

Special Union for the International Deposit of Industrial Designs (Hague Union)

Assembly

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PROPOSED AMENDMENTS TO THE COMMON REGULATIONS WITH RESPECT TO RULE 14 AND TO THE SCHEDULE OF FEES

Document prepared by the Secretariat

INTRODUCTION

1. 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”), at its twelfth session held from December 4 to 6, 2023, considered favorably the submission of proposals to amend the Common Regulations Under the 1999 Act and the 1960 Act of the Hague Agreement (hereinafter referred to as the “Common Regulations”)¹ with respect to Rule 14 and to the Schedule of Fees, to the Assembly of the Hague Union (hereinafter referred to as the “Assembly”) for adoption².

¹ Document H/A/44/1 contains proposed amendments to the Common Regulations consequential to the freeze of the application of the 1960 Act, including a proposed amendment to the title of the Common Regulations. Nevertheless, this change in title would not prejudice the entry into force of the amendments proposed in this document, should they be adopted. See footnote 14 of document H/A/44/1.

² See paragraphs 10 and 11 of document [H/LD/WG/12/9](#).

2. The discussions of the Working Group were based on document [H/LD/WG/12/6](#)³. The following paragraphs summarize the proposed amendments as reproduced in Annex I (using “track-changes”) and Annex II (“clean” text).

PROPOSED AMENDMENTS TO RULE 14 AND THE SCHEDULE OF FEES

3. Where an irregularity is not remedied within the prescribed time limit⁴, the international application shall be considered abandoned⁵ totally or partially (that is, as to the designation of a Contracting Party⁶). The Common Regulations do not currently provide for a relief measure from such constructive abandonment that does not require justification⁷ for the non-observance of the time limit.

4. The Common Regulations, likewise, do not currently provide for a mechanism for (total or partial) withdrawal of an international application. This has resulted in procedural delays for some applicants (who received an irregularity notice and wish to withdraw the international application) and legal uncertainty for others (who did not receive an irregularity notice but nevertheless wish to withdraw the international application), as well as for the International Bureau⁸.

5. The proposed amendments to Rule 14 and the Schedule of Fees would allow an extension of the time limit for correcting irregularities and would formalize and streamline the process for withdrawing international applications, as set forth below.

6. Under proposed Rule 14(1)(c), it would be possible to extend the time limit under Rule 14(1)(a) or (b). A request for such an extension could be made⁹ by anyone¹⁰ at any time prior to expiry of the proposed additional period of two months from the expiry of the initial time limit, upon payment of an extension of time limit fee of 200 Swiss francs, as provided for under the proposed amendment to the Schedule of Fees. The proposed additional period and the proposed fee amount would be in line with the conditions for a similar relief measure existing under the Madrid System¹¹ and those currently included in the proposed Design Law Treaty (DLT)¹².

7. Proposed Rule 14(3)(a) would clarify that an international application shall be considered abandoned totally where an irregularity, other than an irregularity referred to in Article 8(2)(b) of the Geneva Act (1999) of the Hague Agreement (hereinafter referred to as the “1999 Act”), is not remedied within the combined periods of time under Rule 14(1)(a) or (b)¹³ and proposed Rule 14(1)(c).

³ Document [H/LD/WG/12/6](#) considered the discussions held at the eleventh session of the Working Group on the basis of document [H/LD/WG/11/2](#).

⁴ Either three months or two months from the date of the invitation for correction sent by the International Bureau. See Rule 14(1)(a) and (b).

⁵ For further information on the constructive abandonment mechanism, see paragraphs 1 and 2 of document [H/LD/WG/11/2](#) and Annex I thereto.

⁶ Normally, the term “partial constructive abandonment or withdrawal” in the context of an international application means the constructive abandonment or withdrawal of an international application either as to the designation of a Contracting Party, or as to any design included in the international application. In this document, the terms “partial” or “partially” are used in connection only with the former.

⁷ Rule 5 of the Common Regulations requires *force majeure* reasons.

⁸ See paragraphs 23 to 26 of document [H/LD/WG/12/6](#). In paragraph 24, it is noted that, without a provision for withdrawal, the proposed extension of the time limit would prolong these unpopular procedural delays.

⁹ The International Bureau intends to prepare an unofficial extension request form to guide users, but the use of that form would be at their discretion. See footnote 9 of document [H/LD/WG/12/6](#). The proposed wording of “an additional period” is to signal that no second relief would be provided in respect of a time limit for which relief has already been granted. See paragraph 30 of document [H/LD/WG/12/6](#).

¹⁰ See paragraph 11 and footnote 10 of document [H/LD/WG/12/6](#).

¹¹ See Rule 5*bis*(1)(a)(ii) and item 7.6 of the Schedule of Fees of the Regulations Under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks.

¹² At the time of writing of this document, Article 12 of the proposed Design Law Treaty (DLT) and Rule 10 of the proposed regulations under that Treaty, provided for the extension of time limits.

¹³ See paragraphs 8 and 9 of document [H/LD/WG/12/6](#).

8. In parallel with proposed Rule 14(3)(a), proposed Rule 14(3)(b) would clarify that an international application shall be deemed not to contain the designation of the concerned Contracting Party (that is, partial constructive abandonment) where an irregularity referred to in Article 8(2)(b) of the 1999 Act is not remedied within the combined periods of time under Rule 14(1)(a) and proposed Rule 14(1)(c).

