

HOW TO PROTECT YOUR DESIGNS IN EXPORT MARKETS



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IP Viet Nam
21 September 2022

1. Preparing your International Application



2. Filing your International Application



3. Managing your International Registration



4. The role of IP Offices





PREPARING YOUR INTERNATIONAL DESIGN APPLICATION

CHECKING DESIGN NOVELTY

- ❑ Search for prior industrial design rights registered in your country
- ❑ The most efficient way: use Designview, ASEAN Designview and the Global Design Database
- ❑ Designview - <https://www.tmdn.org/tmdsview-web/welcome>
 - ❖ a search platform integrating databases of 70 national, regional and international IP offices
- ❑ ASEAN Designview - <http://www.asean-designview.org/designview/welcome>
 - ❖ a similar platform integrating databases of ASEAN Member States
- ❑ Global Design Database - <https://www3.wipo.int/designdb/en>
 - ❖ an online gateway managed by WIPO containing more than 14 million designs from 39 national, regional and international design databases

CHECKING DESIGN NOVELTY - DESIGNVIEW

DESIGNview



English (en) ▼

Sign in

Register

Search **19,652,019** designs
across the European Union and beyond

Type indication of the product

SEARCH

ADVANCED SEARCH



CONFIGURE YOUR SEARCH

Territories

Select territories ▼

Offices

Select one or more offices ▼

CHECKING DESIGN NOVELTY – ASEAN DESIGNVIEW



[Home](#) | [About](#) | [Help](#) | [Contact Us](#)

External links



Office information

Number of designs in Designview
238002



Find term

Search

Clear



Advanced search

ASEAN Designview is the common online industrial design information platform of the ASEAN Member States aimed at making ASEAN designs data widely available and easily accessible to all interested stakeholders.

ASEAN Designview offers free of charge online access to information on design registrations having effects in the participating ASEAN countries. These are indicated in green in the panel below.

ASEAN Designview has been developed by the Intellectual Property Offices of the ASEAN Member States with the support of the EU-ASEAN Project on the Protection of Intellectual Property Rights (ECAP III Phase II) administered by the European Union Intellectual Property Office (EUIPO).

ASEAN IP offices

- | | | | |
|------|--------------------------------|------|----------------------------|
| ● BN | Brunei Darussalam (BN - 195) | ● MY | Malaysia (MY - 40820) |
| ● ID | Indonesia (ID - 54932) | ● PH | Philippines (PH - 30216) |
| ● KH | Cambodia (KH - 762) | ● SG | Singapore (SG - 30787) |
| ● LA | Lao PDR (LA - 548) | ● TH | Thailand (TH - 16689) |
| ● MM | Myanmar (MM) | ● VN | Vietnam (VN - 63053) |
- 

CHECKING DESIGN NOVELTY – GLOBAL DESIGN DATABASE

WIPO
IP PORTAL

MENU

Global Design Database

HELP



ENGLISH

LOGIN

WIPO

A world-wide collection of designs data; including WIPO Hague registrations and information from participating offices.

searches ▾

records ▾

SEARCH BY

Design

Names

Numbers

Dates

Country

Priority

Indication of
product =

Design class ▾ =

Description =

search 🔍

FILTER BY

Source

Status

Designation

Locarno class

Reg. ⌂

KE Designs

1,225

KH Designs

1,085

KR Designs

949,047

LA Designs

496

MD Designs

11,905

MK Designs

1,074

MN Designs

3,008

MY Designs

34,963

MZ Designs

185

NZ Designs

54,514

PE Designs

6,327

PH Designs

30,219

Display:

List ▾

Sort:

Value - asc ▾

filter 🔍

1 - 10 / 14,637,071

DESIGN view 🔗



Display:

10 ▾

per page

options ⚙️



1

/ 1,463,708



Sort by

Reg. Date - desc ▾

NZ ID

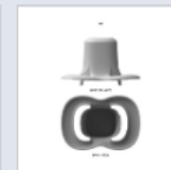
431061



Pacifier Cap Part

2022-09-16

b.box for kids developments Pty Ltd



FILLING INTERNATIONAL APPLICATION FORM

- ❑ International application (IA) must be presented in an official form (DM/1) - <http://www.wipo.int/hague/en/forms/>
- ❑ All necessary information in DM/1 form must be provided
 - ❖ Mandatory content
 - ❖ Additional mandatory content required by some Contracting Parties (CPs) if designated
 - ❖ Optional content
 - ❖ Optional content only relevant for some CPs if designated

MANDATORY CONTENTS

❑ Mandatory contents checked by the International Bureau (IB):

- ❖ Identity of the Applicant (name, address, email address) – Item 1
- ❖ Entitlement of the Applicant – Item 2
- ❖ CP of the Applicant – Item 3
- ❖ Indication concerning the number of industrial designs, the number of Reproductions – Item 6
- ❖ Designation of at least one CP – Item 7
- ❖ Product indication – Item 8
- ❖ Signature – Item 19

❑ The E-Filing system (eHague) automatically checks whether mandatory contents are filled in

ADDITIONAL MANDATORY CONTENTS

- ❑ **Certain elements affecting the filing date under the law of certain Designated Contracting Parties (DCPs):**
 - ❖ Brief description (RO, VN, SY) – Item 9
 - ❖ Identity of creator (FI, GH, HU, IS, MX, RO, US) – Item 11
 - ❖ Claim (US, VN) – Item 12
 - ❖ Statement that the Applicant is the Creator (FI, GH, HU, IS, MX) – Item 7
 - ❖ Assignment of international application by the Creator to the Applicant (FI, GH, HU, IS, MX) – Item 7
 - ❖ Declaration of the Creator (US) – Annex 1
- ❑ The eHague automatically alerts if any additional mandatory contents is missing

OPTIONAL CONTENTS

- ❑ If provided, these contents are checked by the IB:
 - ❖ Identity of the representative – Item 5
 - ❖ Priority claim under Article 4 of the Paris Convention – Item 13
 - ❖ Declaration under Article 11 of the Paris Convention (official or officially recognized international exhibition) – Item 14
 - ❖ Request for immediate publication/deferment of publication – Item 17
 - ❖ Description, claim or disclaimer *
 - ❖ Identity of the creator *
 - ❖ Statement that Applicant is the Creator *

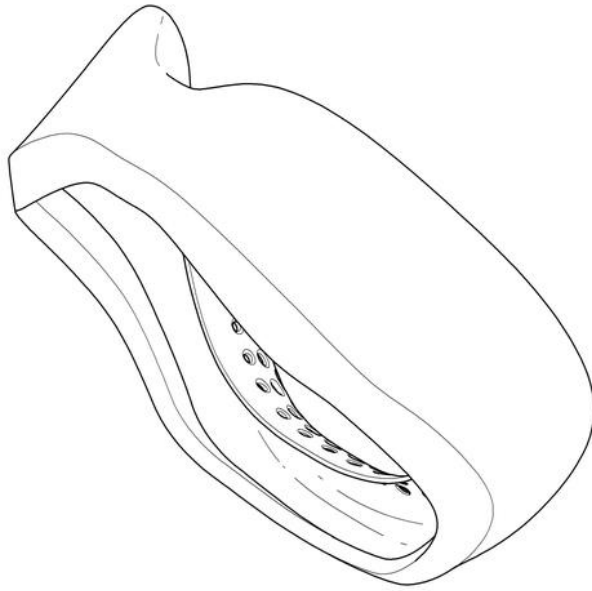
(*) NOT required by DCPs

OPTIONAL CONTENTS ONLY RELEVANT FOR CERTAIN CPs

- ☐ Declaration concerning an exception of lack of novelty (JP, KR) – Item 15
- ☐ Indication that some/all designs are related designs of a principal design (JP, KR) – Item 16
- ☐ Priority documents (KR) – Annex V of paper form or the corresponding section in the E-Filing interface
- ☐ Request of reduction of the individual designation fee (IL, MX, US) – Item 18
- ☐ Locarno class of the designs – Item 8

REPRODUCTION REQUIREMENTS – MODE OF REPRODUCTIONS (1)

- ❑ Can be in the form of photographs or other graphic representations



DM/212 889



DM/209 271



DM/215 695

REPRODUCTION REQUIREMENTS – MODE OF REPRODUCTIONS (2)

- ❑ IA may at the same time comprise both photographs and graphic representations
- ❑ May be in black and white or in color



DM/216 294



DM/219 443

REPRODUCTION REQUIREMENTS – MODE OF REPRODUCTIONS (3)

- ☐ If filed on paper, should be pasted or printed directly onto a separate sheet of A4 paper
- ☐ The separate sheet should be used upright and should not contain more than 25 reproductions
- ☐ Where the IA is filed using form DM/1 a margin of at least five millimeters should be left around the representation of each design.
- ☐ The reproductions should not be folded, stapled or marked in any way.

