following example: an applicant originates from a Contracting Party bound by both the 1999 Act and the 1960 Act and it is assumed first of all that the applicant designates in his/her international application Contracting Parties “A”, “B” and “C”, all of which are bound by the 1999 Act. To the extent that each of these designations is governed by the 1999 Act (the most recent Act), it follows that the international application as a whole is governed *exclusively* by the 1999 Act.

If, in respect of the same international application, the applicant also designates Contracting Party “D” which is bound only by the 1960 Act: the designation of that Contracting Party “D” is governed by the 1960 Act (the single common Act), and it follows that the international application concerned is governed by *both* the 1999 Act and the 1960 Act. In other words, with respect to that international application, the 1999 Act applies in respect of Contracting Parties “A”, “B” and “C” and the 1960 Act applies in respect of Contracting Party “D”.

Declarations by Contracting Parties

The Hague System provides for the possibility for Contracting Parties to make certain declarations concerning the operation of the international registration system so that certain features of their national/regional laws concerning design protection can be taken into account when they are being designated in an international application. For a complete list of possible declarations a Contracting Party may make under the 1999 Act or the Common Regulations, please refer to “Declarations Made by Contracting Parties under the 1999 Act and the Common Regulations under the 1999 Act and the 1960 Act”.

It is to be noted that although the prerequisite for making certain declarations is that the Office of the Contracting Party is an “Examining Office”, there is no obligation under the Hague System to make any of those declarations.

More specific information in respect of the specific elements of the international application and procedures before the International Bureau that result from declarations being made by designated Contracting Parties is provided under "Contents of the International Application", "International Application" and "Effect of the Recording of a Change in Ownership".

Examining Office

The term "Examining Office" is defined in the 1999 Act (Article 1(xvii)) and means an Office which *ex officio* examines applications filed with it for the protection of designs, at least to determine whether the designs satisfy the condition of novelty.

In light of the above definition, in order to be considered as an "Examining Office", the Office must carry out, *ex officio*, a prior art search that matches with the condition of novelty required under the applicable law. This means that, if the criterion for the validity of the design right is worldwide novelty, the prior art search should consider not only pending and/or registered designs in a database but also extend to designs known anywhere in the world.

Submission of declarations

Declarations may be made either simultaneously with the deposit of the instrument of accession or ratification, or after the deposit. Before submission of the declarations to the Director General of WIPO, it is advised that the Legal Section of the Hague Registry be consulted to make sure that the requirements under the 1999 Act, the Common Regulations or the national law for making any declarations, respectively, are satisfied.

Effective date of declarations

If the declaration is submitted together with the instrument of ratification/accession, it becomes effective on the date on which the Contracting Party becomes bound by the 1999 Act. If the declaration is submitted afterwards, it becomes effective three months after the date of receipt of the declaration by the Director General of WIPO, or at any later date indicated in the declaration.

Furthermore, any declaration made after the deposit of the instrument of accession or ratification will apply only in respect of international registrations whose date of registration is the same as, or later than, the effective date of the declaration.

Mandatory declaration

Duration of protection – maximum duration of protection

Under the 1999 Act, an international registration is initially effected for a period of five years and may be renewed for two additional terms of five years (Articles 17(1) and (2)). Thus, under the 1999 Act, the *minimum* term of protection that a Contracting Party must provide is 15 years. If the national legislation of a Contracting Party provides for a duration of protection that is longer than 15 years, then the international registration may be renewed with respect to such Contracting Party for additional periods of five years, up to the expiry of the total duration of protection at the national level.

On acceding to the 1999 Act, a Contracting Party must notify the Director General of WIPO of the maximum duration of protection provided for by its law.

99 *Article 17(3)(c); Rule 36(2)*

Declarations that are mandatory in certain circumstances

Deferment of publication

Deferred publication for a period that is less than the prescribed period

Under the 1999 Act, the general principle is that each Contracting Party is assumed to permit the prescribed deferment period of 30 months from the filing date, or where priority is claimed, from the priority date of the application in question (Rule 16(1)(a)).

Where the law of a Contracting Party that is acceding to the Geneva Act provides for deferment of publication for a period that is less than the prescribed period of 30 months, that Contracting Party must, in a declaration, notify the Director General of WIPO of the allowable deferment period.

99 *Article 11(1)(a)*

No deferment of publication

Where the law of a Contracting Party bound by the 1999 Act does not provide for the deferment of publication, that Contracting Party must, in a declaration, notify the Director General of WIPO of that fact.

99 *Article 11(1)(b)*

Optional declarations

All optional declarations are listed below, some of which are open only to a Contracting Party whose Office is an "Examining Office". Those declarations are namely:

- declaration under Article 5(2),
- declaration under Article 7(2),
- declaration under Article 13(1),
- declaration under Article 14(3),
- declaration under Article 16(2),
- declaration under Article 19(1),
- declaration under Rule 8(1),
- declaration under Rule 9(3),
- declaration under Rule 12(1)(c),
- declaration under Rule 13(4), and
- declaration under Rule 18(1).

The term "Examining Office" is defined in the 1999 Act (Article 1(xvii)) and means "an Office which *ex officio* examines applications filed with it for the protection of designs, at least to determine whether the designs satisfy the condition of novelty".

It is understood that, in light of the above definition, in order to be considered as an "Examining Office", the Office must carry out, *ex officio*, a prior art search that matches with the condition of novelty required under the applicable law. This means that, if the criterion for the validity of the design right is worldwide novelty, the prior art search should consider not only pending and/or registered designs in a database but also extend to designs known anywhere in the world.

Prohibition on filing through national Office

In general, an international application may be filed, at the option of the applicant, either directly with the International Bureau or through the Office of the applicant's Contracting Party. However, under the 1999 Act, any Contracting Party may, by declaration, notify the Director General of WIPO that international applications may not be filed through its Office. When such a declaration is made, all international design applications from applicants attached to that Contracting Party must be filed directly with the International Bureau.

99 *Article 4(1)(b)*

Prohibition on self-designation

Under the 1999 Act a Contracting Party whose Office is an Examining Office may, by declaration, notify the Director General of WIPO that, where it is the applicant's Contracting Party, the designation of that Contracting Party in an international application has no effect, in other words, it is prohibited to self-designate.

99 *Article 14(3)*

Security clearance

Any Contracting Party whose law, at the time that it becomes party to the 1999 Act, requires security clearance, may, in a declaration, notify the Director General of WIPO that the period of one month allowed for its Office to transmit an international application to the International Bureau shall be replaced by a period of six months.

Rule 13(4)

Designation fees (declaration)

Individual designation fees

Any country that is acceding to the 1999 Act *and* whose Office is an Examining Office and any intergovernmental organization acceding to the 1999 Act, may notify the Director General of WIPO that, in connection with each international registration in respect of which it is designated, and in connection with the renewal of such international registration, it wishes to receive an "individual designation fee", instead of a standard fee.

Pursuant to Rule 12(3), a declaration under Article 7(2) may specify that the individual designation fee to be paid in respect of the Contracting Party concerned comprises two parts, the first to be paid at the time of filing the international application and the second part to be paid at a later date which is determined in accordance with the law of the Contracting Party concerned.

The amount of the individual designation fee must not be higher than the equivalent of the amount which the Office of that Contracting Party would be entitled to receive from an applicant for a grant of protection for an equivalent period to the same number of designs, that amount being diminished by the savings resulting from the international procedure.

If this notification is made, then it is required that the amount of the individual designation fees be expressed in the national currency. Subsequently, the Director General will, in consultation with the Registrar, establish the amount of the fees in Swiss currency on the basis of the official exchange rate of the United Nations.

99 *Article 7(2)*

Reduction of individual fees for Least Developed Countries

A Contracting Party making a notification requiring individual designation fees might wish to implement the recommendation made by the Assembly of the Hague Union, which reads as follows:

> "Contracting Parties that make, or that have made, a declaration under Article 7(2) of the 1999 Act or under Rule 36(1) of the Common Regulations are encouraged to indicate, in that declaration or in a new declaration, that for international applications filed by applicants whose sole entitlement is a connection with a Least Developed Country, in accordance with the list established by the United Nations, or with an intergovernmental organization the majority of whose member States are Least Developed Countries, the individual fee payable with respect to their designation is reduced to 10 per cent of the fixed amount (rounded, where appropriate, to the nearest full figure). Those Contracting Parties are further encouraged to indicate that the reduction also applies in respect of an international application filed by an applicant whose entitlement is not solely a connection with such an intergovernmental organization, provided that any other entitlement of the applicant is a connection with a Contracting Party which is a Least Developed Country or, if not a Least Developed Country, is a member State of that intergovernmental organization and the international application is governed exclusively by the 1999 Act."

Individual designation fee: international applications only

Any Contracting Party bound by the 1960 Act whose Office is an Examining Office may, in a declaration, notify the Director General of WIPO that, in connection with any international application in which it is designated under the 1960 Act, the standard designation fee is to be replaced by an individual designation fee, whose amount should be indicated in the declaration and can be changed in further declarations. The declaration may also specify that the individual designation fee to be paid comprises two parts (refer to "Individual designation fees"). The said amount may not be higher than the equivalent of the amount which the Office of that Contracting Party would be entitled to receive from an applicant for a grant of protection for an equivalent period for the same number of designs, that amount being diminished by the savings resulting from the international procedure.

60 *Article 15(1), item 2(b); Rule 12(1)(a)(iii); Rule 12(3); Rule 36(1)*

Amount of the individual designation fee

A declaration concerning individual designation fees (refer to "Standard designation fees" and "Individual designation fees") must indicate the amount of such fees, expressed in the currency used by the Office concerned and, where applicable, any change in the amount.

Where this currency is other than Swiss currency, the Director General of WIPO, in consultation with the Office, establishes the amount of the fees in Swiss currency on the basis of the official exchange rate of the United Nations.

99 *Article 7(2)*

Where, for more than three consecutive months, the official exchange rate of the United Nations between a Contracting Party's currency and Swiss currency is higher or lower by at least 5% than the last exchange rate used to establish the amount of the individual fees in Swiss currency, the Office of that Contracting Party may ask the Director General of WIPO to establish new amounts in Swiss currency for the individual fees.

Rule 28(2)(c)

Where, for more than three consecutive months, this exchange rate is lower by at least 10% than the last rate applied, the Director General of WIPO, at his own initiative, establishes new amounts in Swiss currency for the individual fees. The amounts so fixed are published on the WIPO website and become applicable at a date to be fixed by the Director General of WIPO, which is between one and two months after such publication.

Rule 28(2)(d)

Standard designation fees

A Contracting Party that has not made an individual designation fees declaration under Article 7 will be entitled to a standard fee under Rule 12(1).

There are three different levels of standard designation fee, reflecting the scope of examination carried out by an Office. For level two or three to apply it is necessary to make a declaration to that effect.

The levels are as follows:

- level one, for Contracting Parties whose Office does not carry out examination on substantive grounds – this level will apply *automatically* in the absence of any declaration;
- level two, for Contracting Parties whose Office carries out examination on substantive grounds other than novelty (for example, on issues such as the definition of a "design", public order and morality, or the protection of State emblems);
- level three, for Contracting Parties whose Office carries out examination on substantive grounds, including a limited examination as to novelty (for example, an examination as to local novelty only even if the criterion for the validity of the design right is worldwide novelty), or examination as to novelty following opposition by third parties.

It should be noted that an Office that is an Examining Office, and thus is entitled to make the notification requiring an individual designation fee, may instead, for example, make the declaration requiring the level two or three standard designation fee.

Rule 12(1)

Mandatory contents of an international application (declaration)

Any Contracting Party bound by the 1999 Act whose Office is an Examining Office and whose law, at the time it becomes party to that Act, requires that an application for the grant of protection for a design should contain any of the following elements - (i) indications concerning the identity of the creator, (ii) a brief description and/or (iii) a claim – in order for that application to be accorded a filing date under that law may, in a declaration, notify the Director General of WIPO of those elements.

99 *Article 5(2); Rule 7(4); Rule 11*

Identity of the creator

In order that a country acceding to the 1999 Act can make a declaration requiring that an international application shall contain indications concerning the identity of the creator of the design that is the subject of that application, two conditions must be fulfilled:

- the Office must be an "Examining Office", and
- the national law must provide that, *in order that a national design application be granted a filing date* such application must contain indications concerning the identity of the creator of the design that is the subject of the application.

Otherwise, this declaration cannot be made.

***99** Article 5(2)(b)(i)*

Brief description

In order that a country acceding to the 1999 Act can make a declaration requiring that an international application shall contain a brief description of the reproduction or of the characteristic features of the design that is the subject of that application, two conditions must be fulfilled:

- the Office must be an "Examining Office", and
- the national law must provide that, *in order that a national design application be granted a filing date* such application must contain a brief description of the reproduction or of the characteristic features of the design that is the subject of that application.

Otherwise, this declaration cannot be made.

The requirement to furnish a brief description is to be distinguished from the requirement to furnish reproductions or representations of a design. It is already an established requirement of the Hague System that the latter be furnished (refer to Article 5(1)(iii) and Rule 9(1)). Similarly, it is required by Article 5(1)(iv) that an indication of the product or products that constitute the design or in relation to which the design is to be used be indicated in an international application (item 9 of the international application form).

***99** Article 5(2)(b)(ii)*

Claim

In order that a country acceding to the 1999 Act can make a declaration requiring that an international application shall contain a claim, two conditions must be fulfilled:

- the Office must be an "Examining Office", and
- the national law must provide that, *in order that a national design application be granted a filing date*, such application must contain a claim.

Otherwise, this declaration cannot be made. In accordance with Rule 11(3), the declaration under Article 5(2)(b)(iii) must specify the exact wording of the required claim.

***99** Article 5(2)(b)(iii)*

Special requirements concerning the applicant and the creator (Rule 8) (declaration)

Filing in name of the creator

If the national law of a country that is acceding to the 1999 Act contains a requirement that a national application for the protection of a design must be filed in the name of the creator, that country may make a declaration notifying the Director General of WIPO of that fact.

This declaration should be distinguished from that referred to under "Identity of the creator".

In such case, where the person identified as the creator is a person other than the person named as the applicant, Rule 8(2)(ii) requires that the international application shall be accompanied by a statement or document to the effect that the international application has been assigned by the creator to the applicant, and it is the applicant who will be recorded as holder.

This declaration has been made by seven Contracting Parties, namely Brazil, Finland, Ghana, Hungary, Iceland, Mauritius and Mexico. However, rather than requiring the furnishing of such a statement or document, these Contracting Parties have availed of the facility provided in item 11 of the international application form, which states as follows:

> *"*In respect of the designation of ***Brazil, Finland***, ***Ghana***, ***Hungary, Iceland, Mauritius and/or Mexico***, the person indicated in item 11 declares to be the creator of the design. Where the person identified as the creator is a person other than the applicant, it is hereby stated that the present international application has been assigned by the creator to the applicant.*"*

Otherwise, in principle, the declaration should specify the form and content of any statement or document required.

Rule 8(1)(a)(i)

Oath or declaration of the creator

If the national law of a country that is bound by the 1999 Act contains a requirement that an oath or declaration of the creator must be furnished, that country may make a declaration notifying the Director General of WIPO of that fact. The declaration must specify the form and content of any statement or document required.

This declaration should be distinguished from that referred to under "Identity of the creator".

The international application containing the designation of the Contracting Party which has made the declaration must also contain indications concerning the identity of the creator of the design.

Rule 8(1)(a)(ii)

Unity of design

If the national law of a Contracting Party that is acceding to the 1999 Act contains a requirement that designs which are the subject of the same application should conform to a requirement of unity of design, unity of production or unity of use, or that the designs should belong to the same set or composition of items, or that only one independent and distinct design be claimed in a single application, that Contracting Party may make a declaration notifying the Director General of WIPO of that fact. The declaration should be comprehensive, detailed and specific as to the requirements in question.

The Office of the Contracting Party that made the declaration may refuse the effects of the international registration pending compliance with the specified requirement of unity of design. Following a notification of such refusal, the international registration may be divided before the Office of that Contracting Party in order to overcome the refusal ground.

It is recalled that the requirement of unity of design does not affect the applicant's right to include up to 100 designs in the international application even if a Contracting Party that has made the declaration is being designated. However, to forestall possible refusals on the ground that the designs in the international registration do not conform with the requirement of unity of design under the applicable law, the applicant may wish to take into consideration any declaration of unity of design made by a Contracting Party, in which protection is sought (refer to "How to submit an international application: eHague or form DM/1?", "Item 6: Number of designs, reproductions and/or specimens", or "Refusal of Protection", "Unity of design").

Guidance on multiple designs

The criteria for unity of design may be different from one jurisdiction to another. Therefore, the Guidance on Including Multiple Designs in an International Application in Order to Forestall Possible Refusals was established in consultation with the Contracting Parties that notified a declaration under Article 13(1) of the 1999 Act that its applicable law contains special requirements concerning unity of design, and is intended to mitigate the risk of possible refusals by their Offices. It should, however, be noted that the Guidance cannot be considered an all-inclusive or stand-alone guide.

99 *Article 13(1)*

Requirements concerning views

If the Office of a Contracting Party that is acceding to the 1999 Act requires certain specified views of the product or products which constitute the design or in relation to which the design is to be used, that Contracting Party may make a declaration notifying the Director General of WIPO, specifying the views that are required and the circumstances in which they are required. However, the declaration may not require more than one view where the design or product is two-dimensional, or more than six views where the product is three-dimensional.

The effect of the declaration is that the Office of the Contracting Party that made the declaration can refuse the effects of the international registration pending compliance with the specified requirement of views (refer to "Refusal of Protection", "Specific views or sufficient disclosure of the design").

Rule 9(3)

Refusal of protection

Extension of period for notification of refusal (Rule 18(1)(b))

In principle, the period within which an Office must notify a refusal is six months. However, for a Contracting Party designated under the 1999 Act, this period may be extended to 12 months in the following cases:

- the Office is an "Examining Office", or
- the national law provides for a procedure for opposition to the registration of a design.

A procedure of opposition referred to in the second condition, above, is to be distinguished from a so-called "invalidation" procedure which should normally take place after granting protection, in which case, the refusal period would not need to be extended.

Rule 18(1)(b)

Date of effect of international registration

Date of effect of international registration (Rule 18(1)(c)(i))

The declaration referred to under "Extension of period for notification of refusal (Rule 18(1)(b))", above, may also state that the international registration shall produce the effect referred to in Article 14(2)(a) at the latest at a time specified in the declaration which may be later than the date referred to in that Article but which shall not be more than six months after the said date.

The effect of this declaration is to establish the regime under which the international registration may produce the effect as a grant of protection under the national law after the expiry date of the refusal period, but which must be within six months from that expiry date.

It is to be noted that, where the Office of the country that made the declaration has not found any grounds for refusal, it is obliged to issue a statement of grant of protection provided for in Rule 18*bis*(1) with respect to an international registration designating that country.

Rule 18(1)(c)(i)

Date of effect of international registration (Rule 18(1)(c)(ii))

The declaration referred to under "Extension of period for notification of refusal (Rule 18(1)(b))", above, may also state that the international registration shall produce the effect referred to in Article 14(2)(a) at a time at which protection is 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.

The effect of this declaration is to safeguard certain exceptional circumstances under which the Office cannot complete substantive examination as required by the national law within the applicable refusal period, for instance, due to an unforeseeable circumstance, such as natural disaster. The application of this declaration should therefore be limited to exceptional cases, and on an individual case basis, as opposed to a declaration referred to under "Date of effect of international registration (Rule 18(1)(c)(i))", above.

It is to be noted that, where the Office of the country that made the declaration has not found any grounds for refusal, it is obliged to issue a statement of grant of protection provided for in Rule 18*bis*(1) with respect to an international registration designating that country.

Rule 18(1)(c)(ii)

Effect of change in ownership

Any country may, in a declaration, notify the Director General of WIPO that the recording in the International Register of a change in ownership of an international registration shall not have effect in that country until its Office has received the statements or documents specified in that declaration.

***99** Article 16(2)*

Common Office of several states

If several States have effected the unification of their domestic legislation on designs, they may notify the Director General of WIPO:

- that a common Office is to be substituted for the national Office of each of them, and
- that the whole of their respective territories to which the unified legislation applies is to be deemed to be a single Contracting Party for the purposes of the Hague Agreement.

***60** Article 30(1); **99** Article 19(1)*

Official records

The *I.D.B.* is the official publication of the recordings made in the International Register of the Hague System.

Extracts and certified copies

Extracts and certified copies are official information from the International Register. Extracts and certified copies are also useful for claiming priority under the Paris Convention.

An international application and registration remains confidential in relation to third parties until publication of the international registration. With respect to any published international registration, any person may request the International Bureau to provide, against the payment of the prescribed fees, the following information:

- extracts from the International Register;
- certified copies of recordings made in the International Register or of items in the file of the international registration (typically, “priority documents”);
- uncertified copies of recordings made in the International Register or of items in the file of the international registration;
- written information on the contents of the International Register or of the file of the international registration;
- photographs of specimens.

The fees for these information services are included in the Schedule of Fees.

To obtain these extracts, copies or information, the request must indicate the international registration number or the application number (nine-digit number or "WIPO" + number) assigned by the International Bureau. It is recommended to submit the request through Contact Hague.

It is to be noted that the possibility to ask for an extract, copy or information in relation to any international application or international registration which has not been published is limited to the applicant or holder of that international application or registration or their appointed representative before the International Bureau.

Priority documents and WIPO Digital Access Service (DAS) for International Applications

An international application may itself serve as a basis for claiming priority in a subsequent national, regional or international application. The International Bureau provides a certified copy of such an international application ("priority document") upon request from the applicant or holder.
In this respect, the International Bureau participates in the WIPO Digital Access Service (DAS) as a "depositing Office", offering the following two options:

- The applicant or holder may request a DAS code which is provided free-of-charge (no priority document is provided). This DAS code can be communicated to Offices for the retrieval of the priority document, if they participate in DAS as an "accessing Office" for "Hague international applications" or "National industrial design applications". For more information about DAS and its participating Offices, refer to the WIPO website.
- The applicant or holder may request a priority document which is provided in PDF format (digitally signed and certified) together with a DAS code. The fees for a priority document are set out in the Schedule of Fees.

Data dissemination

Data from the *I.D.B.* is available in computer-readable format, XML, via FTP server.

The following standards apply:

- Standard ST.3: Two-letter codes for the representation of states, other entities and organizations;
- Standard ST.96: Processing of industrial property Information using XML.

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1. This applies, for instance, to the member States of the African Intellectual Property Organization (OAPI) but not to the member States of the European Union (where protection of designs can also be obtained through their own national Offices).
2. This situation corresponds to the Benelux Office for Intellectual Property (BOIP), which is the common Office to Belgium, Luxembourg and the Netherlands (the Benelux countries).
3. This list also concerns the members of the Hague Agreement bound by the 1934 Act.

General

Communications with the International Bureau

Three routes of communication are possible as part of the international procedure, namely:

- between the International Bureau and the Office of a Contracting Party;
- between the International Bureau and the applicant or holder, or his/her representative[1];
- between the applicant or holder (or representative) and the Office of a Contracting Party. These latter communications, which do not involve the International Bureau, are outside the scope of the Hague Agreement. The modalities of such communications are exclusively a matter for the law and practice of the Contracting Party concerned. For example, the question as to whether an appeal against a refusal of protection may be filed by post, facsimile or by electronic means with a given Office is a matter for determination by the legislation and/or practice of that particular Contracting Party.

Rule 1(1)(v); Rule 2

Modalities of communications with the International Bureau

Communications addressed by an applicant, holder or an Office to the International Bureau must be in writing and be typed or otherwise printed. Handwritten communications are not acceptable. The communication must be signed. The signature may be handwritten, printed, typed or stamped. As regards electronic communication and communications through user accounts available on the WIPO website, the signature may be replaced by a mode of identification determined by the International Bureau or agreed upon between the International Bureau and the Office concerned, as the case may be. Pursuant to Section 205(a) of the Administrative Instructions, communications through user accounts must be authenticated through the use of the account holder's user name and password.

A.I. Section 201(a); A.I. Section 202; A.I. Section 205(a)

Communications addressed to the International Bureau may be delivered by hand, sent by mail or by electronic means.

Communications sent by mail

Any communication may be sent to the International Bureau by mail, through a postal or other delivery service, at the following address:

World Intellectual Property Organization
34, Chemin des Colombettes, P.O. Box 18,
CH-1211 Geneva 20
Switzerland

If several documents are mailed to the International Bureau in one envelope, they should be accompanied by a list identifying each one of them. The International Bureau informs the sender of any discrepancy between the list and what is actually received.

A.I. Section 201(b)

Communications sent by facsimile [Deleted]

The use of facsimile for communication with the International Bureau was terminated on January 1, 2019, as a result of the deletion of Section 203 of the Administrative Instructions.

Communications sent by electronic means

Any communication between, on the one hand, an applicant or holder or Office of a Contracting Party and, on the other hand, the International Bureau, including the presentation of an international application, may be made by electronic means, for example, through eHague (Filing and Renewal). In addition, Contact Hague can be used to make enquiries, submit documents or to request priority documents from the International Bureau (refer to "Priority documents and WIPO Digital Access Service (DAS) for International Applications"). Notwithstanding the above, electronic communications between an Office and the International Bureau may take place in a way agreed upon between the International Bureau and the Office concerned.

Where a communication is transmitted to the International Bureau by electronic means and, because of the time difference between the place from where the communication is sent and Geneva, the date on which the sending started is different from the date of receipt by the International Bureau of the complete communication, the earlier of the two dates shall be considered as the date of receipt by the International Bureau.

A.I. Section 204(a); *A.I. Section 205*; *A.I. Section 204(c)*

Provided the sender can be identified and can be reached, the International Bureau will promptly inform him/her, also by electronic transmission, of the receipt of the electronic communication, and of any deficiencies in the transmission (for example, if it is incomplete or illegible). Such an acknowledgement shall contain the date of receipt in the case of an international application.

A.I. Section 204(b)

Official Hague System forms

All official forms are established by the International Bureau. Official forms include both forms made available on the website, as well as electronic interfaces (eHague). Further electronic interfaces may be made available on the WIPO website or on the website of the Office of a Contracting Party. It is recalled that a Contracting Party allowing, in line with Article 4(1) of the 1999 Act, an indirect filing, may make an e-filing interface available on the website of its Office.

99 *Article 4(1); Rule 1(1)(vi)*

As an alternative to using a form produced by the International Bureau, Offices, applicants or holders may generate their own forms. Such self-generated forms are acceptable to the International Bureau provided that they have the same contents and format as the official forms.

Rule 1(1)(vi)

The items in such self-generated forms need not have the same spacing and layout as in the forms established by the International Bureau. Indeed, one advantage of producing such forms is that as much space can be allocated to a given item as is needed; for example, where an international application is in the names of several applicants, or there is a particularly large number of designs, use of such forms can avoid the need for continuation sheets. The following prescriptions must, however, be observed:

- the form must be on A4 format, written on one side only;
- it must contain the same items, with their numbering and titles, in the same order, as the official form established by the International Bureau;
- where an item is not used or is not applicable, the item should not be omitted, but should be included with an appropriate indication, such as “not applicable”, “nil” or “not used”; for example, if an international application submitted on a self-generated form does not include a claim to priority, the form should still include the relevant entry, between items 12 and 14, with an appropriate indication, such as: “Priority Claim: *Not applicable*”.

