

A Guide to The Hague System for the International Registration of Industrial Designs

Introduction

The Hague System provides for acquiring, maintaining and managing registered design protection internationally.

The UK will join the Hague System as an independent member on 13 June 2018.

Amongst other advantages, this will safeguard future access to the Hague System when the UK leaves the EU.

Virginia Driver and Ian Whitfield, patent attorneys at Page White and Farrer, provide an overview of the Hague System for international registration of industrial designs.

December 2017.

Members of the Hague System

There are currently 68 individual countries signed up to the Hague System. The latest list of members can be found at <http://www.wipo.int/hague/en/members/>. China is not yet a member but is expected to sign up in the future.

In addition to the individual member states there are three member organisations, which bring the total number of countries that can be covered in the Hague System application to 83:

- Benelux
- The EU Intellectual Property Office
- African Intellectual Property Organisation

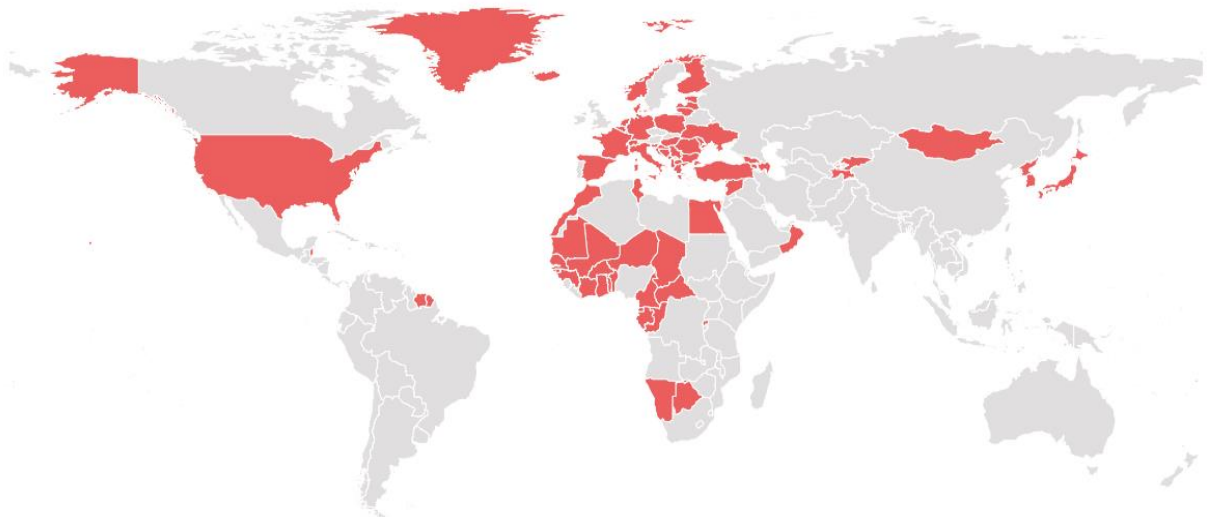


Figure 1: Hague System Members, Source WIPO

Who can apply?

There are three different independent Acts under which the Hague System operates:

- the London Act of 2 June 1934;
- the Hague Act of 28 November 1960; and
- the Geneva Act of 2 July 1999.

The three Acts are independent of one another. Some states are party to only one Act, some states are party to two, and some states are party to all three of the Acts.

The EUIPO has signed up only to the Geneva Act. Therefore, for UK and EU design owners, only the member states and organisations party to the Geneva Act can be designated.

The Hague System is a closed system. To be entitled to file a Hague System application, an applicant must:

- a) be a national of a member state/organisation, or
- b) have a domicile in the territory of a member state/organisation, or
- c) have a real and effective industrial or commercial establishment in the territory of a member state/organisation, or
- d) habitually reside in a member state/organisation.

Filing

A Hague System application may be filed directly at the International Bureau in Geneva or at the office of a member state/organisation. An application may conveniently be filed online, which is easier, cheaper and faster than paper filing.

Unlike the Madrid Protocol, which is the international registration system for trade marks, no home application or registration is required. This removes the vulnerability of a central attack on a home registration, which under the Madrid Protocol causes cancellation of the whole international registration.

Up to one hundred designs can be included in the same application, provided that they are all for the same class of designs (according to the International Classification of Industrial Designs). There is an exemption for the US given that it typically does not allow multiple designs in same application.

There is no limit on the number of representations that can be included for each design.

Desired member states or organisations must be designated on filing. It is not possible to add member states or organisations after filing.

Fees

Official fees consist of a basic fee, a publication fee, and a designation fee in respect of each designated state or organisation. Fees are payable in Swiss Francs.

There is a big variation in the designation fee between member states and organisations. For example for the EU the designation fee is 67 Swiss Francs for a design, but for Japan the designation fee is 665 Swiss Francs.

Some member states such as the US impose a fee that is payable on grant of the application.

Prosecution

The prosecution of a Hague System application consists of two stages: a formalities examination by the International Bureau; and an optional substantive examination by the offices of the designated states/organisations.

Formal examination by the International Bureau

Upon receipt of a Hague System application, the International Bureau will check that it complies with its prescribed formal requirements, including the payment of the official fees and the quality of the representations of the designs in the application form.

If the International Bureau identifies any defects, it will inform the applicant and the defects must be corrected within three months. If the defects are not corrected, the application will be deemed abandoned.

