



WIPO | HAGUE

The International
Design System

■ Preparatory work for Accession to the Hague Agreement: Legal and other Considerations

Pre-accession training on the Hague Agreement

**Promoting Intellectual Property Rights in the ASEAN region,
ARISE + ASEAN Intellectual Property Rights**

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**World Intellectual Property Organization
(WIPO)**

**Genève
Singapore
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Contents

- Geneva Act (1999) of the Hague Agreement
- Roadmap to the Hague Agreement
- Declarations under the 1999 Act and the Common Regulations
- Some Statistics
- Recent Developments in the Hague Legal Framework

GENEVA ACT (1999) OF THE HAGUE AGREEMENT



- The Geneva Act (1999) modernized the Hague System by allowing, among others, the accession of international intergovernmental organizations, such as the European Union (EU) and the African Intellectual Property Organization (OAPI) to it.
- All the recent accessions are to the 1999 Act of the Hague Agreement.

Benefits of the Hague System to the Member States

- Joining the Hague System stimulates innovation and creativity, helping local businesses and designers expand into, and protect their designs within, new global markets.
- At the same time, the local economy and the community at large benefit from investments by foreign businesses that can easily and efficiently secure design protection within that jurisdiction.

Economy Boosting

- The Hague System makes it easier for businesses and designers to:
 - protect and commercialize their designs in foreign markets; and
 - ensure a return on the investment they make in creating and marketing designs.

- The Hague System creates
 - new business opportunities for individual designers and SMEs with a limited IP budget, thanks to its simple and cost-efficient approach to protecting designs internationally.

What is the value added ?

■ For your IP office

- More business;
- less paper work;
- with WIPO taking care of all procedural matters.

■ For the local IP profession

- More non-resident filings through the Hague System = more opportunities for representation in terms of oppositions, licensing etc.
- More opportunities for representation concerning:
 - ❖ Border measures
 - ❖ Licensing
 - ❖ Litigation

Market by market filing



5 applications, 5 languages, 5 IPOs, 5 procedures, 5 registrations, 5 renewals, 5 currencies...



Using the Hague System



CH
F



EUIPO



IMPI



ROSPATENT



USPTO

1 application, 1 language, 1 IPO, 1 procedure, 1 registration, 1 renewal, 1 'rency...







ROADMAP TO THE HAGUE AGREEMENT

ASEAN: IP Ecosystem

- **ASEAN ECONOMIC COMMUNITY BLUEPRINT, 2025**
 - Strengthening IP Offices and build IP infrastructure:
 - Accession to International Treaties: Patent Cooperation Treaty (PCT), Madrid Protocol, Hague Agreement and Singapore Treaty on the Law of Trademarks (STLT)
- **ASEAN Designview (since August 25, 2015)**
 - More than 200,000 design registrations having effects in the participating ASEAN countries (Brunei Darussalam, Cambodia, Indonesia, Lao PDR, Malaysia, Myanmar, Philippines, Singapore, Thailand and Viet Nam)

Who Can Be Party to the 1999 Act?

- The flexibility of the 1999 Act allows both countries/intergovernmental organizations with deposit systems and examination systems to become parties to 1999 Act.
- Contracting States and contracting intergovernmental organizations are collectively known as “Contracting Parties”.
- The Contracting Parties to the 1999 Act are members of the Hague Union.

Steps for accession

■ Implementation of the Hague System at the Office:

- Regulations / Guidelines Concerning Internal Procedures / Examination;
- The Office shall be technically ready to support the said procedures;
- Form of communication with the International Bureau shall be agreed before accession.

