



ARISE+
ASEAN Intellectual Property Rights

Promoting Intellectual
Property Rights in the
ASEAN Region

THE HAGUE SYSTEM Geneva Act & Roles of the Office of a Contracting Party

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PRESENTATION OUTLINE

- The Geneva Act (1999 Act) of the Hague Agreement
 - Membership
 - How it works
- Role of the IPO as Office of the applicant's Contracting Party (ACP)
- Role of the IPO as Office of a designated Contracting Party (DCP)

THE GENEVA ACT (1999 ACT)

The Geneva Act (1999 Act) of the Hague Agreement is a treaty governing the Hague System for the International Registration of Industrial Designs

The Geneva Act offers

- a practical business solution for acquiring and managing industrial design rights in **64 Contracting Parties** (62 States and 2 IGOs) ...
- ... through **a single international application** that results in ...
- **a single international registration** with individual effects in each of the Contracting Parties designated therein

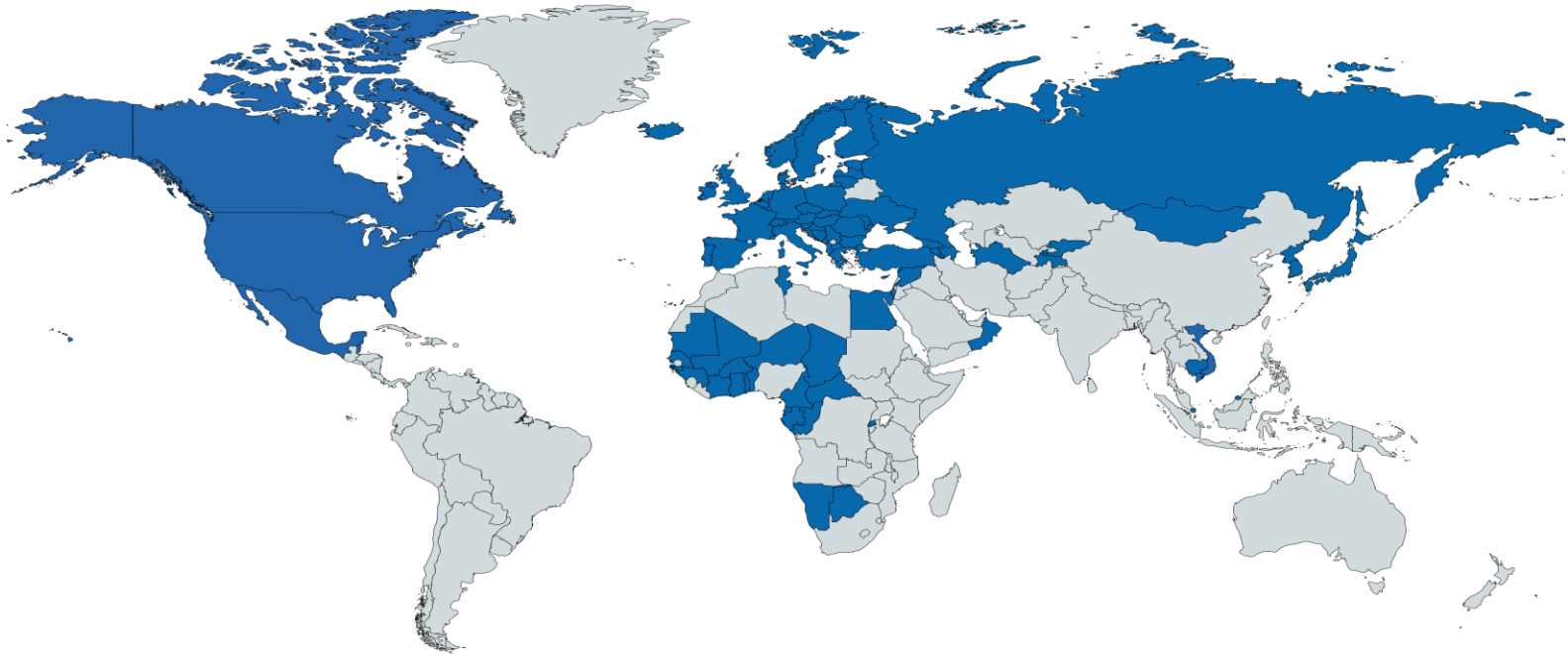
GENEVA ACT MEMBERS BY JUNE 2020

64 Contracting Parties

