



Promoting Intellectual
Property Rights in the
ASEAN Region

Role of IPO as the Office of a Contracting Party

JORGE CARBONELL | NOVEMBER 10TH 2021



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



OUTLINE

Spanish Patent and Trademark Office (SPTO) and The Hague System

IP Office roles as Office of the Applicant's Contracting Party (ACP)

IP Office roles as Office of a Designated Contracting Party (DCP)

The procedure: practical example

Spanish Patent and Trademark Office (SPTO) and The Hague System

Spain was one of the first contracting countries of the original The Hague Arrangement in 1925

National regulations on Industrial Designs apply (Law 20/2003)

Spain

Main IP Laws: enacted by the Legislature

Date of Text	Title
July 7, 2003	Law No. 20/2003 of July 7, 2003, on Legal Protection of Industrial Designs (as amended up to Law No. 6/2018 of July 3, 2018)

Implementing Rules/Regulations

Date of Text	Title
September 27, 2004	Regulation for the Implementation of Law No. 20/2003 of July 7, 2003, on Legal Protection of Industrial Designs (approved by Royal Decree No. 1937/2004 of September 27, 2004, and amended up to Royal Decree No. 316/2017 of March 31, 2017)
October 15, 1999	Royal Decree No. 1595/1999 of October 15, 1999 setting Time Limits for the Payment of Industrial Property Fees

IV. ARRANGEMENT DE LA HAYE

DU 6 NOVEMBRE 1925

CONCERNANT

LE DÉPÔT INTERNATIONAL DES DESSINS OU MODÈLES INDUSTRIELS

Les soussignés Plénipotentiaires des Gouvernements ci-dessus énumérés,
Vu l'article 15 de la Convention d'Union internationale du 20 mars 1883 pour la protection de la propriété industrielle, révisée à Bruxelles le 14 décembre 1900 et à Washington le 2 juin 1911,
Ont, d'un commun accord et sous réserve de ratification, arrêté l'Arrangement suivant:

ARTICLE PREMIER

Les ressortissants de chacun des pays contractants ainsi que les personnes ayant satisfait sur le territoire de l'Union restreinte aux conditions établies par l'article 3 de la Convention générale, pourront s'assurer dans tous les autres pays contractants la protection de leurs dessins ou modèles industriels, au moyen d'un dépôt international effectué au Bureau international de la propriété industrielle à Berne.

ARTICLE 2

Le dépôt international comprendra les dessins ou modèles soit sous la forme du produit industriel auquel ils sont destinés, soit sous celle d'un dessin, d'une photographie ou de toute autre représentation graphique suffisante dudit dessin ou modèle.

Les objets seront accompagnés d'une demande de dépôt international en double exemplaire contenant en langue française les indications qui préciseront le Règlement d'exécution.

ARTICLE 3

Aussitôt que le Bureau international de Berne aura reçu la demande de procéder à un dépôt international, il inscrira cette demande dans un registre spécial, notifiera cette inscription à l'Administration qui lui aura été indiquée par chaque pays contractant et la publiera dans une feuille périodique dont il distribuera gratuitement à chaque Administration le nombre d'exemplaires voulu.

Les dépôts seront conservés dans les archives du Bureau international.

ARTICLE 4

Celui qui effectue le dépôt international d'un dessin ou modèle industriel est considéré jusqu'à preuve du contraire comme propriétaire de l'œuvre.

Spanish Patent and Trademark Office (SPTO) and The Hague System

Currently, Spain adheres to the Geneva Act (1999) of the Agreement (not to the 1960 Act)

WIPO-Administered Treaties

Contracting Parties > Hague Agreement > Spain

Dates	
Signature:	November 6, 1925
Ratification:	May 1, 1928
Entry into force:	June 1, 1928

Act(s)	Article(s)	Signature	Instrument	Entry into Force
Geneva Act (1999)		July 6, 1999	Ratification: September 23, 2003	December 23, 2003
Complementary Act of Stockholm (1967)		July 14, 1967		
Additional Act of Monaco (1961)		March 30, 1962	Ratification: July 9, 1969	August 31, 1969
London Act (1934)		June 2, 1934	Accession: December 20, 1955	March 2, 1956