■ Consultation with Stakeholders; Raising Public Awareness

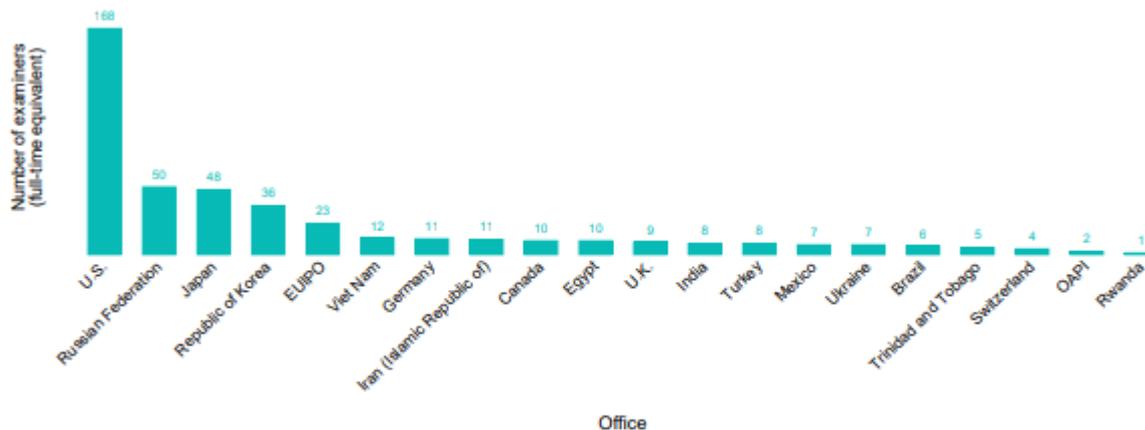
■ Legislative Consideration:

- Interoperability of the national design law with the Hague System legal framework and possible declarations shall be discussed with the International Bureau before the accession;
- Enforcement of IP rights

Implementation of the Hague System at the IP Office

- The Hague System allows the accession of countries with examination and deposit systems;
- National / regional offices have different resources; therefore the scope and level of formality and/or substantive examinations, if any, vary.

C34. Number of industrial design examiners for selected offices, 2019



Note: EUIPO is the European Union Intellectual Property Office and OAPI is the African Intellectual Property Organization.
Source: WIPO Statistics Database, September 2020.

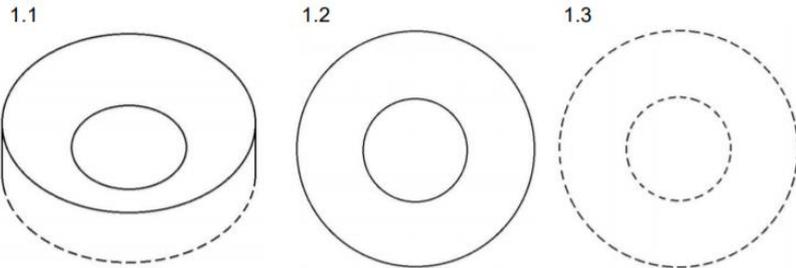
Guidance on Reproductions

<https://www.wipo.int/hague/en/>

EXAMPLE OF POSSIBLE PROBLEMATIC PRACTICE

The contours of a three-dimensional product with curved surfaces have not been clearly shown in the representation since shading is not provided in the drawings.

Indication of the product: "Pharmaceutical tablet"



Problem: Reproductions do not include shading.

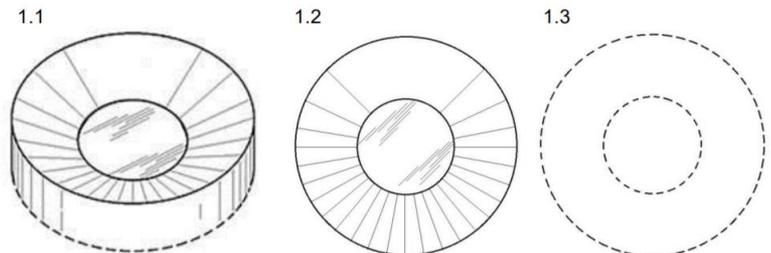
Guidance

Provide Shading, Hatching, Dots or Lines that May Be Used to Indicate Relief or Contours of Surfaces of a Three-Dimensional Product

- (a) Shading, hatching, dots, or lines should be provided in the representations¹⁰ where it is difficult to represent relief or contours of surfaces of a three-dimensional product without them¹¹.
- (b) Shading, hatching or lines should not be provided on unclaimed subject matter where they may lead to confusion as to the scope of the claimed design.
- (c) The purpose of the shading, hatching or lines provided in the representations should be clearly stated in the description in order to avoid any confusion with patterns on the surfaces¹².