The International Bureau does not examine the novelty of the design(s) in a Hague System application and it is therefore not entitled to reject a Hague System application on substantive grounds.

Substantive examination by the office of each designated state or organisation

The application is published in the International Designs Bulletin on the WIPO website after it has passed through formal examination.

The offices of the designated states/organisations then have six months from the date of publication of the application to issue a notice of refusal to the International Bureau if they consider that the application or a design does not fulfil the substantive grounds of their national legislation. A notice of refusal cannot be issued on formal requirements because formal examination has already been carried out by the International Bureau.

Any designated office that substantively examines design applications or whose law provides for oppositions, such as the US, can request that the period to issue a notice of refusal is twelve months rather than six months.

Responding to a notice of refusal

The International Bureau will inform the applicant, or his agent if there is one, if a designated office issued a notice of refusal. The applicant then has the same remedies as if the application was filed directly with the particular designated office. Responding to the notice of refusal does not involve the International Bureau. Appointment of a local attorney may be required.

International registration

If no notice of refusal is issued by the office of a designated state or organisation within the time limit, or if the refusal has subsequently been withdrawn because the objections have been addressed the application, the application proceeds to registration. International registration has the same effect as grant of a registered design application in that state or organisation.

Duration of protection

The initial period of an international registration under the Hague System is five years.

The renewal periods are in blocks of five years up to the expiry of the total term of protection allowed by a designated state or organisation. This varies, but is at least 15 years and in most states and organisation it is 25 years.

Renewals

Renewals are handled centrally by the International Bureau.

It is possible to renew some or all of the designs, and for some or all of the designated states/organisations.

Advantages

By filing a single application centrally rather than having to file separate national applications, there is a saving in time and administrative burden, and therefore costs.

There will be a saving in local attorney charges if no objections are raised by the offices of the designated states/organisations.

There is also a saving in time and administrative burden, and therefore costs, for renewals and registration of assignments and licenses because these are dealt with centrally by the International Bureau. It is not necessary to deal with the offices of the designated states/organisations.

Disadvantages

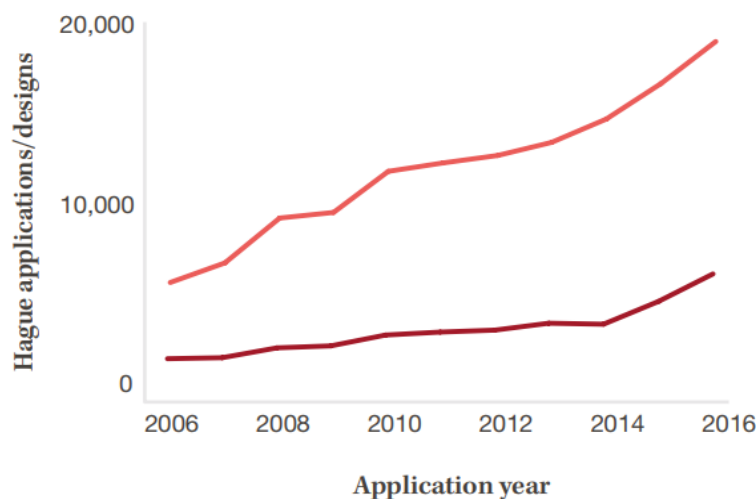
A big problem with the Hague System is that there is no uniform drawings standard between the member states/organisations. Therefore, each country still has different substantive drawing requirements and different drawing sets may be needed depending on which countries are designated. Given the different drawings requirements across the world, it is doubtful that a uniform drawings standard will ever be introduced.

The Hague System is also not particularly flexible because an applicant must designate all desired member states and organisations on filing.

The Hague System in 2016

5,562 Hague System applications were filed in 2016, which is an increase of 35.3% from 2015. These 5,562 applications contained 18,716 designs, an increase of 13.9% from 2015. This is the tenth consecutive year of growth. The high growth in the number of applications filed has been attributed to the recent expansion of the Hague System to include Japan, South Korea and the USA.

Trend in international applications and designs contained in international applications



■ APPLICATIONS ■ DESIGNS

Figure 2: Trend in Hague System Applications, Source WIPO

Applicants from Germany (3,917 designs) were by far the largest users of the Hague System in 2016, followed by Switzerland (2,555), South Korea (1,882), the USA (1,410) and the Netherlands (1,317).

European applicants accounted for 71.9% of the designs contained in Hague System applications.

The number of member states and organisations designated in each Hague System application increased by an average of 13.7% in 2016.

As usual, the EU was the most designated member state/organisation with 4,088 designations containing 14,952 designs. The EU has been the most popular designated member state/organisation since 2010. It was followed by Switzerland (8,811 designs), Turkey (6,137), the USA (4,722) and Norway (3,324).

Hague System applications cover a wide variety of industries. In 2016, designs relating to furnishing (12.6%) had the largest share of the total designs. This was followed by recording and communication equipment (11.3%), means of transport (8.2%) and clocks and watches (7.1%).

Finally, the total number of Hague System registrations in force in 2016 increased by 9.7% to 32,187 registrations containing 131,953 designs.

This briefing is for general information purposes only and should not be used as a substitute for legal advice relating to your circumstances. We can discuss specific issues and facts on an individual basis. Please note that the law may have changed since the day this was first published in December 2017



Virginia Driver
Partner

virginia.driver@pagewhite.com



Ian Whitfield
Associate

ian.whitfield@pagewhite.com

Bedford House
John Street
London WC1N 2BF

www.pagewhite.com