African IP Organization (OAPI), Albania, Armenia, Azerbaijan, Belgium, Belize, Bosnia and Herzegovina, Botswana, Brunei Darussalam, Bulgaria, Cambodia, Canada, Croatia, DPRK, Denmark, Egypt, Estonia, European Union, Finland, France, Georgia, Germany, Ghana, Hungary, Iceland, Israel, Japan, Kyrgyzstan, Latvia, Liechtenstein, Lithuania, Luxembourg, Mexico, Monaco, Mongolia, Montenegro, Namibia, Netherlands, North Macedonia, Norway, Oman, Poland, Republic of Korea, Republic of Moldova, Romania, Russian Federation, Rwanda, Samoa, San Marino, Sao Tome and Principe, Serbia, Singapore, Slovenia, Spain, Switzerland, Syrian Arab Republic, Tajikistan, Tunisia, Turkey, Turkmenistan, Ukraine, United Kingdom, United States of America, Viet Nam

GENEVA ACT COVERAGE

64 Members = 89 countries (by June 2020)



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WHO IS ENTITLED TO USE THE HAGUE SYSTEM ?

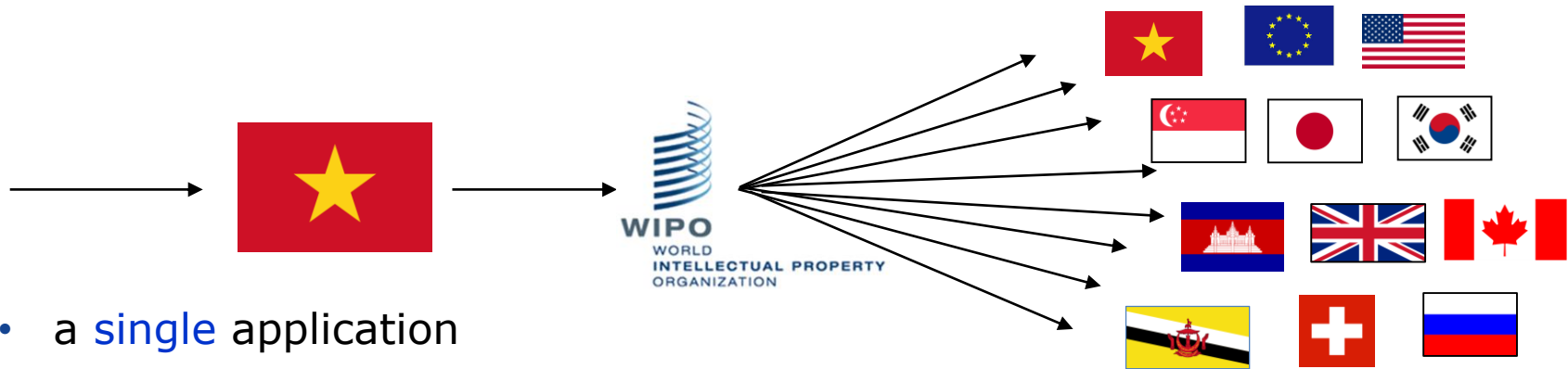
The Hague System can be used by anyone who has
an **attachment to a Contracting Party**

- industrial or commercial establishment, or
- nationality, or
- domicile, or
- habitual residence