Source: <https://wipolex.wipo.int/es/treaties/parties/remarks/ES/9>

Spanish Patent and Trademark Office (SPTO) and The Hague System

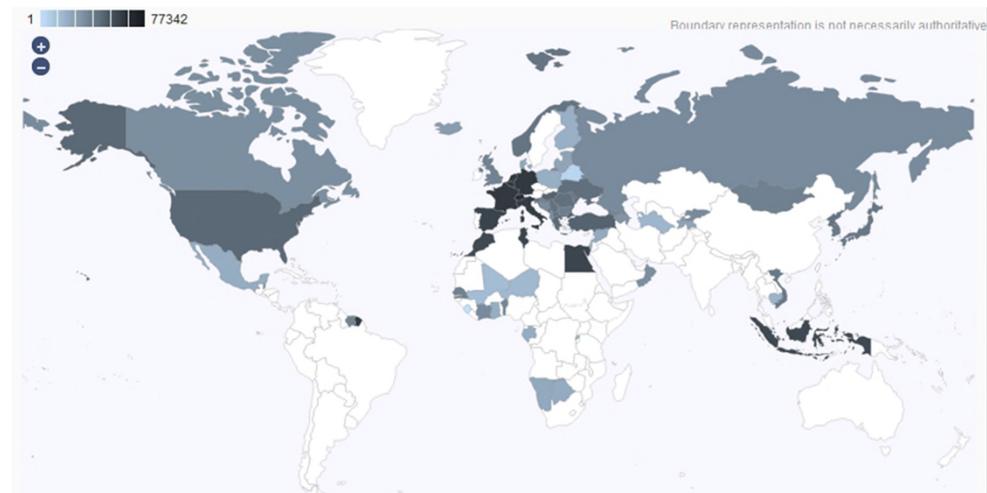
Historically, Spain (ES) ranks #9 for total registered designs as designated country

WIPO IP PORTAL		MENU		Hague Express							
FILTER BY											
	Designation	Locarno class	Reg. Year *	Contracting party *	Expiration *	Holder *					
CH	77,342	BE	57,683	LU	57,680	NL	57,676	BX	57,674	FR	56,520
DE	56,156	IT	51,838	ES	42,358	EG	40,329	TN	40,309	ID	36,239
MA	35,643	EM	35,081	VA	34,056	AN	32,944	MC	23,817	LI	23,077
TR	15,783	HU	15,703	US	13,124	GR	12,085	SG	10,104	UA	10,056
RO	9,765	SI	9,733	ME	9,301	RS	9,120	MK	9,054	NO	8,318
KP	8,219	MD	7,906	BQ	7,897	CW	7,897	SX	7,896	JP	7,395
DD	7,357	VN	6,762	KR	6,556	BG	5,633	HR	5,146	MN	5,102
YU	4,888	SN	4,782	SR	4,677	GB	4,622	GE	4,034	BJ	4,009

Display: List Sort: Count - desc

Designed = ES	
Expired	37885
Valid	4473
Total	42358

Source: WIPO – Hague Express



Spanish Patent and Trademark Office (SPTO) and The Hague System

SPTO is receiving or designated office for:

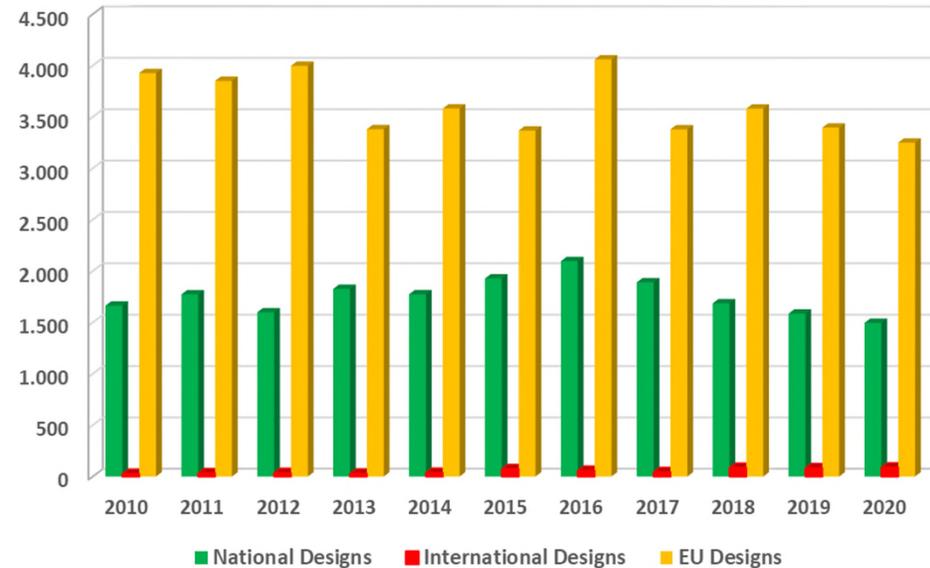
National (ES) designs

EU designs (EUIPO)

IR designs (WIPO)

Year	ACP = ES	HOLDER	ACP = ES
2010	25	SANTA & COLE NEOSERIES S.L.	25
2011	32	SEAT, S.A	24
2012	35	VIBIA LIGHTING, S.L.U	23
2013	27	SEAT, S.A.	23
2014	36	ROTHENBERGER, S.A.	17
2015	73	ANDREU WORLD, S.A.	11
2016	56	SEAT S.A.	10
2017	44	SIMON, S.A.U.	10
2018	85	IMAGINARIUM, S.A.	10
2019	81	BELEN MAYORAL DEL BARRIO	9
2020	87		

Industrial Designs



Sources: WIPO – Hague Express; OEPMStat



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The procedure: practical example

IP Office roles as Office of the Applicant's Contracting Party

- Advice to national applicants

Advantages of the Hague system to obtain design protection in various countries

How to prepare and file an international application (IA)

How to manage the international registration (IR)

- Role as transmittal Office (Art. 4.1)

Language - IPO may choose (English, French or Spanish)

Modality - paper form (DM/1 Form) or electronic filing

Fees - IPO may charge a transmittal fee and collect rest of 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 - can maintain date of receipt at IPO (if received by IB within one month)



IP Office roles as Office of the Applicant's Contracting Party

Notes:

In practice, all applications are directly filed with WIPO (by the applicant or representative), most of them using electronic filing

- simplified procedure
- no transmittal fee

Possible provisions in national regulations may imply using indirect filing (through national IPO), possible assistance of IPO within indirect filing (language, forms...)

Usually, applicants of International Designs are international companies

There is no need to have a national application or registration as the base for an international application (≠ Madrid System – Trademarks)



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IP Office roles as Office of a Designated Contracting Party

Main points:

- National and regional offices check designations of International Registrations
- Formal requirements and examination are performed by International Bureau (IB - WIPO)
- Designated office can refuse protection based on substantive grounds defined in national regulations
- Same effects of the IR in the Designated Contracting Party as a regularly filed application as from the date of the IR

<input type="checkbox"/> AL Albania	<input checked="" type="checkbox"/> ES Spain	<input type="checkbox"/> LT Lithuania	<input type="checkbox"/> RW Rwanda
<input type="checkbox"/> AM Armenia	<input type="checkbox"/> FI Finland	<input type="checkbox"/> LV Latvia	<input type="checkbox"/> SG Singapore
<input type="checkbox"/> AZ Azerbaijan	<input type="checkbox"/> FR France	<input type="checkbox"/> MC Monaco	<input type="checkbox"/> SI Slovenia
<input type="checkbox"/> BA Bosnia and Herzegovina	<input type="checkbox"/> GB United Kingdom	<input type="checkbox"/> MD Republic of Moldova	<input type="checkbox"/> SM San Marino
<input type="checkbox"/> BG Bulgaria	<input type="checkbox"/> GE Georgia	<input type="checkbox"/> ME Montenegro	<input type="checkbox"/> SR Suriname
<input type="checkbox"/> BN Brunei Darussalam	<input type="checkbox"/> GH Ghana	<input type="checkbox"/> MK The Republic of North Macedonia	<input type="checkbox"/> ST Sao Tome and Principe
<input type="checkbox"/> BW Botswana	<input type="checkbox"/> HR Croatia	<input type="checkbox"/> MN Mongolia	<input type="checkbox"/> SY Syrian Arab Republic
<input type="checkbox"/> BX Benelux	<input type="checkbox"/> HU Hungary	<input type="checkbox"/> MX Mexico	<input type="checkbox"/> TJ Tajikistan
<input type="checkbox"/> BZ Belize	<input type="checkbox"/> IL Israel	<input type="checkbox"/> NA Namibia	<input type="checkbox"/> TM Turkmenistan
<input type="checkbox"/> CA Canada	<input type="checkbox"/> IS Iceland	<input type="checkbox"/> NO Norway	<input type="checkbox"/> TN Tunisia
<input type="checkbox"/> CH Switzerland	<input type="checkbox"/> JP Japan	<input type="checkbox"/> OA African Intellectual Property Organization (OAPI)	<input type="checkbox"/> TR Turkey
<input type="checkbox"/> DE Germany	<input type="checkbox"/> KG Kyrgyzstan	<input type="checkbox"/> OM Oman	<input type="checkbox"/> UA Ukraine
<input type="checkbox"/> DK Denmark	<input type="checkbox"/> KH Cambodia	<input type="checkbox"/> PL Poland	<input type="checkbox"/> US United States of America
<input type="checkbox"/> EE Estonia	<input type="checkbox"/> KP Democratic People's Republic of Korea	<input type="checkbox"/> RO Romania	<input type="checkbox"/> VN Viet Nam
<input type="checkbox"/> EG Egypt	<input type="checkbox"/> KR Republic of Korea	<input type="checkbox"/> RS Serbia	<input type="checkbox"/> WS Samoa
<input type="checkbox"/> EM European Union	<input type="checkbox"/> LI Liechtenstein	<input type="checkbox"/> RU Russian Federation	