Continuation sheets

Where the space available in any part of a form is insufficient (for example, in the case of an international application, because there is more than one applicant, or more than one priority claim) one or more continuation sheets should be used (unless a self-generated form has been used). On the continuation sheet, it is necessary to indicate the DM form and the item number, the information then being presented in the same manner as required in the form itself. The number of continuation sheets used must be indicated in the box provided at the beginning of the form.

Indication of dates

Any indication of a date in an official form must consist of the day in two digits, followed by the number of the month in two digits, followed by the number of the year in four digits, all in Arabic numerals and day, month and year being separated by slashes (/). For example, the date April 1, 2014, is to be written as “01/04/2014”.

Unofficial Hague System forms

In addition to the official forms, some unofficial forms are available, for example for renewing an international registration. The use of these forms is not compulsory; they are provided by the International Bureau for the convenience of users.

Calculation of time limits

The Hague System lays down time limits within which certain communications must be made. Normally the date on which the time limit expires is the date on which the communication must be received by the International Bureau. An exception to this is the time limit within which the Office of a designated Contracting Party may notify refusal of protection; in this case, it is the date on which the Office sends the notification to the International Bureau which is decisive (refer also to A.I. section 501). Any communication from the International Bureau which refers to a time limit indicates the date of expiry of that time limit, calculated in accordance with the following rules:

- any period expressed in years expires, in the relevant subsequent year, on the same day and month as the event from which the period started to run, except that a period which started on February 29, and ends in a year in which there is no such date, will expire on February 28. For example, a period of 10 years from February 20, 2008, will expire on February 20, 2018; a period of 10 years from February 29, 2008, will expire on February 28, 2018;

Rule 4(1)

- any period expressed in months expires, in the relevant subsequent month, on the day having the same number as the day of the event from which the period started to run, except that if there is no day with that number, the period expires on the last day of the month. For example, a period of two months which begins on January 31 ends on March 31, while a period of three months which begins on the same date ends on April 30;

Rule 4(2)

- any period expressed in days starts on the day following the day on which the relevant event occurred. For example, a period of ten days which is to be reckoned from an event which occurred on the twelfth day of a month will expire on the twenty-second day of that month.

Rule 4(3)

- If a period within which a communication must be received by the International Bureau would expire on a day on which the International Bureau is not open to the public, it will expire on the next subsequent day on which the Bureau is open. The following examples will illustrate the situation: Firstly, if a period within which a communication must be received by the International Bureau ends on a Saturday or Sunday, the deadline will be met if the communication is received on the following Monday (assuming that the Monday is not a holiday). Secondly, a period of three months starting from October 1 will not expire on January 1 (which is an official holiday at the International Bureau), but on the next working day. A list of the days on which the International Bureau is not scheduled to be open to the public during the current and the following calendar year is published on the WIPO website.

Rule 4(4); Rule 26(2)

Likewise, if the period within which a communication (such as a notification of refusal of protection) must be sent by an Office to the International Bureau would expire on a day on which the Office concerned is not open to the public, it will expire on the next subsequent day on which the Office is open. It should be noted that this applies only where the period in question is specified in terms of the communication being *sent* by an Office within that period. On the other hand, where the period is specified in terms of the communication being *received* by the International Bureau within that period, it is the previous paragraph that applies; in such a case, late receipt of the communication by the International Bureau cannot be excused on the ground that its dispatch was delayed because the Office which sent it was closed.

Rule 4(4)

Excuse of delay in meeting time limits

Failure to meet a time limit specified in the Common Regulation to perform an action before the International Bureau may be excused where an interested party proves to the satisfaction of the International Bureau that such failure was due to a *force majeure* event. Such *force majeure* events include, for example, war, revolution, civil disorder, strike, natural calamity, epidemic, irregularities in postal, delivery or electronic communication services which are beyond the control of the party requesting the excuse of delay.

Rule 5(1)

Failure to meet a time limit will be excused only if the evidence, or the statement in lieu of that evidence, is received by the International Bureau, and the corresponding action is performed before the International Bureau, as soon as reasonably possible, and not later than six months after the expiry of the time limit concerned,

Rule 5(3)

Languages

International applications

An international application may be filed in English, French or Spanish at the applicant's option.

Rule 6(1)

Any communication concerning an international application or an international registration must be

- in English, French or Spanish, where such communication is addressed to the International Bureau by an applicant, holder, or Office[2];
- in the language of the international application, where the communication is addressed by the International Bureau to an Office, unless that Office has notified the International Bureau that any such communications are to be in English, French, or Spanish;

- in the language of the international application, where the communication is addressed by the International Bureau to the applicant or holder, unless that applicant or holder has expressed the wish that all such communications be in English, French, or Spanish.

Rule 6(3)

The recording in the International Register and the publication in the *I.D.B.* of an international registration and of any data to be both recorded and published in respect of that international registration takes place in English, French and Spanish.

Rule 6(2)

In respect of international applications filed before April 1, 2010 and international registrations resulting from such applications, Rule 6 as in force before April 1, 2010, continues to apply. As a consequence, the recording in the International Register and the publication in the *I.D.B.* of an international registration and of any data to be both recorded and published in respect of that international registration only take place in English and in French.

Rule 37(2)

Translation

The necessary translation of the recordings to be made in the International Register and their publication in the *I.D.B.* is performed by the International Bureau. The applicant may annex to the international application a proposed translation of any text contained in the international application. If the proposed translation is not considered by the International Bureau to be correct, it is corrected by the International Bureau after having invited the applicant to make, within one month from the invitation, observations on the proposed correction.

Rule 6(4)

Payment of fees to the International Bureau

The amounts of the fees payable in connection with an international application or registration are either prescribed in the Schedule of Fees appended to the Common Regulations or, in the case of individual fees, fixed by the Contracting Party concerned.

Rule 27(1)

Fees may be paid by the applicant or holder directly to the International Bureau. As regards, in particular, an international application, the fees may also be paid through the Office of the applicant's Contracting Party if the application is filed through that Office and the Office accepts to collect and forward such fees to the International Bureau.

Rule 27(2)(a) and (b)

Currency of payment

All payments to the International Bureau must be made in Swiss currency. An Office which accepts to collect and forward fees may collect payments from the applicant in another currency, but the payment forwarded to the International Bureau by the Office must be in Swiss currency.

Rule 28(1)

Mode of payment

Fees may be paid to the International Bureau:

- by debit to a current account at WIPO;
- by payment into the WIPO bank account or WIPO postal account;
- through the Office of indirect filing where that Office accepts indirect payments (e.g. USPTO);
- through an online payment system made available when using eHague (Filing or Renewal), which offers a range of payment methods according to the user account profile.

A.I. Section 801

An applicant, holder, representative, or an Office having frequent dealings with the International Bureau, may find it useful to maintain a current account at WIPO. This greatly simplifies the payment of fees and reduces the risk of irregularities due to late or incorrect payment.

Whenever a fee is paid to the International Bureau, the purpose of the payment must be indicated, together with information identifying the application or registration concerned. This information should include:

- at the stage of the international application, the name of the applicant and the design to which the payment relates (for example, by indicating the user reference);
- in connection with international registrations, the name of the holder and the international registration number.

Rule 27(4)

Where payment is made other than by debit from a current account at WIPO, the amount should be stated. Where payment is made from a current account at WIPO, it is sufficient to give a general instruction to the International Bureau to debit whatever is the correct amount for the transaction in question (by ticking the appropriate box on the fee payment sheet which is part of the official form).

Nevertheless, if a specific amount is indicated, the International Bureau treats it as indicative only, debits the correct amount and notifies accordingly the party (applicant, holder, representative or Office) that gave the instruction.

Date of payment

The fees are considered to have been paid on the date on which the International Bureau received the required amount. However, in the case of a renewal, if a payment is received by the International Bureau earlier than three months before the date on which the renewal of the international registration is due, it is considered as having been received three months before that date.

Rule 27(5)(a); Rule 24(1)(d)

Change in the amount of fee

Where an international application is filed through the Office of the applicant's Contracting Party and the amount of the fee payable changes between the date on which the application was received by such Office and the date on which it was received by the International Bureau, it is the fee that was valid on the date of reception of the international application by the Office that is applicable.

Rule 27(6)(a)

Where the renewal of an international registration is requested and the amount of the fee payable changes between the date of payment and the date on which renewal is due, then

- where payment is made not more than three months before the date on which renewal is due, it is the fee that was valid on the date of payment that is applicable;

Rule 27(6)(b)

- where the fee is paid more than three months before the date on which renewal is due, the payment is considered to have been received three months before the due date, and it is the fee that was valid three months before the due date that is applicable (refer to "Date of payment").

Rule 24(1)(d)

Where the renewal fee is paid after the due date, it is the fee that was valid on the due date that is applicable.

Rule 27(6)(b)

In any other case, the applicable amount is that which was valid on the date on which the payment was received by the International Bureau.

Rule 27(6)(c)

Representation before the International Bureau

An international application may be filed with the International Bureau directly by the applicant. If so wished, a representative may be appointed to act on the applicant's behalf before the International Bureau.

Rule 3(1)(a)

The provisions of the Hague System relate only to the representation before *the International Bureau*. Requirements as to the appointment of a representative before the Office of a Contracting Party (in the event, for example, that an appeal is lodged against a refusal of protection) are outside the scope of the Hague System and are exclusively a matter for the law and practice of the Contracting Party concerned.

With respect to who may be appointed as a representative before the International Bureau, the Hague System does not provide for any requirement as to professional qualification, nationality or domicile.

Method of appointment of a representative

In the international application

A representative may be appointed in an international application by indicating the name, postal address and email address of such representative in item 5 of the international application form (DM/1) or in the corresponding section of the electronic filing (eHague) interface. A representative appointed in such a manner may sign the international application in item 19 (no power of attorney required). This being said, the international application may still be signed by the applicant or be accompanied by a power of attorney (refer to "Item 5: Appointment of a representative"). A power of attorney in PDF format may be uploaded in the eHague interface.

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In a separate communication (power of attorney)

The appointment of a representative may also be made at any time in a separate communication. Such separate communication must be signed by the applicant or holder.

Rule 3(2)(b)

The appointment may be made either through the eHague interface (for holders only), or by completing unofficial form (DM/7) made available by the International Bureau for the convenience of applicants and holders.

The communication may also be a simple letter, so long as it clearly identifies the person making the appointment, the name, postal address and email address of the appointed representative and the international application or registration concerned.

Such an appointment may relate to any number of international applications or registrations, provided they are all clearly and individually identified. The International Bureau cannot accept, as an appointment of a representative, a communication which simply and collectively refers to all international applications and registrations in the name of the same applicant or holder.

Only one representative

Only one representative may be appointed in respect of a given international application or registration. Therefore, if the appointment indicates more than one representative in respect of the same international application or registration, only the one indicated first is considered to have been appointed. Where a partnership or firm of attorneys or patent or trademark agents has been indicated, this is regarded as a single representative. If both a natural person and a legal entity are indicated, the representative will be recorded with the name of the legal entity preceding the name of the natural person (e.g. “law firm XYZ, John Doe”).

Rule 3(1)(b); Rule 3(1)(c)

Irregular appointment

Where the appointment of a representative does not comply with the applicable requirements, the International Bureau considers the appointment as irregular. It notifies accordingly the applicant or holder and the purported representative and, failing the required correction, it sends all relevant communications to the applicant or holder or their previously appointed representative.

Rule 3(2)(c)

Recording and notification of appointment

If the appointment of the representative complies with the applicable requirements, the International Bureau records that fact, along with the name, postal address and email address of the representative in the International Register, and notifies both the applicant or holder and the representative concerned. Email addresses are recorded in the International Register, but are not made available to third parties.

Rule 3(3)(a) and (b)

Effect of the appointment

The appointment of a representative has effect as of the date on which the International Bureau receives the communication (international application, request to record a change or separate communication) in which the appointment has been made.

Rule 3(3)(a); Rule 21(2)(b)

A duly recorded representative may always sign a communication, or carry out any other procedural step, in place of the applicant or holder. Any communication addressed by the representative to the International Bureau has the same effect as if it had been addressed to the International Bureau by the applicant or holder. Similarly, where a representative is recorded, the International Bureau sends to this representative any communication which would have been sent to the applicant or holder. Any such communication has the same effect as if it had been addressed to the applicant or holder.

Rule 3(4)(a), (b) and (c)

Where a representative is appointed, the International Bureau does not normally send communications also to the applicant or holder. There are a limited number of exceptions to this rule:

- where cancellation of the appointment is requested, the International Bureau so informs both the applicant or holder and the representative (refer to "Cancellation of appointment");

Rule 3(5)(c)

- six months before the expiry of a five-year term of protection, the International Bureau sends an unofficial notice to both the holder and the representative;

Rule 23

- where insufficient fees are paid for the purpose of renewal, the International Bureau notifies both the holder and the representative.

Rule 24(3)

Apart from these exceptions, whenever this Guide refers to anything being sent to, or done by, an applicant or holder, this should be understood as a reference to it being sent to, or allowed to be done by, a duly-recorded representative.

Cancellation of recording of appointment of a representative

The recording of a representative is canceled upon receipt of a corresponding request signed by the applicant, holder or representative. Cancellation may be requested either through the eHague interface or by completing unofficial form DM/9 (or, alternatively, by submitting a simple letter). The cancellation of the recording may be effected for all the international applications or registrations of the same applicant or holder in respect of which the representative has been duly appointed, or for any specified international applications or registrations of that applicant or holder.

Rule 3(5)(a)

The recording of a representative is canceled *ex officio* by the International Bureau where a new representative has been duly appointed. As noted above, only one representative may be recognized at any one time; the appointment of a new representative is therefore assumed to replace any representative previously appointed.

Rule 3(5)(a)

The recording of a representative is also canceled *ex officio* by the International Bureau where a change in ownership has been recorded and no representative has been appointed by the new holder.

Rule 3(5)(a)

The cancellation becomes effective from the date on which the International Bureau receives the communication leading to the cancellation.

Rule 3(5)(b)

Once the cancellation becomes effective, the International Bureau notifies the cancellation and its effective date to the applicant or holder and to the representative whose appointment has been canceled. It sends all future communications either to the new representative or, where no new representative has been recorded, to the applicant or holder.

Rule 3(5)(c)

No fees

The recording of the appointment of a representative, of any change concerning the representative, or of the cancellation of the recording of a representative, is exempted from the payment of fees.

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1. Unless otherwise specified, where this Guide refers to a communication being sent to or by an applicant or holder, this is to be understood as meaning that, where a representative is recorded in the International Register for that applicant or holder, the communication will be sent to, or may validly be sent by, that representative (refer to "Effect of the appointment").
2. Notwithstanding Rule 6(3)(i), where the international registration was amended in a procedure before the Office, the information on amendments referred to in Rule 18(4)(c), 18*bis*(1)(c) and (2)(c), could be provided in the language in which the Office detains it, even if it is a language other than the working language used for the statement or notification concerned.

International procedure

The life of an international registration starts with the international application and proceeds through to the recording of the international registration. Various events can occur following an international registration, such as refusal of protection, requests for the recording of certain changes (change in name or address, change in ownership, limitation, renunciation or cancellation) and renewal of the international registration.

Harmonization of terminology

The 1960 Act, on the one hand, and the 1999 Act, on the other hand, refer at times to identical concepts while using different terminology. Therefore, for the sake of simplicity and consistency and throughout the Common Regulations, the terminology of the 1960 Act has been brought into line with the more modern terminology used in the 1999 Act. For the purpose of the Common Regulations, five terms contained in the 1960 Act have been harmonized with those contained in the 1999 Act:

- reference to “international application” or “international registration” is deemed to include a reference to “international deposit”, as referred to in the 1960 Act;
- reference to “applicant” or “holder” is deemed to include a reference to, respectively, “depositor” or “owner” as referred to in the 1960 Act;
- reference to “Contracting Party” is deemed to include a reference to a State party to the 1960 Act;
- reference to “Contracting Party whose Office is an Examining Office” is deemed to include a reference to “State having a novelty examination” as defined in Article 2 of the 1960 Act;
- reference to “individual designation fee” is deemed to include a reference to the fee mentioned in Article 15(1)2(b) of the 1960 Act.

Rule 1(2)

Entitlement to file an international application

To be entitled to file an international application, an applicant must satisfy at least one of the following conditions:

- be a national of a State that is a Contracting Party or of a State member of an intergovernmental organization that is a Contracting Party, *or*
- have a domicile in the territory of a State that is a Contracting Party or in the territory in which the treaty establishing an intergovernmental organization that is a Contracting Party applies, *or*
- have a real and effective industrial or commercial establishment in the territory of a State that is a Contracting Party or in the territory in which the treaty establishing an intergovernmental organization that is a Contracting Party applies.

***60** Article 3; **99** Article 3*

In addition, but only under the 1999 Act, an international application may be filed on the basis of a habitual residence in a Contracting Party.

The interpretation of “national”, “domicile”, “habitual residence” and “real and effective commercial or industrial establishment” is exclusively a matter for the laws of the Contracting Parties to determine. This Guide can therefore only give some guidance in that regard.

The term “national” is intended to have the same meaning as in Articles 2 and 3 of the Paris Convention. It is taken to be capable of including both natural and legal persons. The question as to whether a natural person is a national of a particular country, and the criteria for deciding whether a legal entity is regarded as a national of that country (for example, place of incorporation or headquarters), are matters for the law of such country.

The concept of “domicile” can have different meanings, depending on national legislation. It is for the law of a Contracting Party to determine the criteria for either a natural person or a legal entity to be regarded as domiciled in that Contracting Party. Under some legislations a natural person can obtain domicile only by virtue of an official authorization. Other legislations interpret “domicile” as more or less equivalent to “residence”. It is generally believed that the Paris Convention did not seek, by using the expression “domicile”, to indicate a legal situation, but rather a more or less permanent situation of fact, so that a foreign national residing in a Contracting Party would, in most cases, be eligible to claim entitlement through domicile. With respect to legal entities, their “domicile” can be considered to be the place of their actual headquarters.

The term “habitual residence” is taken from the Berne Convention for the Protection of Literary and Artistic Works. It has been used in the 1999 Act in order to compensate for any excessively narrow interpretation that might be given to the concept of “domicile” under domestic laws.

The expression “real and effective industrial or commercial establishment” is taken from Article 3 of the Paris Convention, to which it was added at the first conference for the revision of the Convention which took place in Brussels in 1897 - 1900. It was felt that the original provision, which referred simply to “an establishment”, was too broad and should be restricted. The intention was that, by using the French term “sérieux” (“real” in English), fraudulent or fictitious establishments would be excluded. The term “effective” makes it clear that, while the establishment must be one at which some industrial or commercial activity takes place (as distinct from a mere warehouse), it need not be the principal place of business (at the Brussels Conference, the proposal by one of the States party to the Madrid Agreement to narrow down the requirement of the establishment to the principal place of business was not adopted).

Determination of the State of origin (under the 1960 Act) and determination of the applicant’s Contracting Party (under the 1999 Act)

The “State of origin” under the 1960 Act and the “applicant’s Contracting Party” under the 1999 Act both correspond to the Contracting Party in respect of which the applicant derives the right to file an international application under the Hague Agreement, i.e., the Contracting Party with which the applicant has the required entitlement (through establishment, domicile, nationality or, in respect of the 1999 Act, habitual residence).

However, where an applicant has an entitlement with several Contracting Parties (refer to “Item 2: Entitlement to file”), the “State of origin” and the “applicant’s Contracting Party” are determined according to different principles under, respectively, the 1960 Act and the 1999 Act.

Determination of the State of origin under the 1960 Act

The State of origin is determined as:

- the Contracting State to the 1960 Act in which the applicant has a real and effective industrial or commercial establishment; or
- *if the applicant has no such establishment in such a State*, the Contracting State to the 1960 Act in which he/she has his/her domicile; or
- *if the applicant has neither an establishment nor a domicile in such a State*, the Contracting State to the 1960 Act of which he/she is a national.

***60** Article 2*

Thus, where an applicant has multiple entitlements in different Contracting Parties, the State of origin cannot be freely chosen by that applicant; it is to be determined in accordance with the above described hierarchy.

Determination of the applicant's Contracting Party under the 1999 Act

The "applicant's Contracting Party" is defined by the 1999 Act in such a way as to permit the applicant to freely choose his/her Contracting Party on the basis of establishment, domicile, habitual residence or nationality. For example, if an applicant indicates a domicile in Contracting Party A, bound by the 1999 Act, and the nationality of Contracting Party B, also bound by the 1999 Act, the applicant's Contracting Party is, among Contracting Parties A and B, the one which is indicated as such by the applicant in the international application (refer to "Item 2: Entitlement to file").

***99** Article 1(xiv)*

Plurality of entitlements

An applicant enjoying multiple and independent entitlements may cumulate these with a view to obtaining protection on a broader geographical scale. For example, an applicant having the nationality of Contracting Party A, bound *exclusively* by the 1960 Act and whose domicile is located in Contracting Party B, bound *exclusively* by the 1999 Act, could, as a result, designate all Contracting Parties bound by the 1960 and/or 1999 Acts.

A special case of plurality of entitlements arises in respect of States member of an intergovernmental organization that is a Contracting Party to the 1999 Act, where those States are themselves bound by the 1960 Act. For example, an applicant having the nationality of Contracting Party A, bound *exclusively* by the 1960 Act, that is a member State of the European Union, could, as a result, designate all Contracting Parties bound by the 1960 and/or 1999 Acts, as the European Union is a Contracting Party to the 1999 Act.

Where an applicant enjoying a plurality of independent entitlements under the 1960 and 1999 Acts designates a Contracting Party bound by the same Acts, the designation of that Contracting Party will be governed by the 1999 Act, which is the most recent Act refer to "Determination of which Act is applicable in respect of the designation of a given Contracting Party").

Several applicants

Two or more parties (whether natural persons or legal entities) may jointly file an international application, provided that each of them is in a position to establish an entitlement through a Contracting Party bound by the same Act or Acts. It is not necessary that the Contracting Party concerned be the same in respect of each applicant, nor is it necessary that the nature of the entitlement (nationality, domicile, habitual residence or establishment) be the same for each applicant. For example, where Applicant 1 is a national of Contracting Party A, bound by the 1999 Act, and Applicant 2 has a domicile in Contracting Party B, also bound by the 1999 Act, these applicants may jointly file an international application.

Contents of the international application

The contents of an international application may be divided into three categories, namely, the mandatory contents, the additional mandatory contents where certain Contracting Parties are designated and the optional contents.

Mandatory contents

The mandatory contents consist of the information which must be contained in every international application or accompany it (such as the prescribed particulars concerning the applicant, a reproduction of the designs for which protection is sought or the indication of the designated Contracting Parties; refer to "International application").

Rule 7(3)

Additional mandatory contents

The additional mandatory contents of an international application consist of elements that, under certain conditions, may be notified by a Contracting Party and which must be included in an international application where such Contracting Party has been designated. Furthermore, with respect to Contracting Parties designated under the 1999 Act, the international application shall contain the indication of the applicant's Contracting Party. The elements that may be notified by a Contracting Party whose Office is an Examining Office are the following:

- information concerning the identity of the creator[1];
- a brief description of the reproduction or of the characteristic features of the design in respect of which the application is filed[2]; and/or
- a claim[3].

Those three additional elements correspond to the requirements that certain Contracting Parties require in order for a national application to be accorded a filing date under their domestic legislation (refer to "Identity of the creator" and "Mandatory contents of an international application (declaration)"). Finally, in accordance with its national law, a Contracting Party may notify that the application must be made in the name of the creator and/or that an oath or declaration by the creator must be furnished (refer to "Special requirements concerning the applicant and the creator" in "Contents of the international application", "Item 11: Identity of the creator" and "Special requirements concerning the applicant and the creator (declaration)" in "The Hague System: general overview")[4] [5].

99 *Article 5(2)(a) and (b); Rule 7(4); Rule 8(3)*

Optional contents

Even where information concerning the identity of the creator, or a brief description, is not required for a designation of a Contracting Party which has not made the declaration under Article 5(2)(a), such elements may nevertheless be included in the international application, at the applicant's choice. Since, in this case, they are not mandatory elements, their absence does not cause an irregularity in the international application. In contrast, a claim cannot be indicated by the applicant or an oath or declaration of the creator be furnished, if the international application has not designated a Contracting Party requiring them.

Rule 7(5)(a)

In addition to the elements mentioned in the previous paragraph, a number of prescribed optional elements may be provided by the applicant but their absence does not constitute an irregularity in the international application. The optional contents are: the appointment of a representative, priority claim, declaration of disclosure at an international exhibition, the selection of the publication time, a declaration, statement or other relevant indication as specified in the Administrative Instructions or a statement that identifies information known by the holder to be material to the eligibility for the protection of the design concerned (refer to "Item 13: Priority claim" and "Item 14: International exhibition"). Pursuant to Rule 7(6), the International Bureau shall delete *ex officio* any non-required and non-permitted matter in the international application. Furthermore, if the international application is accompanied by any document other than those required or permitted, the International Bureau may dispose of the said document.

Rule 7(5)(b) to (g); Rule 7(6)

As mentioned in the previous paragraph, the international application may contain any declaration, statement or other relevant indication as may be specified in the Administrative Instructions. Section 407 has been introduced into the Administrative Instructions to address the specific features in some jurisdictions concerning the relation with a principal design or a principal application or registration. In these jurisdictions, the law provides for a "related design" system, which requires that under certain circumstances a reference to the "principal design" must be indicated in an application for the registration of a "related design". (refer to "Item 16: Main or principal design (if applicable)")[6].

In order to assist applicants in avoiding a possible refusal, it is recommended to consult the Guidance on Including Multiple Designs in an International Application in Order to Forestall Possible Refusals, which was established in consultation with the Offices of Contracting Parties, which have a "related design system".

Rule 7(5)(f); A.I. Section 407

The international application may contain a declaration claiming the priority of an earlier filing under Article 4 of the Paris Convention. Where the applicant has claimed priority of an earlier filing in the international application, the Office of a Contracting Party may require that a copy of the application on which the priority is based be submitted directly to it.

Alternatively, pursuant to Section 408(a) of the Administrative Instructions the said claim in the international application may be accompanied by a Digital Access Service (DAS) code allowing to retrieve the earlier filing in the DAS system.

Rule 7(5)(c) and (f); A.I. Section 408(a)

As prescribed in Section 408(b), the international application may additionally contain an indication or a claim of the applicant's economic status which would allow the applicant to benefit from a reduction of an individual designation fee concerning the designation of certain Contracting Parties, as indicated in the declaration made by those Contracting Parties, respectively[7] (refer to "Item 18: Reduction of individual designation fee").

99 *Article 7(2); Rule 7(5)(f); A.I. Section 408(b)*

The international application may likewise contain a declaration concerning an exception to lack of novelty and its supporting documentation. This would allow the applicant to claim benefits from exceptional treatment for disclosure of a design during the grace period provided for in the national law of certain Contracting Parties. This information may only be included in the international application if the law of a designated Contracting Party provides for a "declaration concerning an exception to lack of novelty[8] (refer to "Item 15: Declaration concerning exception to lack of novelty and its supporting documentation").

Rule 7(5)(f); A.I. Section 408(c)

The international application may similarly be accompanied by a statement that identifies information known by the applicant to be material to the eligibility for protection of the design concerned. This information could, for example, concern the patentability of the design for which protection is claimed[9] (refer to Annex III: Information on eligibility for protection).