Unlike Madrid

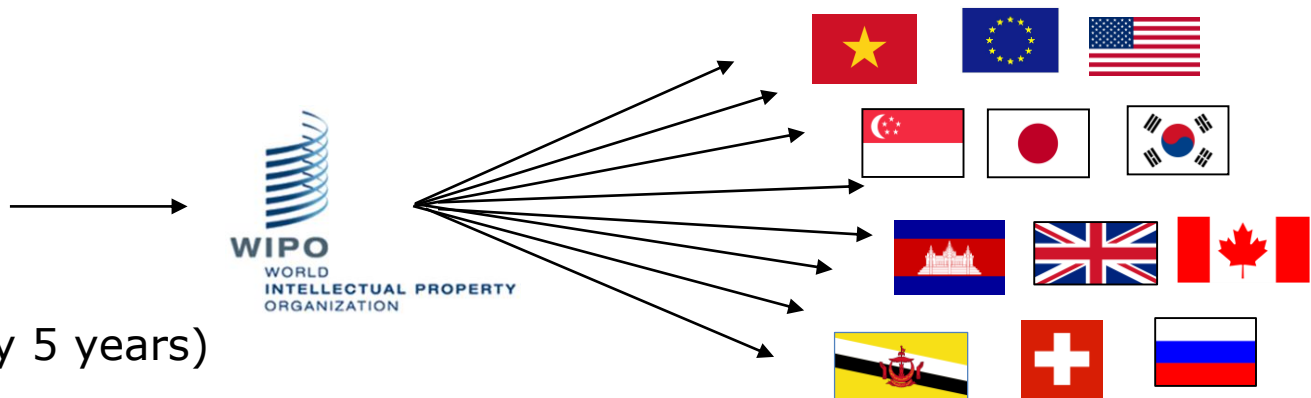
- the applicant does not need to have a “basic design” in that Contracting Party
- moreover, the applicant may designate its own Contracting Party for protection

TRADITIONAL FILING VS HAGUE CENTRAL FILING



- a **single** application
- a **single** language (English)
- fees paid in a **single** currency (CHF)
- local representative **only required in limited cases**
- a **single** international procedure and **strict deadlines** for the rest

HAGUE CENTRAL MANAGEMENT



- renewal (every 5 years)
- modifications
 - changes in name or address (holder/representative)
 - assignments (change in ownership)

HAGUE SYSTEM

The Role of the IPO as Office of the Applicant's Contracting Party

OFFICE OF THE APPLICANT'S CONTRACTING PARTY

- Advice to national applicants
- Role as transmittal Office (optional)

ADVICE TO NATIONAL APPLICANTS REGARDING ...

- advantages of the Hague system to obtain design protection in various countries
- how to prepare and file an international application (IA)
- how to deal with irregularities, publication and refusals of protection
- how to manage the international registration (IR)
change in ownership, change in name or address of the holder or representative, renunciation, limitation

PREPARING THE INTERNATIONAL APPLICATION (IA) – DM/1 CONTENT

Mandatory content: name and address of the applicant; entitlement to file; choice of the applicant's Contracting Party; **number of industrial design(s) (up to 100);** reproduction(s) or specimen(s) of the design(s); designated Contracting Parties (DCPs); **designs (products) in only one international class;** signature of the applicant

Additional mandatory content (required by some CPs if designated):
identity of the creator; brief description; claim

Optional content: address for correspondence; appointment of a representative; product(s) class; description (of designs or reproductions); disclaimer; legends (of the reproductions); identity of the creator; priority claim; claim of international exhibition; request for immediate or deferred publication (up to 30 months)

REPRODUCTIONS

Reproductions

- photographs; other graphic representations
- in black and white or in color

Disclaimers

- may be indicated by means of dotted or broken lines or coloring and/or explained in the description

Number

- no limit; important to submit several views
- each view must be represented separately

Dimensions

- max. 16 x 16 cm; one at least 3cm
- 300 x 300 dpi resolution

Numbering/legends

- *e.g.*: 1.1 perspective, 1.2 front, 1.3 back, 1.4 top, etc.