Select All Clear All Continue

IP Office roles as Office of a Designated Contracting Party

IB - WIPO:

All formalities, including classification, publication and certificate

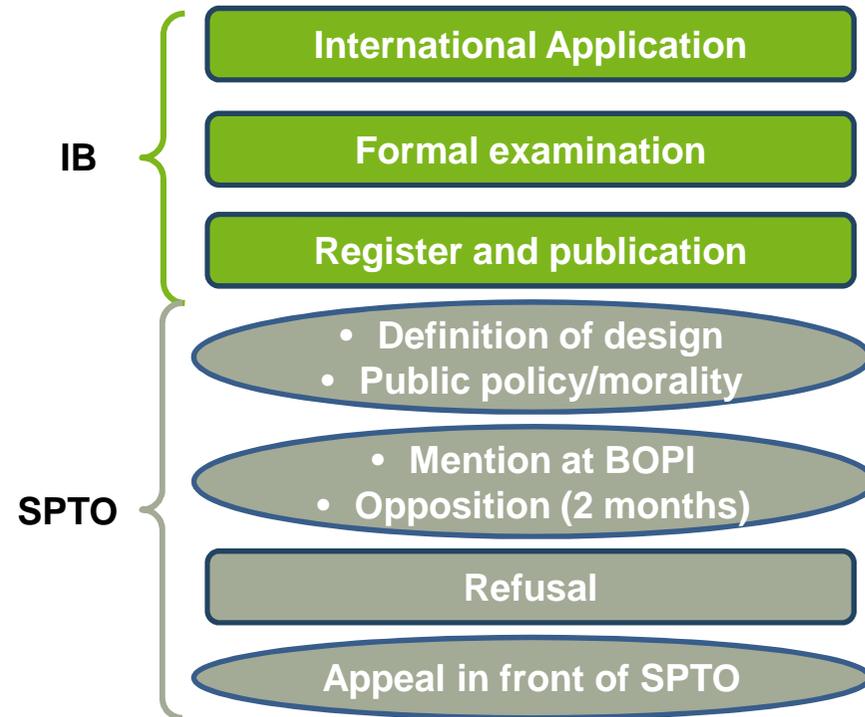
SPTO:

Examination of grounds of refusal

A reference to IR publication made in national bulletin

Opposition by third party, as in national law

Renewal, refusal and effects also according to national law





OUTLINE

Spanish Patent and Trademark Office (SPTO) and The Hague System

IP Office roles as Office of the Applicant's Contracting Party

IP Office roles as Office of a designated Contracting Party

The procedure: practical example

International Registration DM/211697

IB

Date of International Registration: 13/10/2020

International Publication: 16/04/2021 – 15/2021 (WIPO International Bulletin)