Rule 7(5)(g); A.I. Section 408(d)

Special requirements under the law of a Contracting Party

Special requirements concerning the applicant and the creator

Any Contracting Party whose legislation requires an application for the registration of a design to be filed in the name of the creator of the design may notify that fact to the Director General of WIPO (refer to "Additional mandatory contents"). If that Contracting Party is designated in the international application, the identity of the creator of the design must be furnished and that person is deemed to be the applicant for the purposes of the Contracting Party concerned, whether or not the international application was filed in creator's name. Furthermore, if the person mentioned in the international application as the creator is not the same as the person named as the applicant, the international application must be accompanied by a statement or document, depending on what the Contracting Party concerned may require, to the effect that the international application has been assigned by the person identified in the international application as the creator to the person named as the applicant (refer to "Application filed in the name of the creator")[10]. The latter person will be recorded as the holder of the international registration. A standard statement for that purpose is included in item 11 of international application form (DM/1) and in the relevant section of the eHague interface[11].

Rule 7(4)(c); Rule 8(1)(a)(i) and (b); Rule 8(2)

Any Contracting Party whose legislation requires the furnishing of an oath or declaration of the creator may notify that fact to the Director General of WIPO. If that Contracting Party is designated in the international application, the international application shall be accompanied by an oath or declaration of the creator and contain indications concerning the identity of the creator of the design[12] (refer to "Annex I: Oath or Declaration of the Creator").

Rule 7(4)(c); Rule 8(1)(a)(ii) and (b); Rule 8(3)

Special requirements concerning the unity of the design

Any Contracting Party whose law, at the time of its becoming party to the 1999 Act, contains a requirement of unity of design (according to which, generally speaking, two or more designs included in the same application have to conform to the same creative concept) may notify that fact to the Director General of WIPO[13]. The requirement of unity of design may vary from one Contracting Party to another. For example, in some jurisdictions only one independent and distinct design may be claimed in a single application, whereas in another several independent designs may be included in a single application if they belong to a set.

The requirement of unity of design notified by a Contracting Party under the 1999 Act does not affect the applicant's right to include up to 100 designs in the international application even if that Contracting Party is being designated. The purpose of the notification of such a requirement is to enable the Office of the Contracting Party that has made it to refuse the effects of the international registration, pending compliance with the requirement in question. In that case, the international registration may be divided before the Office concerned in order to overcome the ground of refusal based on lack of unity of design. The Office is entitled to charge the holder of that registration as many additional fees as divisions prove necessary. The mode of payment of additional fees for this type of transaction is not governed by the Hague System; they will be specified by each Contracting Party concerned, which will collect them directly from the owner (refer to "Procedure following notification of refusal").

99 *Article 13*

Where an international registration has been divided before the Office of a designated Contracting Party following a notification of refusal based upon lack of unity of design, that Office must notify the International Bureau of that fact, together with the following additional particulars:

- the Office making the notification;
- the number of the international registration concerned;
- the numbers of the designs which have been the subject of the division with the Office concerned; and
- the resulting national or regional application numbers or registration numbers.

A.I. Section 502

Language of the international application

An international application may be in English, French, or Spanish, at the applicant's option. However, where an international application is presented to the International Bureau through the intermediary of an Office, that Office may restrict the choice of the applicant and require the application to be in any one or two of those three languages.

Rule 6

If the international application is not in one of the prescribed languages, this constitutes an irregularity entailing a postponement of the filing date of the international application (refer to "Irregularities entailing a postponement of the filing date of the international application").

Rule 14(2)(a)

With regard to the language of communications relating to an international application or to the resulting international registration, refer to "International applications" under "Languages".

1. Romania is the only Contracting Party that has made a declaration under Article 5(2)(b)(i) concerning the identity of the creator as additional mandatory content.
2. China, Romania, the Syrian Arab Republic and Viet Nam have made a declaration under Article 5(2)(b)(ii) concerning a brief description as additional mandatory content.
3. The United States of America and Viet Nam have made a declaration concerning a claim under Article 5(2)(a) and (b)(iii).
4. Brazil, Finland, Ghana, Hungary, Iceland, Mauritius and Mexico have made a declaration under Rule 8(1) that the international application must be made in the name of the creator.
5. The United States of America is the only Contracting Party that has made a declaration under Rule 8(1)(ii) requiring the furnishing of an oath or declaration of the creator.
6. Section 407 is applicable for the designation of Japan and/or the Republic of Korea.
7. China, Israel, Mexico and the United States of America have indicated in their declaration under Article 7(2) different amounts of individual designation fees, depending on the status of the applicant.
8. This provision is applicable for the designation of China, Japan and the Republic of Korea.
9. Section 408(d) applies for the designation of the United States of America only. The duty of disclosure under the national law of the United States of America continues even after the filing date and shall be monitored by the holder of the international registration.
10. Brazil, Finland, Ghana, Hungary, Iceland, Mauritius and Mexico have made a declaration under Rule 8(1) that the international application must be made in the name of the creator.
11. The national laws of Bulgaria, China, Japan, Republic of Korea, Russian Federation, Serbia, Tajikistan and Türkiye require that the identity of the creator be mentioned. Although this indication is not mandatory within the framework of the Hague System, applicants are advised to declare the identity of the creator as a matter of course, when those Contracting Parties are designated in the international application. Given that this is an optional indication under the international procedure, the International Bureau will not examine whether this requirement has been complied with or not.
12. The United States of America is the only Contracting Party that has made the declaration under Rule 8(1)(a)(ii).
13. Brazil, China, Estonia, Kyrgyzstan, Mexico, Romania, Russian Federation, Syrian Arab Republic, Tajikistan, the United States of America and Viet Nam have made a declaration under Article 13(1).

How to submit an international application to the International Bureau: eHague or form DM/1

It is recommended that an international application be submitted to the International Bureau through the electronic filing (eHague) interface. It may also be submitted by uploading the relevant official form (form DM/1) through Contact Hague. If an international application, governed exclusively by the 1999 Act, has been presented to the International Bureau through an Office, the Office should indicate the date on which it received the international application in the separate box "For use by the Office of indirect filing". This date is important since it will become, in principle, the date of the international registration (refer to "Date of the international registration").

All items of form DM/1 are mandatory, unless it is indicated in the relevant field as "optional". Where an item is mandatory in certain circumstances, for example only for certain designations, it is indicated in the relevant item as "if applicable". The eHague interface automatically checks the said mandatory and additional mandatory contents of the application. In principle, applications using form DM/1 may be submitted either directly to the International Bureau or via the Office of a Contracting Party (refer to "Channels of communication").

Rule 7(1)

Annex I to form DM/1 allows the applicant to submit a "Declaration of Inventorship" or, if not possible, a "Substitute Statement in Lieu of a Declaration of Inventorship", in respect of a designation of the United States of America. This is mandatory if the United States of America is designated. Annex II allows the applicant to submit documentation in support of a declaration concerning exception to lack of novelty in respect of designation of China, Japan or the Republic of Korea. Annex III serves to submit a statement that identifies information known by the applicant to be material to the eligibility for protection of the design concerned. It is only relevant for the designation of the United States of America. Annex IV allows the applicant to support a claim of micro entity status with a micro entity certification in order to benefit from a reduction of the individual designation fee in respect of a designation of the United States of America. Annex V allows the applicant to submit a document in support of a priority claim (priority document) when designating China, Japan or the Republic of Korea.

Sections corresponding to Annexes I, II, III, IV and V are also included in the eHague interface.

The eHague interface has the following advantages:

- personalized workbench environment (Portfolio Manager);
- uploading of multiple reproductions simultaneously;
- real-time checking of certain formalities;
- saving of applications in progress;
- a fully integrated fee calculator;
- online payment options according to the user profile;
- faster delivery of the application;
- lower fees when the application contains many reproductions of the designs to be registered, since reproductions submitted on paper are subject to a fee for each page beyond the first (refer to "Fees due" in "Payment of fees");
- instant acknowledgement of receipt with all the details of the submitted application;
- sending corrections to irregularities or defects (including corrected reproductions and documents) to the International Bureau;
- receiving and downloading notifications from the International Bureau relating to international applications; and
- retrieving in real-time the current status of international applications.

When a notification concerning an international application filed through the eHague interface is available, the user who filed that international application will receive an email alert at the email address provided when creating their user account. The alert will provide a secure download link to the notification or in some cases a PDF attachment. The International Bureau will also send notifications by regular mail.

Rule 9(1); A.I. Section 401(c)

How to complete the international application (form DM/1 or eHague)?

The following explanations are in line with the structure of the official form for an international application (form DM/1) and refer to the successive items contained in the form. It is understood that these explanations equally apply to the eHague interface.

In the separate box of form DM/1, the applicant may indicate: own reference, number of continuation sheets (if any), and the Annex(es) accompanying the international application (if any).

Item 1: Applicant

Name

Where the applicant is a natural person, the name to be indicated is the family (or principal, or last) name and the given (or secondary or first) name(s) of the natural person, as customarily used by that person and in the order in which they are customarily used. Where the applicant is a legal entity, its full official designation must be given. Where the name of the applicant is in characters other than Latin characters, the name must be indicated as a transliteration into Latin characters, following the phonetics of the language of the international application. Where the applicant is a legal entity, the transliteration may be replaced by a translation into the language of the international application.

Rule 7(3)(i); A.I. Section 301

Several applicants

Where there is more than one applicant, the appropriate box should be ticked and the relevant information regarding each of the other applicants should be furnished on a continuation sheet. The eHague interface also allows the indication of several applicants.

Email address

The international application must include the applicant's email address. The International Bureau will send all electronic communications to this email address unless a representative is appointed or an email address for correspondence for multiple applicants is provided under item 4. Email addresses are recorded in the International Register but are not made available to third parties.

Postal address

The postal address of the applicant must be given in such a way as to satisfy the standard requirements for prompt postal delivery and should consist, at least, of all the relevant details up to, and including, the house number, if any. In addition, a telephone number may be given.

Telephone number

It is recommended to indicate a telephone number so as to facilitate communication by the International Bureau with the applicant concerning the international application.

Rule 7(3)(ii); A.I. Section 205(1); A.I. Section 301(d)

Item 2: Entitlement to file

Although only one entitlement with one Contracting Party is required in order to file an international application, more than one Contracting Party may be indicated for each criterion in item 2. The applicant is required to indicate in item 2 the Contracting Party(ies) in which the applicant has a real and effective industrial or commercial establishment (if any), as well as the Contracting Party(ies) in which the applicant has a domicile (if any), and also the Contracting Party(ies) of which the applicant is a national (if applicable).

Rule 7(3)(iii)

In addition, the applicant is required to indicate the Contracting Party(ies) in which the applicant has habitual residence (if any), provided that such Contracting Party is bound by the 1999 Act. In fact, the possibility of claiming an entitlement through habitual residence is contemplated only by the 1999 Act, and not by the 1960 Act.

If official form DM/1 is used, the full name of the Contracting Party should be indicated. For an electronic application, the official two-letter code for the Contracting Party should be selected from the corresponding dropdown list.

The indications concerning each of the above criteria must all be completed, even if the Contracting Party concerned is the same in each case. If any criterion is not applicable, the applicant should simply write “None”.

Entitlement via an intergovernmental organization

Intergovernmental organizations may become party to the 1999 Act. There are currently two such Contracting Parties: the European Union (EU) and the African Intellectual Property Organization (OAPI).

Applicants having a real and effective industrial or commercial establishment, a domicile or a habitual residence, in a Contracting Party that is a member State of an intergovernmental organization that is a Contracting Party, or being a national of a Contracting Party that is a member State of an intergovernmental organization that is a Contracting Party, should indicate both that Contracting Party and that intergovernmental organization. However, where entitlement is derived from a connection with a member State of an intergovernmental organization but which is not itself a Contracting Party, only the name of the intergovernmental organization should be indicated.

Multiple entitlements

It is important for the applicant to indicate possible *multiple* entitlements in different Contracting Parties, since that applicant would then be in a position to cumulate those multiple entitlements with a view to obtaining protection on a broader geographical scale.

For example, an applicant having the nationality of Contracting Party A, bound *exclusively* by the 1960 Act and whose domicile is located in Contracting Party B, bound *exclusively* by the 1999 Act, could, as a result, designate all Contracting Parties bound by the 1960 and/or 1999 Acts.

Where an applicant enjoying a plurality of independent entitlements under the 1960 and 1999 Acts designates a Contracting Party bound by the same Acts, the designation of that Contracting Party will be governed by the 1999 Act, which is the most recent Act (refer to "Determination of which Act is applicable in respect of the designation of a given Contracting Party").

Item 3: Applicant's Contracting Party (only if the 1999 Act applies)

Under the 1999 Act, the applicant's Contracting Party is the Contracting Party through which the applicant derives the right to file an international application. If only one Contracting Party bound by the 1999 Act is indicated under item 2, that Contracting Party must also be indicated under item 3. On the other hand, if several Contracting Parties bound by the 1999 Act are indicated under item 2, one of them must be selected as the applicant's Contracting Party. That Contracting Party must be specified by the applicant in any international application governed *exclusively or partly by the 1999 Act* (as regards the determination of the applicant's Contracting Party, refer to "Determination of the applicant's Contracting Party under the 1999 Act").

***99** Article 1(xiv); Rule 7(4)(a)*

The indication of the State of origin under the 1960 Act is not required in international applications since such indication does not have any effect on the examination carried out by the International Bureau. It may however be deduced through the indications of the entitlements claimed in the international application form (as regards the determination of the State of origin, refer to "Determination of the State of origin under the 1960 Act").

Item 4: Email address for correspondence for multiple applicants *(if applicable)*

Where the name, postal address and email address of a representative have been given in item 5 of the international application form, all communications which are required to be sent by the International Bureau to the applicant are sent to the email address of that representative. Otherwise, all communications are sent to the email address of the applicant, as indicated in item 1 of the application form.

However, if there are multiple applicants and no representative is indicated in item 5 of the application form, one email address *must* be indicated for correspondence with all applicants. In default of such indication in the application form, the email address of the first person named as applicant in item 1 is treated as the relevant email address for correspondence.

A.I. Section 302

Item 5: Appointment of a representative *(optional)*

If the applicant wishes to be represented before the International Bureau, the name, postal address and email address of the representative should be given in this part of the form. The information should be sufficient to enable correspondence to reach the representative, and should preferably include a telephone number. For eHague, the International Bureau will confirm receipt of the international application to the email address as provided.

Error! Hyperlink reference not valid.*; Rule 7(5)(b); A.I. Section 301*

Where the name of the representative is in characters other than Latin characters, the name must be indicated as a transliteration into Latin characters, following the phonetics of the language of the international application. Where the representative is a legal entity, the transliteration may be replaced by a translation into the language of the international application.

A.I. Section 301(c)

A representative may be appointed in an international application by indicating the name, postal address and email address of such representative in this item or in the corresponding section of the eHague interface. Where a representative is appointed, the international application form may be signed either by the applicant or representative in item 19. A power of attorney is not required, but may be submitted with the international application. A power of attorney in PDF format may be uploaded in the eHague interface.

Rule 3(2)(a)

The Hague System does not contain any restriction or requirement as to who may be appointed as representative before the International Bureau (concerning, for example, professional qualification, nationality or residence). It follows that an applicant may appoint a representative residing or carrying on business in a Contracting Party which is not the State of origin or the applicant's Contracting Party, and it is not even necessary that the representative be residing or carrying on business in a Contracting Party.

The appointment of a representative in the international application empowers the representative to act only before the International Bureau. It may subsequently become necessary to appoint one or more further representatives to act before the Offices of designated Contracting Parties, for example, in the event of a refusal of protection notified by such an Office. In such case, the appointment of a representative is governed by the requirements of the Contracting Party concerned.

The International Bureau records in the International Register the appointment of a representative and any other relevant detail concerning that representative. Email addresses are recorded in the International Register but are not made available to third parties.

Item 6: Number of designs, reproductions and/or specimens

The following must be indicated in item 6 of the international application form:

- the total number of designs included in the international application – which may not exceed 100,
- the total number of reproductions,
- the total number of A4 pages comprising reproductions (refer to "The reproductions of the designs"), and

- the total number of specimens, if any (refer to "Filing of specimens under the 1999 Act" and "Filing of specimens under the 1960 Act").

Rule 7(3)(v)

For eHague, the total number of designs and reproductions will be filled in automatically based on the information and reproductions provided. Information in respect of paragraph (c) is not relevant when filing electronically. Furthermore, eHague is unavailable if the application includes specimens of the design(s) instead of reproductions.

If a Contracting Party that has notified a requirement of unity of the design under Article 13(1) is designated under the 1999 Act and this requirement is not satisfied, the designs may nonetheless be filed in the same international application, but the Office concerned may refuse protection pending compliance through a procedure of division of the international registration before that Office (refer to "Procedure following notification of refusal")[1].

If more than one design is included in the international application, it is recommended to consult the Guidance on Including Multiple Designs in an International Application in Order to Forestall Possible Refusals, which was established in consultation with the Offices of Contracting Parties that notified a requirement of unity of the design under Article 13(1) of the 1999 Act.

In particular, the National Institute of Industrial Property of Brazil (INPI), the China National Intellectual Property Administration (CNIPA), the Mexican Institute of Industrial Property (IMPI), the Federal Service for Intellectual Property (ROSPATENT), the United States Patent and Trademark Office (USPTO) and the Intellectual Property Office of Viet Nam (IP Viet Nam) are likely to refuse the effects of an international registration pending compliance with the requirement of unity of design under their respective laws.

As specified in the declaration made by Brazil, an international application may contain only one industrial design, which may consist of up to 20 variants, provided they are intended for the same purpose and maintain the same preponderant distinctive characteristics.

As specified in the declaration made by China, an international application may contain only one design, except that two or more similar designs for the same product or two or more designs which are incorporated in products sold or used in sets may be included in one application. In particular, where an international application contains two or more similar designs for the same product, the total number of designs must not exceed 10 and the applicant must indicate one of them as the "main design" (refer to "Item 16: Main or principal design"). Where an international application contains two or more designs which are incorporated in products sold or used in sets, all designs must have the same concept of design.

As specified in the declaration made by Mexico, an international application may only contain one design or a group of designs which are interrelated in such a way as to form a single concept.

As specified in the declaration made by the Russian Federation, the designs that are the subject of the same international registration shall meet the requirement of the unity of a single creative concept. This requirement is met where there is:

- one independent and distinct design; or
- one design and its variants differing from that design by visually insignificant features and/or by color combination; or

- a group of designs belonging to the same set of products, as well as one or more designs for separate products belonging to the same set of products.

Furthermore, as specified in the declaration made by the United States of America, only one independent and distinct design may be claimed in a single application. This requirement is met where there is only one design in the international registration, or where the designs in the international registration are patentably indistinct.

Finally, as specified in the declaration made by Viet Nam, only one independent and distinct design may be claimed in a single international application, except that:

- designs that are the subject of the same international application must belong to the same set of composition of items and conform to a requirement of unity of design, unity of use or accompaniment of each other in use, or
- a design may be accompanied by single or multiple options, that are variations, of that design, which must conform to a requirement of unity of design and be insignificantly different from that design.

Item 7: Designated Contracting Parties

The applicant must, by ticking the appropriate box, designate each Contracting Party where protection is sought. If filing electronically, only those Contracting Parties which may be designated appear in the eHague interface. It is mandatory to indicate all Contracting Parties for which protection is sought. No Contracting Parties may be added afterwards.

60 *Article 5(2);* **99** Article 5(1)(v)*; Rule 7(3)(vi)*

What Contracting Parties may be designated?

Each designated Contracting Party must be bound by an Act – the 1999 Act and/or the 1960 Act – to which one of the Contracting Parties indicated in item 2 (Entitlement to file*)* is also bound. A table of Contracting Parties, with an indication of the Act or Acts to which each particular State is party, is annexed to official form DM/1. In the eHague interface, the selection of Contracting Parties that may be designated is determined automatically on the basis of the entitlement to file data provided under item 2.

For example, if an applicant has indicated that he/she has an establishment only in Country A, which is bound exclusively by the 1999 Act, and has not indicated any other entitlements, the applicant may only designate Contracting Parties which are bound by the 1999 Act, whether or not such Contracting Parties are also bound by the 1960 Act. The applicant may not, however, designate Contracting Parties bound exclusively by the 1960 Act.

If, instead, the applicant has indicated that he/she has an establishment in Country A, which is bound by the 1960 Act, and that the applicant also has a domicile in Country B, which is bound by the 1999 Act, the application may cumulatively designate Contracting Parties which are party to either the 1960 Act exclusively, the 1999 Act exclusively, or to both the 1960 Act *and* the 1999 Act.

A special case of plurality of entitlements arises in respect of States members of an intergovernmental organization that is a Contracting Party, where those States are themselves bound by the 1960 Act. For example, an applicant having the nationality of Contracting Party A, bound *exclusively* by the 1960 Act, that is a member State of the European Union, could, as a result, designate all Contracting Parties bound by the 1960 or 1999 Acts, as the European Union is a Contracting Party to the 1999 Act.

Where an applicant enjoying a plurality of independent entitlements under the 1960 and 1999 Acts designates a Contracting Party bound by the same Acts, the designation of that Contracting Party will be governed by the 1999 Act (refer to "Determination of which Act is applicable in respect of the designation of a given Contracting Party").

It is essential that an applicant designates, at the time of filing of the international application, *all* those Contracting Parties where it is intended to seek protection for a design. If it subsequently becomes necessary to extend protection to additional Contracting Parties, this can only be done by means of filing a new international application.

Protection in the State of origin and in the applicant's Contracting Party

As a matter of principle, it is possible for an applicant under the Hague System to request protection in the State of origin and in the applicant's Contracting Party (refer to "Entitlement to file an international application").

The 1960 Act provides as a principle that an international registration has effect in the State of origin, unless otherwise specified in its national legislation. Given that information concerning such exclusion is not required to be communicated to the Director General of WIPO, the International Bureau does not carry out an examination in that respect.

***60** Article 7(2)*

The 1999 Act expressly provides that any Contracting Party whose Office is an Examining Office may, in a declaration, notify the Director General of WIPO that, where it is the applicant's Contracting Party, its designation in an international registration has no effect. Where a Contracting Party which has made that declaration is indicated in an international application both as the applicant's Contracting Party and as a designated Contracting Party, the International Bureau disregards the designation of the Contracting Party in question.

***99** Article 14(3)*

Item 8: Product indication

Item 8 provides for a table in which the applicant must indicate what the design(s) consist of. Such indication must be considered differently, depending upon whether one is concerned with a two-dimensional or a three-dimensional design:

- if the design consists of a product, the usual generic name of that product should be indicated, for example: "chair";
- if the design consists of a decorative motif in two-dimensions destined to be used in relation to a product, that product should be indicated, for example: "drawing to be used on dishes" or "motif for textiles".

These indications must be given for each design, in numerical order.

***60** Article 5(2); **99** Article 5(1)(iv)*

Some domestic laws, for example those of Japan and the Republic of Korea, prescribe that the scope of protection of a design be determined by the indication of a product, in addition to the representation of a design. Pursuant to the laws of those Contracting Parties, the indication of a product using a comprehensive term, for example: "material for construction" is not allowed, since, in such a case, the scope of protection would be too broad. Therefore, where an applicant designates those Contracting Parties in the international application, it is recommended that the product be indicated by terms by which the purpose of the product can be clearly understood (for example, "window profile") in order to avoid receiving refusal upon that ground[3].

The applicant may also indicate the (single) class of the Locarno Classification to which those designs belong. In the case of several designs included in the same international application, all those designs must belong to the same class of the Locarno Classification (refer to "Contents of the application")[4].

Rule 7(7)

In addition, in the right-hand side of the table, the sub-class to which the product(s) concerned belong may also be indicated.

The indications relating to the class and sub-class(es) are not compulsory and therefore failure to provide them does not result in an irregularity being raised by the International Bureau. However, if the International Bureau finds that several designs included in the same international application belong to different classes of the Locarno classification, this constitutes an irregularity which will have to be remedied (refer to "Time limit for correcting irregularities").

Item 9: Description *(if applicable)*

As a matter of principle, the description is an optional indication which may be included in any international application. If a description is provided, it should relate to the characteristic visual features of the designs that appear in the reproductions, or describe the type of the reproduction(s) (refer to "Item 10: Legends"). For example, a legend(s) may define a specific view of the product (e.g. "front view", "top view", etc.)[5] (refer to "Representation of the design" and "Numbering of reproductions and legends"). The description may disclose

the operation or possible use of the design as long as this description is not technical. If the description exceeds 100 words, an additional fee of 2 Swiss francs per each word exceeding 100 is payable. If the Russian Federation is designated, ROSPATENT recommends that a brief description of the characteristic features of the design be provided.

Rule 7(5)(a); A.I Section 405(c)

However, under the 1999 Act, any Contracting Party whose Office is an Examining Office and whose law requires that an application for the grant of protection to a design should contain a description in order for that application to be accorded a filing date may, in a declaration, notify the Director General of WIPO accordingly. China, Romania, the Syrian Arab Republic and Viet Nam have made that declaration. Where such Contracting Party is designated under the 1999 Act, the international application should contain a brief description of the characteristic features of the design (or alternatively - only for the Syrian Arab Republic - a brief description of the reproduction).

Failure to provide the necessary description results in the international application being considered as irregular and may entail the postponement of the date of the international registration (refer to "Irregularities concerning special requirement notified by a Contracting Party or regarding the identity of the creator, description and claim"). Both the application form (DM/1) and the eHague interface clearly indicate in respect of which Contracting Parties the description is required.

99 *Article 5(2)(b)(ii); Rule 7(4)(b)*

The description may also serve as a way of disclaiming protection in respect of some characteristics of the designs. Furthermore, matter which is shown in a reproduction but for which protection is not sought may be indicated in the description (and/or by means of dotted or broken lines or coloring in the reproduction (refer to "Disclaimers and matter that does not form part of the claimed design")). Even if the disclaimed part of the design or the matter other than the design is indicated by those means in the reproductions, it is recommended to explain in the description how they are indicated in the reproductions to avoid any confusion by the Office of the Contracting Party.

A.I. Section 403

Item 10: Legends *(optional)*

In item 10, the corresponding code of a legend (for example, No. 1 for perspective view, No. 2 for front view, etc.) may be indicated. If code No. 00 is indicated, other legends may be indicated (limited to 50 characters). It is recommended that a legend be provided, in particular when designating China, Japan and/or the United States of America.

Item 11: Identity of the creator *(if applicable)*

As a matter of principle, the identity of the creator of the designs is an optional indication which may be included in any international application. However, such indication may be mandatory in some circumstances under the 1960 and/or the 1999 Act.

Under the 1960 Act, the law of a Contracting Party may require such information where it is designated under that Act (without the need to make a corresponding notification to the Director General of WIPO). Therefore, whenever such a Contracting Party is designated under the 1960 Act, the international application should contain the identity of the creator. Failure to provide this indication may lead to a refusal of protection being issued by the

Office of the Contracting Party in question. However, given that the requirement to furnish the identity of the creator does not have to be notified to the Director General of WIPO under the 1960 Act, the International Bureau does not carry out an examination in that respect.

***60** Article 8(4)(a)*

Under the 1999 Act, any Contracting Party whose Office is an Examining Office and whose law requires that an application for the grant of protection to a design should contain the identity of the creator in order for that application to be accorded a filing date may, in a declaration, notify the Director General of WIPO accordingly. Romania is the only Contracting Party that has made this declaration. Therefore, if Romania is designated under the 1999 Act, the international application shall contain indications concerning the identity of the creator.