REPRODUCTION REQUIREMENTS - DIMENSIONS

- ❑ The dimensions of the representation of each design may not exceed 16 x 16 centimeters, and in respect of at least one representation of each design one of those dimensions must be at least 3 centimeters
- ❑ If filed through E-Filign system:
 - ❖ Must be in the JPEG or TIFF formats
 - ❖ Resolution of 300 x 300 dpi (A reproduction uploaded with a different resolution is automatically adjusted to have a resolution of 300 x 300 dpi)
 - ❖ The size of each file does not exceed 2MB

REPRODUCTION REQUIREMENTS – REPRESENTATION OF THE DESIGN

- ❑ The reproductions should represent the design alone, do not include any other object, accessory, person or animal
- ❑ Technical drawings showing articles particularly with axes and dimensions, are not acceptable



REPRODUCTION REQUIREMENTS – NEUTRAL BACKGROUND

- ❑ The design must be shown against a neutral plain background



DM/217 182

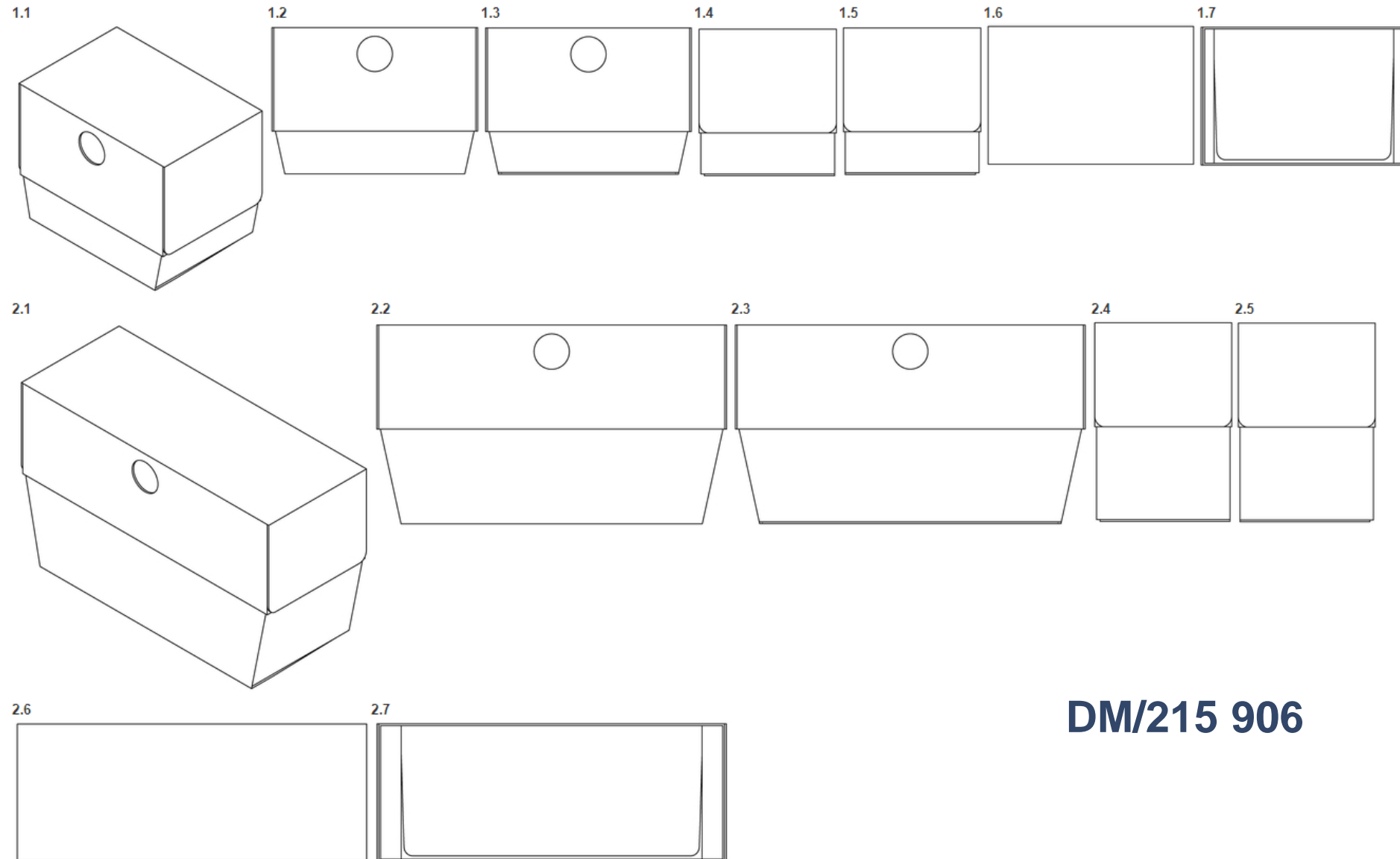


DM/215 468

REPRODUCTION REQUIREMENTS – NUMBERING

- ❑ Each design must be identified by an individual number
- ❑ If filed on paper, numbering must appear in the margin of each reproduction
- ❑ The eHague interface automatically proceeds to the numbering of the reproductions
- ❑ When the same design is represented with different views, the numbering of each view must consist of two separate figures, separated by a dot (for example, 1.1, 1.2, 1.3, etc., for the first design, and 2.1, 2.2, 2.3, etc., for the second design, and so on).
- ❑ The reproductions should be submitted in ascending numerical order.

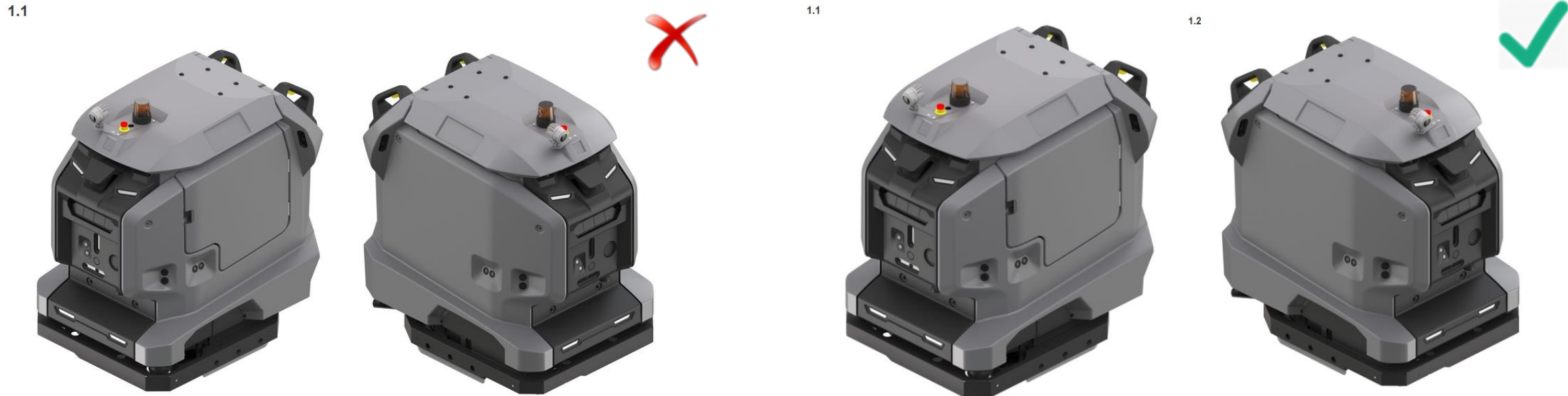
REPRODUCTION REQUIREMENTS – NUMBERING EXAMPLE



DM/215 906

REPRODUCTION REQUIREMENTS – NUMBER OF REPRODUCTIONS

- ❑ There is no limit on the number of reproductions which can be submitted for each design
- ❑ Only a single copy of each reproduction should be submitted
- ❑ Several views shown from different angles may not be included in a single reproduction.
- ❑ Each view must be represented separately.



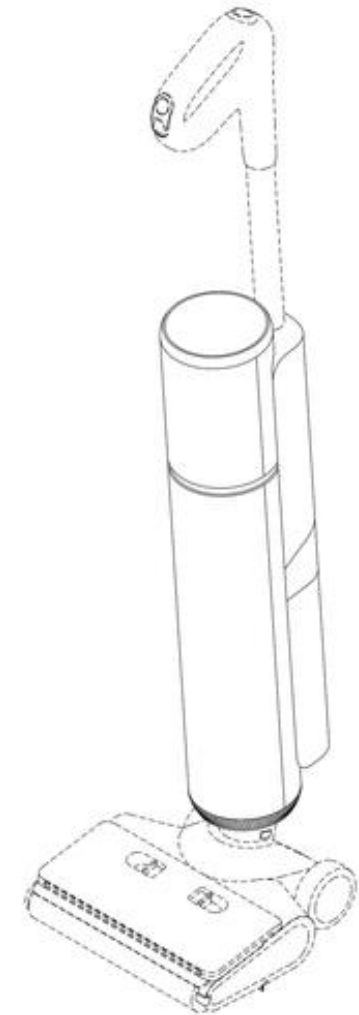
REPRODUCTION REQUIREMENTS – EXPLANATORY TEXT AND LEGENDS

- ❑ Explanatory text or legends are not acceptable in the representation itself
- ❑ Explanatory text or legends indicating the type of view (e.g., “front view”, “top view”, etc.), may be contained in item 10 of form DM/1 and in the relevant section of the eHague interface
- ❑ Legends of reproductions:
 - ❖ Legends to indicate a specific view of the product may be indicated in association with the numbering of the reproduction
 - ❖ The proposed legends are: 1. Perspective; 2. Front; 3. Back; 4. Top; 5. Bottom; 6. Left; 7. Right; 8. Reference; 9. Unfolded; 10. Exploded; 11. Cross-sectional; 12. Enlarged; 00. Other (limited to 40 characters)

REPRODUCTION REQUIREMENTS – DISCLAIMER (1)

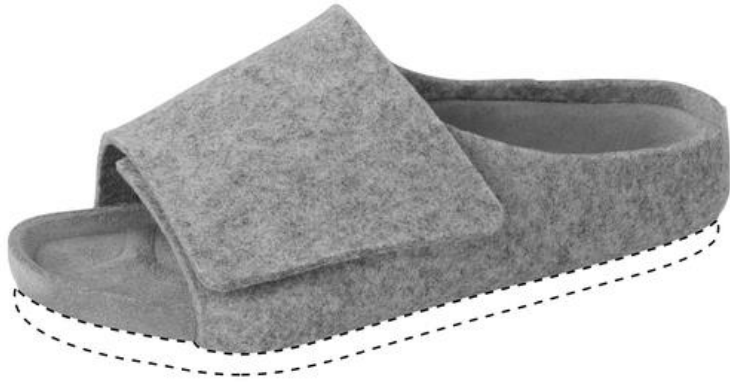
- ❑ Disclaimer: Matter which is shown in a reproduction, but for which protection is not claimed, may be indicated in a reproduction by means of dotted or broken lines or coloring, and/or explained in the description