Weekly and electronically programmed communication between WIPO and SPTO to indicate IRs designating Spain (ES)

SPTO

After examination, reference (mention) published in BOPI (National Bulletin): 04/05/2021

No oppositions are filed

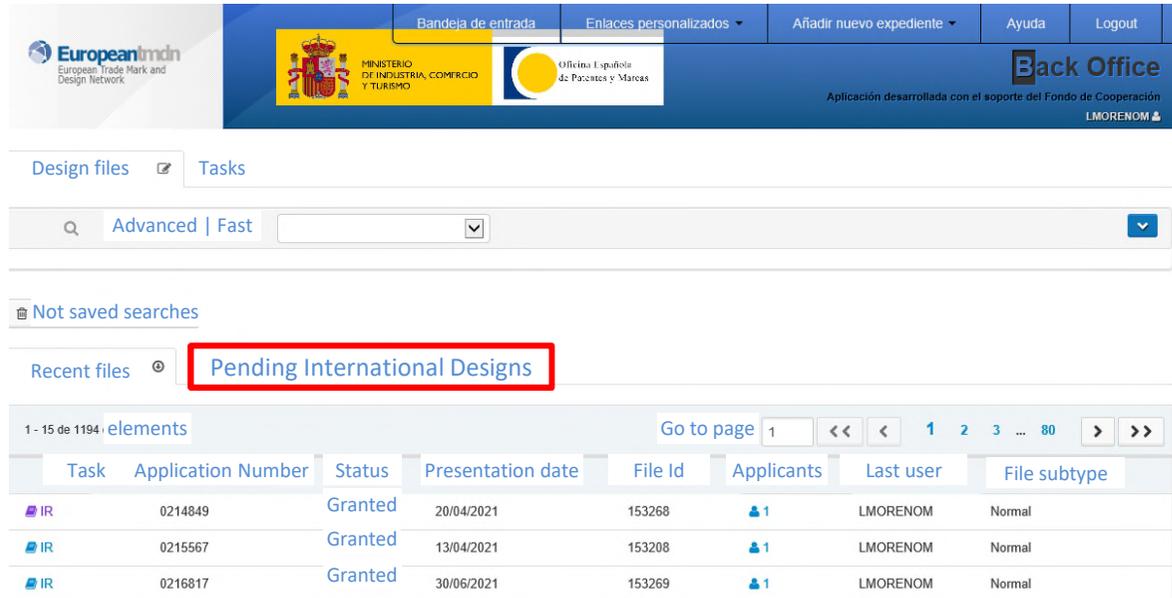
Design is confirmed valid (granted) when opposition period is terminated (with no oppositions filed)

The procedure: practical example

DM/211697

Automatic weekly upload from the International Bulletin of IRs designating Spain (ES) as designated contracting party (DCP)

Examiner's desktop within Back Office (EUIPO)



The screenshot shows the Back Office interface with the following elements:

- Navigation Bar:** Includes "Bandeja de entrada", "Enlaces personalizados", "Añadir nuevo expediente", "Ayuda", and "Logout".
- Logos:** European Trade Mark and Design Network, Ministerio de Industria, Comercio y Turismo, and Oficina Española de Patentes y Marcas.
- Search Bar:** Contains "Design files" and "Tasks" tabs, a search input, and a dropdown menu.
- Not saved searches:** A list containing "Pending International Designs" (highlighted with a red box).
- Table:** Displays a list of elements with the following columns: Task, Application Number, Status, Presentation date, File Id, Applicants, Last user, and File subtype.

Task	Application Number	Status	Presentation date	File Id	Applicants	Last user	File subtype
IR	0214849	Granted	20/04/2021	153268	1	LMORENOM	Normal
IR	0215567	Granted	13/04/2021	153208	1	LMORENOM	Normal
IR	0216817	Granted	30/06/2021	153269	1	LMORENOM	Normal