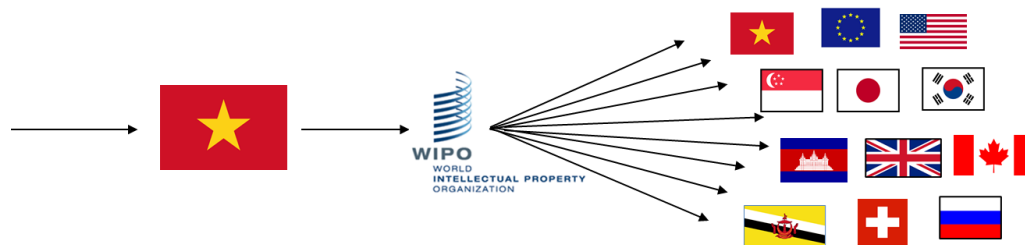
More details

- see Guide at <https://www.wipo.int/hague/en/guide/reproduction.html>

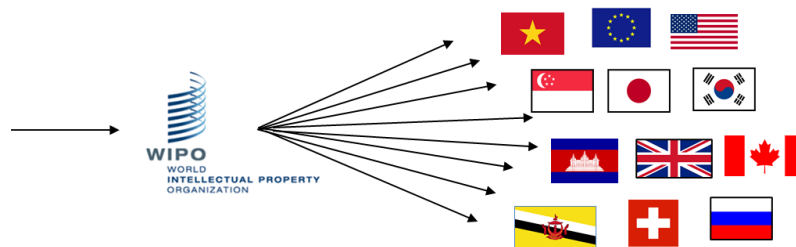
WHERE TO FILE THE INTERNATIONAL APPLICATION ?

Two possibilities

- via the IPO of the ACP
(if accepted by the ACP)



- direct filing at WIPO



INDIRECT FILING - THROUGH THE IPO OF THE ACP

Only possible if ACP accepts the filing of international applications (IA)

- Language** - IPO may choose (English and/or French and/or Spanish)
- Modality** - by hand or by mail ([DM/1 Form](#)) or electronic filing
- Fees**
 - IPO may charge a transmittal fee (if so, notify amount to IB)
 - IPO may accept collecting other fees and transmitting to IB
- Transmittal**
 - IPO sends the IA to the IB (preferably within one month)
 - IPO must indicate the date of receipt at IPO
- Filing date**
 - date of receipt at IPO if received by IB within one month
 - otherwise, date of receipt at IB

DIRECT FILING AT WIPO

Language English, French or Spanish

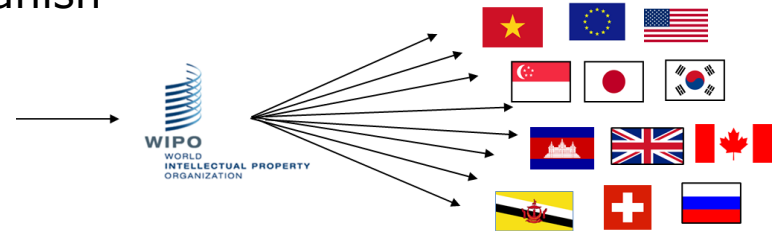
Filing modalities

- DM/1 paper form - by mail
- E-filing - at the E-filing interface on WIPO's website

<https://www3.wipo.int/HagueEFilingWeb/protected/portfolioManager.xhtml>

to use the E-filing interface the applicant must have a WIPO User Account

<https://www3.wipo.int/wipoaccounts/en/usercenter/public/register.jsf>



THE HAGUE SYSTEM

The Role of the IPO as Office of a
Designated Contracting Party (DCP)

EFFECTS OF THE INTERNATIONAL REGISTRATION

International Designs Bulletin

- published every Friday on the WIPO website
- IPO may ask to receive an email reminder
- IPO can download the information from <ftp://ftpird.wipo.int/wipo/hague/>

Effects of the IR in the designated Contracting Party (DCP)

- the same as a regularly filed **application** as from the date of the IR
- the same as a regularly **registered industrial design** in the DCP, if protection is granted or not refused within the prescribed period (6 or 12 months from publication in the *International Designs Bulletin*) or refusal is withdrawn thereafter

REFUSAL OF PROTECTION – PROCEDURE

1/2

Time limit – six months from publication (12 months for some DCPs)

Grounds

- **substantive grounds** that would apply under the law of the DCP to industrial designs filed directly with IPO
- **opposition** by a third party, if envisaged in the DCP's law

Non valid grounds – formal requirements already examined by IB

Notification – Model Form – contents

IR number, refusal for all or some designs, refusal grounds, info on earlier industrial design (if applicable), law provisions, time limit and authority for review or appeal, requirement of representative, date, signature