Disclaimer in description: The parts shown by means of broken lines in the reproductions are not part of the claimed design



DM/223 132

REPRODUCTION REQUIREMENTS – DISCLAIMER (2)



DM/223 278 – No disclaimer in description



DM/222 353 - 2

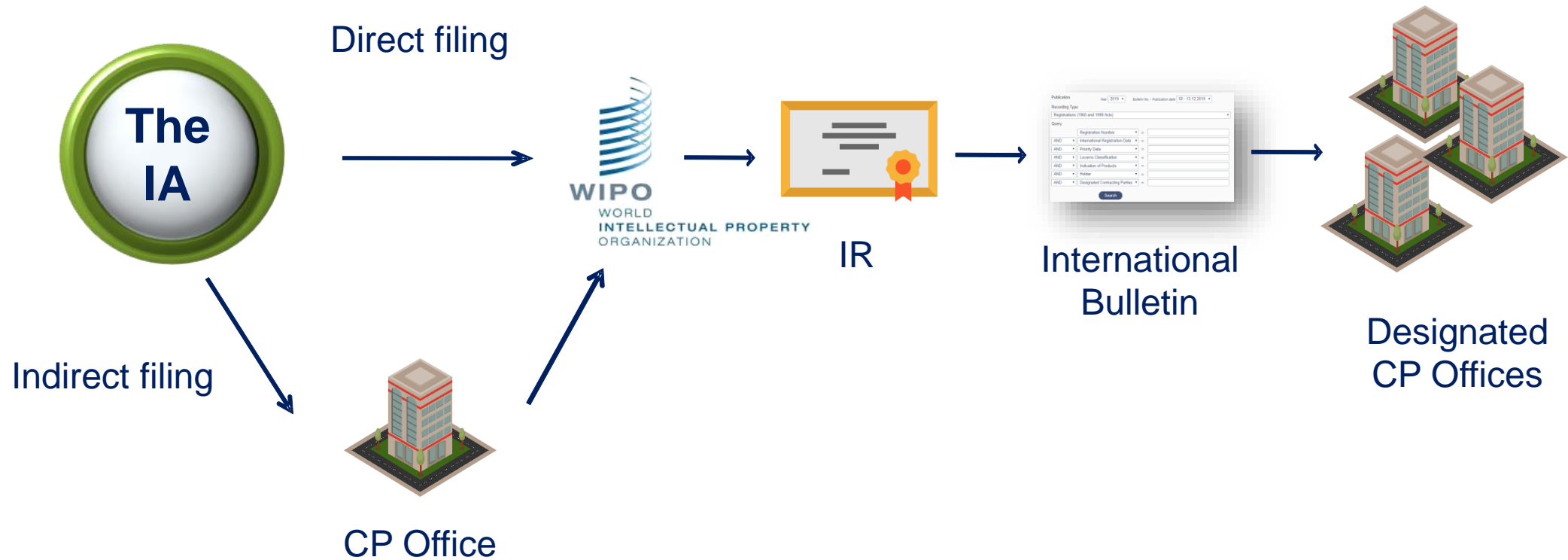
Disclaimer in description: the body of the bag
.... depicted in pale red are not claimed



FILING YOUR INTERNATIONAL DESIGN APPLICATION

FILING INTERNATIONAL DESIGN APPLICATION

□ Two ways:



INDIRECT FILING THROUGH CP OFFICE

- ❑ Only possible if CP accepts the filing of IA
- ❑ Language: selection of CP Office (English and/or French and/or Spanish)
- ❑ Modality: by hand or by mail (DM/1 Form) or electronic filing
- ❑ Fees:
 - ❖ CP Office may charge a transmittal fee
 - ❖ CP Office may accept collecting other fees and transmitting to IB
- ❑ Transmittal: CP Office sends the IA to the IB (preferably within one month). CP Office must indicate the date of receipt at the Office
- ❑ Filing date:
 - ❖ Date of receipt at CP Office if received by IB within one month
 - ❖ Otherwise, date of receipt at IB

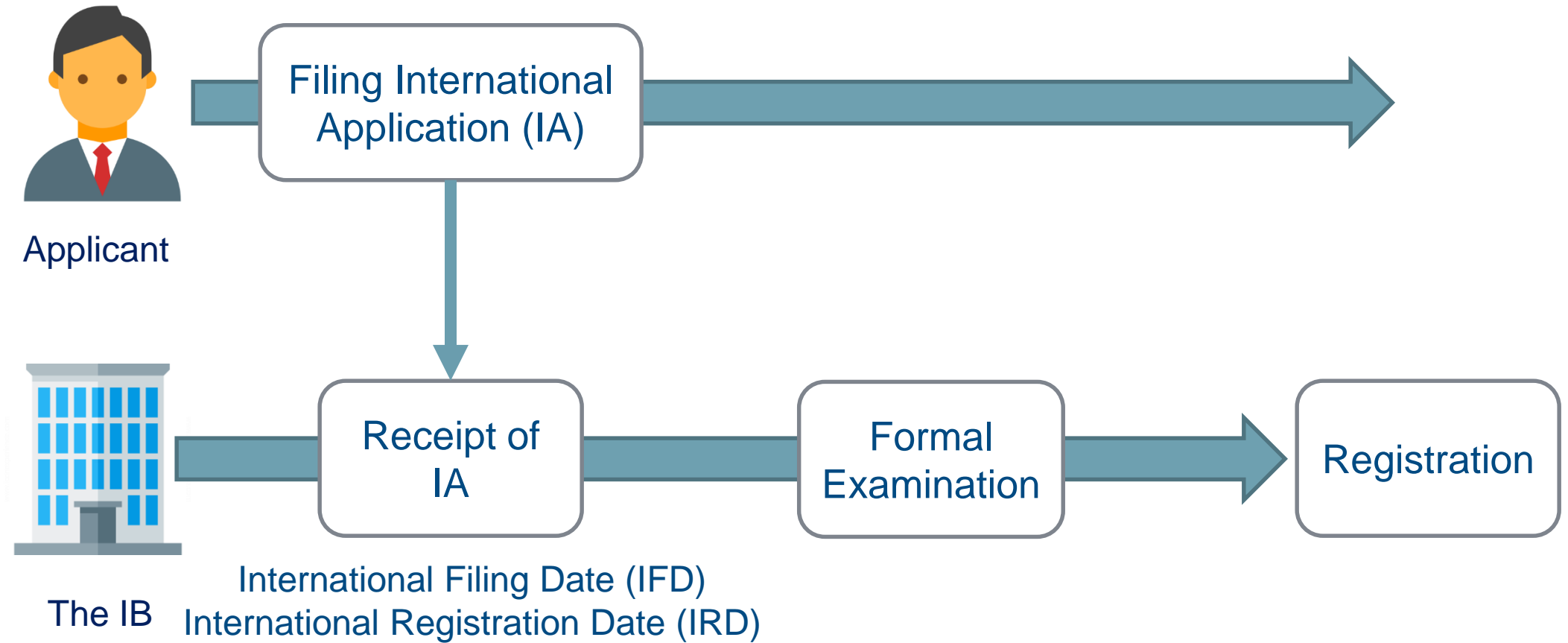
DIRECT FILING AT WIPO

- ❑ Language: English or French or Spanish
- ❑ Modality:
 - ❖ By mail (DM/1 Form) through a postal or other delivery service
 - ❖ Via Contact Hague (<https://www3.wipo.int/contact/en/hague/>)
 - ❖ Electronic filing through eHague interface:
(<https://www3.wipo.int/HagueEFilingWeb>)
 - ❖ To use the eHague interface the Applicant must have a WIPO User Account:
<https://www3.wipo.int/wipoaccounts/generic/public/register.xhtml>

BENEFITS OF E-HAGUE

- ☐ Several reproductions can be uploaded simultaneously
- ☐ Formalities are checked automatically in real time
- ☐ Progress of application preparation can be saved
- ☐ Fee Calculator is fully integrated
- ☐ Fees paid online by credit card
- ☐ Lower fees when the IA contains many reproductions
- ☐ Fast delivery of IA
- ☐ Instant acknowledgement of receipt
- ☐ Receive and download notifications relating to the IA
- ☐ Retrieve current status of the IA in real time