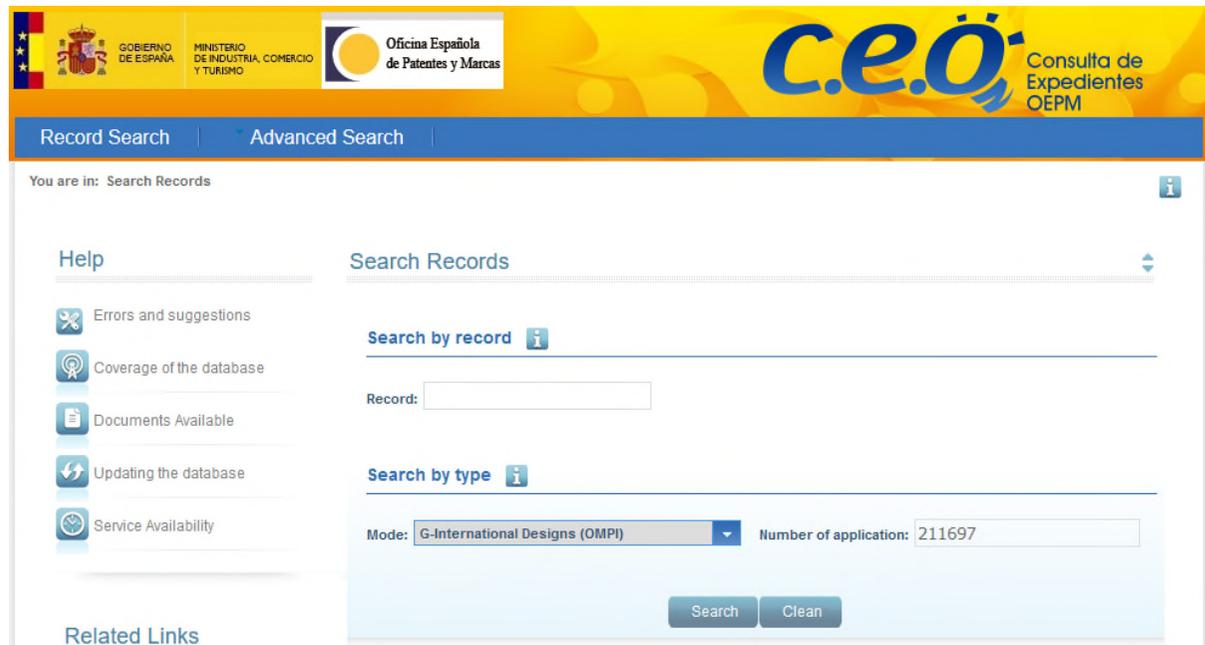
The procedure: practical example

DM/211697

IR (DM) G (national coding)



DM/211697 G211697



The screenshot shows the OEPM search interface. At the top, there are logos for the Spanish Government (GOBIERNO DE ESPAÑA), the Ministry of Industry, Commerce and Tourism (MINISTERIO DE INDUSTRIA, COMERCIO Y TURISMO), and the Spanish Patent Office (Oficina Española de Patentes y Marcas). The main header features the 'c.e.o.' logo and the text 'Consulta de Expedientes OEPM'. Below this, there are tabs for 'Record Search' and 'Advanced Search'. The main content area is titled 'You are in: Search Records'. On the left, there is a 'Help' section with links to 'Errors and suggestions', 'Coverage of the database', 'Documents Available', 'Updating the database', and 'Service Availability'. The main search area is titled 'Search Records' and contains two search methods: 'Search by record' with a text input field labeled 'Record:', and 'Search by type' with a dropdown menu set to 'G-International Designs (OMPI)' and a text input field labeled 'Number of application:' containing '211697'. At the bottom of the search area, there are 'Search' and 'Clean' buttons.

Source: <http://consultas2.oepm.es/ceo/jsp/busqueda/busqRapida.xhtml>

The procedure: practical example

DM/211697

Browse by Bulletin

IRN	Bulletin issue	Publication date	Recording Type	Indication of Products	Contracting Parties
DM/211 697	15/2021	16.04.2021	Registrations (1980 and 1999 Acts)	1.-13. Ballet shoe / 1.-13. Ballerine / 1.-13. Zapatilla de Ballet	III, PL, KH, RO, TR, OM, MN, NO, DE, EG, FI, ES , IL, CH, DK, KR, EM, MX, FR, HU, DA, SG, BZ, GB

Source: <https://www.wipo.int/haguebulletin/?locale=en>

GOBIERNO DE ESPAÑA MINISTERIO DE INDUSTRIA, COMERCIO Y TURISMO Oficina Española de Patentes y Marcas **ce.o** Consulta de Expedientes OEPM

