



TIPS FOR FILING INTERNATIONAL DESIGN APPLICATIONS

SOPHIA BONNE | KINGSTON | 4 MARCH 2020



CARIFORUM



EU-CARIFORUM Regional project, funded by the European Union and implemented by the European Union Intellectual Property Office (EUIPO)

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OVERVIEW

- History of the Hague Agreement
- EU Accession
- Comparison with the RCD
- WIPO examination procedure
- EUIPO examination procedure
- Statistics

HISTORY OF THE HAGUE AGREEMENT

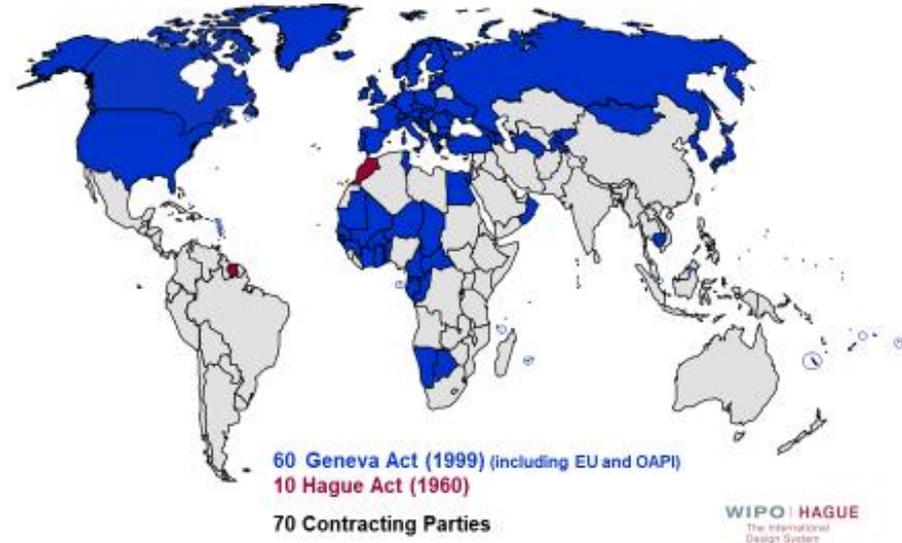
Adopted in 1925 and entered into force in 1928.

The Hague Agreement comprises two different 'acts',
the Hague Act 1960 and the Geneva Act 1999.

Both consist of a different set of legal provisions.

International intergovernmental organisations
may only become party to the Geneva Act.
Currently 73 members.
E.U. accession: 01/01/2008

Hague Union



The instrument of accession was accompanied by the following declarations:

- a declaration as referred to in Article 4(1)(b) of the 1999 Act, to the effect that international applications may not be filed through the Office of the European Community;
- a declaration as required under Article 17(3)(c) of the 1999 Act, specifying that the maximum duration of protection provided for by the legislation of the European Community in respect of industrial designs is 25 years;

- a declaration as referred to in Article 7(2) of the 1999 Act, that, in connection with each international application in which it is designated, and in connection with the renewal of any international registration resulting from such an international application, the prescribed designation fee shall be replaced by an individual designation fee. The amount of the individual designation fee will be the subject of a further information notice. As per *Information Notice No. 9/2011* EUIPO charges:
 - application fee 67 CHF/design
 - renewal fee 34 CHF/design

An international registration of a design designating the EU shall, from the date of its registration, have the same effect as a Registered Community Design (Art. 106 CDR (EC) No 6/2002).

EU ACCESSION –What it implies

1. Applicants are entitled to register a design in countries that are party to the Hague Agreement : **single application** to the WIPO
2. Accession to the Agreement allows EU companies to obtain design protection throughout the EU, with the Community Design, and also in countries which are party to the Geneva Act.
3. The EU may be designated in an international registration