Result

Illustrative Implementations Taking Into Account Guidance No. 3



Communication between the IP Office and the International Bureau

- Before depositing the instrument of accession/ratification, the International Bureau and the Office should discuss the possible establishment of electronic communication between the Office and the International Bureau.
- For example, if the Office allows indirect filing of international applications, the mode of transmission of applications to the International Bureau should be ready at the time of accession.

Transfer of designation fees

- At the time of registration and the time of renewal;
- Breakdown of fee
 - IP Portal – different formats
- Fund transfer
 - Current account or money transfer

- At the time of accession, WIPO's Finance team get in touch with the IP Office to solve the fund transfers.

Consultation with Stakeholders; Raising Public Awareness

- Before and after accession, awareness raising of the Hague System is important;
- Stakeholders, such as Chambers of Commerce, business circles, to be consulted;
- Promotion activities among user circles, universities, industry, etc.
- Information on the Hague System on the Office website, etc.

Legislative Consideration

The Hague legal framework:

WIPO:

- Hague Agreement
- Common Regulations
- Administrative Instructions

Contracting parties:

- Conditions of protection
- Refusal procedures
- Rights resulting from protection

Declarations under the 1999 Act and the Common Regulations

- Contracting Parties may make certain declarations in order to comply with their national laws concerning industrial design protection (Art. 30 of the 1999 Act,)
- Declarations may be made either simultaneously with the deposit of the instrument of accession, or after the deposit (for example, following amendments to the national law).
- Before submission of the declarations to the Director General of WIPO, it is advised that 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.

The Hague System - simple and efficient

- To maintain the user-friendliness of the Hague System, it is strongly recommended that the Contracting Parties make only the absolutely necessary declarations.
- The International Bureau will help you to identify specific features for which individual declarations may be required and to draft any such declarations as well as in respect of technical/practical implementation-based issues.

Instrument of Accession; Declarations under the 1999 Act

- The 1999 Act comes into force in respect of a Contracting Party three months after the deposit of its instrument of accession/ratification with the Director General of WIPO, or at any later date as indicated in the instrument of accession
- Contracting Parties may make certain declarations in order to comply with their national laws concerning industrial design protection
 - Declarations may be made either simultaneously with the deposit of the instrument of accession, or after the deposit (for example, following amendments to the national law)



DECLARATIONS UNDER THE 1999 ACT AND THE COMMON REGULATIONS

Declarations under the 1999 Act and the Common Regulations

- Mandatory declaration: Maximum Duration of Protection (Art. 17(3)(c) of the 1999 Act)
- Mandatory declarations (under certain circumstances)
- Optional declarations

MANDATORY DECLARATION

- Duration of Protection – Maximum Duration of Protection (Art. 17(3)(c) of the 1999 Act)
 - The minimum term of protection that the national law must provide is 15 years, subject to renewal;
 - Where the national law provides for a protection of more than 15 years, the duration of protection of an IR shall be the same as under the national law, subject to renewal.

MANDATORY DECLARATIONS (under certain circumstances)

■ General principle

- Each CP is assumed to permit the period of deferment of 30 months from the filing date, or where priority is claimed, from the priority date (Rule 16(1)(a))

■ Deferment of publication

- Where the law of a CP provides for a deferment period of less than 30 months, that CP must make a declaration of the allowable period of deferment (Art. 11(1)(a))

■ No deferment of publication

- Where the law of a CP does not provide at all for the deferment of publication, that CP must make a declaration notifying that fact

OPTIONAL DECLARATIONS

- Prohibition of filing through National Office (Art. 4(1)(b))
 - In general, international application may be filed, at the option of the applicant, either directly with the IB or through the Office of the applicant's Contracting Party.
 - However, a CP may make a declaration that international applications may not be filed through its Office

eHague

Digital gateway to international design protection

- If a declaration under Article 4(1)(b) of the 1999 Act is made, the applicants may only file international applications directly to the International Bureau.
- **92.5%** of the international applications are filed through eHague (available on the WIPO website)



What is an Examining Office under the Hague System?