Record Search

You are in: Inicio

International Designs (OMPI) G0211697

- Filing date: 13/10/2020 00:00
- Applicant / Owner:
 - Name: Gavirell Brands LLC
 - Address:
- Agent / Representative: Without an agent
- Description: Model/Drawing with description provided
- Title/products: Zapatilla de Ballet
- Designer or team of designers: Gavirell,Kfir

Source: <http://consultas2.oepm.es/ceo/jsp/busqueda/busqRapida.xhtml>

Reference in the national bulletin (BOPI) to the publication of an IR that designates Spain (ES)

04 MAY 2021 – OFFICIAL BULLETIN OF INDUSTRIAL PROPERTY

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MENTION TO THE REGISTERS THAT DESIGNATE SPAIN

From the publication date of the current official bulletin, a period a two months is open for the filing of oppositions, as indicated in Art. 33.1 of the Law 20/2003, July 7th, of Legal Protection of Industrial Designs, to the international registers having effects in Spain, and published in the International Designs Bulletin of the World Intellectual Property Office (WIPO), that are listed below:

21 **G 0211697 (9)**

International Bulletin Number: 15/2021

58 WIPO Publication date: 16-04-2021

Source: <https://consultas2.oepm.es/bopiweb/descargaPublicaciones/>

The procedure: practical example

DM/211697

Once the 2 months period has expired with no oppositions, an automatic electronic communication from SPTO to WIPO confirms the grant of the IR in Spain, as a National ES Design



HAGUE AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF INDUSTRIAL DESIGNS

- STATEMENT OF GRANT OF PROTECTION -

Rule 18 bis (1) of the Common Regulations

- 1. Office sending the statement:**
Oficina Española de Patentes y Marcas (OEPM) | Paseo de la Castellana, 75 - 28071 Madrid (España) | Teléfono información general: 902 157 530 | informacion@oepm.es
- 2. International deposit No. DM/211697 dated:** 13/10/2020
Número asignado en la OEPM: G0211697
- 3. Name and address of owner:**
Gavrieli Brands LLC, 269 S. Beverly Drive , 90212 Beverly Hills, CA, US
- 4. Protection is (to be) granted for all the industrial designs**
- 5. Date on which the international registration produced or shall produce the effect as a grant of protection under the applicable law (in respect of the industrial designs indicated under item 4):** 13/10/2020
- 6. Date of the statement:** 18/07/2021
- 7. Signature or official seal of the Office sending the statement:**



Fdo.: Elena Borque Sanz
P.D. Jefa de Servicio de Diseños Industriales

Source: <https://www3.wipo.int/designdb/hague/en/>

The procedure: practical example

DM/211697

Statement of Grant of Protection is published in the International Bulletin and added to the record of the IR by WIPO

Browse by Bulletin Search by Registration Number

DM/ 211697 Search

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IRN	Bulletin issue	Publication date	Recording Type	Indication of Products	Contracting Parties
DM/211 697	15/2021	16.04.2021	Registrations (1960 and 1999 Acts)	1.-13. Ballet shoe / 1.-13. Ballerine / 1.-13. Zapatilla de Ballet	III. PL, KH, RO, TR, OM, MN, NO, DE, EG, FI, RU, IL, CH, DK, KR, EM, MX, FR, HU, ES, OA, SG, BZ, GB
DM/211 697	18/2021	07.05.2021	Statements of Grant of Protection		EM; 13.10.2020
DM/211 697	21/2021	28.05.2021	Statements of Grant of Protection		NO; 13.10.2020
DM/211 697	23/2021	11.06.2021	Refusals		IL
DM/211 697	23/2021	11.06.2021	Statements of Grant of Protection		PL; 13.10.2020
DM/211 697	31/2021	06.08.2021	Statements of Grant of Protection		ES; 13.10.2020
DM/211 697	32/2021	13.08.2021	Statements of Grant of Protection		KR; 01.08.2021
DM/211 697	35/2021	03.09.2021	Statements of Grant of Protection		RU; 19.08.2021
DM/211 697	42/2021	22.10.2021	Statements of Grant of Protection		KR; 06.10.2021

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Source: <https://www.wipo.int/haguebulletin/?locale=en>



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THANK YOU



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