COMPARISON WITH THE RCD

WIPO	EUIPO
<p>Users: Be a national of a Contracting Party or a member State of an intergovernmental organization which is a Contracting party, such as the European Union or the African Intellectual Property Organization</p> <p>Have a domicile or habitual residence (<i>only for members of Geneva Act</i>) in the territory of a Contracting Party</p> <p>Have a real and effective industrial or commercial establishment in the territory of a Contracting Party</p>	<p>Users: No restrictions as to nationality, domicile or place of business</p>
<p>Direct filings to WIPO (e-filings 93.5 %) Filing also to receiving National Offices of Contracting Parties</p>	<p>Direct filings to EUIPO (e-filings 97%) Filing also to National Offices of EU Member States</p>
<p>Languages of filing EN, FR or ES</p>	<p>Any of the 23 official EU languages</p>
<p>Fees in CHF</p> <ul style="list-style-type: none">• <i>basic fee</i>• <i>publication fee</i>• <i>individual fee for each designated Contracting Party</i>	<p>Fees in €</p> <ul style="list-style-type: none">• <i>registration fee</i>• <i>publication fee</i>• <i>deferment fee (if deferred publication is requested)</i>

WIPO EXAMINATION PROCEDURE

The Hague system is a Procedural Arrangement.

Issues such as:



the conditions for protection



the refusal procedure to be applied when deciding whether a design may be protected



the rights which result from protection

are governed by the law of each Contracting Party designated in an international registration

WIPO EXAMINATION PROCEDURE

WIPO examines formal requirements such as quality of the representations of the design and the payment of the required fees.

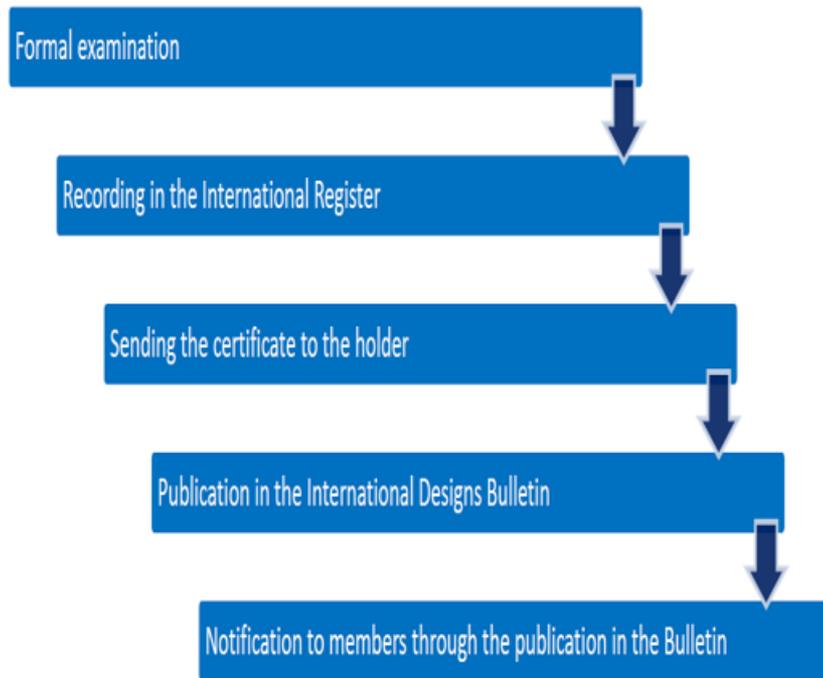
The applicant is informed of any deficiencies and is given a time limit of 3 months to correct them. If he fails the application is considered abandoned.

Where the application complies with the formal requirements the design is recorded to the International Register and published in the Bulletin (unless deferment of publication has been requested).

Substantive examination falls within the exclusive competence of the Office of each designated Contracting Party (6 to 12 months for refusal).

Scope of protection, duration and renewal according to the domestic legislation of Contracting Parties.

Invalidity only at the Contracting Party level.



The Hague System



EUIPO carries out weekly an examination on the grounds for non-registrability (Art. 11 CDIR) :

- **no compliance with definition of design**
- **against public policy and morality**

and communicates to WIPO the outcome of the examination no later than 6 months.

Where EUIPO finds a **ground for refusal**, it communicates a notification of refusal to WIPO which forwards the notification of refusal to the holder of the international registration, who may respond to it by submitting observations directly to EUIPO. EUIPO notifies the final decision to WIPO.

Communications between the EUIPO and the International Bureau are made by electronic means.

EUIPO EXAMINATION

Where no ground for refusal is found EUIPO sends a Statement of Acceptance.

There is no need to appoint a representative unless a ground for refusal is raised or in case of invalidity action.

EUIPO does not republish the international designs with EU designation in the Registered Community Designs Bulletin.