***99** Article 5(2)(b)(i)*

In addition, any Contracting Party to the 1999 Act whose legislation requires an application for the registration of a design to be filed in the name of the creator of the design or requires the furnishing of an oath or declaration of the creator may notify that fact to the Director General of WIPO. Brazil, Finland, Ghana, Hungary, Iceland, Mauritius and Mexico have made such a declaration to the effect that the application be filed in the name of the creator. Therefore, applicants who designate Brazil, Finland, Ghana, Hungary, Iceland, Mauritius and/or Mexico in their international applications shall indicate the identity of the creator, and if the person identified as the creator is different from the applicant, state under this item that the present international application has been assigned by the creator to the applicant (refer to "Special requirements concerning the applicant and the creator" and "Application filed in the name of the creator"). However, both the official form DM/1 and the eHague interface contain an embedded standard statement to that effect so that in practice no specific statement is required when any of these Contracting Parties is designated.

In the case that a Contracting Party having made a declaration requiring the furnishing of an oath or a declaration of the creator is designated in an international application, the international application shall be accompanied by an oath or declaration of the creator and contain indications of the identity of the creator. At present, only the United States of America has made such a declaration. Annex I to form DM/1 (refer to "Annex I: Oath or Declaration of the Creator") and the eHague interface allows the applicant to submit a declaration of inventorship (or, if not possible, a substitute statement in lieu of a declaration of inventorship) for the designation of the United States of America. It is mandatory content for an international application designating the United States of America.

***99** Article 10(2)(b); Rule 7(4)(b); Rule 8(1),(2) and (3))*

Finally, the law of a Contracting Party may require that the identity of the creator be indicated. Bulgaria, China, Japan, Republic of Korea, Russian Federation, Serbia, Tajikistan and Türkiye have informed the International Bureau that their respective national laws require that element. Applicants who designate Bulgaria, China, Japan, Republic of Korea, Russian Federation, Serbia, Tajikistan or Türkiye are thus advised to declare the identity of the creator as a matter of course. However, given that this is an optional indication under the international procedure as such the International Bureau will not examine whether this requirement has been complied with or not.

Item 12: Claim *(if applicable)*

Where the international application contains the designation of the United States of America or Viet Nam, a claim with the wording as specified in the declaration under Article 5(2)(a) of the 1999 Act made by the United States of America or Viet Nam must be contained in the international application (United States of America: "the ornamental design for [indicate an article] as shown and described"; Viet Nam: "Application for overall protection for design(s) as shown and described"). That wording is reproduced in the application form and the eHague interface.

If neither the United States of America nor Viet Nam is designated, a claim may not be included in the international application.

With respect to the designation of the United States of America, it is important to note the relationship between the claimed invention, as defined by the claim (Item 12), and naming each creator (Item 11). Under U.S. national law, the creators, referred to as inventors, of the claimed invention must be named. The claimed invention is also relevant to the oath or declaration of each creator required under Rule 8(1)(a)(ii), because the oath or declaration must include a statement that the person signing the oath or declaration believes that each named inventor is an inventor of a claimed invention in the application. For international applications that contain multiple designs, care should be taken to name and submit an oath or declaration for each creator (inventor) of the claimed design. For example, if the international application contains a design for a ring invented by creator A and a different design for a necklace invented by creator B, but the claimed invention is to "[a]n ornamental design for a ring as shown and described", then it would not be proper for creator B to execute the Declaration of Inventorship (Annex I), since creator B is not the inventor of a claimed invention. Accordingly, the article indicated in the claim should be chosen to ensure consistency with the naming of the creators and proper execution of the oath or declaration of the creator required under Rule 8(1)(a)(ii), and to cover all embodiments applicant intends to claim protection for in the United States of America.

Item 13: Priority claim *(if applicable)*

Priority of an earlier filing may be claimed under Article 4 of the Paris Convention. Priority may be claimed on the basis of a first filing made in one of the States party to the Paris Convention or any member of the World Trade Organization.

***60** Article 5(2); **99** Article 6(1)(a)*

Moreover, since an international application for registration of designs may be a *first* application under the Hague System, it may itself also serve as a basis for claiming priority with regard to a subsequent national, regional or international application.

A priority claim should be indicated under item 13. The priority claim may be to a single earlier filing or to multiple earlier filings.

Where priority is claimed, the name of the Office with which the earlier filing was made or the country in which it was filed, the number of the earlier filing (if available), and the date of the earlier filing (in the order of day, month and year) must be indicated. A priority claim to an earlier filed international application for registration of designs should indicate the International Bureau as the Office of earlier filing and identify the number of the earlier filing by the application number (nine-digit number where the application was filed using form DM/1 or in the case of indirect filings, or "WIPO" + number where the application was filed using eHague) assigned by the International Bureau[6]. Where priority is claimed from more than one earlier filing and all the relevant details cannot be accommodated in the space

provided, those with the earliest date should be provided under item 13 and all other details should be set out on a continuation sheet (unless a self-generated form is used).

Furthermore, if the Office of the earlier filing participates in the WIPO Digital Access Service (DAS) as a "depositing Office" with respect to priority documents for design applications, an access code (DAS code) may be obtained from that Office and indicated under item 13, as explained below.

Rule 7(5)(c)

Where the earlier filing does not relate to all the designs included in the international application, the applicant should specify those designs for which priority is claimed by referencing the numbers of the designs in question. If nothing is specified in this part of item 13, it will be assumed by the International Bureau that the priority claim relates to *all* the designs.

The International Bureau disregards any claimed priority which bears a date which is more than six months earlier than the filing date of the international application, and so informs the applicant.

Priority document

A priority document is a certified copy of an earlier application, which is obtained from the Office with which the earlier application was filed.

The International Bureau does not require a priority document, where the applicant claims the priority of an earlier application. Therefore, a priority document should not be submitted with the international application. Similarly, subsequent submission of a priority document to the International Bureau is not accepted. A priority document submitted to the International Bureau will be disposed of, with the exception of the submission of priority documents using Annex V (or corresponding section in the eHague interface) for the designation of China, Japan or the Republic of Korea, as explained below.

This does not, however, preclude the Office of a designated Contracting Party from requesting that the holder furnish a priority document to it directly. Such a request could, for example, be made in the context of a refusal, where the Office takes the view that the priority document is necessary in order to establish novelty, because of disclosure of a competing design during the period covered by the priority claim.

Notwithstanding the general principles above, if the applicant claims priority of an earlier filing, several Contracting Parties have indicated that, under their national laws, a priority document must, without exception, be furnished to their Offices in order to support the priority claims.

If China, Japan or the Republic of Korea is designated, and a priority claim is indicated in item 13, the applicant may tick the appropriate box in item 13 and submit a copy of a priority document with the international application, either through the eHague interface, or by using Annex V to form DM/1. The submission of a copy of a priority document in this manner is only possible at the time of filing the international application and only to support the priority claim for a designation of China, Japan and/or the Republic of Korea. The copy of a priority document so received by the International Bureau will be electronically distributed to the China National Intellectual Property Administration (CNIPA), the Japan Patent Office (JPO) and/or the Korean Intellectual Property Office (KIPO). Instead, if the Office of the earlier filing participates in the WIPO Digital Access Service (DAS) as a "depositing Office" with respect to priority documents for design applications, an access code

(DAS code) may be obtained from that Office and indicated under item 13, as the CNIPA, JPO and KIPO participate in DAS as an "accessing Office" with respect to priority documents for design applications. If the copy of a priority document was submitted using Annex V or a DAS code was indicated in item 13, the priority document does not need to be furnished to the CNIPA, JPO or KIPO.

If China, Japan or the Republic of Korea is designated but neither a copy of a priority document is submitted using Annex V nor a DAS code is indicated in item 13, the priority document must be submitted directly to the Office concerned within three months from the date of publication of the international registration in the *I.D.B.*, failing which the right of priority will be lost and, as a result, their Offices may refuse the international registration. If Japan or the Republic of Korea is designated, and the holder resides outside the country concerned, the priority document must be submitted through a local representative.

Similarly, Mexico requires the submission of a priority document if priority is claimed in an international application in which Mexico is designated. Therefore, if Mexico is designated, the priority document must be submitted directly to the Mexican Institute of Industrial Property (IMPI) within three months from the date of publication of the international registration in the *I.D.B.* Furthermore, the proof of payment of the fee for a recognition of the priority claim as well as a Spanish translation, when the priority document is in a different language, must be submitted to IMPI within the said period. The holder of the international registration or his/her representative residing outside the country may file the priority document directly with IMPI and, in that case, must provide a postal address in Mexico for receiving notifications. When the priority document is submitted through a representative, that representative must establish his/her identity in accordance with the law of Mexico. IMPI participates in WIPO DAS as an "accessing Office" with respect to priority documents for design applications. However, the submission of the proof of payment of a priority claim fee to IMPI is required, as well as a Spanish translation when the priority document is in a different language, even if a DAS code is indicated in item 13.

With respect to China, Japan, Mexico and the Republic of Korea, it is important to note that, pursuant to their national legislations, the international registration may be refused on the ground of lack of novelty if the first filing on which the priority is based was published prior to the date of the international registration (which in most cases is the same as the filing date of the international application), and no priority document was submitted in the aforementioned applicable means.

Brazil and the United States of America also require the submission of a priority document if priority is claimed in an international application in which they are designated. Both the National Institute of Industrial Property of Brazil (INPI) and the United States Patent and Trademark Office (USPTO) participate in WIPO DAS as an "accessing Office" with respect to priority documents for design applications. Thus, if the Office of the earlier filing participates in WIPO DAS as a "depositing Office", a DAS code may be indicated under item 13, in which case the priority document does not need to be furnished to those Offices.

However, in the case of the designation of Brazil, if no DAS code is indicated in item 13, the priority document must be submitted directly to INPI within 90 days from the date of publication of the international registration in the I.D.B, together with the payment of a priority claim fee. Furthermore, the priority document must be accompanied by a Portuguese translation, if it is in a different language, and a declaration that the content of the international application is faithfully contained in the priority document. If the holder resides outside the country, the priority document must be submitted to INPI through a local representative.

In the case of the designation of the United States of America, if no DAS code is indicated in item 13, the priority document must be submitted during the pendency of the application for a design patent before the USPTO (i.e., prior to the issuance of the patent or abandonment, as the case may be) and, furthermore, should be submitted on or before the date of the payment of the issue fee (second part of the individual designation fee for the United States of America). If the priority document is submitted after the date of payment of the second part of the individual designation fee, the patent will not include the priority claim unless corrected in accordance with United States law (refer to 37 CFR 1.55). The submission of the priority document should be accompanied by a cover letter identifying the international registration to which the priority document is directed. Such a letter must be signed either by a patent practitioner registered to practice before the USPTO or by the applicant, provided that the applicant is not a juridical entity.Furthermore, if the Russian Federation or Türkiye are designated, the priority document must be submitted directly to the Federal Service for Intellectual Property (ROSPATENT) and/or the Turkish Patent and Trademark Office (TURKPATENT), in support of a priority claim, within three months from the date of publication of the international registration in the *I.D.B.* If the priority document is not submitted within the above-mentioned three-month period, the priority claim will be disregarded. In respect of Russia, the submission of the priority document should be accompanied by a cover letter identifying the international registration to which it is directed; the priority document does not need to be submitted to ROSPATENT by a local patent attorney. In respect of Türkiye, the priority document must be accompanied by a Turkish translation if the priority document is in a different language, and, if the holder resides outside the country, the priority document must be submitted to TURKPATENT through a local representative.

Rule 7(6)

WIPO Digital Access Service (DAS)

The WIPO Digital Access Service (DAS) is an electronic system allowing priority documents to be securely exchanged between participating IP Offices. If the Office of the earlier filing participates in DAS as a “depositing Office” with respect to priority documents for design applications, an access code may be obtained from that Office. If the Office of a designated Contracting Party also participates in DAS as an “accessing Office” with respect to priority documents for design applications, the applicant may provide the access code under this item so that the latter Office is able to access the priority document via DAS. For more information about DAS and its participating Offices, refer to the WIPO website.

A.I. Section 408(a)

Further national provisions regarding priority claims

Under the national law of China, where the name of the applicant in the priority document is not identical to the name of the holder of the international registration, the latter must submit the related certifying documents to the China National Intellectual Property Administration (CNIPA) within three months from the date of publication of the international registration in the *I.D.B.*

Under the national law of Israel, where an applicant claims the priority of an earlier application, the applicant cannot benefit from a reduced individual designation fee.

Item 14: International exhibition *(if applicable)*

Temporary protection of designs exhibited at certain exhibitions may be claimed under Article 11 of the Paris Convention. If it is intended to claim exhibition priority in the international application, the applicant should provide all relevant information in item 14 of the international application form.

The application form must indicate where the exhibition took place, the date on which the product was first exhibited and the number of each design shown at the exhibition.

Where the claim does not relate to all the designs included in the international application, then the applicant should indicate those designs for which exhibition priority is claimed. If no design is indicated, it is assumed by the International Bureau that all the designs were shown at the exhibition in question.

Rule 7(5)(d)

Item 15: Exception to lack of novelty *(if applicable)*

Item 15 allows the applicant to make a declaration concerning an exception to lack of novelty in respect of a designation of China, Japan or the Republic of Korea. The applicant is required to indicate the design(s) for which exceptional treatment provided for in the design law of the Contracting Party(ies) concerned, is claimed.

The supporting documentation must be submitted, either along with the international application using Annex II, or directly to the China National Intellectual Property Administration (CNIPA), the Japan Patent Office (JPO) and/or the Korean Intellectual Property Office (KIPO). Any documentation received by the International Bureau as part of the application will be electronically distributed to the CNIPA, JPO and/or KIPO.

The holder submitting the supporting documentation directly to the CNIPA, JPO or KIPO should do so within the respective time period, through a local representative if the holder resides outside of the country. With respect to the designation of China, the CNIPA requires that the supporting documentation be submitted to it directly within 2 months from the date of publication of the international registration in the *I.D.B*. With respect to the designation of Japan, the JPO requires that the supporting documentation be submitted to it directly within 30 days from the date of publication of the international registration in the *I.D.B*. With respect to the designation of the Republic of Korea, the supporting documentation should be submitted directly to KIPO either within 30 days from the date of publication of the international registration in the *I.D.B*., or during the pendency of the application for registration before KIPO (i.e. before a statement of grant of protection is issued or a refusal becomes final).

It should be noted that a declaration concerning exception to lack of novelty might affect the applicant's rights in other jurisdictions. It is the responsibility of the applicant to ensure that his/her rights are preserved.

A.I. Section 408(c)

Item 16: Main or principal design *(if applicable)*

Item 16 is applicable for the designation of China, Japan and the Republic of Korea only (refer to "Optional contents").

China: Main design

The national law of China contains a requirement of unity of design (refer to "Item 6: Number of Designs, Reproductions and/or Specimens"). As specified in the declaration made by China, an international application may contain only one design, except that two or more similar designs for the same product or two or more designs which are incorporated in products sold or used in sets may be included in one application.

Furthermore, if the application contains two or more similar designs for the same product, the total number of the designs cannot exceed 10, and the applicant must indicate one of them as the "main design" which is similar to all the others.

Examination as to whether designs are similar to the main design or not will be conducted by the China National Intellectual Property Administration (CNIPA). In the event of a notification of refusal of the effects of the international registration issued by CNIPA on the ground of lack of unity of design, the holder of the international registration may, in his/her reply to CNIPA, overcome the refusal ground by amending the international registration for the sake of the designation of China.

In addition, it is recommended to consult the Guidance on Including Multiple Designs in an International Application in Order to Forestall Possible Refusals, which was established in consultation with the Offices of Contracting Parties which have made a declaration concerning unity of design.

Article 13(1)

Japan and/or the Republic of Korea: Principal and related designs

The national laws of Japan and the Republic of Korea provide for related design systems. Under the related design systems of those countries, a design may be registered as a related design which is similar to another design identified as a principal design, under the condition that both designs belong to the same applicant/holder. Failure to do so may lead to a refusal by the Office concerned on the ground of conflict with a prior similar design.

Accordingly, in order to forestall a possible refusal, the applicant may indicate that some or all of the designs contained in the international application are to be considered in relation to a principal design that

- is contained in the present international application (in such a case, that design should be indicated as the principal design); or
- is contained in, or is the subject of, a prior application or registration (national or international).

Furthermore, where the principal design is not the subject of the same international application, the international application containing the design(s) which is(are) requested to be registered as related design(s) has to be filed within the prescribed periods : under the national law of Japan, before the lapse of 10 years from the date of the national application or international registration containing the fundamental design or, where priority is claimed from the priority date of the application concerned (the first selected principal design is the fundamental design of all subsequent related designs), and under the national law of the Republic of Korea, within one year from the filing date of the national or international application containing the principal design.

Examination as to whether or not a design may be registered as a related design will be conducted by the Japan Patent Office (JPO) and Korean Intellectual Property Office (KIPO), respectively. In the event of a notification of refusal of the effects of the international registration issued by the Office on the ground of missing/erroneous indication of the principal design, the holder of the international registration may, in his/her reply to the Office, request the addition or deletion of the indication of the principal design so as to overcome such a refusal ground.

Detailed information on the related design system is available on the JPO website (in English) and on the KIPO website (in English).

In addition, it is recommended to consult the Guidance on Including Multiple Designs in an International Application in Order to Forestall Possible Refusals, which was established in consultation with the Offices of Contracting Parties, which have a “related design system”.

A.I. Section 407

Item 17: Publication of the international registration *(optional)*

Standard publication

Default publication takes place 12 months after the date of the international registration (“standard publication period”), unless the applicant requests otherwise (refer to “Timing of publication”).

Rule 17(1)(iii)

There are two exceptions, namely, where the applicant requests immediate publication or publication at a chosen time.

Immediate publication

The applicant may request immediate publication by ticking the appropriate box in item 17. Immediate publication can be an advantage if, for instance, under national or regional laws the rights emanating from registration are only enforceable once published. Note that the notion of “immediate” publication must allow for the time required by the International Bureau to carry out relevant technical preparations.

Rule 17(1)(i)

Publication at a chosen time

The applicant may request publication at a chosen time by ticking the appropriate box in item 17 and indicating the chosen time for publication (specified in months from the filing date).

The applicant may always request publication at a time earlier than the standard publication period of 12 months.

The applicant may request to defer publication beyond the standard publication period, whereby the possible maximum deferment period depends on the Contracting Parties designated in the international application.

Rule 17(1)(ii)

For more information on the duration of deferment beyond the standard publication period, refer to "Periods of deferment". Both the application form (DM/1) and the eHague interface clearly indicate the periods of deferment which may be requested in respect of certain Contracting Parties.

Item 18: Reduction of the individual designation fee *(if applicable)*

Israel, Mexico and the United States of America have made the declaration referred to in Article 7(2) of the 1999 Act that, in connection with an international application in which they are designated, the prescribed designation fee shall be replaced by an individual designation fee.

Israel, Mexico and the United States of America are the only Contracting Parties that provide for a reduction of the individual designation fee for certain applicants. The declaration made by Israel has specified a reduced amount for an applicant who qualifies as:

- a natural person;
- a "small entity" whose yearly revenue does not exceed the amount set in the Israeli Design Regulations;
- a higher education institution recognized by the Israeli law.

The fee reduction does not apply if the international application contains a priority claim. To benefit from a reduction of the individual designation fee in respect of Israel, the applicant must check the relevant box.

The declaration made by Mexico has specified a reduced amount for an applicant who is a:

- creator who is a natural person;
- micro or small entity;
- public or private higher education institution; or
- public scientific or technological research institute.

To benefit from a reduction of the individual designation fee in respect of Mexico, the applicant must check the relevant box.

The declaration made by Mexico also specified, in accordance with Rule 12(3) of the Common Regulations, that the individual designation fee comprises two parts.

The declaration made by the United States of America has specified reduced amounts for applicants who qualify:

- for "small entity" status within the meaning of Section 41(h) of Title 35 of the United States Code and Section 3 of the Small Business Act, and applicable regulations of the United States Patent and Trademark Office (USPTO);
- as a "micro entity" within the meaning of Section 123 of Title 35 of the United States Code and applicable regulations of the USPTO.

To benefit from a reduction of the individual designation fee in respect of the United States of America, the applicant may assert small entity status by checking the appropriate box. If the applicant checks the box for micro entity, the applicant has to submit the micro entity certification form PTO/SB/15A or PTO/SB/15B (available using Annex IV: Reduction of United States individual designation fee).

The declaration made by the United States of America also specified, in accordance with Rule 12(3) of the Common Regulations, that the individual designation fee comprises two parts.

A.I. Section 408(b)

Item 19: Signature

The international application form may be signed by the applicant or the representative (or by an Office when the international application has been presented to the International Bureau through that Office). In either case, the name of the signatory should be indicated separately. It is recommended to use text string signatures (e.g. /John Doe/). Signatures may be handwritten, printed, stamped, typed or in another electronic form (image, digital or computer generated).

Rule 7(1); A.I. Section 202

For eHague, a signature is replaced by an electronic authentication through a user account which requires the account holder's user name and password.

A.I. Section 205

Payment of fees

The following paragraphs should be read in conjunction with the general remarks contained in "Payment of fees to the International Bureau" concerning fees.

On the fee payment sheet which precedes the Fee Calculations Sheet and forms part of the international application form, it is possible to indicate the following:

- An authorization to debit the required amount from a current account at WIPO (indicating also the name of the holder of the account, the account number and the identity of the party giving the authorization). In such a case, it is not necessary to specify the amount of the fees in question. This mode of payment has the advantage of avoiding the risk of a fees irregularity.
- Another method of payment, namely, via a bank transfer to the WIPO postal account or the WIPO bank account or through the Office of indirect filing where that Office accepts indirect payments (e.g. USPTO) (in both cases, indicating the identity of the party making the payment and the amount of fees being paid).
- A reference to a payment which the applicant has previously sent to the International Bureau and wishes to use for that international application. In that case, it is necessary to indicate the identity of the party who made the payment (name of the bank account holder) and the WIPO receipt number.

When using the eHague interface, the fees may be paid to the International Bureau through an online payment system offering a range of payment methods according to the user account profile.

For more information on the payment system under the Hague System, refer to the WIPO website.

Fees due

The fees payable in connection with an international application consist of:

- a basic fee;
- a standard designation fee (level one, two or three) or, where a designated Contracting Party is one in respect of which an individual designation fee is payable, that fee (refer to "Individual designation fees")[7];

- a publication fee, consisting of an amount to be paid in respect of each reproduction to be published and, where these reproductions are shown on a page of A4 format (refer to "The reproductions of the designs"), an amount to be paid in respect of each such page, in addition to the first.

Rule 12(1)

These fees are payable at the time of filing the international application, except for

- the publication fee where the international application contains a request for publication beyond the standard publication period of 12 months (refer to "Consequences of deferred publication"), and
- the second part of the of the individual designation fee where Mexico or the United States of America is designated (refer to "Individual designation fee payable in two parts").

For more information, refer to "Payment of fees".

Rule 12(2)

Reduction of fees for applicants from Least Developed Countries (LDCs)

For international applications filed by applicants whose sole entitlement is a connection with a Least Developed Country (LDC), in accordance with the list established by the United Nations, or with an intergovernmental organization the majority of whose member States are LDCs, the fees intended for the International Bureau are reduced to 10% of the prescribed amounts (rounded to the nearest full figure). The reduction also applies in respect of an international application filed by an applicant whose entitlement is not solely a connection with such an intergovernmental organization, provided that any other entitlement of the applicant is a connection with a Contracting Party which is an LDC or, if not an LDC, is a member State of that intergovernmental organization and the international application is governed exclusively by the 1999 Act. If there are several applicants, each must fulfill the said criteria.

The reduction to 10% of the regular amount of the fee also applies to the standard designation fees under the same conditions.

The Assembly of the Hague Union adopted, at its twenty-sixth (10th extraordinary) session, the following recommendation concerning individual fees:

> "Contracting Parties that make, or that have made, a declaration under Article 7(2) of the 1999 Act or under Rule 36(1) of the Common Regulations are encouraged to indicate, in that declaration or in a new declaration, that for international applications filed by applicants whose sole entitlement is a connection with a Least Developed

Country, in accordance with the list established by the United Nations, or with an intergovernmental organization the majority of whose member States are Least Developed Countries, the individual fee payable with respect to their designation is reduced to 10% of the fixed amount (rounded, where appropriate, to the nearest full figure). Those Contracting Parties are further encouraged to indicate that the reduction also applies in respect of an international application filed by an applicant whose entitlement is not solely a connection with such an intergovernmental organization, provided that any other entitlement of the applicant is a connection with a Contracting Party which is a Least Developed Country or, if not a Least Developed Country, is a member State of that intergovernmental organization and the international application is governed exclusively by the 1999 Act."

Individual designation fee payable in two parts (applicable only to the designation of Mexico and the United States of America)

The declarations under Article 7(2) of the 1999 Act made by Mexico and the United States of America concerning the application of an individual designation fee specified, in accordance with Rule 12(3) of the Common Regulations, that the individual designation fee comprises two parts. The declarations also specified reduced amounts of the first part and of the second part of the individual designation fee for certain applicants.

The first part of the individual designation fee is to be paid at the time of the international application.

The second part will become payable only if the Mexican Institute of Industrial Property (IMPI) or the United States Patent and Trademark Office (USPTO) is satisfied that the design that is the subject of the international registration qualifies for protection, i.e., if the design is allowed. Therefore, the payment of the second part will, if applicable, be required at a later date.

The date by which the second part of the individual designation fee must be paid will be notified through an invitation. IMPI will issue a Notice of Allowance and Invitation for Payment (Notice of Allowance) which will be sent to the holder through the International Bureau in respect of each concerned international registration. The USPTO will issue a Notice of Allowance and Fee(s) Due (Notice of Allowance), both directly to the holder, using the address for correspondence established before it, and through the International Bureau.

The Notice of Allowance from IMPI sets forth detailed information concerning the payment of the fee and the status of the holder. The Notice of Allowance from USPTO sets forth detailed information concerning the payment of the fee, the current economic status, and how to change the economic status.

Furthermore, the International Bureau will send a letter to the representative of the holder of the international registration or, if no representative was appointed before the International Bureau, to the holder of the international registration, giving instructions on the payment of the second part of the individual designation fee and indicating the date by which the second part of the individual designation fee must be paid.

Upon receipt of the Notice of Allowance, the holder may pay the fee either directly to the Office concerned, to IMPI in Mexican pesos, or to the USPTO, in United States dollars, or through the International Bureau, in Swiss francs. The International Bureau only accepts the payment in full corresponding to the holder's status indicated in the Notice of Allowance issued by the Office concerned (IMPI or USPTO). Accordingly, if the status of the holder has changed after the Notice of Allowance has been issued, the fee should be paid directly to the Office concerned (IMPI or USPTO).

Where the payment is made through the International Bureau, the International Bureau will record the payment in the International Register and notify the Office concerned (IMPI or USPTO) accordingly. No confirmation of payment will be sent to the representative/holder.

The International Bureau will not accept a late payment. Where the second part of the individual designation fee is paid through the International Bureau, the date of the payment will be the date on which the International Bureau receives the required amount, in accordance with Rule 27(5)(a) of the Common Regulations. Thus, for instance, in case of payment through a bank or postal transfer, the date of payment is the date on which the required amount is received in the WIPO bank or postal account. If the payment is late, all fees paid will be refunded.

If the second part of the individual designation fee is not paid in full within the time period specified in the Notice of Allowance to either the International Bureau or the Office concerned (IMPI or the USPTO, the Office may request the cancellation of the international registration with respect to the designation of Mexico or the United States of America respectively in accordance with Rule 12(3)(d) of the Common Regulations. The International Bureau shall then cancel the international registration in the International Register with respect to the designation of Mexico and the Unites States of America, respectively, and communicate the cancellation to the representative of the holder of the international registration or, if no representative was appointed before the International Bureau, to the holder of the international registration. The cancellation will be published in the *I.D.B.*

Finally, it shall be noted that Rule 5 does not apply to the payment of the second part of the individual designation fee through the International Bureau (refer to "Excuse of delay in meeting time limits").

