

Summary of the Hague Agreement Concerning the International Registration of Industrial Designs

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The Hague Agreement facilitates international protection of industrial designs by providing a central filing office (WIPO's International Bureau hereinafter the "IB") at which industrial design applicants may file an application, precluding Hague member states from rejecting the application based upon formal requirements, and providing that the registration of the application at WIPO will automatically provide design protection in member states unless those states timely refuse (*aka* reject) the application. The Hague Agreement is expected to come into force in the United States in the near future, after years of delay in implementation. The most recent Congressional action on the treaty is H.R. 6432, introduced September 19, 2012 following introduction of S. 3486 August 2, 2012. It is likely that the Hague agreement will come into effect in the United States one year after being signed into law.

The Hague Agreement consists of the 1999 Act, the 1960 Act, and the 1934 Act which each provide for international registration of Industrial Designs. The 1960 and 1999 Acts (which are in force in most Hague member countries) provide for international registration of industrial designs by a filing an application at either the IB or the governmental filing office of a country or Intergovernmental Organization that is a Contracting Party of the Hague Agreement. I refer below to a Contracting Party as a country, for simplicity. Different countries are contracting parties to different versions of the Hague Agreement. Therefore, it is useful to know the provisions common to the 1960 and 1999 Acts, and the provisions in the 1999 Act.

The following summary refers to provisions common to the 1960 and 1999 Acts. An international application filing requesting an international registration of an industrial design is equivalent to a national filing in each country. Importantly, the application may be made in English. A Hague international registration of the application automatically effects compliance with all formalities and administrative acts required for grant in each such designated country. That is, a national office cannot impose formality rejections. A Hague international registration results in national design protection in each Hague country, automatically, at 6 or 12 months (depending upon an election made by each country acceding to Hague) after the international registration is published by the IB, unless that country refuses (*aka* rejects) the application on some substantive basis, before the automatic date. The term of protection is renewable every five years for at least 15 years of protection.

Under the 1960 Act, the application is entitled to the right of priority under the Paris convention. The application must include one or more photographs or other graphic representations of the design; designation of the article(s) intended to incorporate the design; designation of contracting countries in which the registration will be effective; and particulars of any claim to Paris convention priority. The application may include a short description of characteristic features of the design; a declaration identifying the creator of the design; a request for deferred publication; and samples or models of article(s) incorporating the design. The application may include multiple designs ("multiple deposit" application) intended to be incorporated in articles in the same International Design Classification (as defined in Article

21(2)((4) of the Act). The request for deferred publication may request publication of the application be deferred up to 12 months from the priority date. The owner of the application generally pays fees to WIPO instead of directly to the designated countries.

Under the 1999 Act, the following requirements also apply. The application must include data concerning the applicant. The application is deemed to be registered when filed, unless it fails to comply with the application filing requirements. Countries that issue a refusal, will transmit that refusal to the IB, which will forward the refusal to the "holder" (aka owner) of the registration. Any country may enforce its national law for unity of design requirements against an international registrations, and require division and charge fees for divisions pursuant to that country's national law. The effect in a country that has not timely refused the registration shall be the same for that registration as for a national grant of rights to a corresponding national design application. The duration of protection in any country shall not be less than that provided for granted national industrial design applications.

There are currently (as of November 1, 2012) 60 contracting parties to the Hague Agreement, including 58 countries, the European Union and OAPI. A list of contracting parties is available at: <http://www.wipo.int/export/sites/www/treaties/en/documents/pdf/hague.pdf>. A Hague application may be filed online, directly with WIPO, using their Web interface at: <https://webaccess.wipo.int/hagueform/>

In summary, the Hague agreement provides a convenient mechanism to obtain international protection for industrial designs, and is likely to come into effect in the United States in the relatively near future.

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