Invalidation of Community designs (via the Hague system) pursuant to Articles 24, 25, 26 CDR.

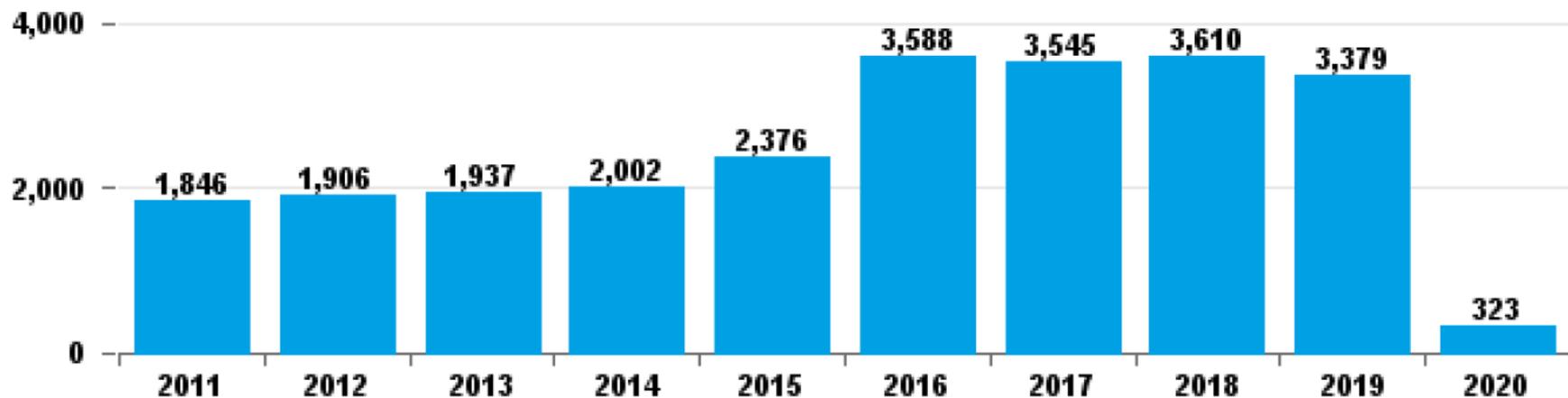
<https://euipo.europa.eu/ohimportal/en/community-design-legal-texts>

Definition of design - Art 3(a) (b)CDR	Public Policy /Morality - Art 9 CDR
<p>Design: the appearance of the whole or a part of a product resulting from the features of the product itself and/or its ornamentation.</p> <p>Product: any industrial or handicraft item, including inter alia: Parts assembled into a complex product, packaging, get-up, graphic symbols, typographic typefaces, but excluding computer programs.</p>	<p>Given the unitary character of the registered Community design (Article 1(3) CDR), it is enough that a design be found contrary to public policy in at least part of the European Union for the design to be refused.</p>
<p>Do not comply with the definition of “design” Natural products, living organisms in their natural state; Colours per se ; Mere verbal elements and sequences of letters (not figurative); Music and sounds; A subject matter of an application related to a concept, an invention or a method for obtaining a product.</p>	<p>Against public policy Designs that portray or promote violence or discrimination based on sex, racial or ethnic origin, religion or belief, disability, age or sexual orientation will be refused on that account (<i>Article 10 of the Treaty on the Functioning of the European Union</i>).</p> <p>Against morality Designs that are perceived as sufficiently obscene or offensive from the perspective of a reasonable person of normal sensitivity and tolerance.</p>

