

International Design Registration - The Hague Agreement

The Hague Agreement is a system which enables design owners who belong to certain countries to apply centrally for designs for a number of states and/or intergovernmental organizations (in particular the Community Designs Office), rather than having to make separate applications for each state and/or intergovernmental organization.

THE COMMUNITY DESIGN OFFICE AND THE HAGUE AGREEMENT

There are three different acts under which the Hague Agreement operates:

- The London Act of 2 June 1934
- The Hague Act of 28 November 1960
- The Geneva Act of 2 July 1999

The three acts are independent of each other; some states are party to only one act, some to two, and others all three.

The Community Designs Office has only signed up to the Geneva Act, and so for UK design owners only the states and intergovernmental organizations (“contracting parties”) governed by the Geneva Act can be designated

This information sheet relates only to the Geneva Act.

Who can use the system?

It is not open to everyone; the applicant has to be

- a) a national of a contracting party, or
- b) have a domicile in the territory of a contracting party, or
- c) have a real and effective industrial or commercial establishment in the territory of a contracting party, or
- d) habitually resident in a contracting party

How does one apply?

The application is filed directly at the World Intellectual Property Organization in Geneva. Unlike the International Registration system for trademarks, no home application or registration is required. 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). Note however some contracting parties have particular requirements which will mean in some circumstances the International Registration will not be effective for all the designs for that contracting party. Official fees are payable and depend upon the number of designs, whether publication is to take place immediately and the particular contracting parties designated.

There is no limit on the number of representations that can be included for each design. It is possible to enter disclaimers. It is also possible to include a description of the design and/or include the identity of the creator of the design; for some contracting parties inclusion of one or both of these is mandatory.

Deferment of publication

It is possible in some cases to request that the publication of the designs be deferred by up to 30 months from the filing date, or, where priority is claimed, from the priority date. However some contracting parties have a shorter deferment period, and some do not allow deferment at all.

Formal examination by WIPO

WIPO will check that the application complies with its formal requirements, in particular the payment of the official fees and the quality of the representations of the designs in the application form. Note that WIPO does not examine on substantive grounds; it is for the national offices to reject designs, for example on the grounds of lack of novelty.

Procedures after formal examination by WIPO

Once formal examination has been concluded, and any formalities objections have been dealt with, the application is recorded in the International Register and is published. Publication takes place electronically on WIPO’s website. Publication normally takes place six months after registration (to reflect the fact that there is often a similar delay under national law, in order that designs are not immediately made public). A request can be made for publication to take place as soon as possible. Conversely, depending upon the designated parties, deferment can be requested.

It is then up to the designated offices to check the publications on the internet and identify those designs in which they have been designated.

The designated offices have six months to issue a notice of refusal to WIPO that the design does not comply with their legislation on substantive grounds; they cannot object on formal grounds, as WIPO has already done that check.

Where a designated office examines design applications, or if their law has provisions for oppositions, then the designated office can request that the refusal period can be twelve months rather than six months.

What if there is a notice of refusal?

WIPO will notify the applicant, or his agent, if there is one. Responding to the refusal does not involve WIPO; the matter has to be taken up with the designated office concerned.

What are the effects of the International Registration?

Assuming that no notices of refusal have been issued, or else they have been withdrawn, the International Registration has the same effect as if design protection had been applied for directly at the designated offices concerned.

What is the life of an International Registration?

The initial period of an International Registration is five years. The renewal periods are likewise five years, but only up to the normal duration of design protection in the designations concerned; this varies from designated office to designated office; in most cases it is 25 years, but for some it is 10 or 15 years. Please see the list of contracting parties at the end of this sheet for details.

Renewal procedure

Renewals are dealt with through WIPO; it is possible to renew some or all of the designs, and for some or all of the designations.

Recordal of changes

Various changes relating to the designs are recorded through WIPO:

- changes of name and address of the owner
- recordal of transfers (which may be for some or all of the designations and/or some or all of the designs)
- renunciation of all of the designs, in respect of any or all of the designations
- limitation of the designs, in respect of any or all of the designations

Advantages of using the Hague Agreement

There is a clear saving in being able to apply centrally to cover a number of designated offices, and being able to deal with the recordal of changes and renewals centrally, rather than office by office.

Assuming that objections do not arise, there will also be a saving in local design attorney's charges.

LIST OF CONTRACTING PARTIES TO THE GENEVA ACT AS AT 15 OCTOBER 2008

African Intellectual Property Organization ^{#15T}	Latvia ^{E25}
Albania ¹⁵	Liechtenstein ²⁵
Armenia ¹⁵	Lithuania ^{E25B}
Bosnia and Herzegovina ^{10A}	Macedonia ²⁵
Botswana ¹⁵	Moldova ²⁵
Bulgaria ^{E25N}	Mongolia ¹⁰
Croatia ^{25T}	Namibia ¹⁵
Denmark ^{E25*B}	Romania ^{E25N}
Egypt ¹⁵	Sao Tome and Principe ^{15C}
Estonia ^{E25T}	Singapore ^{15N}
European Community ²⁵	Slovenia ^{E25T}
France ^{EA25}	Spain ^{E25}
Georgia ¹⁵	Switzerland ²⁵
Ghana ¹⁵	Syria ^{15T}
Hungary ^{E25}	Turkey ²⁵
Iceland ^{25N}	Ukraine ^{15N}
Kyrgyzstan ¹⁵	

^Δ Including all Overseas Departments and Territories

^T Only twelve month deferment of publication

^N No deferment of publication

^E Member of the European Community

¹⁰ Maximum duration ten years

¹⁵ Maximum duration fifteen years

²⁵ Maximum duration twenty five years

[#] Member countries are Benin, Burkina Faso, Cameroon, Central African Republic, Chad, Congo, Ivory Coast, Equatorial Guinea, Gabon, Guinea, Guinea Bissau, Mali, Mauritania, Niger, Senegal and Togo

^{*} But only 15 years for items for the repair of a combined product.

^A As from 24 December 2008

^B As from 9 December 2008

^C As from 8 December 2008

www.mewburn.com

mail@mewburn.com

This information is simplified and must not be taken as a definitive statement of the law or practice. For more information on Mewburn Ellis LLP and other intellectual property matters, please contact us or visit our website at www.mewburn.com. Mewburn Ellis LLP is a Limited Liability Partnership registered in England (no. OC306749). Registered Office at 33 Gutter Lane, London EC2V 8AS

London

33 Gutter Lane
London
EC2V 8AS

Tel: 020 7776 5300

Fax: 020 7776 5399

Bristol

22-24 Queen Square
Bristol
BS1 4ND

Tel: 0117 945 1234

Fax: 0117 926 5692

Manchester

Bridgewater House
Whitworth Street
Manchester M1 6LT

Tel: 0161 247 7722

Fax: 0161 247 7766

Cambridge

Newnham House
Cambridge Business Park
Cambridge CB4 0WZ

Tel: 01223 420383

Fax: 01223 423792