



Promoting Intellectual
Property Rights in the
ASEAN Region

THE GENEVA ACT

A roadmap towards accession

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Funded by the European Union



This Project is funded by the European Union and implemented by the European Union Intellectual Property Office (EUIPO)

A ROADMAP TOWARDS ACCESSION ...

Becoming a Party to the Geneva Act

Preparatory work: main areas requiring attention

- Legal
 - implementing provisions
 - declarations and other info to be conveyed to WIPO
- Organization and procedures
- Information technology
- User community information and promotion

IMPLEMENTING PROVISIONS

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When acceding to the Geneva Act, your country

- shall implement the procedures provided for in the Geneva Act, Common Regulations and Administrative Instructions, as in force
- shall confer to international registrations (IRs) the same rights that accrue to industrial designs applied for or registered at the IPO

Implementing provisions (options)

- an amendment to your Industrial Design Law
- a bill of accession placing all relevant provisions in the Regulations, or
- placing some provisions in the Law itself and others in the Regulations, Ministerial decisions or IPO instructions

Role of your Office as Office of the Applicant

Will your Office process IAs originating in your country?

- if no => implementing provisions **shall** prescribe that IAs originating in your country shall be submitted directly to WIPO
- if yes => implementing provisions **shall** prescribe the tasks to be performed by your Office as a transmittal Office with respect to:
 - filing modalities, filing language(s)
 - transmission of IA to the IB indicating filing date
 - IPO to charge a transmittal fee?
 - IPO to handle and transmit other fees to WIPO?

Effects of the *IDB* publication

The publication by WIPO of any notice regarding an IR (including renewals, changes) in the International Designs Bulletin (*IDB*) shall have the same effects as if they had been published in your national IP gazette or official journal

Effects of the IR

the implementing provisions **shall** prescribe that any IR designating your country **shall** have the same effect as

IR = an **application** regularly filed at your Office, as from the date of the IR

IR = a **grant of protection** for the industrial design, if protection is granted or not refused by your Office within the refusal period (6 or 12 months) or the refusal is subsequently withdrawn

Grounds for refusal of protection

The implementing provisions **shall** prescribe that such grounds **shall** be the same **substantive grounds** envisaged in your national Law

e.g., non-compliance with definition of industrial design; lack of novelty; design contrary to public order or morality; registration opposed by a third party on grounds that the application does not comply with substantive requirements for protection

No refusal on formality grounds

No IR **shall** be refused on the ground that requirements relating to the form or content of the IA, or additional to, or different from, those requirements have not been satisfied

(formality requirements have already been examined by the IB)

Opposition procedures

If your law provides for opposition by a third party to the registration of a design, the relevant opposition procedures **shall** apply, *mutatis mutandis*, to the opposition by a third party to the grant of protection to an IR, specifying the date as from which such procedures shall run.

Notifications to the IB regarding refusals and grants of protection

Your Office **shall** follow the Hague System procedures regarding notifications of

- refusals
- withdrawal of refusals
- statements of grant of protection following a refusal
- statements of grant of protection in the absence of a refusal

Remedies in case of refusal

The implementing provisions **shall** specify that in case of refusal of an IR, the holder of the IR **shall** enjoy the same remedies as if the industrial design had been filed directly with your Office and such remedies **shall at least** consist of the possibility of a **re-examination** or a **review** of the refusal by your Office **or an appeal** against the refusal

Date of effect of protection

The implementing provisions **shall** specify the date as from which the IR shall enjoy protection in the country if protection is granted or not refused or refusal is withdrawn

In most DCPs, such date is the date of the IR

Duration of protection

If renewed every five years, the IR **shall** have the same maximum duration of protection as provided for in your national law in respect of an industrial design registered directly at your Office provided that this duration is of at least 15 years.

Effects of the recording of changes in the International Register

Any change to an IR recorded by WIPO in the International Register,
e.g., change in ownership, change in name / address of the holder,
IR renunciation, IR limitation, IR invalidation

shall have the same effects in your country as if that change had been recorded by your Office in the national register.

Nevertheless, your country **may** declare that the recording of a change in ownership shall only have that effect in your country once your Office has received a statement or document certifying the transfer of rights

Invalidation

National law provisions regarding invalidation (cancellation, revocation, annulment) of a national industrial design registration **shall** apply, *mutatis mutandis*, to the invalidation of IRs.

In any case, no invalidation may be pronounced without the holder having, in good time, been afforded the opportunity of defending his rights.

Exemption from authentication, legalization or other certification

The implementing provisions **shall** prescribe that any IR certificate issued by WIPO (and any extract from the International Register, or certified copy of a recording therein, or of items in the file of the IR), bearing the seal of the IB of WIPO and the signature of the WIPO DG, shall be exempted from authentication, legalization or any other certification.