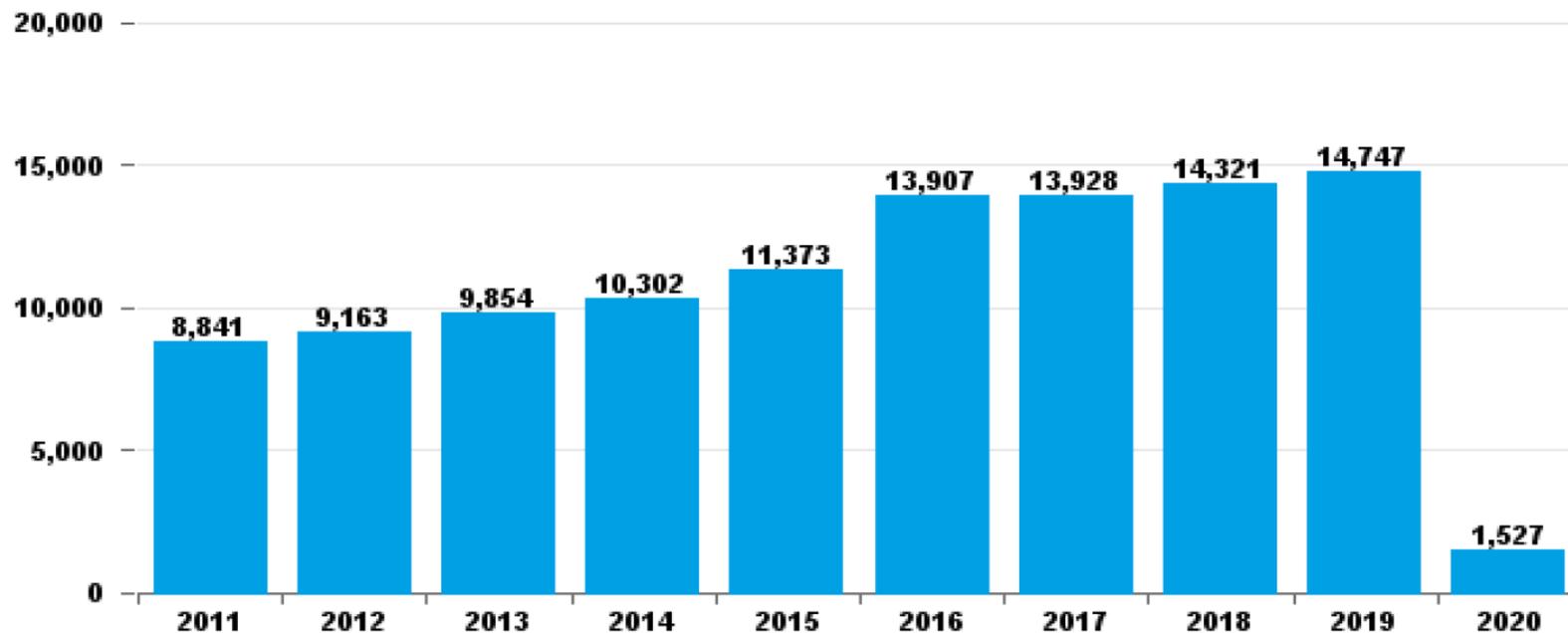
EUIPO PROCEDURE - Experience

- No grounds for refusal found (yet)
- Examination of newly published IRD carried out within 1 week after publication
- Statement of Acceptance is sent immediately after examination
- Only few IR's are challenged in invalidity proceedings before the EUIPO

Total Number of International Design Applications Received in EUIPO



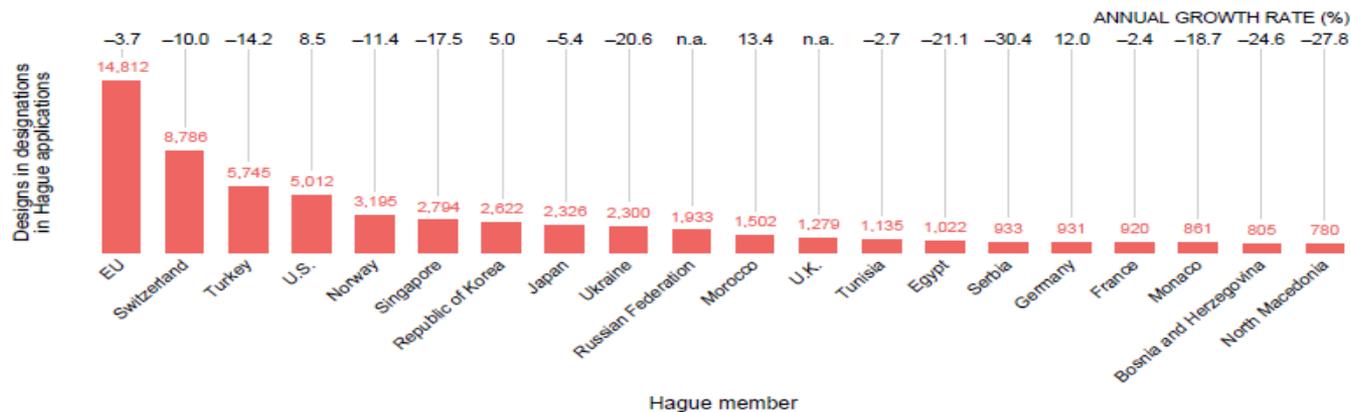
of International Designs Received in EUIPO



MOST DESIGNATED COUNTRIES

The EU and Switzerland continue to attract the most designs in designations.