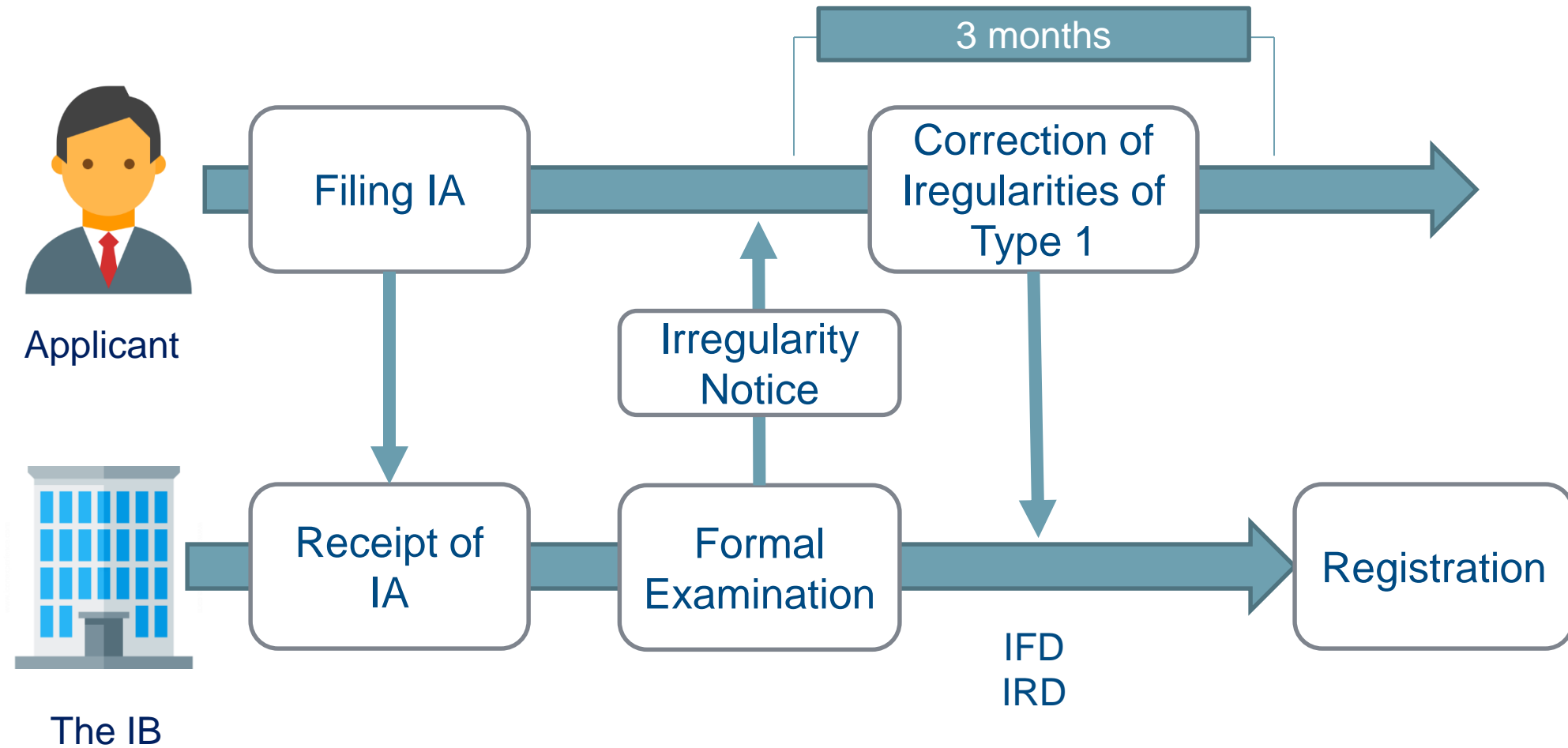
REGULAR APPLICATION



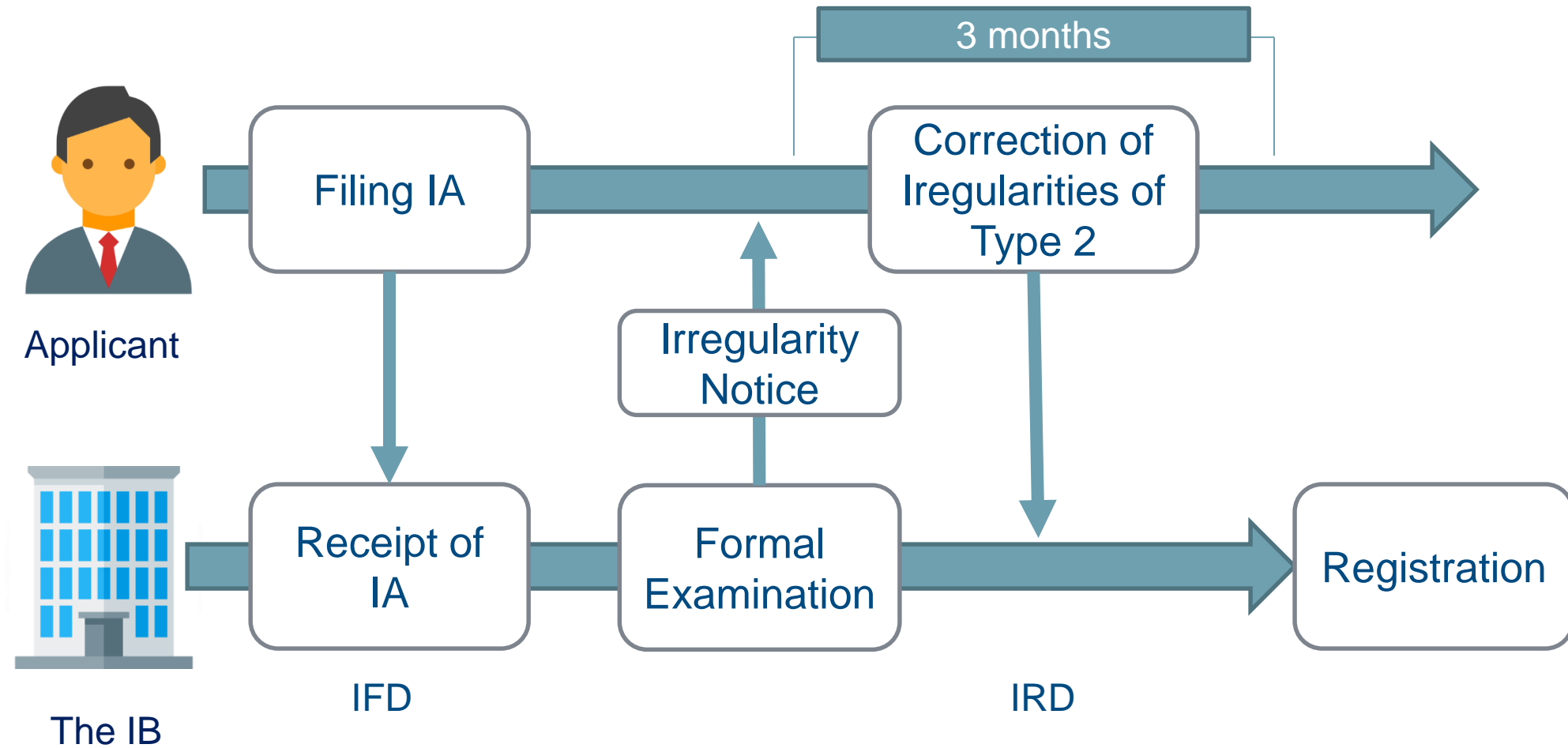
IRREGULARITIES

- ❑ Type 1: Irregularities affecting the IFD
 - ❖ The IA is not in one of the prescribed languages
 - ❖ Identity of the Applicant is missing
 - ❖ No indication that international registration under the 1999 Act or the 1960 Act is sought
 - ❖ Designation of at least one CP is missing
 - ❖ Reproductions of each design are missing
 - ❖ Sufficient contact information of the Applicant or Representative is missing
- ❑ Type 2: Irregularities affecting the IRD: Irregularities relating to additional mandatory contents
- ❑ Type 3: Other Irregularities (not affecting IFD and IRD)

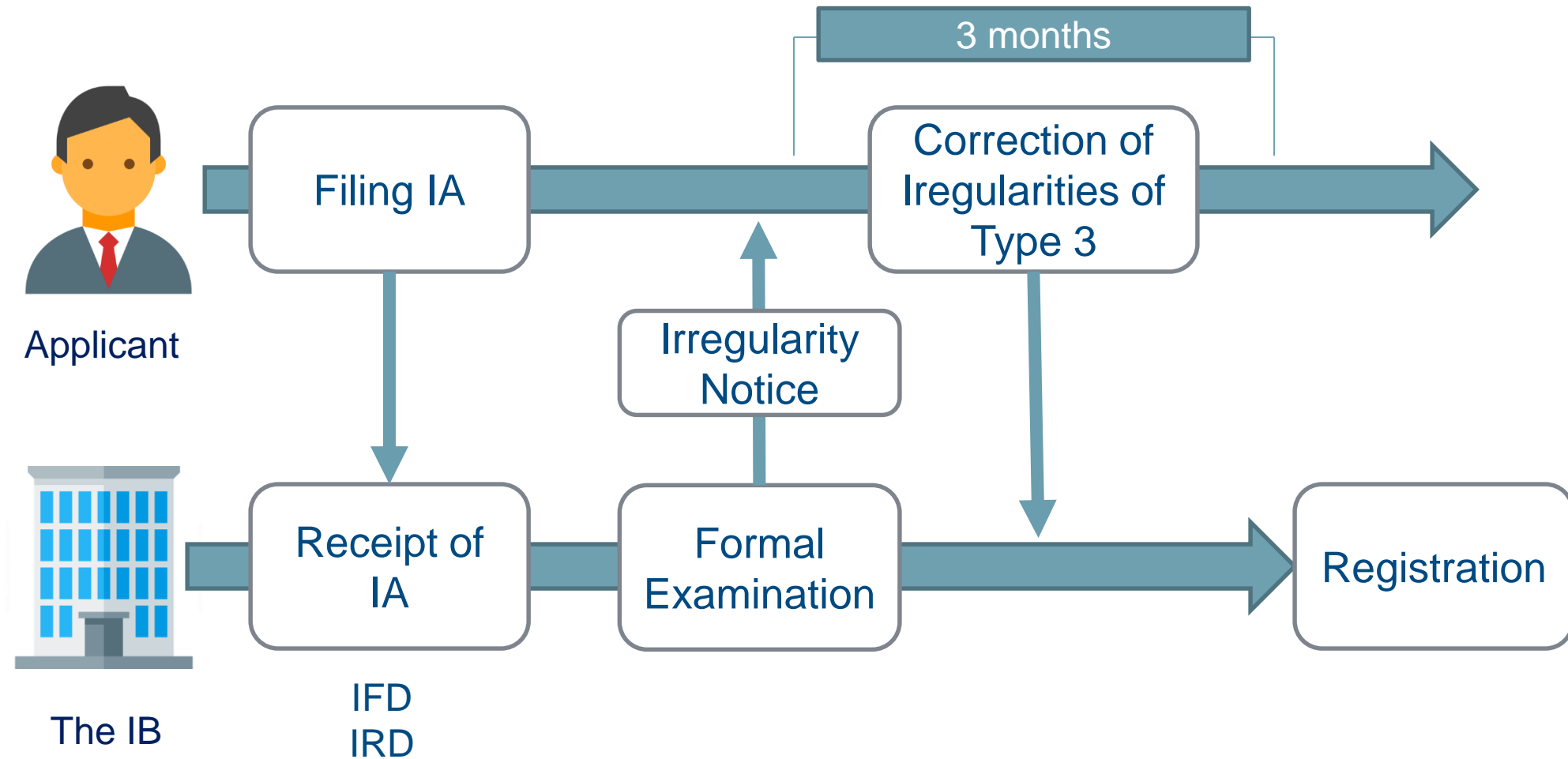
FORMAL EXAMINATION BY THE IB – IRREGULAR APPLICATION (1)