REFUSAL OF PROTECTION – PROCEDURE

2/2

Language – English, French or Spanish

Irregular notification – two types of irregularity

- that can be remedied – *e.g.*, notification lacks signature or date
- that cannot be remedied – the refusal is not regarded as such by IB
 - if it lacks an IR number
 - if it does not indicate and ground for refusal
 - if it was sent to the IB after the six-month period had expired

IB nevertheless transmits a copy to the holder

PROCEDURE FOLLOWING A REFUSAL

Review or appeal

- the holder has the same rights and remedies as if the design had been filed directly with IPO
- IPO may require that a local representative be appointed

Withdrawal of refusal notification – Model Form

- may relate to all or some designs
- shall indicate the date on which the IR became protected
- if the IR was amended before IPO, shall contain all amended elements (may be in a language other than E, F, S)
- may also take the form of a statement of grant of protection following a refusal

STATEMENT OF GRANT OF PROTECTION

Following a refusal – Model Form

- date on which the designs in the IR became protected
- if not all, IPO should indicate which designs are protected or not
- if the IR was amended by IPO, amendments should be indicated

In the absence of a prior refusal – Model Form

- date on which the designs in the IR became or will become protected
- if not all, indicate which designs are protected
- if the IR was amended by IPO, indicate amendments

IB records the statement (or withdrawal of refusal) in the International Register, publishes the record and makes a PDF copy available in the *Bulletin*

TERM OF PROTECTION

Minimum 5 years + two renewal periods of 5 years each = up to 15 years

The maximum term of protection may be longer (depends on the DCP law)

- 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)
- 20 years – KR (1)
- 25 years – AM, BA, BE, BG, CH, DE, DK, EE, EM, ES, FI, FR, GB, GE, HR, HU, IS, IL, JP, LV, LI, LT, LU, ME, MK, NL, NO, PL, MX, MD, RO, RU, RS, SI, SM, TR (36)
- 50 years – MC (1)

THE ROLE OF THE IPO DURING THE LIFE OF THE INTERNATIONAL REGISTRATION

- Renewal, limitation, renunciation - no action required
- Change of name or address - no action required
- Change in ownership
- Corrections to the IR
- Invalidation

CHANGE IN OWNERSHIP

Who can request the change ?

- the current holder
- the transferee, provided that the request is also
 - signed by the current holder, or
 - accompanied by an attestation from a competent authority of the holder's CP

Recording / validity / effects

- IB takes care of **recording** the change **in the International Register** - to make it public against third parties
- **Validity** of the change **in DCP** is governed exclusively by the DCP's law (*e.g.*, need of a document to certify assignment, proof of age of the parties, etc.)
- Unless refused, the recording has the same **effects** as if the change in ownership had been made directly at IPO

CORRECTIONS

If there is an error concerning the IR

IB, *ex officio* or at the request of the holder, will modify the International Register and inform the holder accordingly

Effect of the IR correction in the DCP

- immediate effect in the DCP, unless IPO refuses to recognize such effect
- IPO may declare that it refuses to recognize the effect of such correction on the basis of the same grounds that would apply to a new designation of the DCP
- the procedure would be the same as explained under refusal of protection

INVALIDATION

1/2

Invalidation of the IR in the DCP

any decision by a competent authority (administrative or judicial) revoking or cancelling the effect of an IR in the DCP with regard to all or some of the designs covered by the designation of the DCP

Proceedings

- directly between the holder, whoever brought the invalidation action and the competent authority (Office or tribunal)
- governed entirely by the law and practice of the DCP
- may not be pronounced without the holder having been afforded the opportunity to defend his rights in good time

INVALIDATION

2/2

IPO's notification to IB

When the invalidation is **no longer subject to any appeal**,
IPO must notify the IB

- name of the authority (Office or tribunal) that pronounced the invalidation
- IR number
- which designs are concerned
- effective date of the invalidation

- IB** - records the invalidation in the International Register
- publishes the invalidation in the IDB



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THANK YOU!
ANY QUESTIONS?



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