No authority in your country **shall** require authentication, legalization or any further certification of such documents

DECLARATIONS UNDER THE GENEVA ACT AND COMMON REGULATIONS

Mandatory declarations – envisaged in the Geneva Act

- Maximum duration of protection
- Deferment of publication for less than 30 months
- No deferment of publication

Optional declarations

- Several such declarations envisaged
 - in the Geneva Act
 - in the Common Regulations

MANDATORY DECLARATION – Article 17(3)(c)

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Maximum duration of protection

- Each Contracting Party shall notify, in a declaration, the maximum duration of protection provided for by its law
- Such duration cannot be less than 15 years from the date of the IR
- It shall be more than 15 years, if your law provides for a duration of protection for industrial designs registered at your Office that may be longer than 15 years (*e.g., 25 years*)

MANDATORY DECLARATION – Article 17(3)(c)

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Maximum duration of protection

- 25 years – AM, BA, BX (BE, NL, LU), BG, CH, DE, DK, EE, EM, ES, FI, FR, GB, GE, HR, HU, IS, IL, JP, LV, LI, LT, MX, ME, MK, NO, PL, MD, RO, RU, RS, SI, SM, TR (36 Contracting Parties)
- 15 years – AL, AZ, BN, BW, BZ, CA, EG, GH, KG, KH, KP, MN, NA, OA, OM, RW, SG, ST, SY, TJ, TM, TN, UA, US, VN, WS (26 Contracting Parties)
- 20 years – KR (1 Contracting Party)
- 50 years – MC (1 Contracting Party)

MANDATORY DECLARATION – Article 11(1)(a)

Deferment of publication for less than 30 months

If your law allows the deferment of publication of designs for less than 30 months from filing date or priority date (maximum period allowed by the Geneva Act), your country **shall**, in a declaration, notify the allowable period

18 Contracting Parties have made such declaration

- 12 months OA, BZ, **BX** (BE, NL, LU), BN, KH, HR, EE, WS, SI, SY (12 CPs)
- 6 months DK, FI, NO (3 CPs)
- 18 months SG (from filing date) (1 CP)
- 12 months GB (from filing date) (1 CP)
- 6 months IL (from filing date) (1 CP)

MANDATORY DECLARATION – Article 11(1)(b)

No deferment of publication

If your law does not provide for the deferment of publication of an industrial design, your country **shall**, in a declaration, notify the DG of WIPO of that fact

9 Contracting Parties have made such declaration

HU, IS, MX, MC, PL, RU, UA, US, VN (9 CPs)

OPTIONAL DECLARATIONS

Optional declarations regarding

- IA (international applications) direct filing at WIPO
- IA additional mandatory content (only available to certain CPs)
- applicant filing in the name of the creator
- unity of design
- specified views
- standard designation fees
- individual designation fees (only IGOs and CPs with an “Examining Office”)
- extended refusal period (12 months)
- effect of a change in ownership

OPTIONAL DECLARATION – Article 4(1)(b)

Direct filing of international applications at WIPO

Any Contracting Party **may**, in a declaration, notify the Director General of WIPO that international applications (IA) may not be filed through its Office.

If that declaration is made, any IA originating in the country shall be filed directly at the International Bureau of WIPO

18 Contracting Parties have made such declaration

OA, **BX** (BE, NL, LU), BZ, CA, HR, EM, FR, IL, LV, MC, ME, MK, SM, SI, UA, GB

OPTIONAL DECLARATIONS – Article 5(2)(b)

Declarations requiring additional mandatory contents of IAs

- Identity of the creator – RO (1 CP)
- Brief description – RO, SY, VN (3 CPs)
- Claim – US, VN (2 CPs)

These declarations **can only be made** by a Contracting Party

- whose **national law, at the time it becomes party** to the Geneva Act, requires that an application for the protection of an industrial design contain any such elements in order for that application to **be accorded a filing date (filing date requirement)**, and
- whose Office is an “**Examining Office**”

OPTIONAL DECLARATIONS – Article 1(xvii)

“Examining Office”

an Office which *ex officio examines* applications filed with it for the protection of industrial designs, at least to determine whether the industrial design satisfies the condition of *novelty*

WIPO’s Hague Guide for Users says that the Office must carry out, *ex officio*, a *prior art search* that matches up the condition of novelty required by the law (if *worldwide novelty*, the prior art search should consider not only pending and registered designs in IP databases, but also designs made public / known anywhere in the world)

CPs whose Offices are currently considered “Examining Offices”

CA, HU, IL, JP, KG, KR, MX, MD, RO, RU, SY, US, VN (13 Contracting Parties)

OPTIONAL DECLARATION – Rule 8(1)(a)(i)

Declaration requiring the applicant to file in the name of the creator

This declaration can be made only if the national law requires that a national application must be filed in the name of the creator

The countries that have made this declaration have agreed to have a note included in the IA form (DM/1) requiring the applicant to identify the creator and stating that where the applicant is a person other than the creator the IA has been assigned by the creator to the applicant

5 Contracting Parties have made such declaration: FI, GH, HU, IS, MX

OPTIONAL DECLARATION – Article 13(1)

Declaration regarding unity of design

This declaration can be made if your law requires that a single application contain

- only one design, or
- several designs provided that they
 - conform a unity of design, unity of production or unity of use, or
 - belong to the same set or composition of items

The Office of the CP having made this declaration can refuse the effects of the IR pending compliance with the specified requirement of unity of design. Following a notification of such refusal, [the IR may be divided before that Office](#).