Article 7(2); Rule 5(1); Rule 12(3)(c) and (d); Rule 18bis(1)(a) and (2); Rule 26(1)(viii); Rule 27(5)(a)

The amounts of the basic fee, the standard designation fee and the publication fee are set out in the Schedule of Fees comprised in the Common Regulations. With regard to individual fees, users should refer to "Individual Fees under the Hague Agreement" where details of individual fees are published and updated.

In addition, a fee calculator is available which takes into account all the possible fee permutations, depending upon the particular Contracting Parties designated in any given international application, the number of designs, etc.

As far as eHague is concerned, the fee calculator automatically calculates and indicates the fees to be paid, based on the data entered by the applicant.

Annex I: Oath or declaration of the creator

Annex I is mandatory content for an international application designating the United States of America and, if the application form is used, it must be submitted with form DM/1. It cannot be submitted alone. Annex I is also available in the eHague interface, which automatically verifies that the mandatory contents for the designation of the United States of America in an international application are complied with and alerts the applicant accordingly. Annex I is applicable for the designation of the United States of America only.

Annex I enables the submission of an oath or declaration of the creator pursuant to Rule 8(1)(a)(ii) or, in the impossibility to provide such a declaration, for example, where the inventor is deceased, a Substitute Statement in Lieu of a Declaration of Inventorship.

Pursuant to 37 CFR 1.63 and 37 CFR 1.64 (law of the United States of America), the oath or declaration and the substitute statement must be "signed". Signature requirements for documents are set forth in 37 CFR 1.4. Accordingly, the inventor or the person executing the substitute statement may apply a text string signature in between two forward slashes as follows: / Inventor Name /, or a handwritten signature. In the case of several creators, the declaration has to be signed by each of them. In particular, the "inventor" must be the same as the "creator" indicated under item 11 of form DM/1 or in the relevant sector of the eHague interface.

For detailed information on the inventor's oath or declaration, please visit the USPTO website.

Annex II: Supporting document(s) concerning a declaration to the exception to lack of novelty

Annex II is optional content of the international application, which can be submitted with form DM/1. This Annex cannot be submitted alone to the International Bureau. Annex II is applicable for the designation of China, Japan or the Republic of Korea only (refer to "Optional contents"). Annex II is also available in the eHague interface.

A.I. Section 408(c)

The applicant may make a declaration as provided for in item 15 concerning exception to lack of novelty. If this declaration is made, the international application may be accompanied by supporting documentation. The supporting documentation must be attached to Annex II, its page numbers being properly referenced. Any documentation received by the International Bureau will be electronically distributed to the CNIPA, JPO and/or KIPO.

The applicant is not obliged to submit supporting documentation at the time of filing the international application. However, if the international application is not accompanied by its supporting documentation, the latter must be submitted directly to the Office of the Contracting Party concerned, subject to the national requirements. It cannot be submitted later to the International Bureau (refer to "Item 15: Exception to lack of novelty").

Annex III: Information on eligibility for protection

Annex III is optional and serves to submit a statement that identifies information known by the applicant to be material to the eligibility for protection of the design concerned. This Annex must be submitted with form DM/1. It cannot be submitted alone. Annex III is also available in the eHague interface.

Rule 7(5)(g); A.I. Section 408(d)

Annex III is only relevant for the designation of the United States of America and serves to submit an Information Disclosure Statement and relevant accompanying documentation as prescribed under the national law of the United States of America. The purpose of a "duty of candor" under the law of the United States of America is to assist the examination process by the USPTO obliging applicants to disclose any information they know of, which could consequently prevent them from acquiring a valid right.

In this context, it is recalled that Rule 6 of the Common Regulations does not exclude the submission of documentation accompanying the international application in a working language other than that of the international application (refer to "Languages"). Thus, to the extent that Annex III can be submitted only in respect of a designation of the United States of America, it is recommended that applicants submit their documentation in English.

Rule 7(5)(g)

The Information Disclosure Statement forms (SB08a/SB08b/SB08a-EFS-web) are available on the USPTO website. These forms may be submitted to the USPTO also after the filing of the international application.

For detailed information on the Information Disclosure Statement, please visit the USPTO website.

Annex IV: Reduction of United States individual designation fee

Optional Annex IV allows the applicant to support a claim of micro entity status (item 18) with a micro entity certification in order to benefit from a reduction of the individual designation fee in respect of the United States of America. This Annex must be submitted with form DM/1. It cannot be submitted alone. Annex IV is also available in the eHague interface.

A.I. Section 408(b)

The requirements to qualify for a reduction for micro entity status are set forth in 37 CFR 1.29 (law of the United States of America) and detailed in Section 509.04 of the Manual of Patent Examining Procedure.

Annex IV is mandatory content if the applicant claims "micro entity status" in item 18 of form DM/1. The eHague interface automatically alerts the applicant to attach the micro entity certification, completed and signed, to the international application in which the United States of America is designated and micro entity status is claimed.

The certification form (PTO/SB/15A or PTO/SB/15B), along with the instructions for its completion and signature, is available on the USPTO website.

Annex V: Supporting document concerning a priority claim

Annex V is optional and can be used to submit a document in support of a priority claim (priority document) when designating China, Japan or the Republic of Korea. Note: this Annex cannot be submitted independently to the International Bureau. Any priority document received by the International Bureau will be electronically distributed to the Office of the designated Contracting Party concerned. For more information, refer to "Optional contents".

Alternatively, a priority document may be submitted directly to the CNIPA, JPO and/or KIPO, **within three months of the date of publication of the international registration** in the *International Designs Bulletin*. If the holder resides outside the country, the document must be submitted through a local representative. The right of priority will be lost if the priority document is not submitted within this deadline.

1. For more specific information concerning the requirement of unity of design applicable in each of these Contracting Parties, please consult the Office(s) in question.
2. If Brazil, Finland, Ghana, Hungary, Iceland, Mauritius and/or Mexico is/are designated, it is compulsory to indicate in item 11 the identity of the creator. The latter declares to be the creator of the design. Where the person identified as the creator is a person other than the applicant, it is hereby stated that the present international application has been assigned by the creator to the applicant.
3. It should be noted that a more specific indication of a product would entail a possible risk of narrowing the scope of protection in other jurisdictions where a broader indication of a product is accepted and the scope of protection is determined by a product indication.
4. Generally, designs relating to products belonging to class 32 of the Locarno Classification cannot be protected under the laws of Canada, Israel, Mexico and the Republic of Korea. Consequently, a designation of Canada, Israel, Mexico or the Republic of Korea in an international registration for designs in class 32 would be the subject of a refusal by the Offices of those Contracting Parties. Under the law of China, designs in class 32-01 cannot be protected and would be the subject of a refusal by CNIPA.
5. For sufficient disclosure of a design, Japan and the United States of America may require that the legend corresponding to each reproduction be indicated.
6. In the case of eHague, this nine-digit number is not automatically notified to the applicant. If an irregularity notice is issued, that number is included in the notice.
7. For international applications in which the Republic of Korea is designated, the designation fee is determined by class of the Locarno Classification:

- For designs belonging to classes 1, 2, 3, 5, 9, 11 or 19, level 3 of the standard designation fee applies.
- For designs belonging to any other class, an individual designation fee applies.

The reproductions of the designs

The reproductions accompanying an international application must comply with the formal requirements described in the "International procedure". When the reproductions do not comply with these requirements, the International Bureau may treat the international application as irregular (refer to “Irregularities in the international application”).

However, it is important to note that even where these requirements have been complied with to the satisfaction of the International Bureau, the Office of a Contracting Party may find that the reproductions contained in the ensuing international registration are not sufficient to disclose fully the design and, on that basis, issue a refusal of protection (refer to “Refusal of protection”).

Rule 9(4)

Guidance on reproductions

The criteria for sufficient disclosure of a design may be different from one jurisdiction to another.

Therefore, Guidance on Preparing and Providing Reproductions in Order to Forestall Possible Refusals on the Ground of Insufficient Disclosure of an Industrial Design by Examining Offices was established in consultation with Contracting Parties, in particular all those that currently have an Examining Office, and several user organizations, and is intended to mitigate the risk of refusals pursuant to Rule 9(4).

It should, however, be noted that the Guidance cannot be considered self-sufficient or exhaustive.

Rule 9(4)

Mode of reproduction

The reproductions of the designs for which registration is sought may be in the form of photographs or other graphic representations of the designs, or of the products which constitute the designs. A single international application may at the same time comprise both photographs and graphic representations, which may be in black and white or in color.

*Rule 9(1); **99** Article 5(1)(iii); A.I. Section 401(a)*

The reproductions accompanying an international application using form DM/1 should be either pasted or printed directly onto a separate sheet of A4 format which is white and opaque. The separate sheet should be used upright and should not contain more than 25 reproductions. The reproductions should be arranged in the orientation in which the applicant wishes them to be published. Where the application is filed using form DM/1, a margin of at least five millimeters should be left around the representation of each design.

A.I. Section 401(c) and (d)

Each reproduction should fall within a right-angled quadrilateral containing no other reproduction, or part of another reproduction, and no numbering. The term 'right angled quadrilateral' is intended to include both squares and rectangles. The reproductions should not be folded, stapled or marked in any way.

A.I. Section 401(e)

Representation of the design

For eHague, any reproduction accompanying an international application shall be in the image formats JPEG or TIFF, its file size shall not exceed 2 megabytes. Any reproduction shall have a resolution of 300 x 300 dots per inch (dpi). A reproduction uploaded with a different resolution is automatically adjusted to have a resolution of 300 x 300 dpi. The interface asks for validation of the adjusted resolution by the applicant. Detailed instructions can be found under "How to submit an international application to the International Bureau: eHague interface or form DM/1?".

In principle, the reproductions should represent the design alone, or the product in relation to which the design is to be used, to the exclusion of any other object, accessory, person or animal. Thus, for example, if protection is sought for a bowl, the bowl should be represented without fruit, or a frame for which protection is sought should be represented without a picture (refer to "Disclaimers and matter that does not form part of the claimed design").

A.I. Section 402(a)

Technical drawings showing articles in section or in plan, particularly with axes and dimensions, are not acceptable. Explanatory text or legends are not acceptable in the representation itself. (Explanatory text or legends indicating the type of view (e.g., "front view", "top view", etc.), may be contained in item 10 of form DM/1 and in the relevant section of the eHague interface (refer to "Numbering of reproductions and legends").)

***99** Article 5(2)(b)(ii); A.I. Section 402(c)(ii); A.I. Section 405*

If the reproductions consist of photographs, such photographs must be of professional standard and have all their edges cut at right angles. In such case, the design must be shown against a neutral plain background and photographs may not be retouched with ink or correcting fluid.

A.I. Section 404(a)

If the reproductions consist of other graphic representations, they must be of professional standard and produced with drawing instruments or by electronic means and, where the application is filed on paper, must be produced on good quality white, opaque paper, and have all their edges cut at right angles. The representation may comprise shading and hatching to provide relief. Graphic representations executed by electronic means may be shown against a background, provided that it is neutral and plain and has only edges cut at right angles.

A.I. Section 404(b)

Disclaimers and matter that does not form part of the claimed design

Matter which is shown in a reproduction, but for which protection is not claimed, may be indicated in a reproduction by means of dotted or broken lines or coloring, and/or explained in the description (refer to "Item 9: Description"). Accordingly, protection of part of the design may be disclaimed.

A.I. Section 403(a)

Notwithstanding the principle under Section 402(a) (refer to "Representation of the design"), matter which does not form part of the claimed design and for which protection is not sought ("environmental matter"), may be shown in a reproduction if it is indicated by means of dotted or broken lines or coloring (and/or in the description).

A.I. Section 403(b)

Number of reproductions

There is no limit on the number of reproductions which can be submitted for each design included in an international application. Only a single copy of each reproduction should be submitted (by default, reproductions are published in color). An applicant wishing to obtain the maximum protection for a design should ensure that the design is fully represented, as only aspects visible in the reproduction will be protected. It may be necessary, therefore, to represent a single article from many angles and submit several different views. However, several views shown from different angles may not be included in a single reproduction. Each view must be represented separately.

Rule 9(1)(b); A.I. Section 401(a) and (b)

Numbering of reproductions and legends

Where there are several designs included in an international application, each design must be identified by an individual number appearing in the margin of each reproduction. The eHague interface automatically proceeds to the numbering of the reproductions filed by the applicant. When the same design is represented from different angles, the numbering must consist of two separate figures, separated by a dot (for example, 1.1, 1.2, 1.3, etc., for the first design, and 2.1, 2.2, 2.3, etc., for the second design, and so on). In such case, the reproductions should be submitted in ascending numerical order.

99 *Article 5(2)(b)(ii); A.I. Section 401(b); A.I. Section 405*

An applicant may choose to submit different views of the same design (e.g., "front view", "top view", etc.), in order either to illustrate all the characteristic features of a three-dimensional design or to comply with the requirement of the law of a designated Contracted Party which has made a declaration whereby it requires certain specified views of the product concerned (refer to "Requirements concerning views"). Legends to indicate a specific view of the product may be indicated in association with the numbering of the reproduction in item 10 of form DM/1 or in the relevant section of the eHague interface. The proposed legends are: 1. Perspective; 2. Front; 3. Back; 4. Top; 5. Bottom; 6. Left; 7. Right; 8. Reference; 9. Unfolded; 10. Exploded; 11. Cross-sectional; 12. Enlarged; 00. Other (limited to 50 characters).

A.I. Section 401(c)

Dimensions of the reproductions

The dimensions of the representation of each design appearing in a photograph or other graphic representation may not exceed 16 x 16 centimeters, and in respect of at least one representation of each design one of those dimensions must be at least 3 centimeters, at a resolution of 300 x 300 dpi.

A.I. Section 402(b)

In respect of eHague, any reproduction shall be in a combination of pixel number and resolution such that, when that reproduction is printed, the dimensions of the reproduction of each design appearing in a photograph or other graphic representation will not exceed 16 x 16 centimeters, and in respect of at least one representation of each design one of those dimensions must be at least 3 centimeters, at a resolution of 300 x 300 dpi.

Specific views

Under the 1999 Act, any Contracting Party which requires certain specific views of the product in relation to which the design is to be used may, in a declaration, notify the Director General of WIPO accordingly. If those requirements are not met in an international application, the International Bureau will not raise an irregularity but the ensuing international registration might be the subject of a refusal by the Office of that Contracting Party.

Rule 9(3)

China has made a declaration under Rule 9(3) whereby the compliant view(s) of the product shall be submitted if the product which constitutes the design is three-dimensional or the essential features of the design of the product concern a Graphic User Interface (GUI) only. The China National Intellectual Property Administration (CNIPA) has further clarified the required compliant views, as follows:

- For a three-dimensional design: if the essential features of the design involve six sides of the product, six orthographic projection views; if the essential features of the design concern one or some of the six sides only, orthographic view(s) of the side(s) concerned, and for the remaining side(s), either orthographic view(s) or perspective view(s), unless those sides are not easily seen or not seen at all when the product is in use; if the application is filed for a partial design, perspective view(s) of the whole product showing the claimed partial design must also be included; and
- For a GUI design: if the application is filed for the whole product containing the GUI, at least orthographic view(s) of the whole product showing the GUI; if the application is filed for the GUI as a partial design, orthographic view(s) of the whole product showing the GUI; if the GUI is designed to be applied to any electronic device and the application is filed for the GUI itself as a product, mere view(s) of the GUI without showing such electronic device(s); if the application is filed for a dynamic GUI, an orthographic view showing the initial state of the GUI as the front view, and for the remaining states, views of the key frames of the GUI as views of states of variation, must be submitted, those views being sufficient to determine the complete variation process of the animation in the dynamic pattern.

The Republic of Korea has made a declaration under Rule 9(3) specifying that the following specific views are required, respectively:

- for a design of a set of articles: one view of the coordinated whole and corresponding views of each of its components, and
- for a design for typefaces: views of the given characters, a sample sentence and typical characters.

Viet Nam has made a declaration under Rule 9(3) requiring, where the product which constitutes the design is three-dimensional, a perspective view of the design.

Quality of the reproductions

Reproductions must be of a quality permitting all the details of the design to be clearly distinguished and permitting publication. The reproductions which accompany an international application should be of the highest possible quality, since, in the final analysis, it is upon the content and quality of the reproductions that the scope of protection will depend.

Rule 9(2)(a)

Filing of specimens under the 1999 Act

Where an international application is governed exclusively by the 1999 Act, it is permissible in certain limited circumstances to substitute reproductions by specimens. This is possible where the international application:

- is governed *exclusively* by the 1999 Act, and
- contains a request for deferment of publication, and
- concerns a two-dimensional design.

Rule 10(1)

Where specimens are submitted instead of reproductions, the applicant must furnish one specimen for the International Bureau and one further specimen for each designated national Office that has notified the International Bureau that it wishes to receive copies of international registrations. This requirement aims at enabling Examining Offices to take into account the designs which are the subject of the international registration when carrying out the novelty examination provided for by their domestic legislation (refer to "Grounds for refusal").

Filing of specimens under the 1960 Act

In the case of an international application is governed exclusively or partly by the 1960 Act, the application *may* be accompanied *also* by specimens. This means that the filing of specimens is optional but does not exempt the applicant from the requirement to furnish a reproduction of the designs.

60 *Article 5(3)(b)*

Requirements concerning specimens

All the specimens should be contained in a single package. None of the dimensions of the package should exceed 30 centimeters and the overall weight of the package and its packing should not exceed four kilograms.

Rule 10(2); A.I. Section 406(b)

The individual specimens may be folded and may not exceed 26.2 centimeters x 17 centimeters in size (unfolded), 50 grams in weight, or 3 millimeters in thickness. The specimens should also be pasted on sheets of A4 format and numbered in ascending numerical order. If, and when, in due course, the reproductions are submitted to the International Bureau, the number assigned to each reproduction should be the same as the number assigned to each corresponding specimen.

A.I. Section 406(a)

Perishable products or products which may be dangerous to store are not accepted by the International Bureau.

A.I. Section 406(c)

No additional matter

If the international application contains any matter other than that required or permitted by the 1999 Act, the 1960 Act, the Common Regulations or the Administrative Instructions, the International Bureau deletes it *ex officio*. If the international application is accompanied by any document other than those required or permitted, the International Bureau may dispose of such document.

Rule 7(6)

Presentation of the international application to the International Bureau

Channels of communication

An international application is normally sent directly by the applicant or his/her representative to the International Bureau. However, a number of exceptions to that principle are provided for by the 1960 and the 1999 Acts.

Under the 1960 Act, an international application may be filed through the Office of a Contracting State if such State so permits. In addition, a Contracting State may *require* that, where it is considered to be the State of origin, the deposit be filed through its national

Office. To the extent that such requirement is not required to be notified to the Director General of WIPO under the 1960 Act, the International Bureau does not check whether an international application governed exclusively or partly by the 1960 Act has been presented through the Office of the State of origin pursuant, where applicable, to the law of that Contracting State. Non-compliance with this requirement shall not prejudice the effects of the international deposit in the other Contracting States.

60 *Article 4*

Under the 1999 Act, it is possible for Contracting Parties to prohibit the indirect route, but they are not allowed to impose it. Where an international application is presented to the International Bureau through the intermediary of an Office, that Office may fix, and collect for its own benefit, a fee to cover the cost of the work involved in handling the international application. An Office that requires a transmittal fee must notify the International Bureau of the amount of such fee, which should not exceed the administrative costs of receiving and transmitting the international application, and its due date.

99 *Article 4; Rule 13(2)*

Where an international application governed exclusively or partly by the 1999 Act is addressed to the International Bureau through the Office of the applicant's Contracting Party, it must be received by the International Bureau within a period of one month from the date of receipt by that Office. However, that period may not be sufficient for a Contracting Party whose law requires a security clearance. The possibility has therefore been provided for such a Contracting Party to notify the replacement of the period of one month by a period of six months. If the applicable time limit is not complied with, the filing date of the international application is the date of its receipt by the International Bureau.

The United States of America and the Russian Federation are the only Contracting Parties that have made the notification under Rule 13(4) to replace a period of one month by a period of six months. It is a requirement under the law of the United States of America that, for designs created in the United States of America, the applicant first obtains an export license before filing outside of the United States of America. If the applicant needs to obtain such a license, alternatively, an international application may be filed through the USPTO (in most cases the security clearance will be performed within a couple of days) or through the International Bureau once the said license has been received by the applicant (it is the responsibility of the applicant to comply with any national security provisions before filing the international application).

More information on foreign filing is available on the USPTO website.

It is a requirement under the law of the Russian Federation that designs created in the Russian Federation by Russian legal entities or nationals are subject to a security clearance procedure by the Federal Service for Intellectual Property (ROSPATENT) to ensure that the designs do not contain state secrets.

More information on foreign filing is available on the ROSPATENT website.

Rule 13(3) and (4)

Filing date of the international application

Provided that the international application does not contain any irregularities entailing a postponement of the filing date (refer to "Irregularities entailing a postponement of the filing date of the international application"), the International Bureau allocates to the international application a filing date in accordance with the following principles:

- in the case of direct filings, and in the case of indirect filings of international applications other than international applications governed exclusively by the 1999 Act, the filing date is the date of receipt by the International Bureau of the international application (refer to "Communications with the International Bureau");

Rule 13(3)(ii)

- in the case of indirect filings of international applications governed exclusively by the 1999 Act, the filing date is the date on which the application was received by the Office of the applicant's Contracting Party concerned, *provided* that it is received by the International Bureau within one month of that date or within six months in case of security clearance (refer to "Security clearance" and "Channels of communication"). If that time limit is not complied with, the filing date of the international application is the date of its receipt by the International Bureau.

Rule 13(3)(i) and (4)

Irregularities in the international application

Payment of fees

If the International Bureau finds that the required fees have not been paid, it invites the applicant to pay these fees within two months from the date of the invitation (refer to "Fees due"). If the basic fee is not paid within the two-month time limit, the international application is considered abandoned. The International Bureau will not start examining the international application until at least the basic fee for one design has been received.

Rule 12(2); Rule 14(1)(b) and (3)

Time limit for correcting irregularities

If the International Bureau finds that the international application does not, at the time of its receipt by the International Bureau, fulfill the applicable requirements, it invites the applicant to make the required corrections within three months from the date of the invitation sent by the International Bureau. Where an irregularity is not remedied within this three-month time limit, the international application is considered abandoned and the International Bureau refunds any fees paid in respect of that application, after deduction of an amount corresponding to the basic fee.

Rule 14(1); Rule 14(3)

Irregularities entailing a postponement of the filing date of the international application

Where the international application has, on the date on which it is received by the International Bureau, an irregularity which is prescribed as an irregularity entailing a postponement of the filing date, the filing date is the date on which the correction of such irregularity is received by the International Bureau. The irregularities which are prescribed as entailing a postponement of the filing date of the international application are the following:

- the international application is not in one of the prescribed languages;
- any of the following elements is missing from the international application:
  - an express or implicit indication that international registration under the 1999 Act or the 1960 Act is sought;
  - indications allowing the identity of the applicant to be established;
  - indications sufficient to enable the applicant or its representative, if any, to be contacted;
  - a reproduction, or, in accordance with Article 5(1)(iii) of the 1999 Act, a specimen, of each design that is the subject of the international application;
  - the designation of at least one Contracting Party.

Rule 14(2)

Irregularities concerning the prohibition on self-designation

Where a Contracting Party designated under the 1999 Act, whose Office is an Examining Office, has made the declaration prohibiting its self-designation (refer to "Prohibition on self-designation" and is indicated in an international application both as the applicant's Contracting Party and as a designated Contracting Party, the International Bureau disregards the designation of that Contracting Party.

99 *Article 14(3)*

Irregularities concerning special requirement notified by a Contracting Party or regarding the identity of the creator, description and claim

In the case of an irregularity which relates either:

- to a special requirement notified by a Contracting Party concerning the applicant or the creator (refer to "Special requirements concerning the applicant and the creator (Rule 8) (declaration)"), or
- to one of the additional elements which has been notified by a Contracting Party under Article 5(2) of the 1999 Act (namely, indications concerning the identity of the creator, a brief description and/or a claim; refer to "Additional mandatory contents"), if the applicant does not remedy such irregularity within the prescribed time limit of three months, the international application is deemed not to contain the designation of the Contracting Party in question.

Furthermore, if the applicant does remedy an irregularity which relates to Article 5(2) of the 1999 Act, the date of the international registration is the date on which the correction of such irregularity is received by the International Bureau or the filing date of the international application, whichever is the later.

Publication of the international registration

Centralized publication of an international registration having effect in all the designated Contracting Parties is one of the fundamental features of the international registration system. International registrations are published by the International Bureau in the *I.D.B.* and such publication is deemed, in all Contracting Parties, to be sufficient publication and to take the place of any national or regional publication, so that no other publication may be required of the holder.

***99** Article 10(3)(a); **60** Article 6(3); Rule 17*

Nevertheless, a Contracting Party is not precluded from republishing the international registration, in whole or in part, if it so wishes (for example, in order to translate into its national language the particulars contained in the international registration). However, in such a case, the republication may not create for the holder an obligation to furnish further reproductions of the design or an obligation to pay an additional fee to the Office of that Contracting Party.

Publication of the *I.D.B.* takes place on the WIPO website. In addition to the relevant data concerning international registrations, the Bulletin also contains data relating to refusals, invalidations, changes (change in ownership, changes of the name or address of the holder or representative, renunciations, limitations), appointments of representatives and cancellations thereof, corrections, renewals, cancellations of international registrations due to lack of payment of the second part of the fee, and declarations that a change in ownership has no effect and withdrawals of such declarations. Furthermore, the International Bureau publishes any declaration made by a Contracting Party under the Acts or the Common Regulations on the WIPO website.

Rule 26

If so requested by the Office of a Contracting Party, the International Bureau communicates to the Office the date on which each issue of the Bulletin is made available on the WIPO website. Such communication is made electronically – by email – on the same day as the Bulletin is to appear on the WIPO website. The publication by the International Bureau of each issue of the Bulletin on the WIPO website is deemed to replace the “sending” of the Bulletin referred to in the 1999 and the 1960 Acts and will constitute, at the same time, the date of receipt of the Bulletin by the Offices of the designated Contracting Parties.

Rule 26(3); A.I. Section 204(d)

The publication of the international registration in the Bulletin contains the following:

- the relevant data recorded in the International Register;
- the reproduction or reproductions of the design;
- where publication has been deferred, an indication of the date on which the deferment period expired or is considered to have expired.

Rule 17(2)

Publication cycle

The publication cycle of the *I.D.B.* can be broken down into two components: the frequency of publication and the time lag needed for the preparation of the Bulletin. The frequency of publication is the number of times the Bulletin is issued in a given year. The time lag is linked to the preparation work for the Bulletin and refers to the number of days that elapse between the last recording day considered for the insertion of data in a given issue of the Bulletin and actual date of publication of that issue.

Since January 1, 2012, the Bulletin is published on a weekly basis. In addition, the time required to prepare each issue of the Bulletin has also been shortened to one week.

Timing of publication

At the time of filing, the applicant may choose from the following three options concerning the timing of publication:

- 12 months after the date of the international registration, as the default timing of publication ("standard publication"); or
- immediately after the recording of the international registration (i.e., immediate publication); or
- at a chosen time (specified in months counted from the filing date).