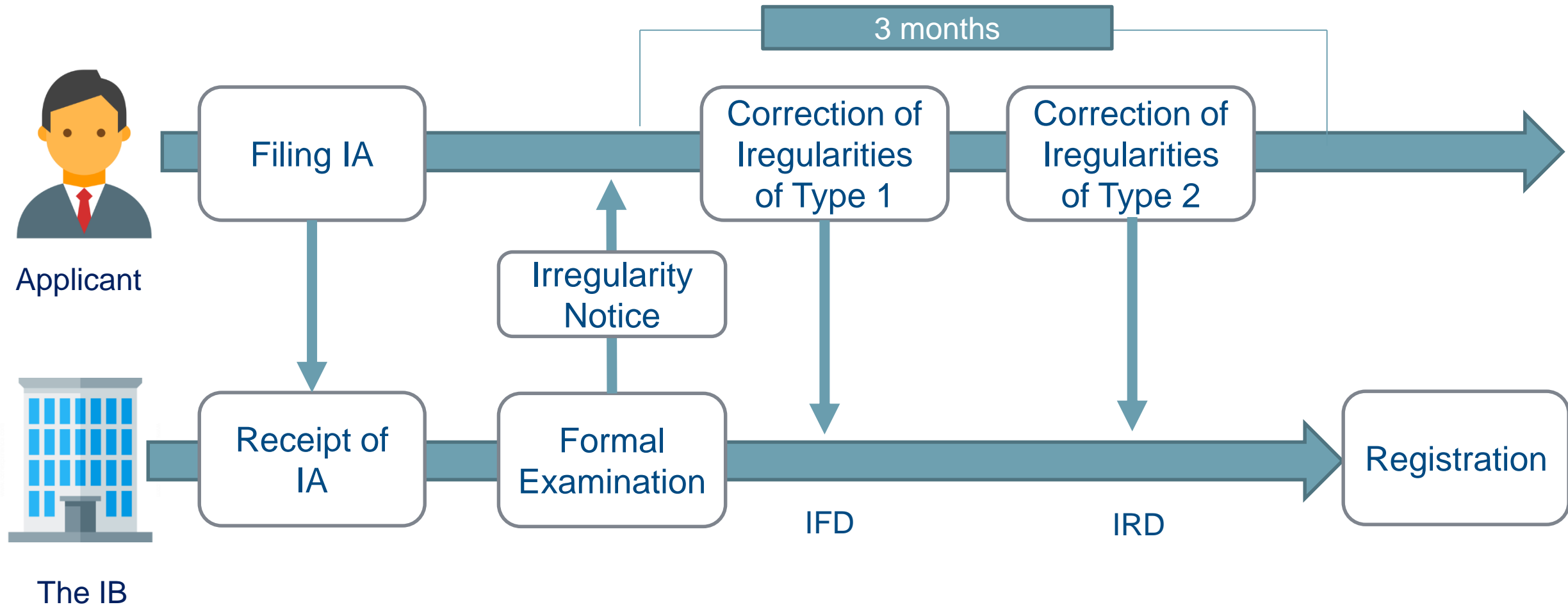
FORMAL EXAMINATION BY THE IB – IRREGULAR APPLICATION (2)



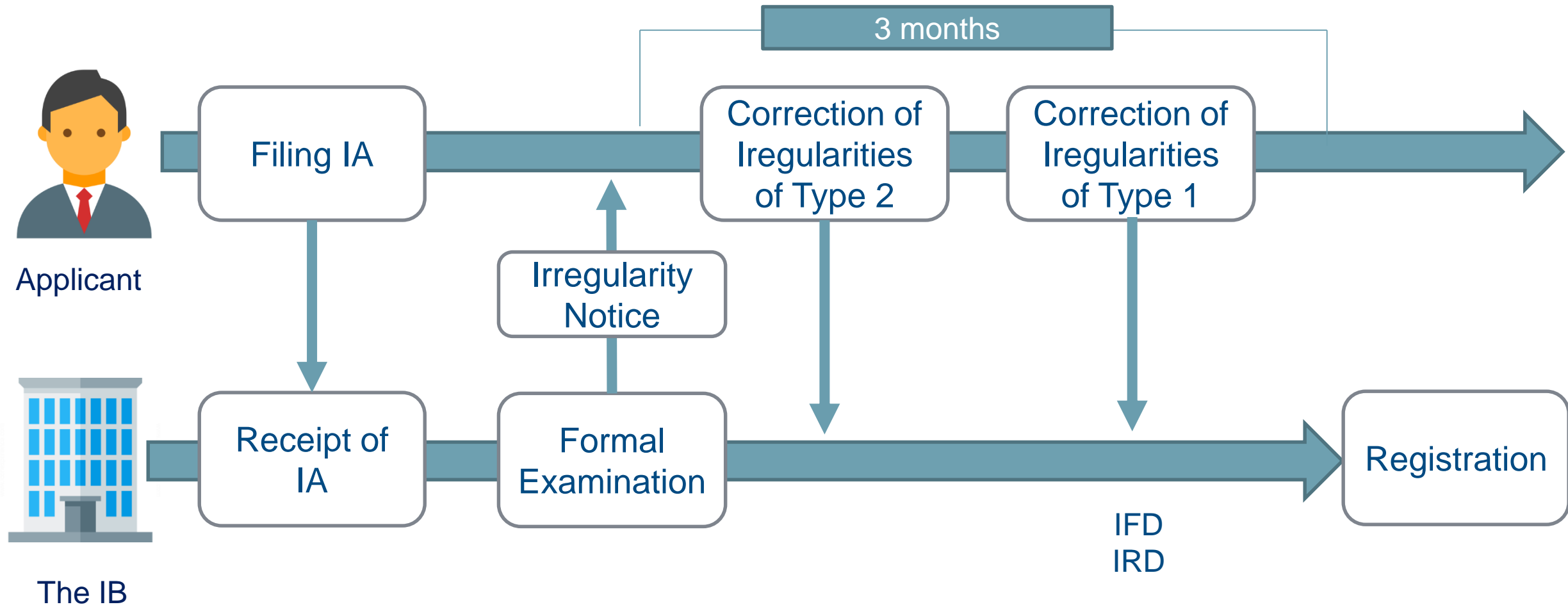
FORMAL EXAMINATION BY THE IB – IRREGULAR APPLICATION (3)



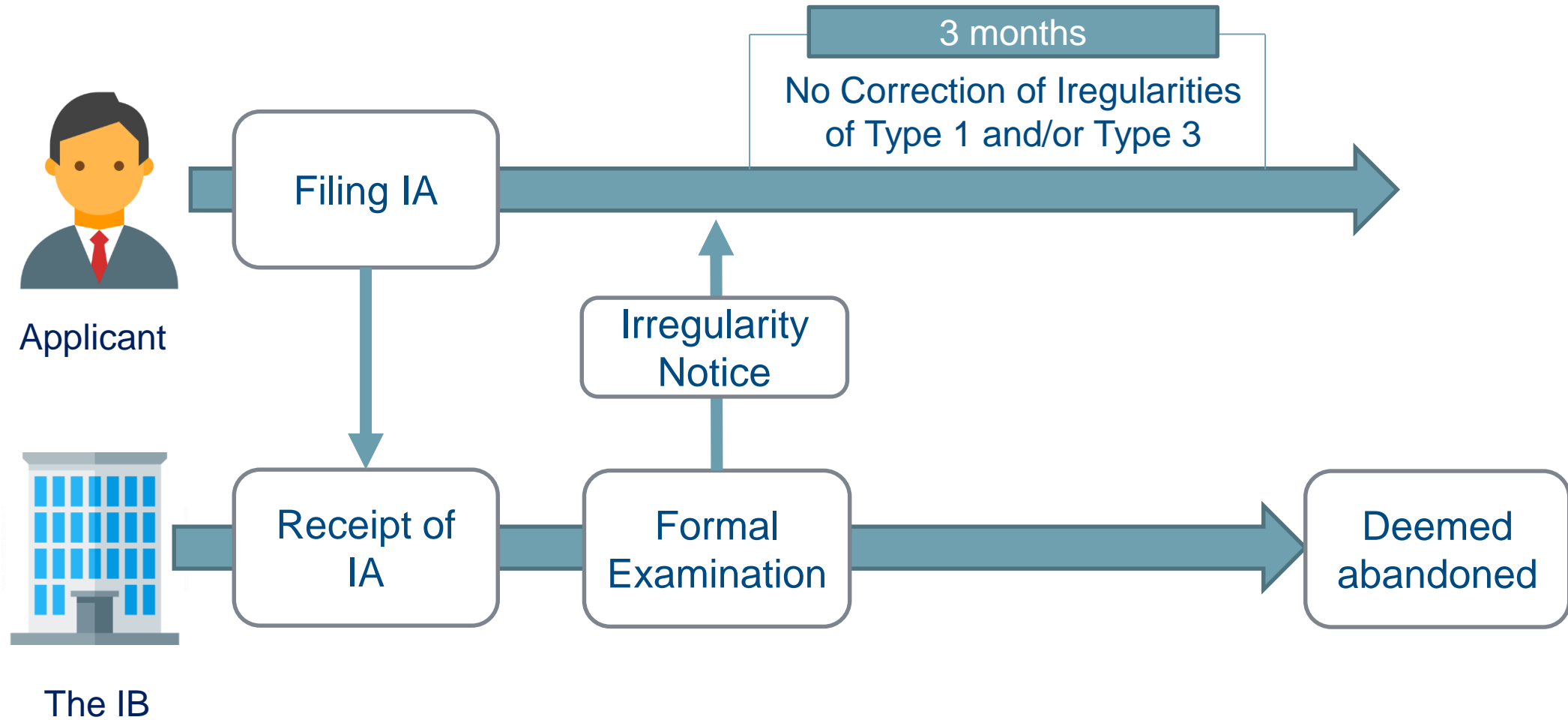
FORMAL EXAMINATION BY THE IB – IRREGULAR APPLICATION (4)



