

Timing of the Publication of an International Registration under the Hague System for the International Registration of Industrial Designs

Questionnaire

The purpose of this Questionnaire is to offer non-governmental organizations (NGOs) representing users of the Hague System an opportunity to comment on the proposed extension of the standard publication period of international registrations from the current six months to 12 months.

BACKGROUND

WORKING GROUP DECISION IN 2019

The Working Group on the Legal Development of the Hague System for the International Registration of Industrial Designs (hereinafter referred to as the “Working Group”) discussed at its eighth session, held in Geneva from October 30 to November 1, 2019, a proposal to extend the six-month standard publication period currently provided for in Rule 17(1)(iii) of the Common Regulations Under the 1999 Act and the 1960 Act of the Hague Agreement (hereinafter referred to as the “Common Regulations”) to a period of 12 months (document H/LD/WG/8/6). At that session, the Working Group requested the International Bureau of the World Intellectual Property Organization (WIPO) to consult with user groups on this proposal and report back on its findings at the next session of the Working Group (document H/LD/WG/8/8 “Summary by the Chair”, paragraph 20).

CURRENT PROVISIONS ON PUBLICATION UNDER THE HAGUE SYSTEM

In general, the publication of an international registration takes place six months after the date of the international registration (hereinafter referred to as “standard publication”), unless the applicant requested immediate publication or deferment of publication, which cannot exceed 30 months under the Geneva Act (1999) or 12 months under the Hague Act (1960), counted from the filing date or, where priority is claimed, from the priority date¹.

In relation to the 1999 Act, however, some Contracting Parties have made a declaration that their domestic legislation only provides for a deferment period shorter than 30 months². To date, 16 Contracting Parties have made such a declaration³. Moreover, some other Contracting Parties have made a declaration that their legislation does not provide for deferment of publication at all⁴. To date, nine Contracting Parties have made that declaration⁵.

Consequently, if the international application designates “one” Contracting Party that has made a declaration under the 1999 Act in accordance with which deferment of publication is not possible at all under its law, the applicant cannot benefit from a deferment of publication, and publication takes place six months after the date of the international registration.

HISTORICAL BACKGROUND AND CURRENT SITUATION

The current six-month period for standard publication was agreed on and adopted at the Diplomatic Conference for the Adoption of a New Act of the Hague Agreement Concerning the International Deposit of Industrial Designs (Geneva Act) in 1999, following a suggestion by the Committee of Experts on the Development of the Hague Agreement Concerning the International Deposit of Industrial Designs.

The above suggestion took into account the fact that under some national and regional systems, a certain period of time lapses before the publication of an industrial design due to its examination (whether it is formal or substantive) and the technical preparations for publication⁶. The six-month period was therefore chosen to intend to grant the holder of an international registration the same benefit of *de facto* deferment which they would have enjoyed if they had filed national applications⁷.

However, as the membership of the 1999 Act expands to include a variety of national and regional systems, the seminal purpose of the standard publication scheme has been obscured. Indeed, the Offices of some of the Contracting Parties having made a declaration that their legislation does not allow deferment of publication carry out the examination as to novelty, among other requirements. As under the domestic systems in question, designs are published only after the issuance of a design patent or registration, the publication of design patents or registrations often takes place much later than 6 months from the filing date, and more typically at least 12 months after.

¹ Rule 17(1)(i) to (iii) of the Common Regulations.

² Article 11(1)(a) of the 1999 Act.

³ African Intellectual Property Organization (OAPI) (12 months), Belize (12 months), Benelux (12 months), Brunei Darussalam (12 months), Cambodia (12 months), Croatia (12 months), Denmark (6 months), Estonia (12 months), Finland (6 months), Israel (6 months), Norway (6 months), Samoa (12 months), Singapore (18 months), Slovenia (12 months), Syrian Arab Republic (12 months) and United Kingdom (12 months).

⁴ Article 11(1)(b) of the 1999 Act.

⁵ Hungary, Iceland, Mexico (as from June 6, 2020), Monaco, Poland, Russian Federation, Ukraine, United States of America and Viet Nam.

⁶ Refer to document H/CE/VII/3, Notes on Article 7 (paragraph 7.06), and document H/DC/6, Notes on Rule 17 (paragraph R17.01).

⁷ Refer to document H/DC/6, Notes on Rule 17 (paragraph R17.01).

PROPOSED EXTENSION OF THE STANDARD PUBLICATION PERIOD

The proposal to extend the current standard publication period to 12 months aims to ensure that the seminal purpose of the standard publication scheme is achieved by approximating the standard publication period to the *de facto* deferment period, which users enjoy under the domestic systems of many Contracting Parties.

For details concerning the background and proposal, refer to document H/LD/WG/8/6, available at: https://www.wipo.int/meetings/en/doc_details.jsp?doc_id=452295.

INSTRUCTIONS

Please complete the Questionnaire by checking the appropriate box(es); kindly elaborate on your answers. If additional space is needed, please attach supplementary pages to this Questionnaire clearly indicating the relevant question.

The completed questionnaire should be submitted to the International Bureau of WIPO by email to hague.registry@wipo.int.

QUESTIONNAIRE

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On behalf of [*Organization*]: Bundesverband Deutscher Patentanwälte e.V.

How many members does your organization represent? 800.....

1. Is your organization in favor of extending the standard publication period from six months to 12 months?

Yes

No

Reasons (optional):

In our opinion, the Geneva Act (1999) is very beneficial for the applicants that we represent as the possibility of deferring the publication of the representation for up to 30 months gives applicants the opportunity to protect their new designs without informing competitors before the new design is presented to the public. Therefore, it is possible for the applicant to enhance the product that comprises the design for an extended time without having to be afraid that a competitor will present a similar styled product.

Also, it is possible for the applicant to introduce a whole product line comprising a new kind of style (i.e. "new edge design" of ford, "kodo design" of mazda, minimalism design of apple used by the first iphone/ipod). The competitor isn't aware of this new style and the first presentation of the new style to the public can be made by the applicant with the products of the product line that are each protected. So, the public will give credit of the new style to the applicant and not to a competitor.

If the applicant wishes an early publication, he can request publication according to Rule 17(1)(i). We believe it to be important that this request is maintained and also possible for individual designs from a multiple design application

2. Would your organization see any disadvantages (e.g. for third parties) regarding the extension of the standard publication period to 12 months? Please explain:

In our opinion, a disadvantage for third parties exists in those Member States designated in the application where deferment of publication of the design is not possible and where publication of a design earlier than 12 months after priority date is mandatory. For such parties, there is the risk of infringing an unpublished registered design extended by six months. Third parties of the other Member States have been bearing such a risk for up to 30 months for a long time.

3. If the standard publication period were to be extended to 12 months, would your organization be in favor of the introduction of the possibility to request earlier publication at any time before the expiry of the 12-month standard publication period?

Yes

No

Reasons (optional):

Normally the applicant doesn't know the design of a seasonal product 12 months in advance. If there wasn't the possibility of an earlier publication the applicant would have to contact every possible infringer of the seasonal product beforehand or risk getting no damages. As the seasonal article generally isn't sold for a long time the injunctive relief can't be used effectively. Also, with the possibility to request earlier publication the applicant can react to current events (i.e. corona pandemic) and bring new products to the market that are effectively protected.

4. Does your organization have any other suggestions or concerns in relation to the timing of publication of international registrations?

We prefer that the deferment of publication up to 30 months from the priority date requested by the applicant would be effective in all Member States.

5. Any other relevant information

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