Rule 17(1)

Regarding the option to indicate publication "at a chosen time", the applicant may always indicate a time earlier than the 12-month standard publication period. The applicant may also request to defer publication beyond the standard publication period; the possible maximum deferment period depends on the Contracting Parties designated in the international application.

For more information about the duration of deferment beyond the standard publication period, refer to "Periods of deferment". Both the application form (DM/1) and the eHague interface clearly indicate the periods of deferment which may be requested in respect of certain Contracting Parties.

After filing, the applicant or holder may request earlier publication at any time before the expiration of the publication period initially specified in the international application. The international registration will be published immediately upon receipt of any such request by the International Bureau.

For more information about earlier publication, refer to "Request for earlier publication".

Rule 17(1)(iibis)

Deferment of publication beyond the standard publication period

Consequences of deferred publication

When requesting deferment of publication beyond the standard publication period of 12 months from the date of international registration, publication fees do not have to be paid at the time of filing. They must however be paid no later than three weeks before the expiry of such deferment period.

Rule 16(3) and (4)

The obligation to pay publication fees no later than three weeks prior to the expiry of the deferment period also applies if the deferment period is "considered to have expired". This relates to the situation under Article 11(4)(a) of the 1999 Act and Article 6(4)(b) of the 1960 Act where an applicant requests earlier publication (refer to "Request for earlier publication").

Three months before the expiry of the deferment period, the International Bureau sends an unofficial reminder notice to the holder of the international registration, indicating the date by which the publication fee must be paid. Non-receipt of that reminder by the holder does not constitute an excuse for failure to comply with any time limit for payment of the publication fee. Failure to pay the publication fee (no later than three weeks before the expiry of the deferment period) results in the cancellation of the international registration.

Rule 16(3)(b) and (5)

Periods of deferment

The period of deferment depends upon the domestic law of each Contracting Party designated in the international application.

For Contracting Parties designated under the 1960 Act, the maximum period of deferment is 12 months from the filing date or, when claiming priority, from the priority date of the application concerned. Since the standard publication period is 12 months after the date of international registration, no request for deferment (beyond the 12-month standard publication period) should be made if any Contracting Party is designated under the 1960 Act.

***60** Article 6(4)(a); Rule 17(1)(iii)*

Under the 1999 Act it is generally presumed that – unless a Contracting Party has officially declared that it authorizes only a shorter period or does not authorize deferment – all Contracting Parties permit the prescribed 30-month period of deferment counted from the filing date or, where priority is claimed, from the priority date of the application concerned. Refer to "Deferred publication for a period which is less than the prescribed period" and "No deferment of publication".

***99** Article 11(1); Rule 16(1)(a)*

Where an international application governed *exclusively* by the 1999 Act (i.e., in respect of which all Contracting Parties have been designated under the 1999 Act) contains a request for deferment of publication (beyond the 12-month standard publication period), such deferment may in principle be requested for a period of up to 30 months from the filing date, or – where priority is claimed – from the priority date. However:

- if a designated Contracting Party has declared that, under its domestic law, the period of deferment allowed is less than 30 months, then publication takes place on the expiry of the period stated in that declaration, or 12 months after the date of international registration if that declared deferment period is shorter than the standard publication period. Both the application form (DM/1) and the eHague interface clearly indicate the periods of deferment which may be requested in respect of certain Contracting Parties. Note that some Contracting Parties count deferment from the filing date, regardless of whether or not priority is claimed;

99 Article 11(2)(ii)

- if more than one designated Contracting Party has declared that the period of deferment allowed for is less than 30 months, then publication takes place on the expiry of the shortest of the periods stated in those declarations, or 12 months after the date of international registration if any of those declared deferment periods are shorter than the standard publication period;

99 Article 11(2)(ii)

- if a designated Contracting Party has declared that deferment of publication is not possible under its domestic law, the International Bureau notifies the applicant that the request for deferment of publication is incompatible with the designation of the Contracting Party concerned. If the holder does not withdraw that designation within one month of the date of the notification sent by the International Bureau, the request for deferment of publication is not taken into consideration and the standard publication period applies.

99 Article 11(3)(i); Rule 16(2)

Summary of time of publication

If any of the following Contracting Parties is designated, and the chosen time for publication in item 17 is more than 12 months, the international registration is published at 12 months after the date of the international registration (standard publication):

- Contracting Parties which have declared that the period of deferment allowed is 12 months or less;
- Contracting Parties which have declared that that deferment of publication is not possible and the holder did not withdraw that designation; and
- Contracting Parties designated under the 1960 Act.

If any of the above mentioned Contracting Parties is designated, and the chosen time for publication in item 17 is less than 12 months, the international registration is published at the chosen time.

Rule 16(1)(b); Rule 17(1)(ii) and (iii)

Options for the holder before publication

Before publication, the following actions may be initiated by the holder with regard to the international registration:

Request for earlier publication

The holder may request earlier publication – i.e., publication prior to the expiry of the publication period initially specified in the international application or the 12-month standard publication period – in respect of any or all of the designs contained in the international registration. The international registration is then published immediately after the receipt of such request by the International Bureau.

__60__ Article 6(4)(b); __99__ Article 11(4)(a); Rule 17(1)(iibis)

Request to provide extract or authorize access

It is a general principle that international applications and international registrations are kept secret by the International Bureau until publication. This principle of confidentiality also applies to any document accompanying the international application. However, there may be situations where the holder may no longer wish to preserve such confidentiality, for example, in order to assert his/her rights before a jurisdiction or third parties. Therefore, the holder may request the International Bureau to provide an extract of the international registration to a third party he/she has designated, or to authorize access to the international registration by a third party.

__99__ Article 11(4)(b)

Renunciation or limitation

The holder may renounce the international registration for "all" the designated Contracting Parties, in respect of all the designs that are the subject of the international registration. Such a renunciation will result in the *de facto* cancellation of the whole international registration, and the design or designs that are the subject of the international registration will not be published.

The holder may also limit the international registration, for "all" the designated Contracting Parties, in respect of some of the designs that are the subject of the international registration. In such case, only the designs that are not affected by the limitation will be published.

If the holder wishes that a request for the recording of a renunciation or limitation is taken into account for the publication of an international registration, such a request must comply with the applicable requirements (refer to "Renunciation" and "Limitation"), and be received by the International Bureau no later than three weeks prior to the expiry of the applicable publication period. In default of this, the international registration is published at the expiration of the applicable publication period without account being taken of the request for the recording of a limitation or renunciation. Provided that the request for limitation or renunciation complies with the applicable requirements, the limitation or renunciation is nevertheless recorded in the International Register.

__60__ Article 6(4)(b); __99__ Article 11(5); A.I. Section 601

Furnishing of confidential copies to Examining Offices

Confidentiality

As a general principle, the International Bureau keeps in confidence each international application and each international registration until publication in the Bulletin (refer to "Publication of the international registration").

60 Article 6(4)(d); 99 Article 10(4)

Examining Offices are faced with the situation in which they need to examine applications without knowing whether an international registration whose publication does not take place immediately is included in the prior art. In order to resolve this problem, immediately after registration has been completed, the International Bureau must send, by electronic means agreed upon between the International Bureau and the Office concerned, a copy of the international registration, along with any documentation accompanying the international application, to each Office that has notified the International Bureau that it wishes to receive such a copy and has been designated in an international application.

99 Article 10(5)(a); A.I. Section 901

In such a case, the Office is required to maintain the confidentiality of the international registration until publication, and may use the documentation sent to it only for the purpose of the examination of other applications. It may not divulge the contents of the international registration to any persons outside the Office, except for the purposes of administrative or legal proceedings involving a conflict over entitlement to file the international application on which the international registration is based.

99 Article 10(5)(b)

If an Examining Office concludes that an application concerns a design that is similar to a design that is the subject of an unpublished international registration resulting from an earlier application, of which it has received a confidential copy, it must suspend the prosecution of the later application until publication of the international registration, since it will not be able to divulge the content of the international registration to the holder of the later application.

The Office may notify the holder of the later application of the fact that prosecution of that application is suspended on account of possible conflict with an as yet unpublished registration resulting from an earlier application. If the later filing is also an international registration, the Examining Office will refuse the effect of that later international registration until the earlier unpublished international registration has been published and it has taken a decision regarding the conflict between the two registrations.

Updating of data concerning the international registration

Updated data concerning an international registration shall be communicated to each Office that has received a confidential copy of the international registration in the same manner as established for confidential copies. The purpose of Section 902(a) is to inform the Offices of all the designated Contracting Parties that have received a confidential copy of the international registration of its cancellation under Rule 16(5), in the case where the publication fee is not paid or proper reproductions of the design are not submitted. Furthermore, the purpose of Section 902(b) is to inform the Office of a designated Contracting Party that has received a confidential copy of the international registration of any change relevant to that Contracting Party upon its recording in the International Register. Finally, the purpose of Section 902(c) is to inform the Offices of designated Contracting

Parties that have received a confidential copy of the international registration of any correction effected before the publication of the international registration, unless the correction only concerns the designations of other Contracting Parties.

A.I. Section 902

If the international application is accompanied by a specimen, instead of a reproduction, the designated Examining Office receives a specimen at the same time as a copy of the international registration. In effect, therefore, the number of copies of specimens accompanying an international application in cases where specimens can take the place of reproductions (refer to "Filing of specimens under the 1999 Act" and "Filing of specimens under the 1960 Act") corresponds to the number of Contracting Parties designated in the international application under the 1999 Act, having an Examining Offices, and having made a notification under Article 10(5) of the 1999 Act – plus one copy for the International Bureau.

Rule 10(1)(ii)

The international registration

Registration in the International Register

Where the International Bureau finds that the international application conforms to the applicable requirements, it registers the design in the International Register and sends a certificate to the holder. This is so, whether or not deferment of publication of the international registration has been requested.

Rule 15(1)

The international registration contains:

- all the data contained in the international application, except any priority claim where the date of the earlier filing is more than six months before the filing date of the international application;
- any reproduction of the design;
- the date of the international registration;
- the number of the international registration; and
- the relevant class of the International Classification, as determined by the International Bureau.

Rule 15(2)

Crediting of fees

Any standard designation fee or individual designation fee collected by the International Bureau is credited to the account maintained with the International Bureau by the Contracting Party concerned. This is done within the month following the month during which was recorded the international registration or, as regards the payment of the second part of an individual fee, upon its receipt by the International Bureau.

Rule 29

Date of the international registration

As a matter of principle, the date of the international registration is the filing date of the international application (refer to "Filing date of the international application"). However, where the international application has, on the date on which it is received by the International Bureau, an irregularity which relates to one of the additional elements which may be notified by a Contracting Party to the 1999 Act (namely the identity of the creator, a brief description and/or a claim; refer to "Irregularities concerning special requirement notified by a Contracting Party or regarding the identity of the creator, description and claim"), the date of the international registration is the date on which the correction of such irregularity is received by the International Bureau or the filing date of the international application, whichever is the later.

Refusal of protection

Notion of refusal

Under the Hague Agreement, the word "refusal" does not mean a *final* decision of refusal, that is to say, a decision that is no longer subject to review or appeal. All that is required is that, within the applicable refusal period (refer to "Time limits for refusal"), a designated Office indicates the grounds which may be *liable* to lead to a refusal of protection. In other words, what must be notified within the applicable refusal period is simply a provisional objection. In practice, therefore, refusals may be based on:

- an objection resulting from the *ex officio* examination undertaken by an Office;
- an opposition lodged by a third party. It must be emphasized that, under the wording of the Hague Agreement, the simple fact of an opposition being lodged against an international registration must be notified to the International Bureau as a "refusal of protection based on an opposition". This does not prejudge the eventual decision taken by the Office concerned on the opposition.

Ex officio examination, as well as examination following an opposition by a third party, is carried out by the Office in accordance with the law of its Contracting Party. For example, the Office may examine *ex officio* only the formal requirements of national applications, or that the design meets the definition of a design under its law, or carry out an exhaustive worldwide novelty examination.

Grounds for refusal

Each designated Contracting Party has the right to refuse, in its territory, the grant of protection to an international registration. Such refusal may be total or partial, in the sense that it may apply to all the designs which are the subject of the international registration or to some only of them.

60 *Article 8(1);* ***99*** *Article 12(1)*

Pursuant to Article 12(1), protection may not be refused on the grounds that the international registration does not satisfy formal requirements, since such requirements are to be considered by each Contracting Party as having already been satisfied following the examination carried out by the International Bureau. For example, a designated Office may not refuse protection on the ground that the required fees have not been paid or that the quality of the reproductions is not sufficient, since such verification is the exclusive responsibility of the International Bureau.

Likewise, a Contracting Party may not refuse the effects of the international registration on the ground that requirements relating to the form of the reproductions that are additional to, or different from, those which may have been notified by that Contracting Party (refer to "Specific Views" have not been met. A Contracting Party may however refuse protection on the ground that a reproduction does not sufficiently disclose the appearance of the design. In such a case, the reason for the refusal would be the substantive ground that the design is not sufficiently disclosed, *not* the formal ground that the reproduction, for example, does not contain surface shading.

The refusal must indicate all the grounds on which it is based, together with the provisions of the applicable legislation. In general, the refusal grounds may only relate to substantive issues, such as lack of novelty of the design. However, there are two exceptions to that general principle, namely, where a Contracting Party has notified a declaration under Article 13(1) concerning the requirement of unity of design, or a declaration under Rule 9(3) concerning views required (refer to "Declarations by Contracting Parties", "Unity of design", "Specific Views"), it may issue a refusal on that basis.

Rule 9(4)

It is not within the competence of the International Bureau to express an opinion as to the justification of a refusal of protection or to intervene in any way in the settlement of the substantive issues raised by such a refusal.

Unity of design

There is an exception to the principle set up in Article 12(1), namely, a Contracting Party whose law, at the time of its becoming party to the 1999 Act, contains a requirement of unity of design may notify that fact to the Director General of WIPO.

The purpose of the notification is to enable the Office of the Contracting Party to refuse the effects of the international registration, pending compliance with the requirement of unity of design, as specified in the notification by that Contracting Party. In such a case, the holder of the international registration may divide the international registration before the Office concerned in order to overcome the grounds for refusal. The Office is entitled to charge the holder of that registration as many additional fees as divisions prove necessary.

Brazil, China, Estonia, Kyrgyzstan, Mexico, Romania, the Russian Federation, the Syrian Arab Republic, Tajikistan, the United States of America and Viet Nam have made a declaration under Article 13 of the 1999 Act to notify that they require that all designs contained in a single international application are subject to a requirement of unity of design (refer to "Declarations by Contracting Parties", "Unity of design").

It is not within the competence of the International Bureau to express an opinion whether or not the requirement of unity of design under the law of a designated Contracting Party is met. However, applicants who designate Brazil, China, Mexico, the Russian Federation, the United States of America or Viet Nam are highly recommended to refer to their respective declarations, in order to mitigate the risk of refusals by those Contracting Parties (refer to "How to submit an international application to the International Bureau: eHague interface or form DM/1?", "Item 6: Number of designs, reproductions and/or specimens").

In addition, it is recommended to consult the Guidance on Including Multiple Designs in an International Application in Order to Forestall Possible Refusals, which was established in consultation with the Contracting Parties that notified a declaration under Article 13(1) of the 1999 Act that its applicable law contains special requirements concerning unity of design.

99 *Article 13*

Specific views or sufficient disclosure of the design

Only China, the Republic of Korea and Viet Nam have made a declaration under Rule 9(3) (refer to "Specific views"). This being said, it is recalled that any Office of a designated Contracting Party may refuse the effects of the international registration on the ground that the reproductions contained in the international registration are not sufficient to disclose fully the design, pursuant to Rule 9(4).

The criteria for sufficient disclosure of a design may be different from one jurisdiction to another. In order to mitigate the refusals under Rule 9(4), applicants are highly recommended to refer to the Guidance on Preparing and Providing Reproductions in Order to Forestall Possible Refusals on the Ground of Insufficient Disclosure of an Industrial Design by Examining Offices.

Rule 9(3) and (4)

Time limits for refusal

A refusal of protection must be notified to the International Bureau within a prescribed time limit. Any refusal sent after the expiry of that time limit will not be considered as such by the International Bureau (refer to "Calculation of time limits").

Rule 18; Rule 19(1)(a)(iii)

As a matter of principle, the time limit for the notification of a refusal is six months from the date of publication of the international registration.

Rule 18(1)(a)

However, any Contracting Party to the 1999 Act whose Office is an Examining Office or whose law provides for opposition proceedings may declare that, for international registrations in which it is designated under the 1999 Act, the time limit of six months is replaced by a time-limit of 12 months.

Rule 18(1)(b)

In order to determine whether a notification of refusal of protection meets the applicable time limit, it is the date of *sending* of the notification of refusal, by the Office concerned, which is decisive. In the case of a notification of refusal sent by mail, the date of sending is determined by the postmark. If the postmark is illegible or missing, the International Bureau will treat the notification as having been sent 20 days before the date on which it was actually received by the International Bureau; if, however, this date would be earlier than the date of any refusal or date of sending mentioned in the notification, the notification will be treated as having been sent on the latter date. In the case of a notification sent through a delivery service, the date of sending will be determined on the basis of the information recorded by the delivery service.

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Procedure for refusal of protection

A notification of refusal must relate to only one international registration. It must also be dated and signed by the Office making the notification.

Rule 18(2)(a)

Contents of the notification

A notification of refusal must contain the following information and indications:

- the Office making the notification;
- the number of the international registration;
- all the grounds on which the refusal is based, together with a reference to the corresponding essential provisions of the law;
- if the grounds refer to similarity with a design that is the subject of an earlier national, regional or international application or registration, all relevant data concerning that design, including the filing or registration date and number, the priority date (if any), a copy of a reproduction of the earlier design and the name and address of the owner of the design in question[1];
- if the refusal does not concern all the designs that are the subject of the international registration, those to which it does or does not relate;
- if the refusal may be subject to review or appeal, the time limit, reasonable under the circumstances, for filing a request for review of, or appeal against, the refusal, and the authority to which such request for review or appeal lies; if such request for review or appeal must be filed through the intermediary of a representative whose address is within the territory of the Contracting Party whose Office has pronounced the refusal, this should also be indicated. In such a case, the requirements for appointment of a representative is governed by the law and practice of the Contracting Party concerned; and
- the date on which the refusal was pronounced.

Rule 18(2)(b)

A refusal must state the grounds on which it is based in order to enable the holder to assess the appropriateness of challenging these grounds in a review or appeal procedure before the Office or other authority concerned.

A refusal may also indicate a possible remedy concerning a refusal ground, for example, where the refusal ground is that all the designs in the international registration are not in conformity with the requirement of unity of design under the law of the designated Contracting Party, the Office of that Contracting Party may indicate which designs conform to the same concept of unity of design, as required under its law, and give instructions on the possible division of the international registration before that Office.

The requirement to state in the notification of refusal all grounds on which the refusal is based does not prevent new grounds from being raised subsequently during the procedure before the Office, even after expiry of the time limit for refusal, as a result of the holder's reaction to the refusal, or during an appeal procedure lodged by the holder, since the latter is informed of those grounds under the procedure in question.

Recording and publication of the refusal; transmittal to the holder

A refusal of protection is notified to the International Bureau by the Office of the Contracting Party concerned. The International Bureau records such refusal in the International Register (unless it is not considered as such; refer to "Irregular notifications of refusal"), publishes it in the Bulletin, and transmits a copy of the notification to the holder of the international registration concerned.

Rule 18(2)(b)

Language of the notification of refusal

The refusal may be notified to the International Bureau in English, French, or Spanish, at the option of the Office making the notification. The refusal is recorded and published. The holder receives from the International Bureau a copy of the notification of refusal, in the language in which it was sent by the Office of the designated Contracting Party.

Irregular notifications of refusal

There are two kinds of irregular refusals, those which can be remedied and those which entail that the notification of refusal is not considered as such by the International Bureau.

A notification of refusal is not regarded as such by the International Bureau (and is therefore not recorded in the International Register) if:

- it does not contain an international registration number (unless other indications contained in the notification permit the International Bureau to identify the international registration concerned);
- it does not indicate any grounds for refusal; or
- it was sent to the International Bureau after the expiry of the applicable refusal period (six months or 12 months, as the case may be; refer to "Time limits for refusal").

Rule 19(1)(a)

In all three cases, the International Bureau nevertheless transmits a copy of the notification to the holder and informs him/her (and at the same time the Office that issued it) that it does not regard the notification of refusal as such, and indicates the reasons therefor.

Rule 19(1)(b)

It is useful for the holder of the international registration to receive from the International Bureau copies of such notifications of refusal (even if they have not been regarded as such, and consequently have not been recorded in the International Register), because this holder should be aware of potential grounds of refusal in the Contracting Party concerned. For example, a third party might initiate an invalidation action against the designation, based on the same grounds as were cited by the Office in the defective notification of refusal.

If the notification is irregular in other respects (for example, it is not signed by the Office or it does not indicate the date of refusal), the International Bureau nonetheless records the refusal in the International Register and transmits a copy of the (irregular) notification to the holder. If the holder so requests, the International Bureau invites the Office concerned to rectify its notification without delay.

Rule 19(2)

Where an Office rectifies a notification of refusal that specified a period for requesting review or appeal, it should also, where appropriate, specify a new period (for example, starting from the date on which the rectified notification was sent to the International Bureau), preferably with an indication of the date on which the new time limit expires.

Procedure following notification of refusal

Where the holder of an international registration receives, through the International Bureau, a notification of refusal, he/she has the same rights and remedies (such as review of, or appeal against, the refusal) as if the design had been filed directly with the Office that issued the notification of refusal. The international registration is, therefore, with respect to the Contracting Party concerned, subject to the same procedures as would apply to an application for registration filed with the Office of that Contracting Party.

***60** Article 8(3); **99** Article 12(3)(b)*

When lodging a request for review or an appeal against a decision of refusal or responding to an opposition, the holder may, even if this is not required by the law of the Contracting Party concerned, find it useful to appoint a local representative who is familiar with the law and practice (and the language) of the Office that pronounced the refusal. The appointment of such a representative is entirely outside the scope of the Hague Agreement and the Common Regulations, and is governed by the law and practice of the Contracting Party concerned.

In the case that the Office has issued a notification of refusal on the ground that the designs do not conform with the requirement of unity of design under its law, the holder of the international registration may divide the international registration before the Office concerned in order to overcome the grounds for refusal (refer to "Grounds for refusal" and "Contents of the notification"). The Office is entitled to charge the holder of that registration as many additional fees as divisions prove necessary. The mode of payment of additional fees of this type is not governed by the Hague System; they will be specified by each Contracting Party concerned, which will collect them directly from the holder of the international registration. Hague System Member Profiles database may be consulted to find more about the procedure following a notification of refusal on the ground that the designs do not conform to the requirement of unity of design before the Office concerned.

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1. In the event of a refusal based on similarity with a design that is the subject of an earlier registration that has not been published (in particular because deferred publication has been requested), the Office will not be able to provide the data concerning the conflicting earlier design since it is required to keep the copy of that earlier registration secret. In such case it will have to indicate in its notification, as ground for refusal, similarity with an earlier unpublished registration. The holder of the later international registration should receive the detailed contents of the earlier registration once publication has taken place. The time limits applicable to a possible appeal against refusal would be set accordingly.

Notification of withdrawal of refusal and statement of grant of protection

Notification of withdrawal of refusal

An Office which has issued a notification of refusal may withdraw the said notification, following, in particular, the lodging of an appeal by the holder. The notification of withdrawal of refusal must relate to only one international registration, but may relate only to one or some of the designs in the international registration to which the refusal applied. It must also be dated and signed by the Office concerned.

99 *Article 12(4); Rule 18(4)(a)*

A notification of withdrawal of refusal must contain the following information and indications:

- the Office making the notification;
- the number of the international registration;
- if the withdrawal does not concern all the designs that are the subject of the refusal, those to which it does, or does not, relate;
- the date on which the international registration produced the effect as a grant of protection under the applicable law;
- the date on which the refusal was withdrawn.

Rule 18(4)(b)

Where the international registration was amended in a procedure before the Office, the notification shall also contain or indicate either all the amended elements or the whole information concerning the designs as amended, at the discretion of the Office. This information could be provided in the language in which the Office detained it, even if it were a language other than the working language used for the notification of withdrawal of refusal.

Rule 18(4)(c)

Where a designated Contracting Party has made a declaration under Article 7(2) of the 1999 Act, concerning the individual designation fee to be paid in two parts, the effect as grant of protection is subject to the payment of the second part of the individual designation fee (refer to "Individual designation fee payable in two parts (applicable only to the designation of Mexico and the United States of America)"). Accordingly, a notification of withdrawal of refusal will be sent once the second part of the individual designation fee is paid.

99 *Article 7(2)*

Statement of grant of protection following a refusal

A withdrawal of refusal by an Office that has communicated a notification of refusal may also take the form of a statement to the effect that the Office concerned has decided to grant protection to the designs, or some of the designs, as the case may be, that are the subject of the international registration.

Rule 18bis(2)

A statement of grant of protection following a refusal must contain the following information and indications:

- the Office making the notification;
- the number of the international registration;
- where the statement does not relate to all the designs that are the subject of the international registration, those to which it relates or does not relate;
- the date on which the international registration produced the effect as a grant of protection under the applicable law;
- the date of the statement;
- where the international registration was amended in a procedure before the Office, the statement shall also contain or indicate all amendments (refer to "Notification of withdrawal of refusal").

Rule 18bis(2)(b) and (c)

Where a designated Contracting Party has made a declaration under Article 7(2) of the 1999 Act, concerning the individual designation fee to be paid in two parts, the effect as grant of protection is subject to the payment of the second part of the individual designation fee (refer to "Individual designation fee payable in two parts (applicable only to the designation of Mexico and the United States of America)"). Accordingly, a statement of grant of protection will be sent once the second part of the individual designation fee is paid.

99 *Article 7(2)*

Statement of grant of protection in the absence of a prior notification of refusal

The Office of a designated Contracting Party which has not communicated a notification of refusal may, within the applicable refusal period, send to the International Bureau a statement to the effect that protection is granted to the designs or some of the designs, as the case may be, that are the subject of the international registration in the Contracting Party concerned.

Rule 18bis(1)(a)

Where a designated Contracting Party has made a declaration under Article 7(2) of the 1999 Act, concerning the individual designation fee to be paid in two parts, the effect as grant of protection is subject to the payment of the second part of the individual designation fee (refer to "Individual designation fee payable in two parts (applicable only to the designation of Mexico and the United States of America)"). Accordingly, a statement of grant of protection will be sent once the second part of the individual designation fee is paid.

99 *Article 7(2)*

In general, no legal consequences result from the fact that such a statement of grant of protection has not been sent by an Office. It remains the case that the designs that are the subject of the international registration are protected if no notification of refusal has been sent within the applicable refusal period.

However, where a Contracting Party has made a declaration under Rule 18(1)(b) covering situations under Rule 18(1)(c)(i) or (ii), and either of them applies, and where protection is granted following amendments in the procedure before an Office, the sending of a statement of grant of protection is mandatory (refer to "Extension of period for notification of refusal (Rule 18(1)(b))").

Rule 18bis(1)(d) and (e)

A statement of grant of protection where no notification of refusal has been communicated must contain the following information and indications:

- the Office making the statement;
- the number of the international registration;
- where the statement does not relate to all the designs that are the subject of the international registration, those to which it relates;
- the date on which the international registration produced or shall produce the effect as a grant of protection under the applicable law;
- the date of the statement;
- where the international registration was amended in a procedure before the Office, the statement shall also contain or indicate all amendments (refer to "Notification of withdrawal of refusal").