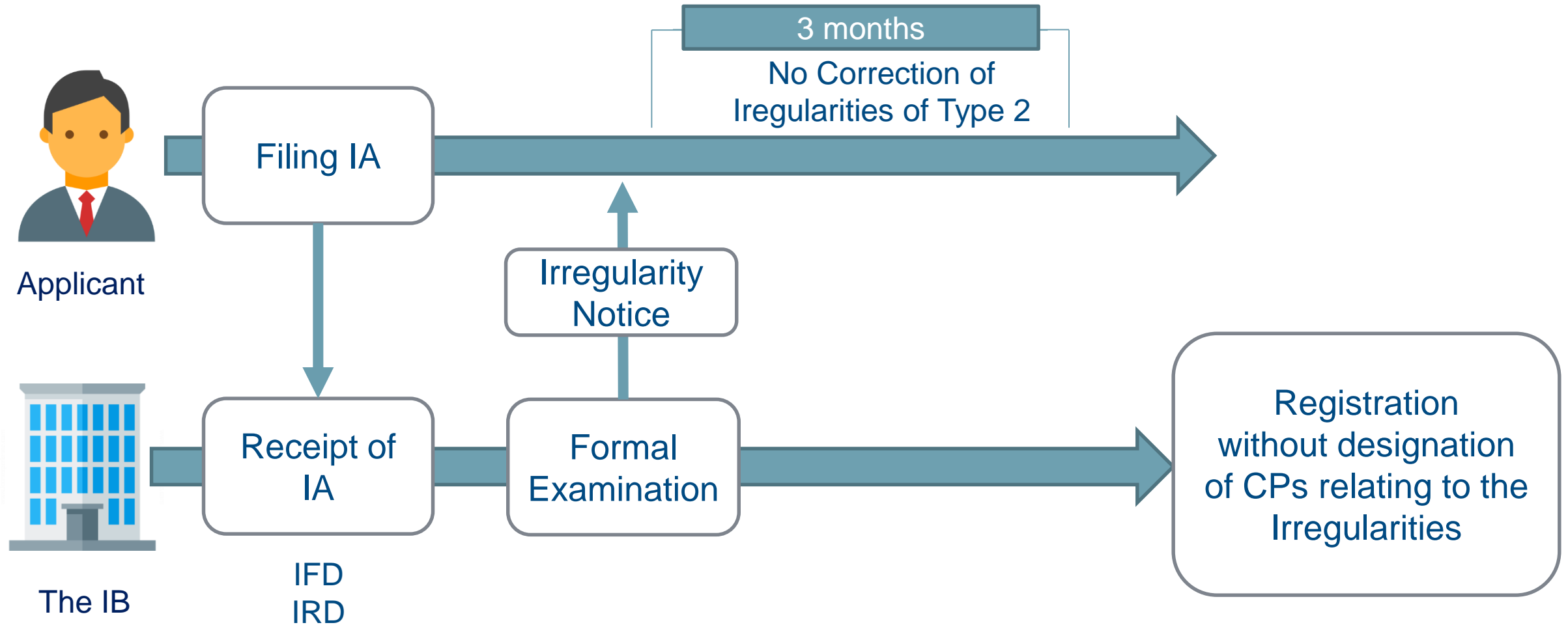
FORMAL EXAMINATION BY THE IB – IRREGULAR APPLICATION (5)



FORMAL EXAMINATION BY THE IB – IRREGULAR APPLICATION (6)



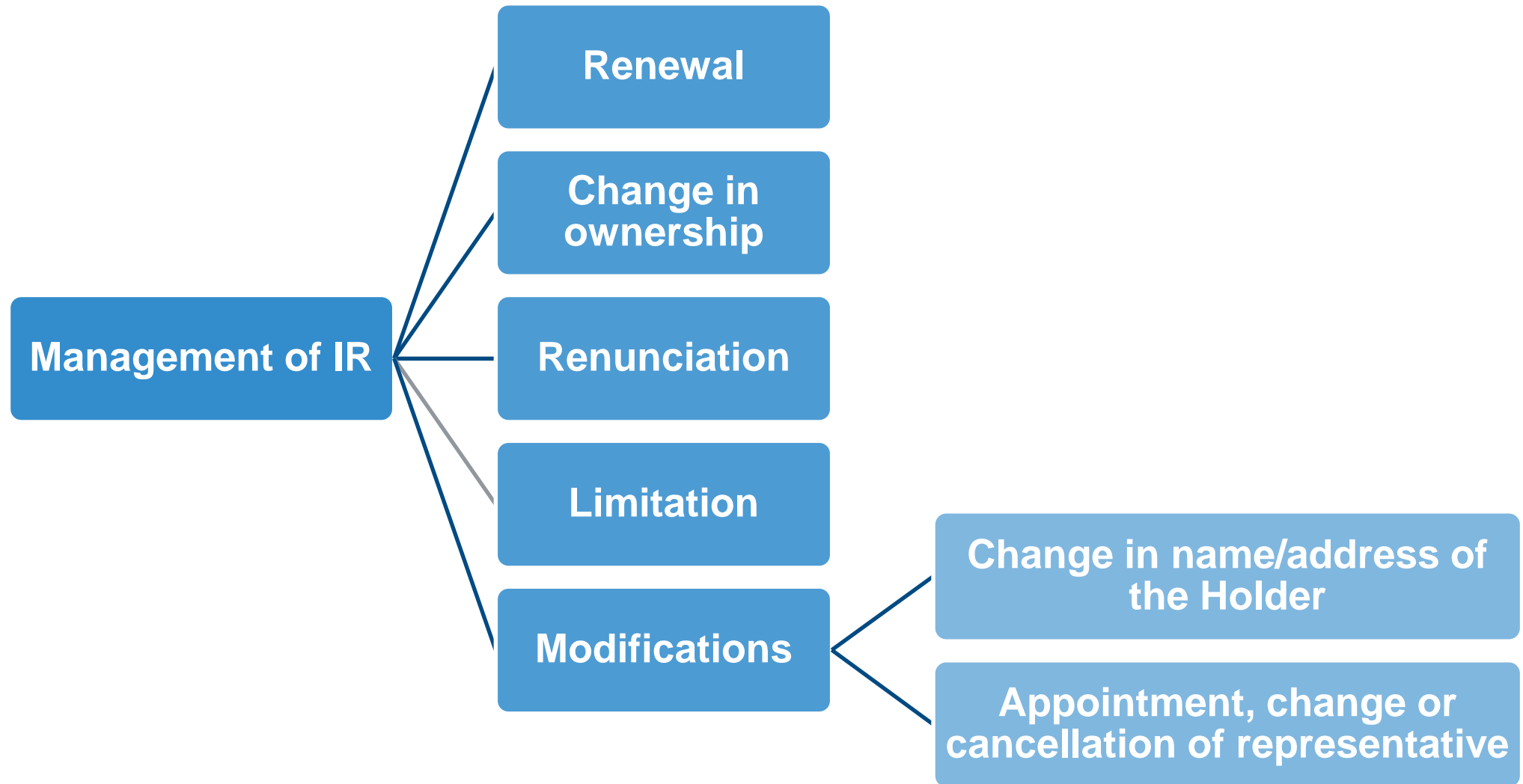
FORMAL EXAMINATION BY THE IB – IRREGULAR APPLICATION (7)