10 CPs have made such declaration: EE, JP, KG, MX, RO, RU, SY, TJ, US, VN

OPTIONAL DECLARATION – Rule 9(3)

Declaration regarding specified views

This declaration can be made if your law requires certain **specified views** of the product / design (*e.g., perspective, exploded, cross-sectional*)

The declaration must specify the views that are required and the circumstances in which they are required. Not more than one view of a two-dimensional design or product or six views of a three-dimensional product can be required.

When such declaration has been made, the Office can refuse the effects of the IR pending compliance with the specified requirement of views

2 Contracting Parties have made such declaration: KR, VN

Declarations regarding standard designation fees

In respect of **each IR**, a **CP** will qualify to receive a **standard designation fee** at

- **Level 1** if the legislation does not require the IPO to carry out any examination on substantive grounds
- **Level 2** if the legislation requires the IPO to carry out **examination on substantive grounds other than novelty** (*e.g.*, as to the definition of “design”, public order or morality, non-functionality, protection of State emblems, etc.)
- **Level 3** if the legislation requires the IPO to carry out examination on substantive grounds, including **examination as to novelty** (either *ex officio* or following opposition by third parties)

OPTIONAL DECLARATION – Rule 12(1)

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Declarations regarding standard designation fees

For levels 2 or 3 to apply, the CP must make a **declaration** to that effect

- **Level 1** CHF 42 + 2* automatic (no need of declaration) (25 Offices)
- **Level 2** CHF 60 + 20* AM, BG, KH, HR, DK, EE, DE, LV, NO PL, CH, TN, UA (13)
- **Level 3** CHF 90 + 50* BN, KP, FI, GE, GH, IS, LT, KR, RO, RS, SY, TJ, VN (13)

The **standard designation fee** comprises a basic amount **for one design** + an additional amount **for each* additional design** in the same IA

Standard **renewal fees**: only one level CHF 21 + 1*

OPTIONAL DECLARATION – Article 7(2)

Declaration regarding an individual designation fee

IGOs (EU, OAPI) and any State whose Office is an “Examining Office” may opt to receive an **individual fee** instead of a standard fee for designations at the application and renewal stages

The level of the individual fee may not be higher than the equivalent of the amount for a national application/renewal, that amount being diminished by the savings resulting from the international procedure (formalities examination, publication)

12 Contracting Parties have declared for the application of **individual fees**

CA, JP, HU, IL, KG, KR, MX, MD, RU, US, **EM, OA** (12)

OPTIONAL DECLARATION – Rule 18(1)(b)

Declaration extending refusal period to 12 months

This declaration can only be made

- if your law provides for **third-party opposition** to registration (**opposition procedure**), or
- if your Office is an “**Examining Office**”

17 Contracting Parties have notified such declaration:

CA, KP, FI, IS, IL, JP, KG, LT, KR, MX, MD, RO, RU, ES, SY, TR, US (**17**)

OPTIONAL DECLARATION – Article 16(2)

Declaration regarding the effect of a change in ownership

You may declare that the recording of a change in ownership of an IR in the International Register shall have no effect in your country until your Office has received a statement or document specified in the declaration

6 Contracting Parties have made such declaration:

OA, DK, MX, KR, RU, US (6)

OTHER LEGAL MATTERS

Additional info to be conveyed to the International Bureau regarding

- Priority claim (under Paris Convention Art. 4)
- Identity of the creator
- Description of the characteristic features of the design

PRIORITY CLAIM – Paris Convention Article 4

If your law requires a certified copy of the priority document

You may require the IR holder to submit a certified copy of the earlier application (priority document) within a given period. You may also accept retrieving such document from the WIPO DAS service if available there.

In any case, you may [ask the International Bureau to inform users](#) about your national requirements in respect of priority documents

- [in the Hague Guide for Users](#) and
- [in a note to Item 13 in the international application form \(DM/1\)](#)

IDENTITY OF THE CREATOR

If your law requires the applicant to indicate the identity of the creator

even though your country may not qualify to make a declaration under the Geneva Act Article 5(2)(b)(i) or Common Regulations Rule 8(1)(a)(i),

you may, nevertheless, [ask the International Bureau to inform users](#) of this requirement

- [in the Hague Guide for Users](#) and
- [in a note to Item 11 in the international application form \(DM/1\)](#)

DESCRIPTION

If your law requires a description of the industrial design

even though your country may not qualify to make a declaration under the Geneva Act Article 5(2)(b)(ii),

you may, nevertheless, [ask the International Bureau to recommend users to provide such description](#)

- [in the Hague Guide for Users](#) and
- [in a note to Item 9 in the international application form \(DM/1\)](#)



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THANK YOU!
ANY QUESTIONS?



Funded by the European Union



This Project is funded by the European Union and implemented by the European Union Intellectual Property Office (EUIPO)