Rule 18bis(1)(b)

The International Bureau records any withdrawal of refusal or statement of grant of protection in the International Register, informs the holder accordingly and, where the withdrawal or statement was communicated, or can be reproduced, in the form of a specific document, transmits a copy of that document to the holder. The recording of any withdrawal or statement is published in the Bulletin and a pdf copy of the document is made publicly available in the Bulletin alongside the publication.

Rule 18(5), (6) and *Rule 18bis(3)*

Effects of the international registration

Effects of the international registration in respect of Contracting Parties designated under the 1999 Act

Effect as a national application and effect as a grant of protection

The 1999 Act provides for the recognition of, successively, two sets of effects to an international registration, namely, the effect as an application under the domestic law, and the effect as a grant of protection.

Firstly, as from the date of the international registration, the international registration has at least the same effect in each designated Contracting Party as a regularly-filed application under the law of that Contracting Party. "At least the same" is a minimum standard; in other words, the effect may start on an earlier date, or its scope may be broader in respect of international registrations. One of the consequences is that any Contracting Party that affords provisional protection to published *national or regional applications* must also afford that type of protection to published international registrations in which it is designated.

Furthermore, where under the applicable law only the granted registrations are published, that Contracting Party may afford provisional protection to international registrations as from the publication date of the international registration in which it is designated.

99 *Article 14(1)*

Secondly, in each designated Contracting Party the Office of which has not notified a refusal of protection, the international registration has the same effect as a grant of protection under the law of that Contracting Party. The effect of protection starts to run, at the latest, from the date of expiry of the applicable refusal period (six or 12 months, as the case may be).

99 *Article 14(2)*

The only exception to the above principle is that a Contracting Party whose Office is an Examining Office, or whose law provides for the possibility of opposition to the grant of protection, may, by making the corresponding declaration to the Director General of WIPO, specify that the international registration will have the effect as a grant of protection at the latest:

- at a time specified in the declaration which may be later than the date of expiry of the applicable refusal period but which may not be more than six months after that date (in such case, the effect as a grant of protection begins at the time stated in that declaration), or
- at a time at which protection is granted according to the law of the Contracting Party where a decision regarding the grant of protection was unintentionally not communicated; in the latter case, the Office of the Contracting Party concerned should notify the International Bureau accordingly and endeavor to communicate its decision to the holder of the international registration promptly thereafter.

99 *Article 14(2); Rule 18(1)(c)*

The effect as a grant of protection, as described above, applies to the design or designs that are the subject of that registration as received from the International Bureau by the designated Office or, where applicable, as amended in the procedure before that Office.

99 *Article 14(2)(c)*

The words “at the latest” mean that each Contracting Party has the possibility of recognizing that the international registration has the effect as a grant of protection under its laws at an earlier date, for example as from the date of the international registration. Moreover, it is to be understood that, where a multiple international registration has been refused with respect to some only of the designs contained in the registration, protection of the international registration under the applicable law is limited to those designs that are not subject to the notification of refusal.

Furthermore, where a refusal of protection has been notified and subsequently withdrawn (totally or partially), the effect as a grant of protection under the law of the Contracting Party concerned must be afforded to the international registration, to the extent that the refusal is withdrawn, at the latest on the date of its withdrawal. Again in this case, the words “at the latest” mean that each Contracting Party has the possibility of recognizing that the effect of protection under its applicable law begins at an earlier date, for example retroactively as from the date of the international registration. The words “to the extent that the notification of refusal is withdrawn” indicate that, where a refusal is withdrawn with respect to some only of the designs that were the subject of the notification, the protection under the applicable law does not extend to the designs with regard to which the refusal has not been withdrawn.

Since a withdrawal of refusal may take the form of a statement of grant of protection, the foregoing applies where such a statement is issued in the context of a withdrawal of refusal (refer to "Notification of withdrawal of refusal").

99 *Article 14(2)(b); Rule 18(4); Rule 18bis(2)*

The Office of a designated Contracting Party may, within the applicable refusal period, send to the International Bureau a statement of grant of protection where it has not communicated a notification of refusal and has decided to accept the effects of an international registration (refer to "Statement of grant of protection in the absence of a prior notification of refusal"). In such a case, the international registration may have, in accordance with the law of the designated Contracting Party, the effect as a grant of protection, for example, as from the date on which the statement of grant of protection was issued, since each Contracting Party has the possibility of recognizing that the effect of protection begins at an earlier date. As regards the latest time at which protection must be granted, the principles explained above remain applicable.

Postponed international registration date

Finally, the date of the international registration is, in principle, the filing date of the international application. However, pursuant to Article 10(2)(b) of the 1999 Act, the date of the international registration may be later than the filing date owing to certain irregularities in the international application relating to Article 5(2) (refer to "Date of the international registration" and "Irregularities concerning special requirement notified by a Contracting Party or regarding the identity of the creator, description and claim").

The postponement of the date of the international registration may expose the design(s) in the international registration to potential risks under the applicable law (also in the designated Contracting Parties which have not made a declaration under Article 5(2) of the 1999 Act, which would cause a postponement of the date of the international registration), for example:

– where the effect as a regularly-filed application under the law of a designated Contracting Party commences on the date of the international registration

(i) the novelty of the design(s) may be destroyed by a design made available to the public before the (postponed) date of international registration (i.e., including the period between the filing date of the international application and the (postponed) international registration date);

(ii) a priority claim in the international registration may be dismissed by the Office of a designated Contracting Party if the filing date of the earlier application is more than six months prior to the (postponed) date of the international registration, even if the filing date of the international application is within the six-month priority period (refer to "Item 13: Priority claim").

– where the effect as a grant of protection under the law of a designated Contracting Party begins from the date of international registration, protection may not be provided to the design(s) against the use of same/similar design(s) by a third party before the (postponed) date of international registration.

Applicants are thus advised to make sure to provide the additional mandatory contents, where applicable, at the time of filing the international application, in order to avoid any potential risks.

However, it is recalled that a designated Contracting Party has the possibility of recognizing that the international registration has the same effect as a regularly-filed application, as well as, as a grant of protection under its law, as from the filing date of the international application, rather than the date of the international registration.

Rule 18bis(1)

Payment of the second part of the individual designation fee

Where a designated Contracting Party has made a declaration under Article 7(2) of the 1999 Act, concerning the individual designation fee to be paid in two parts, the effect as grant of protection is subject to the payment of the second part of the individual designation fee.

Rule 12(3); Rule 18bis(1)(a) and (2)

Effects of the international registration in respect of Contracting Parties designated under the 1960 Act

If no refusal is notified within the prescribed time limit of six months by a Contracting Party designated under the 1960 Act, the international registration becomes effective in that Contracting Party as from the date of the international registration. However, in a Contracting Party having a novelty examination, the international registration becomes effective from the expiration of the refusal period unless the domestic law provides for an earlier date for registrations made with its national Office. Furthermore, if, under the provisions of the domestic law of a Contracting State having a novelty examination, protection commences at a date later than that of the international registration, the term of protection must be computed from the date at which protection commences in that State. The fact that the international registration is not renewed or is renewed only once shall in no way affect the terms of protection thus defined.

***60** Articles 8(1) and 11(1)(b)*

Where a refusal of protection has been notified and subsequently withdrawn (totally or partially), the effects under the law of the Contracting Party must be afforded to the international registration, in accordance with the principles mentioned above.

Where a statement of grant of protection has been notified in the absence of a prior notification of refusal, the same considerations as outlined in "Effects of the international registration in respect of Contracting Parties designated under the 1999 Act" apply (refer to "Statement of grant of protection in the absence of a prior notification of refusal"). As regards the latest time at which protection must be granted, the principles explained above remain applicable.

Term of protection of international registrations in respect of Contracting Parties designated under the 1999 Act

With respect to Contracting Parties designated under the 1999 Act, the international registration is effected for an initial period of five years and may be renewed for two additional five-year periods before each of those periods expires. Subject to renewal, the minimum duration of protection in each Contracting Party designated under the 1999 Act is therefore 15 years following the date of international registration.

***99** Article 17*

Moreover, if the national legislation of a Contracting Party provides for a duration of protection in excess of 15 years for designs filed for registration by the national route, the international registration may be renewed with respect to that Contracting Party for additional periods of five years up to the expiry of the total duration of protection provided for in its national legislation.

Term of protection of international registrations in respect of Contracting Parties designated under the 1960 Act

With respect to Contracting Parties designated under the 1960 Act, the international registration is made for an initial period of five years and may be renewed for one additional period of five years. Subject to renewal, the minimum duration of protection in each Contracting Party designated under the 1960 Act is therefore 10 years following the date of international registration.

60 *Article 11(1)(a)*

Moreover, if the national legislation of a Contracting Party provides for a duration of protection in excess of 10 years for designs filed for registration by the national route, the international registration may be renewed with respect to that Contracting Party for additional periods of five years up to the expiry of the total duration of protection provided for in its national legislation.

60 *Article 11(2)*

Changes in the international registration

Types of changes

A request for the recording of a change may relate to any of the following:

- change in ownership of an international registration (form DM/2);

Rule 21(1)(a)(i)

- change in the name and/or address of the holder (form DM/6);

Rule 21(1)(a)(ii)

- renunciation of the international registration in respect of any or all of the designated Contracting Parties (form DM/5);

Rule 21(1)(a)(iii)

- limitation, in respect of any or all of the designated Contracting Parties, to one or some of the designs that are the subject of the international registration (form DM/3);

Rule 21(1)(a)(iv)

- change in the name and/or address of the representative (eHague or form DM/8);

Rule 21(1)(a)(v)

Where the request for the recording of a change concerns any of the above, such request must be presented to the International Bureau on the corresponding official form.

Rule 21(1)

Change in ownership

The ownership of a design may change for various reasons and in different ways. A change in ownership may result from a contract, such as an assignment. Other reasons might be a court decision, or operation of law, such as an inheritance or bankruptcy, or from the merger of two companies.

***99** Article 16(1)(i)*

The change in ownership of an international registration may relate to all the designs covered by the international registration, or to some only of them. Similarly, the change in ownership may be in respect of all the designated Contracting Parties or some only of them.

Rule 21(2)(a)(v)

The Common Regulations do not distinguish between such different causes for, or different types of, change in ownership. The uniform terminology “change in ownership” is used for all cases. Until the change has been recorded in the International Register, the former owner of the international registration is referred to as the “holder”, since this term is defined as the person or legal entity in whose name the international registration is recorded. The new owner is referred to as the “transferee”. Once the change in ownership has been recorded, the transferee becomes the holder of the international registration.

Furthermore, the issue of the recording of a change in ownership in the International Register must be distinguished from that of the validity of such change in ownership. The Hague Agreement does not set out, for example, the conditions to be met regarding the validity of a deed of assignment relating to an international registration. These conditions are, and remain, governed exclusively by the relevant domestic legislation, and may therefore vary from one Contracting Party to another (e.g., the need for execution of a document in writing certifying the assignment, proof of the age of the parties in order to assess their legal entitlement, etc.).

The Hague Agreement provides only for the requirements to be complied with in order to validly record a change in ownership in the International Register. This issue is therefore a matter which comes into play only subsequently to the formal conclusion of the contractual arrangement or to the occurring of the non-contractual cause for the change in ownership.

The recording of a change in ownership in the International Register normally aims at ensuring that such change in ownership will be effective against third parties.

Moreover, it is to be noted that, in certain circumstances, a designated Contracting Party may refuse the effect of a recording of a change in ownership in the International Register with respect to its designation, pursuant to a declaration requiring certain statements or documents, under Article 16(2) of the Geneva Act (1999), or to a declaration to refuse the effects of the recording of a given change in ownership issued pursuant to Rule 21*bis*(1) (refer to “Effect of the recording of a change in ownership” *et seq.*).

Entitlement to be recorded as new holder

Where there has been a change in the ownership of an international registration, the new owner (transferee) may be recorded as the new holder in respect of a given designated Contracting Party provided he/she holds an entitlement (i.e., by virtue of establishment, domicile, habitual residence or nationality) in a Contracting Party bound by an Act to which the designated Contracting Party concerned is also bound.

***99** Article 3; Rule 21(2)(a)(iv)*

For example, if a designated Contracting Party is bound by both the 1960 Act and the 1999 Act, the transferee could be recorded as the new holder in respect of such Contracting Party to the extent that he/she holds an entitlement in a Contracting Party bound by either (but at least one) of these Acts. On the other hand, where the transferee is a company holding an entitlement only in a Contracting Party bound *exclusively* by the 1999 Act, such transferee cannot be recorded as new holder in respect of designated Contracting Parties bound *exclusively* by the 1960 Act (or *vice-versa*).

In certain situations, the application of this principle may entail a change in the Act governing the designation of the Contracting Party concerned *vis-à-vis* the Contracting Party of the new holder. The following example may illustrate the issue concerned.

An applicant originates from a Contracting Party bound exclusively by the 1960 Act and has designated a Contracting Party bound by both the 1960 and the 1999 Acts. Such designation is therefore governed by the 1960 Act (the single common Act). The corresponding registration is subsequently assigned to a company established in a Contracting Party bound exclusively by the 1999 Act. This transfer can be recorded in the International Register, since the 1999 Act is common to the Contracting Party of the new holder and the designated Contracting Party concerned. For the very same reason, however, it follows that the designation of that Contracting Party is no longer governed by the 1960 Act, but instead by the 1999 Act (the only common Act between the designated Contracting Party and the Contracting Party of the *new* holder).

Where this situation occurs, however, the following consequences must be inferred.

Refusal period

If the recording of the change in ownership takes place during the course of the refusal period, and given that such period may differ according to whether a Contracting Party has been designated under the 1960 Act or under the 1999 Act (refer to "Time limits for refusal"), the recording of the change in ownership does not have the effect of prolonging – or reducing – the refusal period allowed for a designated Contracting Party to notify a refusal of protection. This solution was approved by the Assembly of the Hague Union at its twenty second session in September/October 2003, by means of an interpretative statement.

Timing of publication of the international registration

The change in ownership has no effect on the timing of publication requested at the time of filing, even when such change in ownership takes place before publication. This also applies where (i) deferment of publication beyond the 12-month standard publication period had been requested under the 1999 Act and (ii) the international registration concerned is transferred to a person having an entitlement in a Contracting Party bound *exclusively* by the 1960 Act (under which the maximum period of deferment allowed is normally 12 months). This solution was approved by the Assembly of the Hague Union at its twenty second session in September/October 2003, by means of an interpretative statement.

Individual renewal fees

Given that an individual fee may be required at the stage of renewal for Contracting Parties designated under the 1999 Act, but that such a fee is not provided for in respect of Contracting Parties designated under the 1960 Act in the context of renewal, it follows that the *new holder* may have to pay individual renewal fees in a designated Contracting Party (while such possibility had been precluded with respect to the initial holder), or *vice versa*. This solution was approved by the Assembly of the Hague Union at its twenty second session in September/October 2003, by means of an interpretative statement.

Entitlements of the new owner in several contracting parties bound by different acts (plurality of entitlements)

The transferee may indicate, in the request for the recording of change in ownership, an entitlement in *several* Contracting Parties which may be bound by different Act(s) (refer to "Entitlement to file an international application"). Therefore, assuming for example that the transferee:

- claims a domicile in a Contracting Party bound exclusively by the 1960 Act (Contracting Party A) and the nationality of a Contracting Party bound exclusively by the 1999 Act (Contracting Party B), and
- requests to be recorded as the new holder in respect of a Contracting Party bound by both Acts (Contracting Party C),

it is the more recent (1999) Act which is taken into account to determine which Act governs the designation of the Contracting Party concerned (Contracting Party C) *vis-à-vis* the new holder (the same result would ensue if, in the example above, Contracting Party B was not the State from which the assignee is a national but an intergovernmental organization of which Contracting Party A is a member State). This solution was approved by the Assembly of the Hague Union at its twenty second session in September/October 2003, by means of an interpretative statement. It results mainly from the fact that the 1999 Act is the more modern legal instrument and that such a solution is also in the spirit of Article 31(1) of the 1999 Act and Article 31(1) of the 1960 Act, which give preference to the more recent Act.

Who can present the request

As a matter of principle, requests for the recording of changes must be presented and signed by the holder. However, a request for the recording of a change in ownership (form DM/2) may also be presented by the *new* owner, provided that it is

- signed by the holder, or
- signed by the new owner and accompanied by a document providing evidence that the new owner appears to be the successor in title of the holder. Documents that may be submitted in support of such a request are, for example, copies of assignment documents, merger documents, court decisions transferring ownership, or any other document sufficient to provide evidence for the change in ownership.

Rule 21(1)(b)

Contents of the request

A request for the recording of a change in ownership (form DM/2) must contain or indicate the following:

- the number of the international registration concerned (a single request form may be used for several international registrations in the name of the same holder, provided that the request relates to a total change in ownership as provided for in item 6 of the form. On the other hand, if the request relates to a partial change in ownership, as provided for in item 6, the request form may be used only for a single international registration);

Rule 21(2)

- the name of the current holder (if there are several holders, the names of all holders must be indicated);
- the name, postal address and email address, given in accordance with the Administrative Instructions, of the new owner of the international registration (if there are several new owners, the names, postal addresses and email addresses of all of them must be indicated);
- the name, postal address and email address, given in accordance with the Administrative Instructions, of current holders that remain holders of the international registration after the change in ownership (this concerns cases where the request for the recording of a change only concerns some of the holders, where some holders are to be removed, or where additional holders are to be added);
- where there are several new owners and no representative is appointed, an email address for correspondence should be indicated. If no such email address is indicated, the email address of the person named first (in item 3 of the form) is treated as the email address for correspondence. It should be noted that where there is only one new owner, or a representative is appointed, item 4 of the form (email address for correspondence for multiple new owners) should not be completed;

A.I. Section 301; A.I. Section 302

- the Contracting Party or Parties in respect of which the new owner fulfills the conditions to be the holder of an international registration;
- in the case of a change in the ownership of the international registration that does not relate to all the designs and to all the Contracting Parties, the numbers of the designs and the designated Contracting Parties to which the change in ownership relates;
- the amount of the fees being paid and the method of payment, or instruction to debit the required amount of fees from a current account at WIPO, and the identification of the party effecting the payment or giving the instructions.

99 *Article 16(3); Rule 21(2)(a)(vi)*

The form should be signed and the identity of the signatory should be indicated as provided for in item 8.

Rule 21(1)(b); A.I. Section 202

Appointment of a representative

The new owner or transferee may also, optionally, appoint a representative, simultaneously with the filing of the request for the recording of the change in ownership. This is provided for in item 9 of the form DM/2 (Change in Ownership), which requires that such appointment be made either by means of attaching the appropriate power of attorney or the duly completed form DM/7 (Appointment of Representative).

Rule 3(1)(b); Rule 21(2)(b)

Irregular or inadmissible requests

Request not admissible

A change in the ownership of an international registration may not be recorded in respect of a designated Contracting Party if that Contracting Party is not bound by an Act to which the Contracting Party, or one of the Contracting Parties, in respect of which the new owner fulfills the conditions to be the holder of an international registration, is also bound (refer to "Entitlement to be recorded as new holder").

Rule 21(3)

Irregular request

If the request does not comply with any of the applicable requirements, the International Bureau notifies that fact to the holder and, if the request was presented by a person claiming to be the new owner, to that person.

Rule 21(4)

An irregularity in a request for recording of a change in ownership may be remedied within three months from the date of the notification of the irregularity by the International Bureau. If the irregularity is not remedied within that three months period, the request is considered abandoned and the International Bureau notifies accordingly and at the same time the holder and, if the request was presented by a person claiming to be the new owner, that person, and refunds any fees paid, after deduction of an amount corresponding to one half of the relevant fees.

Rule 21(5)

Partial change in ownership – numbering

An assignment or other transfer of the international registration in respect of some only of the designs, or some only of the designated Contracting Parties, is recorded in the International Register under the number of the international registration of which a part has been assigned or otherwise transferred. In such case, any assigned or otherwise transferred part is cancelled under the original number of the international registration and is recorded as a separate international registration. The separate international registration bears the number of the international registration of which a part has been assigned or otherwise transferred, together with a capital letter.

Rule 21(7)

Merger

Where the same person becomes the holder of two or more international registrations resulting from a partial change in ownership, the registrations may be merged at the request of such person. In that regard, the requirements concerning a request for the recording of a change in ownership (refer to "Change in ownership") apply *mutatis mutandis* to the request for the recording of a merger.

Rule 21(8)

The international registration resulting from the merger bears the number of the international registration of which a part had been assigned or otherwise transferred, together, where applicable, with a capital letter.

Recording, notification and publication

Provided that the request is in order, the International Bureau promptly records the change in the International Register and informs both the new holder and the previous holder.

Rule 21(6)(a)

The International Bureau publishes in the Bulletin the relevant data concerning the change in ownership, including the data regarding the appointment of a representative of the new owner, if the request was accompanied by such an appointment. Email addresses are recorded in the International Register, but not made available to any third parties.

Rule 26(1)(iv)

Effect of the recording of a change in ownership

The recording of a change in ownership in the International Register has the same effect as if it had been made directly at the corresponding national or regional Register of the Office. However, Article 16(2) of the 1999 Act provides for one possible exception, namely a Contracting Party may, in a declaration, notify the Director General of WIPO that a recording of a change in ownership in the International Register shall not have effect in that Contracting Party until the Office of that Contracting Party has received the statements or documents specified in that declaration.

***60** Article 7(1)(b); **99** Article 16(2)*

Refusal of the effects of the recording of a change in ownership issued by the Office of a designated Contracting Party

As indicated above, a Contracting Party may make a declaration under Article 16(2) of the 1999 Act to the effect that the recording of a change in ownership in the International Register does not have effect in that Contracting Party until the Office has received the statements or documents specified in that declaration.

Rule 21bis

Furthermore, there are situations under some national/regional laws, where the recording of a partial change in ownership is not allowed. For example, this is the case under certain jurisdictions where a set of designs is considered to constitute a single design, which means that all the designs belonging to the same set acquire legal protection as a whole and do not

acquire protection independently. As a consequence, all the designs forming the set can only be transferred to the same transferee at the same time. This is also the case under certain jurisdictions where the law provides for a “similar design” system or a “related design” system. Designs registered under this particular condition can only be transferred all together at the same time.

As described above, if a given change in ownership is not allowed under its national/regional laws, the Office of that Contracting Party may declare that the change in ownership recorded in the International Register has no effect in the said Contracting Party.

Rule 21bis(1)

That declaration must be sent by the Office to the International Bureau within six months from the date of publication of the change in ownership or within the applicable refusal period, whichever expires later. The declaration should indicate (i) the reasons for which the change in ownership has no effect, (ii) the corresponding essential provisions of the law, (iii) the numbers of the designs concerned by the declaration where it does not relate to all the designs that are the subject of the change in ownership, and (iv) whether such a declaration may be subject to review or appeal.

Rule 21bis(2) and (3)

Upon its receipt, the International Bureau records the declaration in the International Register and notifies accordingly the previous holder (the transferor) and the new holder (transferee). The International Bureau also modifies the International Register, so that that part of the international registration which has been the subject of the said declaration be recorded as a separate international registration in the name of the previous holder (the transferor). The International Bureau notifies accordingly the previous holder (the transferor) and the new holder (the transferee).

Rule 21bis(4)

The withdrawal of a declaration of refusal issued under this Rule shall be notified to the International Bureau which shall then record it in the International Register, modify the International Register accordingly, and notify accordingly the previous holder (the transferor) and the new holder (the transferee).

Rule 21bis(5)

The International Bureau publishes the relevant data concerning declarations of refusal of the effects of the recording of a change in ownership and their withdrawals.

Rule 26(1)(ix)

The following example may illustrate how this Rule works: a given international registration contains the designations of Contracting Parties A and B under the 1999 Act, Contracting Party A having made the declaration under Article 16(2) of the 1999 Act. A total change in ownership of the international registration has been recorded in the International Register from holder X to new holder Y. After three months from the date of publication of the recording of the said change in ownership, the International Bureau receives from the Office of Contracting Party A the declaration that the change in ownership has no effect in that Contracting Party. The International Bureau records the said declaration in the International Register and notifies accordingly the previous holder (the transferor) and the new holder (the transferee), in accordance with paragraph (4) of this Rule. Pursuant to the said paragraph, the International Bureau modifies the total change in ownership to a change in ownership in

respect of Contracting Party B, this modification leading to the creation of a new international registration in the name of X for Contracting Party A. According to the general principle established under Rule 21(7) for the recording of a partial change in ownership, the new international registration would bear the number of the original international registration, together with a capital letter. In the event of a further decision to withdraw the aforementioned declaration of refusal in Contracting Party A, it shall be notified to the International Bureau pursuant to paragraph (5) of Rule 21*bis*. The International Bureau then modifies the name of the holder of the new international registration from X (the previous holder) to Y (the new holder) and notifies the previous and the new holder accordingly. The International Bureau then merges those two international registrations in the name of Y (the new holder) and informs the new holder (transferee) accordingly.

Rule 21bis and 21(7)

Change in the name and/or address of the holder

A request for the recording of a change in the name and/or postal address of the holder must be presented to the International Bureau on official form DM/6. This form must *not* be used where the change of name results from a change in ownership. In such a case, form DM/2 should be used (refer to "Change in ownership"). If the holder wishes to record a new or updated **email address only**, this change should be communicated through **Contact Hague** (this service is free of charge).

Rule 21(1)(a)(ii)

Item 1: International Registration Number(s)

A single request may relate to several international registrations recorded in the name of the same holder. If, in respect of a given international registration, the number is not known (because the international registration has not yet been effected or notified to the holder), no other number should be given. The holder should wait until he/she is notified of the international registration number concerned and then make a further request.

Rule 21(2)(a)(i)

Item 2: Name of the holder

The name of the holder, as recorded in the International Register, must be indicated in the same way as that described under "Applicant".

Rule 21(2)(a)(ii)

Item 3: Change in name and/or address of the holder

Spaces are provided to indicate the new name, new address, new telephone number and new email address. Only the information which has changed need be indicated. That is, for example, where only the name has changed, it is sufficient to indicate the new name, leaving the other spaces blank; similarly, where only the address has changed, there is no need to repeat the name.

Rule 21(2)(a)(iii)

Where only the telephone number and/or email address has changed, it is sufficient to indicate the new number and/or email address through Contact Hague (the use of form DM/6 is not necessary). Where this is the only change to be recorded, no fee is payable for the request.

Item 4: Email address for correspondence for multiple holders

This item should be completed only if there are multiple holders and no representative is appointed, and the holders wish to:

- maintain the email address for correspondence as already recorded in the International Register (if this item is *not* completed, the email address for correspondence which has already been recorded in the International Register is automatically disregarded by the International Bureau); or
- replace the existing email address for correspondence already recorded in the International Register with a different email address for correspondence; or
- indicate for the first time an email address for correspondence other than that provided in item 3.

Item 5: Signature

The form should be signed and the identity of the signatory should be indicated.

Rule 21(1)(b)(i)

Payment of fees

A request to record a change in the name or address of the holder is subject to the payment of the fee specified in the Schedule of Fees. Refer to the general remarks concerning payment of fees to the International Bureau (refer to "Payment of fees to the International Bureau").

***99** Article 16(3); Rule 21(2)(a)(vi)*

Change in the name and/or address of the representative

A request for the recording of a change in the name and/or postal address of the representative must be presented to the International Bureau either through the eHague interface or by completing official form DM/8. This form must *not* be used to appoint a new or different representative. In such a case, form DM/7 should be used (Appointment of Representative). If the representative wishes to record a new or updated **email address only**, this change should be communicated through **Contact Hague** (this service is free of charge). The recording of a change in the name and/or address of the recorded representative is free of charge.