MANAGING YOUR INTERNATIONAL DESIGN REGISTRATION

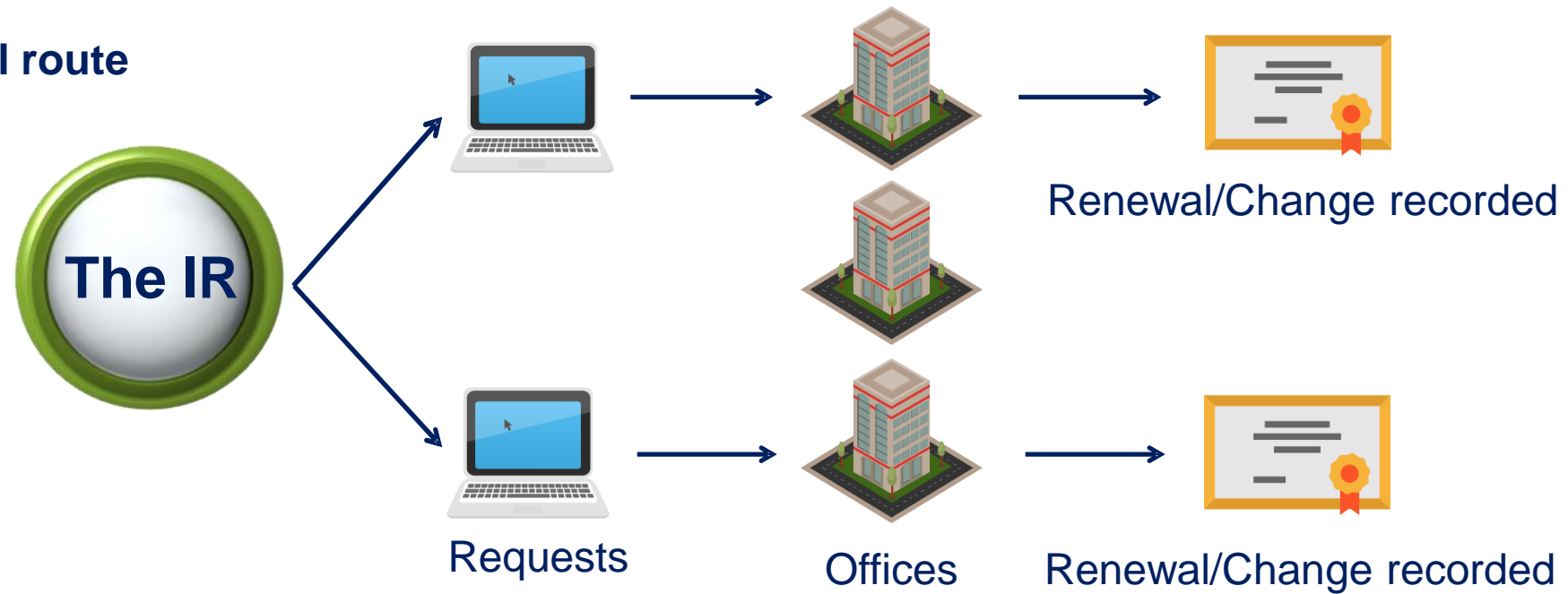
MANAGEMENT OF IR (1)



- ❑ Long-term advantages of having a single registration
- ❑ Central management for renewals and modifications
 - ❖ single renewal date and cycle to monitor
 - ❖ single request
 - ❖ single set of requirements
 - ❖ one language
 - ❖ single payment in a single currency

MANAGEMENT OF IR (3)

Traditional route



The Hague route



- ☐ IR is valid for an initial period of five years
- ☐ May be renewed for at least two additional periods of five years (minimum term of protection: 15 years)
- ☐ Longer term of protection may be applied if allowed by the law of the DCP
- ☐ In respect of those CPs that provide for longer terms of protection (20, 25 or 50 years), the IR may be renewed for additional periods of five years up to the expiry of the total duration of protection provided for in their law

- ❑ Six months before the expiry of each five-year term, the IB will send Holder a notice indicating the expiry date of the IR.
- ❑ Partial renewal:
 - ❖ IR may be renewed for some only of the DCPs
 - ❖ IR may be renewed for some only of the industrial designs
- ❑ The renewal fees should be paid to WIPO on the date of expiry of the IR at the latest
- ❑ Grace period: The payment can be made up to six months after the expiry date but a surcharge must be paid at the same time. WIPO records the renewal with the due date

□ Modality:

- ❖ Request by using the Hague E-Renewal System (<https://hague.wipo.int/renewal/IndexController?lang=EN>) – recommended
- ❖ Request by sending the paper form DM/4 to the IB (the form can be downloaded at <http://www.wipo.int/hague/en/forms/>)
- ❖ Request by sending a simple communication to WIPO indicating the IR number and the payment of the renewal fees

CHANGE IN OWNERSHIP (1)

- ❑ The Holder may request the IB to record the transfer of rights to a new owner
 - ❖ for all or some of the industrial designs
 - ❖ in respect of all or some of the DCPs
- ❑ Such recording can only take place if the new owner is also entitled to use the Hague System
- ❑ The request must be submitted to WIPO in the form DM/2

CHANGE IN OWNERSHIP (2)

- ☐ The change in ownership recorded in the International Register has immediate effects in all the DCPs concerned
- ☐ A CP may declare that recording of change in ownership shall not have effect in that CP until its Office has received certain statements or documents (OAPI, DK, MX, KR, RU, US)
- ☐ A CP may declare that the partial change in ownership has no effect in its territory.

THE ROLE OF IP OFFICES

- ❑ Giving advice to national applicants:
 - ❖ Advantages of the Hague system to obtain design protection in various countries
 - ❖ How to prepare and file an IA
 - ❖ How to deal with irregularities and refusals of protection
 - ❖ How to manage the IR
- ❑ Role as transmittal Office in case of indirect filing of IA (optional)

THE ROLE AS THE OFFICE OF A DCP (1)

- ☐ NO formal examination
- ☐ Substantive examination: same as for applications filed under the national law

→ Possible Office Actions

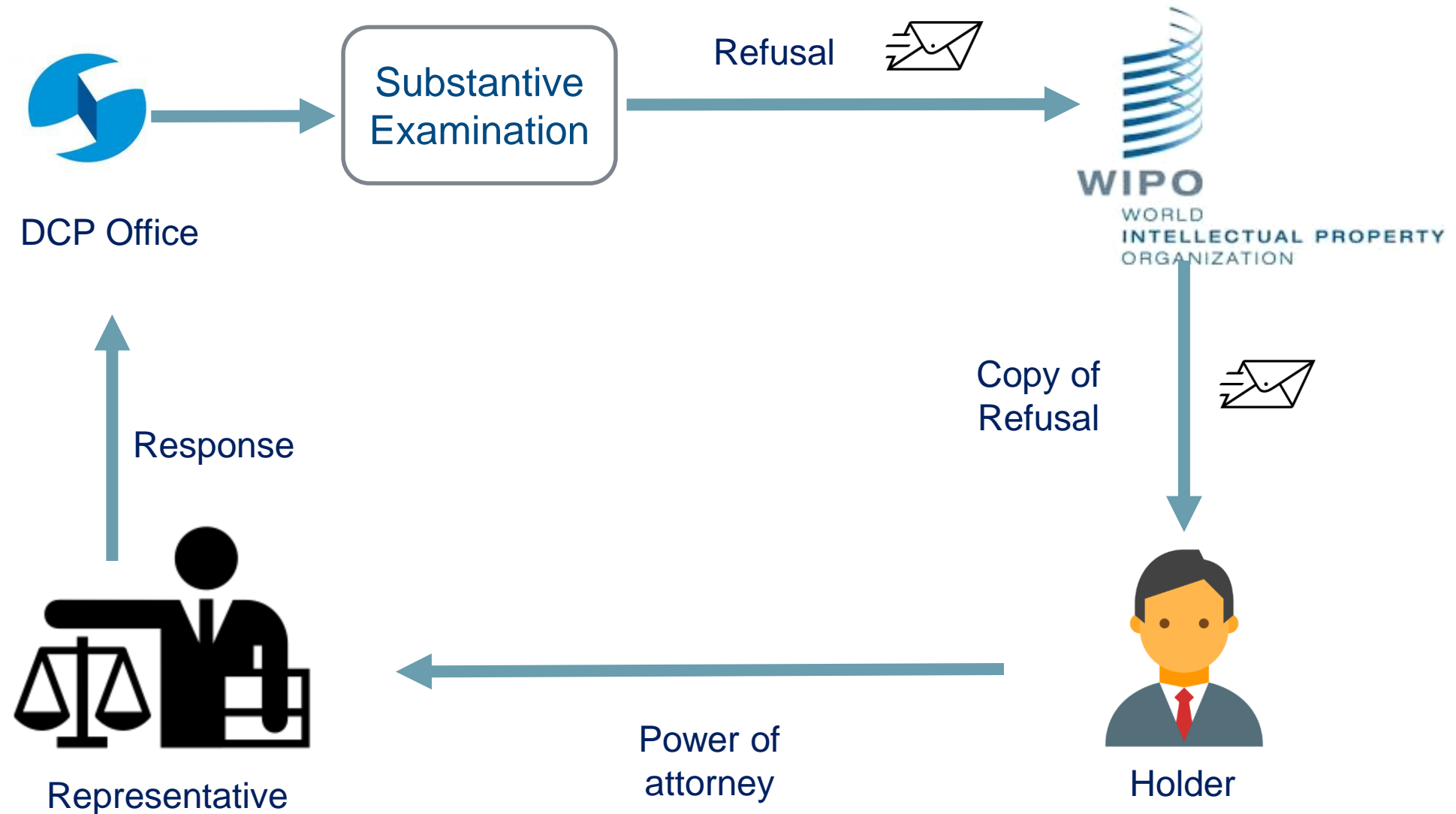
- ☐ Statement of Grant of Protection (SGP)
- ☐ Refusal
- ☐ Withdrawal of Refusal
- ☐ Invalidation

- ❑ Refusal if any must be sent to the IB within the time limits from the publication date of the IR
 - ❖ 6 months (Article 12(2) of the Geneva Act 1999 and Rule 18(1)(a))
 - ❖ Exeptions (Rule 18(1)(b)): Declaration made by the CP whose Office is an Examining Office or whose law provides for opposition procedure - The time limit is extended to 12 months

REFUSAL PRINCIPLES

- ☐ Total or partial refusal (may relate to all or some designs)
- ☐ The holder has the same rights and remedies as if the design had been filed directly with the CP's Office
- ☐ Effect limited to territory of the CP
- ☐ Provisional refusal, but may become final refusal (no need of further notification from the CP Office)