- Article 1(1)(xvii) of the 1999 Act
 - Some optional declarations are open only to a Contracting Party whose Office is an “Examining Office”. Those declarations are:
 - declaration under Article 5(2) (Additional mandatory contents of the International Application),
 - declaration under Article 7(2) (Individual designation fee),
 - declaration under Article 14(3) (Prohibition of self-designation), and
 - declaration under Rule 18(1)(b) (Extension to 12 months of the refusal period).

What is an Examining Office under the Hague System?

■ Definition in the Geneva Act:

Article 1(xvii) “Examining Office” means an Office which **ex officio** examines applications filed with it for the protection of industrial designs at least to determine whether the industrial designs satisfy the condition of **novelty**;

- An Examining Office must carry out, **ex officio**, a prior art search that matches up 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.

What is an Examining Office under the Hague System

■ Qualifying as an Examining Office:

Examining Office” means an Office which ***ex officio*** examines

(1.) all applications filed with it for the protection of industrial designs

(2.) before the grant of protection

(3.) systematically

(4.) according to the laws of the Contracting Party,

(5.) at least to determine whether the industrial designs satisfy the condition of novelty

OPTIONAL DECLARATIONS

■ Standard designation fee (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.
- A CP with an Examining Office may, instead of a declaration concerning individual designation fee, make a declaration requiring the level two or three standard designation fee.

Levels of the Standard Designation Fee

- level one, for CPs whose Office does not carry out examination on substantive grounds – this level will apply *automatically* in the absence of any declaration;
- level two, for CPs 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 CPs 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.

OPTIONAL DECLARATIONS

■ Unity of Design (Art. 13(1))

- The national law of a CP 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.
- The declaration should be comprehensive, detailed and specific as to the requirements in question.

OTHER OPTIONAL DECLARATIONS

- Filing in Name of the Creator (Rule 8(1)(a)(i))
- Oath or Declaration of the Creator (Rule 8(1)(a)(iii))
- Requirements Concerning Views (Rule 9(3))
- Security Clearance (Rule 13(4))
- Effect of Change in Ownership (Art. 16(2))
- Rule 18(1)(b): Extension of Period for Notification of Refusal (if opposition provided under the national law)

SOME STATISTICS



Over 1 million design applications filed worldwide, in 2019

- Since 2005 the number of (national, regional and international) applications filed per year has more than doubled.
- Increase in filing activity in China alone explains 86% of this growth.

An estimated 1.04 million industrial design applications were filed worldwide

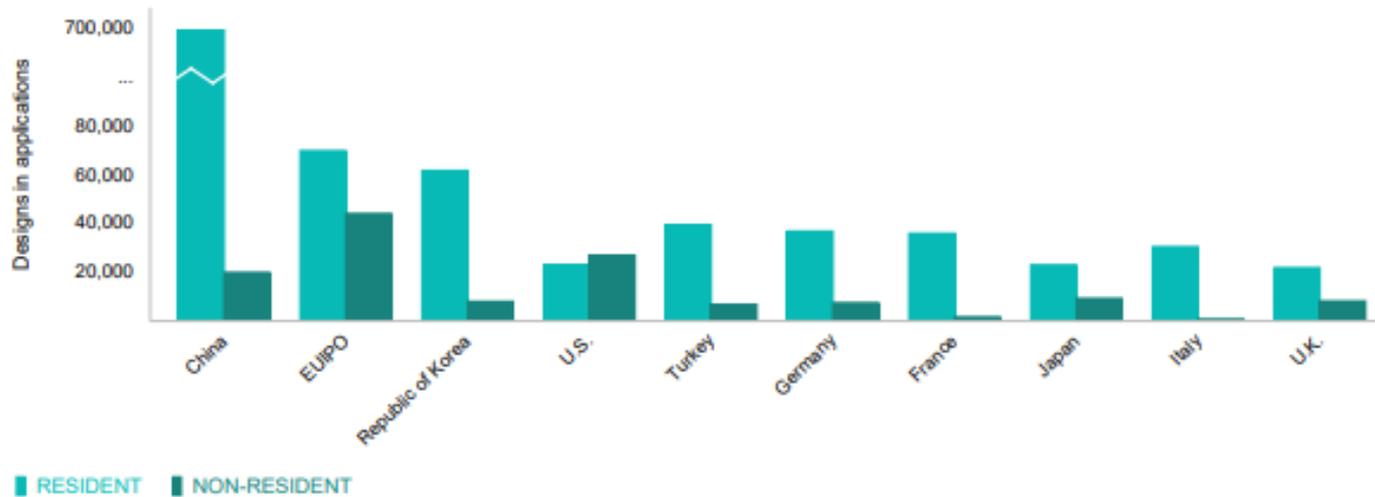
3.1. Industrial design applications worldwide, 2005–2019