Rule 21(1)(a)(v) and (2)(a)(ii)

Irregular requests

If a request to record a change in name or postal address of the holder or representative does not comply with any of the applicable requirements, the International Bureau notifies that fact to the holder or to the recorded representative. The irregularity may be remedied within three months from the date of the notification. If this is not done, the request will be considered abandoned and any fee paid will be reimbursed to the party that paid it, after deduction of an amount corresponding to one half of the relevant fee.

Rule 21(4) and (5)

Recording, notification and publication

Provided that the request is in order, the International Bureau promptly records the change in the International Register and informs the holder or the recorded representative. The change is recorded as of the date of receipt by the International Bureau of the request complying with the applicable requirements. Where however the request indicates that the change should be recorded after another change, or after renewal of the international registration, the International Bureau proceeds accordingly. The International Bureau publishes in the Bulletin the relevant data concerning the change in the name and/or address of the representative.

99 *Article 16(4); Rule 21(6); Rule 26(1)(iv)*

Renunciation

Renunciation of an international registration always concerns *all* the designs that are the subject of the international registration, but may relate to some or all of the designated Contracting Parties. If the request relates to some only of the designs covered by the international registration, form DM/3 (limitation) must be used.

99 *Article 16(1)(iv); Rule 21(1)(a)(iii)*

A request for the recording of a renunciation should be presented to the International Bureau on official form DM/5.

Rule 21(1)(a)

Item 1: International registration number

If, in respect of a given international registration, the number is not known (because the international registration has not yet been effected or notified to the holder), no other number should be given. The holder should wait until he/she is notified of the international registration number concerned and then make a further request.

Rule 21(2)(a)(i)

One single form may be used to request the recording of a renunciation in respect of several international registrations of the same holder, provided that the designated Contracting Parties in respect of which the international registration is renounced are the same for each of the international registration concerned.

The request must necessarily relate to all the designs covered by the international registration(s) in respect of some, or all, the designated Contracting Parties. If the request relates to some only of the designs covered by the international registration(s), form DM/3 (limitation) must be used instead.

Item 2: Name of the holder

The name of the holder, as recorded in the International Register, must be indicated in the same manner as that described in "Applicant".

Rule 21(2)(a)(ii)

Item 3: Contracting parties

The holder must indicate whether the request for the recording of the renunciation relates to all designated Contracting Parties or to only some of the designated Contracting Parties in which case the boxes corresponding to the Contracting Parties concerned should be ticked.

Item 4: Signature

The form should be signed and the identity of the signatory should be indicated.

Rule 21(1)(b)

Payment of fees

A request to record a renunciation is subject to the payment of the fee specified in the Schedule of Fees (refer to "Payment of fees to the International Bureau").

***99** Article 16(3); Rule 21(2)(a)(vi)*

Irregular requests

If a request to record a renunciation does not comply with any of the applicable requirements, the International Bureau notifies that fact to the holder. The irregularity may be remedied within three months from the date of the notification. If this is not done, the request will be considered abandoned and any fee paid will be reimbursed to the party that paid it, after deduction of an amount corresponding to one half of the relevant fee.

Rule 21(4) and (5)

Recording, notification and publication

Provided that the request is in order, the International Bureau promptly records the renunciation in the International Register and informs the holder. The change is recorded as of the date of receipt by the International Bureau of the request complying with the applicable requirements. The International Bureau publishes in the Bulletin the relevant data concerning the renunciation.

***99** Article 16(4); Rule 21(6); Rule 26(1)(iv)*

Normally, the renunciation is recorded as of the date of the receipt of the request by the International Bureau. It may happen, however, that a holder wishes that the date of the recording of a renunciation be linked with the recording of another change.

Rule 21(6)(b)

Limitation

A request for the recording of a limitation should be presented to the International Bureau on official form DM/3. It may be used only to request the recording of a limitation for a single international registration.

***99** Article 16(1)(v); Rule 21(1)(a)(iv)*

A limitation enables the holder to delete some of the designs from the international registration. Thus, it must concern only some of the designs, but may relate to some or all of the designated Contracting Parties. If the request concerns all designs covered by the international registration(s), form DM/5 (renunciation) must be used.

Item 1: International registration number

A request must relate to a single international registration. If the number is not known (because the international registration has not yet been effected or notified to the holder), no other number should be given. The holder should wait until he/she is notified of the international registration number concerned and then make a further request.

Rule 21(2)(a)(i)

Item 2: Name of the holder

The name of the holder, as recorded in the International Register, must be indicated in the same manner as that described in "Applicant".

Rule 21(2)(a)(ii)

Item 3: Designs

Each design affected by the limitation (that is, for which protection is no longer sought) must be specified by indicating its number.

Item 4: Contracting parties

The holder must indicate whether the request for the recording of the limitation relates to all the designated Contracting Parties or only to some of the designated Contracting Parties (in which case the boxes corresponding to those Contracting Parties concerned must be ticked).

Item 5: Signature

The form should be signed and the identity of the signatory should be indicated.

Rule 21(1)(b)

Payment of fees

A request to record a limitation is subject to the payment of the fee specified in the Schedule of Fees (refer to "Payment of fees to the International Bureau").

99 Article 16(3); Rule 21(2)(a)(vi)

Irregular requests

If a request to record a limitation does not comply with any of the applicable requirements, the International Bureau notifies that fact to the holder. The irregularity may be remedied within three months from the date of the notification. If this is not done, the request is considered abandoned and any fee paid is reimbursed to the party that paid it, after deduction of an amount corresponding to one half of the relevant fee.

Rule 21(4) and (5)

Recording, notification and publication

Provided that the request is in order, the International Bureau promptly records the limitation in the International Register and informs the holder. The change is recorded as of the date of receipt by the International Bureau of the request complying with the applicable requirements. The International Bureau publishes in the Bulletin the relevant data concerning the limitation.

99 Article 16(4); Rule 21(6); Rule 26(1)(iv)

It is not possible to record a license in the International Register

There is no provision in the Hague System allowing for the possibility of recording a license in the International Register. Therefore, formalities which may be necessary to secure the effectiveness of a licensing agreement in a designated Contracting Party must be carried out at the national or regional level directly before the Office of the Contracting Party concerned, provided that the domestic legislation in question so permits.

Corrections in the International Register

Where the International Bureau, acting *ex officio* or at the request of the holder, considers that there is an error in the International Register concerning an international registration, it will modify the International Register and inform the holder accordingly.

Rule 22(1)

The Office of any designated Contracting Party has however the right to declare in a notification to the International Bureau that it refuses to recognize the effects of such correction. Rules 18 and 19, concerning refusal of protection, apply *mutatis mutandis*.

Rule 22(2)

Renewal of the international registration

With respect to Contracting Parties designated under the 1999 Act, the international registration is valid for an initial period of five years and may be renewed for two additional five-year periods. Subject to renewal, the duration of protection available in each Contracting Party designated under the 1999 Act is at least 15 years, counted from the date of international registration (refer to "Individual designation fee and renewal for the United States of America"). Moreover, if the national legislation of a Contracting Party provides for a duration of protection in excess of 15 years for designs filed for registration by the national route, the international registration may be renewed with respect to that Contracting Party for additional periods of five years up to the expiry of the total duration of protection provided for in its national legislation.

***99** Article 17; **99** Article 17(3)(b)*

With respect to Contracting Parties designated under the 1960 Act, the international registration is valid for an initial period of five years and may be renewed for an additional period of five years. Subject to renewal, the duration of protection available in each Contracting Party designated under the 1960 Act is at least 10 years counted from the date of international registration.

Moreover, if the national legislation of a Contracting Party provides for a duration of protection in excess of 10 years for designs filed for registration by the national route, the international registration may be renewed with respect to that Contracting Party for additional periods of five years up to the expiry of the total duration of protection provided for in its national legislation.

***60** Article 11(1)(a) items 1 and 2; **60** Article 11(2)*

Contracting Parties are required to notify to the Director General of WIPO the maximum duration of protection provided for by their domestic law. This information is supplied to holders in the unofficial notices of expiry which are sent by the International Bureau six months before the expiration of each five-year term (refer to "Procedure for renewal"). Where the holder wishes to renew the international registration in respect of a designated Contracting Party notwithstanding the fact that the maximum period of protection in that Contracting Party has expired, payment of the required fees for that Contracting Party must be accompanied by a statement that the renewal of the international registration is to be recorded in the International Register in respect of that Contracting Party. Allowing a renewal with respect to a designated Contracting Party notwithstanding the fact that the maximum period of protection in that Contracting Party, as notified to the Director General of WIPO, has expired is aimed at preserving the rights of the holder in the event, for example, of a change in the maximum duration of protection under the law of a Contracting Party which has not yet been notified to the Director General of WIPO.

***99** Article 17(3)(c); Rule 36(2); Rule 23; Rule 24(2)(b)*

Renewal following refusal or invalidation

If a refusal is recorded in the International Register with respect to a particular Contracting Party for all the designs covered by the international registration, the holder may nevertheless request the renewal of the international registration with respect to that Contracting Party. The payment of the renewal fees must however be accompanied by a statement that the renewal is to be recorded in respect of that Contracting Party. The reason for allowing a renewal with respect to a Contracting Party that has pronounced a refusal is that, at the time of renewal, there may still be pending a judicial or administrative

procedure in respect of such refusal. The rights of the holder may need to be preserved where the refusal was the subject of an appeal and no final decision had been taken by the date on which the renewal was due. A designated Contracting Party which has pronounced a refusal is, of course, free to determine the effects in its territory of such a renewal.

Rule 24(2)(c)

The situation is different with respect to an invalidation, since the recording of an invalidation in the International Register means, by definition, that the invalidation is no longer subject to appeal. The international registration may not, therefore, be renewed with respect to a Contracting Party for which an invalidation has been recorded for all the designs. Nor may it be renewed with respect to a Contracting Party in respect of which a renunciation has been recorded. Furthermore, the international registration may not be renewed in respect of any Contracting Party for those designs in respect of which an invalidation in that Contracting Party has been recorded. Nor may it be renewed for those designs in respect of which a limitation has been recorded in that Contracting Party.

Rule 20; Rule 21; Rule 24(2)(d)

Procedure for renewal

Six months before the expiry of each five-year term, the International Bureau sends to the holder and the representative, if any, a notice indicating the date of expiry of the international registration, along with the maximum term of protection which has been notified to the Director General of WIPO by the Contracting Parties concerned (refer to "Declarations by Contracting Parties"). If however the holder (or representative) does not receive such unofficial notice, this does not constitute an excuse for failure to comply with any time limit for payment of the renewal fees due.

Rule 23; A.I. Section 701

The international registration may be renewed for some only of the designated Contracting Parties and for some only of the designs that are the subject of the international registration.

***99** Article 17(4); Rule 24(2)(a)*

An electronic renewal interface is available in eHague for total or partial renewal of international registrations.

In addition, eHague (Renewal) automatically calculates the renewal fees to be paid based on the data entered by the holder of a given international registration and allows the holder to view the reproductions of the designs contained in the international registration. eHague (Renewal) allows the payment of the renewal fees through an online payment system offering a range of payment methods according to the user account profile.

No official form is prescribed for the renewal of an international registration. Renewal may be effected by using unofficial form DM/4 which provides for the necessary information, namely:

- the international registration number concerned;
- the name of the holder (which must be the same as the name recorded in the International Register);
- the email address of the holder;

- either that the international registration is to be renewed for all the designs and for all the designated Contracting Parties – including, where applicable, those Contracting Parties in respect of which a total refusal has been recorded in the International Register and those Contracting Parties designated under the 1999 Act or the 1960 Act in respect of which the maximum period of protection has expired – or that the international registration is to be partially renewed (*i.e.* for only *some* of the designs and/or only *some* of the designated Contracting Parties);
- the signature of the holder or his/her representative; and
- the fees being paid and the method of payment, or instructions to debit the required fees from a current account at WIPO.

In case of partial renewal (*i.e.* for only *some* of the designs and/or only *some* of the designated Contracting Parties), the holder may specify the scope of the renewal by either indicating in item 4(a) the designs and the designated Contracting Parties for which renewal is requested, or by selecting in item 4(b) *different sets* of designated Contracting Parties for which *different sets* of designs are to be renewed (e.g. renewal of design 1 in Contracting Party A, and renewal of design 2 in Contracting Party B).

Renewal may also be effected by any communication giving the required indications (the international registration number concerned and purpose of the payment).

Fees for renewal

The fees due for the renewal of an international registration must be paid directly to the International Bureau by the holder. Those fees consist of:

- a basic fee;
- an individual designation fee for each Contracting Party designated under the 1999 Act which has required such fee[1]; and
- a standard designation fee in respect of each other Contracting Party for which the international registration is to be renewed.

Rule 24(1)

The payment of individual designation fees in the context of renewal may only apply to Contracting Parties designated under the 1999 Act (provided that they have requested such fees) and cannot concern those Contracting Parties designated under the 1960 Act. In fact, the 1960 Act envisages solely the payment of “individual designation fees” in the context of a designation in the international application and not at the stage of renewal.

99 *Article 17(2); Rule 24(1)(iii)*

Individual designation fee and renewal for the United States of America

The individual designation fee, which must be paid in connection with an international application in which the United States of America is designated, is payable in two parts, in accordance with Rule 12(3). The second part of the individual designation fee covers a single 15-year duration counted from the date of grant of protection.

Therefore, subject to the payment of the second part of the individual designation fee, no renewal is required in order to maintain the effects of the international registration with respect to the designation of the United States of America. This does not, however, preclude the holder to renew the international registration with respect to the designation of the United States of America, in order to benefit from the possibility of centralized

subsequent management of the international registration for this designation, such as the recording of a change in ownership in the International Register. In this case, only the payment of the basic fee is required in order to effect the renewal of the international registration in respect of the United States of America. In other words, no renewal designation fee is payable for the designation of the United States of America.

99 *Article 7(2); Rule 12(3)*

The fee calculator may be used to calculate the fees payable for the renewal of an international registration. eHague (Renewal) automatically calculates the renewal fees to be paid taking into account the scope of the renewal.

The fees should be paid to the International Bureau by, at the latest, the date of expiry of the registration. However, payment may still be made within six months from the date on which the renewal of the international registration is due, provided that the surcharge specified in the Schedule of Fees is paid at the same time.

Rule 24(1)(c)

If any payment made for the purposes of renewal is received by the International Bureau earlier than three months before the date on which the renewal of the international registration is due, it is considered as having been received three months before that date.

Rule 24(1)(d)

If the amount of a renewal fee changes between the date on which the fee was paid to the International Bureau and the date on which renewal is due,

- where payment is made not more than three months before the date on which renewal is due, it is the fee that was valid on the date of payment that is applicable;
- where the fee is paid more than three months before the date on which renewal is due, the payment is considered to have been received three months before the due date, and it is the fee that was valid three months before the due date that is applicable; and
- where the renewal fee is paid after the due date, it is the fee that was valid on the due date that is applicable.

Rule 27(6)(b)

Insufficient fees paid

If the amount received is less than the amount required for renewal, the International Bureau promptly notifies at the same time both the holder and the representative, if any, accordingly. The notification specifies the missing amount.

If the amount received, after the expiry of the period of six months following the date on which renewal was due, is less than the amount required (including the surcharge for late payment), the renewal is not recorded. The International Bureau refunds the amount received and notifies accordingly the holder and the representative, if any.

Rule 24(3)

Where the amount paid is insufficient, the holder may, instead of paying the missing amount, ask for some of the designated Contracting Parties and/or designs to be omitted, thereby

reducing the amount due. This request must however be made within the time within which the missing payment would have had to be made.

Recording of the renewal; certificate and publication

The International Bureau records the renewal in the International Register, with the date on which it was due, even if the fees required were paid within the grace period of six months after the due date. The relevant data concerning the renewal is published in the *I.D.B.*

*Rule 25(1); **99** Article 17(5); Rule 26(1)(vi)*

Where the international registration has been renewed, the International Bureau sends a certificate of renewal to the holder.

Rule 25(2)

Crediting of fees

Any standard designation fee or individual designation fee collected by the International Bureau is credited to the account maintained with the International Bureau by the Contracting Party concerned. This is done within the month following the month during which was recorded the renewal in connection with which the fee was paid.

Rule 29

Non-renewal

If an international registration is not renewed (because the holder did not pay the renewal fees or because the fees paid were not sufficient), it lapses with effect from the date of expiry of the previous period of protection.

Where the international registration has not been renewed, that fact is published in the Bulletin. Such publication is not made until there is no longer any possibility that the international registration might be renewed, that is, after the expiry of the period of six months following the due date (within which period renewal was possible upon payment of a surcharge).

Rule 26(1)(vii)

Where the required renewal fees have not been paid by the due date, no recordings concerning the international registration concerned may be recorded in the International Register during the period of six months after the due date within which renewal remains possible upon payment of a surcharge. It is only after renewal has been recorded in the International Register that changes may be recorded in the International Register.

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1. Designation and renewal fees for international applications and registrations, in which the Republic of Korea is designated, are determined by class of the Locarno Classification. For a renewal, the following designation fees apply, depending on the international registration date:
   - before December 1, 2020: for designs belonging to classes 2, 5 or 19 of the Locarno Classification, level 3 of the standard designation fee applies. For designs belonging to any other class, the individual designation fee applies.
   - after December 1, 2020: for designs belonging to classes 1, 2, 3, 5, 9, 11 or 19 of the Locarno Classification, level 3 of the standard designation fee applies. For designs belonging to any other class, the individual designation fee applies.

Invalidation in a designated Contracting Party

The term “invalidation” must be understood as encompassing any decision by a competent authority (whether administrative or judicial) of a designated Contracting Party revoking or canceling the effects, in the territory of that Contracting Party, of an international registration with regard to all or some of the designs covered by the designation of that Contracting Party.

Rule 20

Proceedings concerning such invalidation take place directly between the holder of the international registration, the party who has brought the action for invalidation and the competent authority concerned (Office or tribunal). It may be necessary for the holder to appoint a local representative. The proceedings are governed entirely by the law and practice of the Contracting Party concerned. However, the invalidation of an international registration may not be pronounced without the holder having, in good time, been afforded the opportunity to defend his/her rights.

The procedures governing such invalidation should be the same as for designs registered directly with the Office of that Contracting Party. For example, the protection of a design may be revoked in proceedings brought by a third party, or in a counterclaim in infringement proceedings.

Where the effects of an international registration are invalidated (in whole or in part) in a Contracting Party, and the invalidation is no longer subject to any appeal, the Office of that Contracting Party, where it is aware of the invalidation, must notify the International Bureau of the relevant facts, namely:

- the authority (for example, the Office or tribunal) which pronounced the invalidation;
- the fact that the invalidation is no longer subject to appeal;
- the number of the international registration;
- if the invalidation does not concern all the designs, those which are concerned (either by indicating those designs which are no longer covered or those which are still covered); and
- the date on which the invalidation was pronounced and its effective date.

Rule 20(1)

The International Bureau records the invalidation in the International Register, together with the data contained in the notification. It also publishes the invalidation in the *I.D.B*.

Rule 20(2)

Termination of the 1934 Act

The termination of the 1934 Act became effective on October 18, 2016. The application of the 1934 Act had already been frozen since January 1, 2010. It has not been possible to file international deposits under the 1934 Act, or to make designations governed by that Act since that date. However, the prolongation (the renewal) of designations made under the 1934 Act before January 1, 2010, and the recording of any changes affecting such designations remains possible in the International Register up to the maximum duration of protection under the 1934 Act, which is 15 years[1].

All activities under the 1934 Act will gradually diminish, and, finally, terminate at the latest on December 31, 2024, *i.e.*, 15 years after the last possible deposits or designations under the 1934 Act were made.

Implications of the freezing of the application of the 1934 Act

Rule 37(1) of the Common Regulations provides for a transitional provision relating to the 1934 Act.

Since January 1, 2010, no new registrations or designations under the 1934 Act have been allowed to be recorded in the International Register. However, those with a registration date prior to January 1, 2010, remain in force. This means, more precisely, that those registrations and designations could be the subject of a renewal or any other recording provided for in the version of the Common Regulations that was in force before January 1, 2010.

As provided for in Rule 37(1)(b), the Common Regulations, as in force before January 1, 2010, that is the Common Regulations Under the 1999 Act, the 1960 Act and the 1934 Act of the Hague Agreement, as in force on January 1, 2009, remain applicable to an international application governed exclusively by the 1934 Act (refer to "International registrations resulting from international applications governed exclusively by the 1934 Act") and filed before that date and that was still pending on that date, as well as in respect of any Contracting Party designated under the 1934 Act in an international registration resulting from an international application filed before that date.

Rule 37(1)(b)

International registrations resulting from international applications governed exclusively by the 1934 Act

An international application was considered as governed exclusively by the 1934 Act where all the Contracting Parties designated in that international application were designated under the 1934 Act.

As a general principle, the international procedure applies equally to international registrations resulting from international applications governed exclusively by the 1934 Act, subject however to the exceptions mentioned below.

Rule 30(1)[2]

Language

Any communication concerning an international registration resulting from an international application governed exclusively by the 1934 Act must be in French. This is in contrast with communications in respect of the other kinds of international registrations, which may be in English, French or Spanish. The recording and publication of any new data will also be made only in French. (The publication of an international registration in the *I.D.B* under the 1934 Act contains only bibliographical data relating to that registration.)

Rule 30(2)(a)[2]

No refusal of protection

The 1934 Act does not provide for the possibility for the Offices of the designated Contracting Parties to notify a refusal of protection, therefore, international registrations resulting from international applications governed exclusively by the 1934 Act may not be the subject of such refusals.

Rule 30(2)(j)[2]

Change in ownership

A change in ownership cannot be recorded in respect of a Contracting Party designated under the 1934 Act if that Act would cease to be applicable following the recording of the change in ownership concerned. For example, assuming that Contracting Party A, bound by both the 1960 and the 1934 Acts, has been designated under the 1934 Act and that the international registration concerned is transferred to a new owner originating from Contracting Party B, bound exclusively by the 1960 Act, this change in ownership could not be recorded in the International Register because the 1934 Act would cease to be applicable in such a case. This derogation from the general principle concerning the possibility of recording a change in ownership in the International Register is due to the number and types of features which are exclusive to the 1934 Act.

Rule 30(2)(k)[2]

Renewal

Only one renewal may be requested under the 1934 Act (which provides for a *maximum* period of protection of 15 years divided into two periods: one period of five years and one of 10 years). Having regard to this specific feature of the 1934 Act, the renewal of an international registration resulting from an international application governed exclusively by the 1934 Act, for the second period of protection of 10 years, could have been requested at the time of filing the international application concerned.

Rule 30(2)(l),(m) and (n)[2]

The renewal of an international registration resulting from an international application governed exclusively by the 1934 Act is subject only to the payment of the basic fee, irrespective of the number of designated Contracting Parties. The amount of that fee is prescribed under item IV of the Schedule of Fees, part of the Common Regulations in the version in force before January 1, 2010.

Rule 30(2)(l)[2]

International registrations resulting from international applications governed partly by the 1934 Act

The international registrations resulting from international applications governed partly by the 1934 Act comprise three categories, namely:

- international registrations resulting from international applications governed by both the 1960 and the 1934 Acts, which means that, at the time of filing the application, the designated Contracting Parties included:
  - at least one Contracting Party designated under the 1960 Act, and
  - at least one Contracting Party designated under the 1934 Act, while
  - no Contracting Party had been designated under the 1999 Act.
- international registrations resulting from international applications governed by both the 1999 and the 1934 Acts, which means that, at the time of filing the application, the designated Contracting Parties included:
  - at least one Contracting Party designated under the 1999 Act, and
  - at least one Contracting Party designated under the 1934 Act, while
  - no Contracting Party had been designated under the 1960 Act.
- international registrations resulting from international applications governed by the 1999, the 1960 and the 1934 Acts, which means that, at the time of filing the application, the designated Contracting Parties included:
  - at least one Contracting Party designated under the 1999 Act, and
  - at least one Contracting Party designated under the 1934 Act, and
  - at least one Contracting Party designated under the 1960 Act.

No refusal of protection

In relation to an international registration resulting from an international application governed partly by the 1934 Act (refer to "International registrations resulting from international applications governed partly by the 1934 Act"), the Contracting Party or Parties designated under the 1934 may not notify a refusal of protection since such possibility is not envisaged under the 1934 Act.

Rule 31(2)(c)(ii)[2]

Change in ownership

A change in ownership cannot be recorded in respect of a designated Contracting Party if the 1934 Act would cease to be applicable, or would become applicable, in respect of that Contracting Party following the recording of the change in ownership. For example, assuming that Contracting Party A, bound by both the 1999 and the 1934 Acts, has been designated under the 1999 Act and that the international registration concerned is

transferred to a new owner originating from Contracting Party B, bound exclusively by the 1934 Act, this change in ownership could not be recorded in the International Register given that the 1934 Act would become applicable in such a case (refer also to "Renewal").

Rule 31(2)(b)[2]

Renewal

In relation to an international registration resulting from an international application governed partly by the 1934 Act (refer to "International registrations resulting from international applications governed partly by the 1934 Act"), a renewal cannot be recorded with respect to Contracting Parties designated under the 1934 Act where the maximum duration of international protection of 15 years has expired. This differs from the situation applicable to Contracting Parties designated under the 1999 Act or the 1960 Act (refer to "Renewal of the international registration").

Rule 31(2)(c)(iv)[2]

The renewal of a designation under the 1934 Act does not give rise to the payment of a designation fee.

Rule 31(2)(c)(iii)[2]

Termination of the 1934 Act

The Director General of WIPO received the required instruments of acceptance of termination or instruments of denunciation[3] of the 15 Contracting Parties to the 1934 Act, namely, Benin, Côte d'Ivoire, Egypt, France, Germany, Indonesia, Liechtenstein, Monaco, Morocco, the Netherlands, Senegal, Spain, Suriname, Switzerland and Tunisia, according to their decision to terminate that Act which was taken at the Extraordinary Meeting of Contracting States to the London Act (1934), on September 24, 2009.

Consequently, in accordance with the above decision, and pursuant to Article 54(b) of the Vienna Convention on the Law of Treaties of May 23, 1969, the termination of the 1934 Act and of the Additional Act of Monaco, became effective on October 18, 2016, that is, three months after the deposit of the last required instrument of acceptance of the termination of the 1934 Act.

As the application of the 1934 Act was frozen since January 1, 2010, it was not possible, since that date, to file international deposits under the 1934 Act, or to make designations governed by that Act in an international application.

However, the prolongation (the renewal) of designations made under the 1934 Act before January 1, 2010, and the recording of any changes affecting such designations remain possible in the International Register up to the maximum duration of protection under the 1934 Act, which is 15 years.

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1. Refer to document H/A/28/3 entitled "Freezing of the Application of the London Act (1934) of the Hague Agreement" and document H/A/28/1 entitled "Proposed Amendments to the Common Regulations under the 1999 Act, the 1960 Act and the 1934 Act of the Hague Agreement".
2. Citation of Rules 30 and 31 is in reference to the (archived) edition of the Common Regulations which was in force on January 1, 2009. Rules 30 and 31 have been deleted from the Common Regulations effective as from the edition in force on January 1, 2010.
3. The denunciation of the 1934 Act by Indonesia, Switzerland and the Netherlands took effect, on June 3, 2010, November 19, 2010, and December 13, 2011, respectively.

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