REFUSAL NOTICE



REFUSAL GROUNDS

- ❑ No formal grounds (already examined by the IB)
- ❑ Only substantive grounds (Article 12(1) of Geneva Act 1999)
 - ❖ Substantive grounds that would apply under the law of the DCP to industrial designs filed directly with its Office
 - ❖ Opposition by a third party (if this procedure is provided by the national law)
- ❑ Exeptions:
 - ❖ Unity of design requirements as in declaration by the DCP (Article 13)
 - ❖ Specific views of the design not provided as in declaration by the DCP (Rule 9(3)(a))
 - ❖ The reproductions are not sufficient to disclose fully the industrial design (Rule 9(4))

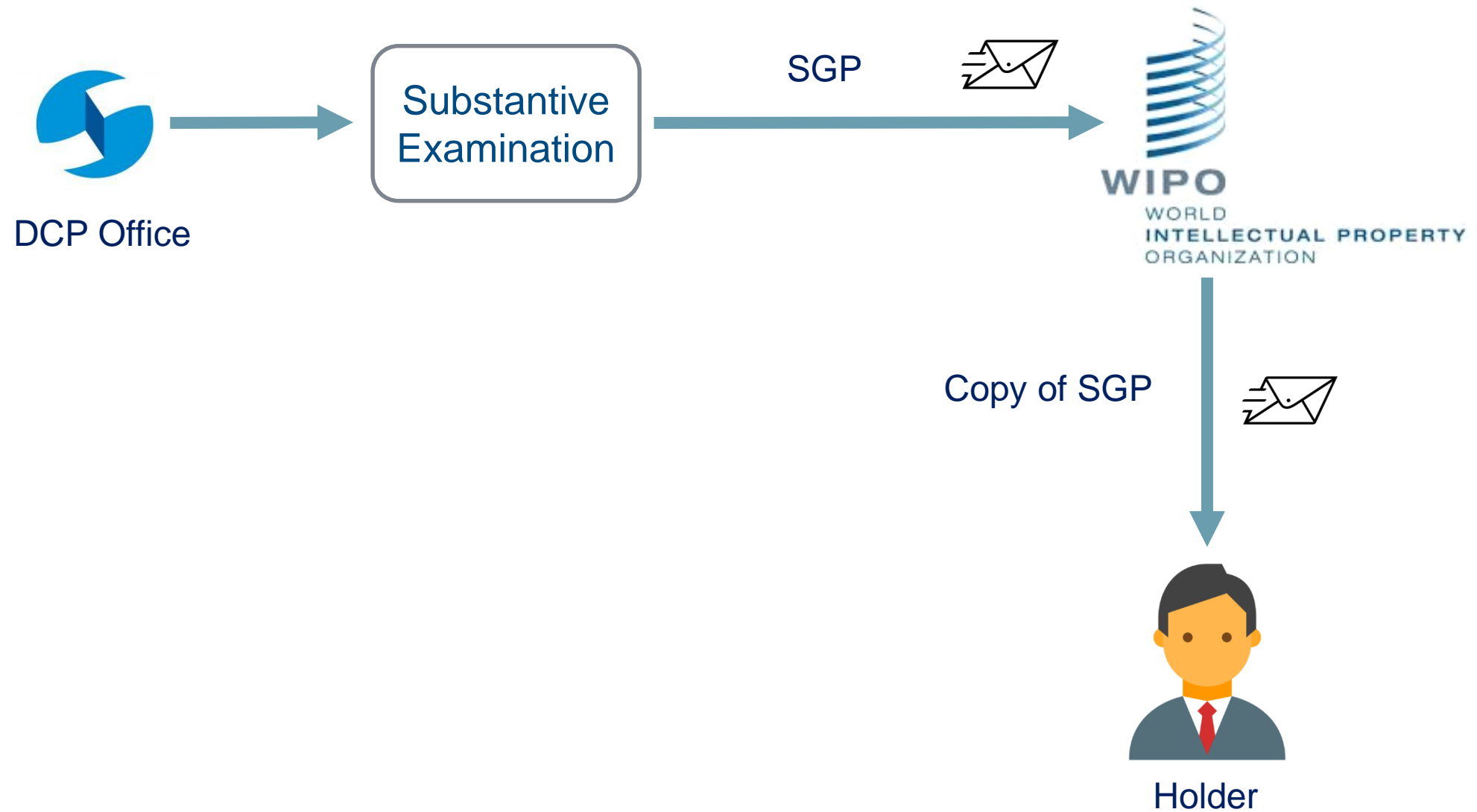
WITHDRAWAL OF REFUSAL

- ❑ Refusal may be withdrawn (Rule 18(4))
- ❑ The withdrawal may relate to all or some designs (total or partial withdrawal)
- ❑ Shall include:
 - ❖ Indication of the date on which the designs in the IR became protected
 - ❖ All amended elements if the IR was amended before the Office
- ❑ May take the form of a Statement of Grant of Protection (SGP) following a Refusal (Rule 18bis(2))

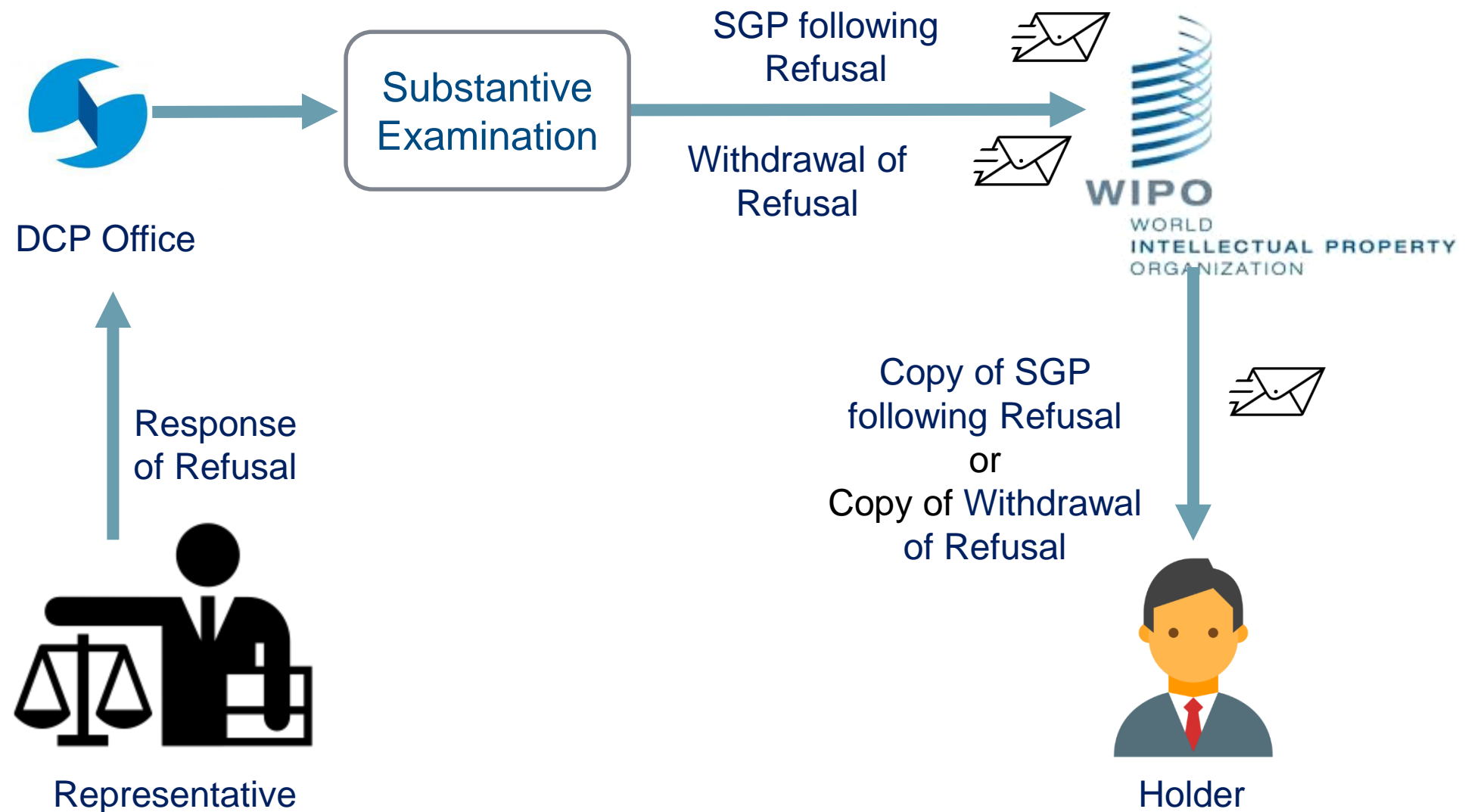
STATEMENT OF GRANT OF PROTECTION

- ❑ SGP following a Refusal or in the absence of a prior Refusal
- ❑ Where no prior Refusal: the SGP is optional but recommended (Rule 18bis(1))
- ❑ SGP must include:
 - ❖ Indication of the date on which the designs in the IR became protected
 - ❖ Indication as to which designs are protected or not (total or partial SGP)
 - ❖ All amended elements if the IR was amended before the Office

STATEMENT OF GRANT OF PROTECTION



GRANT OF PROTECTION FOLLOWING REFUSAL



INVALIDATION

- ❑ Where the effects of an IR are invalidated
- ❑ Only the final decision shall be sent to the IB (no longer subject to any review or appeal)
- ❑ Invalidation Notification must include:
 - ❖ Indication of the date on which the invalidation was pronounced and its effective date
 - ❖ Indication as to which designs are invalidated (total or partial invalidation)



Q&A



THANK YOU!