Top Ten Offices (design count)

China received 52% of all designs contained in applications filed worldwide

3.3. Application design counts for the top 10 offices, 2019



Source: Figure C10.

1.36 Million Designs Contained in Applications, in 2019

Designs contained in applications totaled 1.36 million

3.2. Number of designs in industrial design applications worldwide, 2005–2019



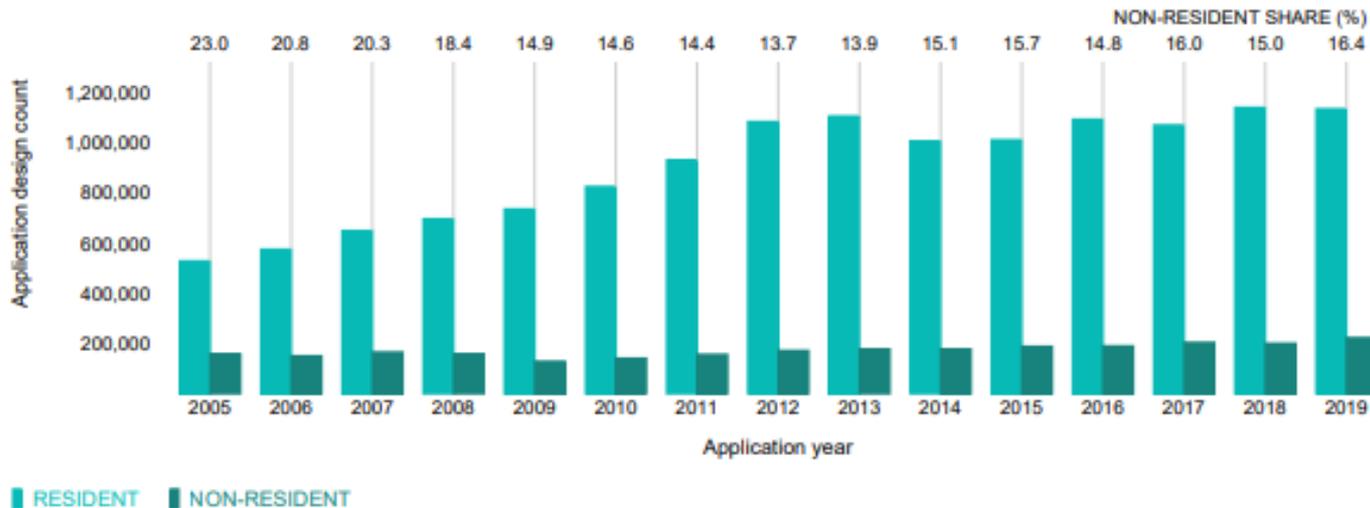
Source: Figure C2.