A22. Designs contained in designations in international applications for the top 20 designated Hague members, 2018



n.a. indicates not applicable.

Source: WIPO Statistics Database, May 2019.

MOST COMMON CLASSES

Furnishing accounted for the largest share of total designs (10.5%), followed by communication equipment (10,3%), means of transport (7.6%), lighting apparatus (6,9%) and clocks & watches (6.9%).



Class 6
Furnishing



Class 14
Recording, communication
or information retrieval
equipment



Class 12
Means of transport or
hoisting

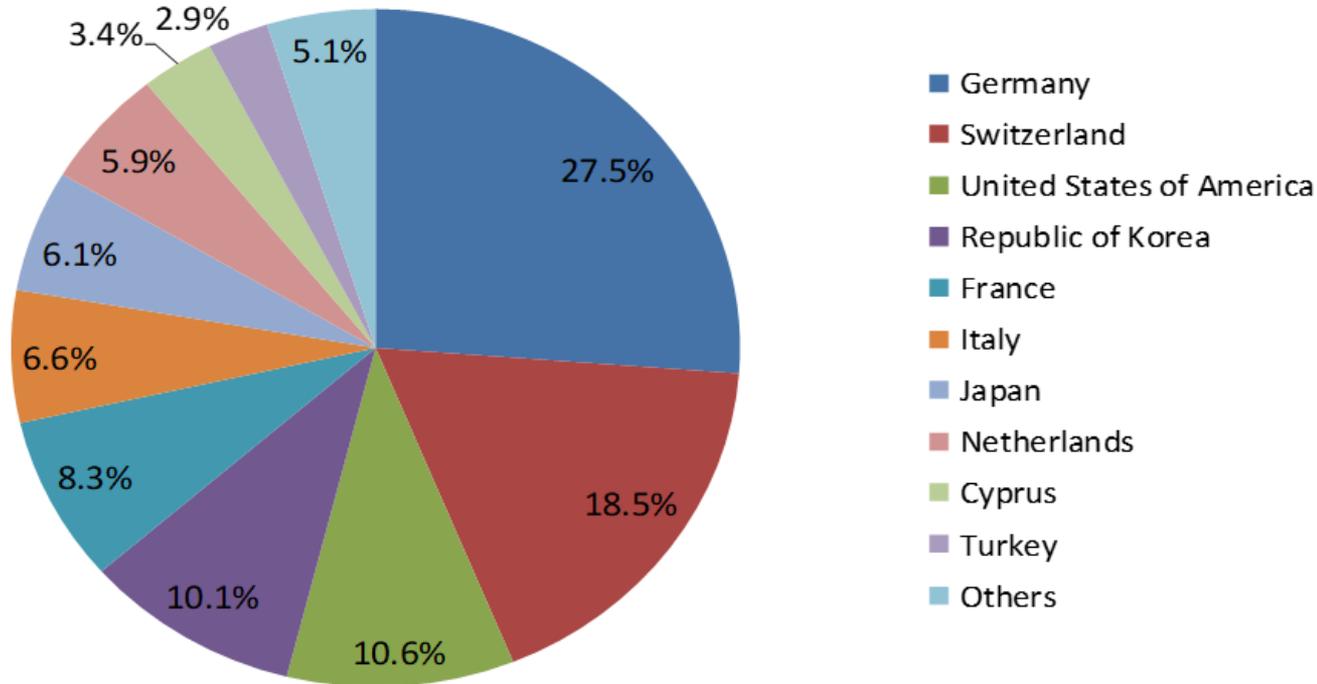


Class 10
Clocks and watches and
other measuring
instruments, checking and
signaling instruments



Class 7
Household goods, not
elsewhere specified

LARGEST USERS BY COUNTRY OF ADDRESS OF HOLDER





THANK YOU
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MERCÍ
BEDANKT



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