Industrial designs

Application design counts worldwide	1,343,800	1,360,900	1.3	100.0
China	708,799	711,617	0.4	52.3
EUIPO (EU office)	108,553	113,319	4.4	8.3
Republic of Korea	68,310	69,360	1.5	5.1

Non-resident filings grew by 11%, in 2019 (design count)

C3. Resident and non-resident application design counts worldwide, 2005–2019



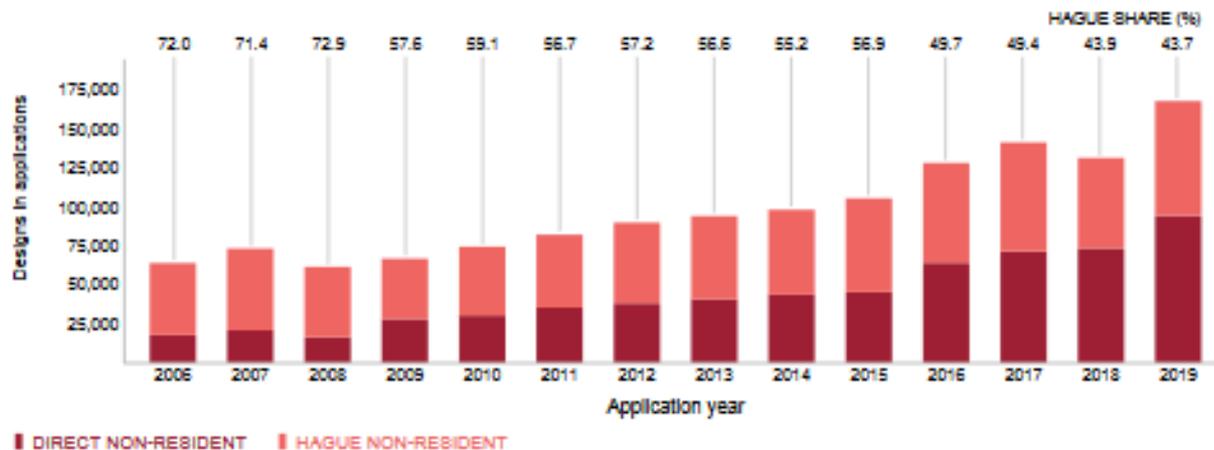
Note: World totals are WIPO estimates using data covering 153 IP offices. These totals include design counts in applications filed directly with national and regional offices (known as the Paris route), as well as design counts in designations received via the Hague System (where applicable). See the glossary for the definition of design count.

Source: WIPO Statistics Database, September 2020.

Around 44% of Non-resident filings via the Hague System (design count)

Around 44% of non-resident applications were filed via the Hague System in 2019.

A26. Trends in non-resident application design counts by filing route (direct and Hague), 2006–2019



Note: Direct application data are available only up to 2019, therefore 2020 Hague designation data are not reported. The direct route refers only to applications filed directly with the national or regional IP offices of Hague members. The Hague route refers to designations received by offices via the Hague System. For the sake of simplicity, designations are referred to as applications received via the Hague route.

Source: WIPO Statistics Database, March 2021.

RECENT DEVELOPMENTS IN THE HAGUE LEGAL FRAMEWORK



Default publication period extended from 6 to 12 months (January 2022)



Streamlining of the change in ownership procedure (January 2022)



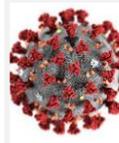
Email address becomes mandatory (February 2021)



13th Ed. of the Locarno Classification (January 2021)



BREXIT – EU Designation in an IA has no longer effect in the UK (January 2021)



COVID-19 – Measures put in place to address failure to meet time limits (March 2020)



WIPO becomes a depositing office for Hague applications under WIPO DAS (January 2020)

FIND OUT MORE

■ www.wipo.int/hague/en/

Join the Hague System

The Hague System currently has 75 contracting parties covering 92 countries. When filing an international application under the Hague System, applicants can designate as few or as many of those contracting parties as desired.

Interested in becoming a member?

Find out all about [how to accede to the Geneva Act \(1999\) of the Hague Agreement](#) and what the benefits are.

Find out more

Want to find out more about becoming a member of the Hague System?

Contact Hague

Download our Accession Kit

Thank You!