9. Under proposed Rule 14(4), the total or partial¹⁴ withdrawal of an international application, prior to the international registration¹⁵, would be recognized.

10. Proposed Rule 14(5)(a) would set forth a policy for the refund of fees following the total constructive abandonment in accordance with proposed Rule 14(3)(a) or following the total withdrawal under proposed Rule 14(4). In such instances, the International Bureau would be able to retain the amount corresponding to the basic fee and the extension of time limit fee, if any¹⁶, and would refund the remainder of the fees paid in respect of the international application.

11. Proposed Rule 14(5)(b) would set forth a policy for the refund of fees following the partial constructive abandonment in accordance with proposed Rule 14(3)(b) or following the partial withdrawal under proposed Rule 14(4). In such instances, the International Bureau would refund any designation fee paid in respect of that Contracting Party.

12. The resulting structure of proposed Rules 14(3), 14(4) and 14(5) may be summarized, as follows:

	Total (concerning an international application as a whole)	Partial (concerning the designation of a Contracting Party)
Constructive abandonment	Rule 14(3)(a)	Rule 14(3)(b)
Withdrawal	Rule 14(4)	Rule 14(4)
Refund	Rule 14(5)(a)	Rule 14(5)(b)

¹⁴ Paragraph 34 of document [H/LD/WG/12/6](#) explains why there is no mention in proposed Rule 14(4) of the possibility of withdrawing one or some of the designs included in one international application.

¹⁵ After the international registration, the holder must seek already existing renunciation or limitation, neither of which would result in refund of the basic fee or the designation fee.

¹⁶ The expression "if any" would concern both the basic fee and the extension of time limit fee. In any event, the latter would not be refundable. See footnote 29 of document [H/LD/WG/12/6](#).

ENTRY INTO FORCE OF THE PROPOSED AMENDMENTS

13. The implementation of the proposed amendments to Rule 14 and to the Schedule of Fees would require certain modifications to the International Bureau's information technology (IT) system and examination procedures¹⁷. The Working Group, at its twelfth session, thus recommended that the date of entry into force of the proposed amendments be determined and announced by the International Bureau¹⁸.

14. *The Assembly of the Hague Union is invited to adopt the proposed amendments to the Common Regulations with respect to Rule 14 and to the Schedule of Fees, as set out in Annexes I and II to this document, with a date of entry into force to be decided by the International Bureau.*

[Annexes follow]

¹⁷ See paragraph 39 of document [H/LD/WG/12/6](#).

¹⁸ See paragraph 11 of document [H/LD/WG/12/9](#).

**Common Regulations
Under the 1999 Act and the 1960 Act
of the Hague Agreement**

(as in force on [.....])

*Rule 14
Examination by the International Bureau*

(1) [*Time Limit for Correcting Irregularities*] (a) If the International Bureau finds that the international application does not, at the time of its receipt by the International Bureau, fulfill the applicable requirements, it shall invite the applicant to make the required corrections within three months from the date of the invitation sent by the International Bureau.

(b) Notwithstanding subparagraph (a), where the amount of the fees received at the time of receipt of the international application is less than the amount corresponding to the basic fee for one design, the International Bureau may first invite the applicant to make the payment of at least the amount corresponding to the basic fee for one design within two months from the date of the invitation sent by the International Bureau.

(c) The time limit referred to in subparagraph (a) or (b), as the case may be, may be extended by an additional period of two months upon payment of an extension of time limit fee specified in the Schedule of Fees at any time prior to expiry of this additional period.

(2) [*Irregularities Entailing a Postponement of the Filing Date of the International Application*] Where the international application has, on the date on which it is received by the International Bureau, an irregularity which is prescribed as an irregularity entailing a postponement of the filing date of the international application, the filing date shall be the date on which the correction of such irregularity is received by the International Bureau. The irregularities which are prescribed as entailing a postponement of the filing date of the international application are the following:

- (a) the international application is not in one of the prescribed languages;
- (b) any of the following elements is missing from the international application:
 - (i) an express or implicit indication that international registration under the 1999 Act or the 1960 Act is sought;
 - (ii) indications allowing the identity of the applicant to be established;
 - (iii) indications sufficient to enable the applicant or its representative, if any, to be contacted;
 - (iv) a reproduction, or, in accordance with Article 5(1)(iii) of the 1999 Act, a specimen, of each industrial design that is the subject of the international application;
 - (v) the designation of at least one Contracting Party.

(3) [*Failure to Correct Irregularities Within the Prescribed Time Limit*] (a) Where an irregularity, other than an irregularity referred to in Article 8(2)(b) of the 1999 Act, is not remedied within the time limit referred to in paragraph (1), the international application shall be considered abandoned.

(b) Where an irregularity referred to in Article 8(2)(b) of the 1999 Act is not remedied within the time limit referred to in paragraph (1), the international application shall be deemed not to contain the designation of the concerned Contracting Party.

(4) [*Withdrawal*] The applicant may withdraw the international application or the designation of a Contracting Party at any time prior to the international registration.

(5) [*Refund of Fees*] (a) Where the international application is considered abandoned in accordance with paragraph (3)(a), or is withdrawn under paragraph (4), the International Bureau

shall refund any fees paid in respect of that international application, after deduction of an amount corresponding to the basic fee and the extension of time limit fee, if any.

(b) Where the international application is deemed not to contain the designation of a Contracting Party in accordance with paragraph (3)(b), or the designation of a Contracting Party is withdrawn under paragraph (4), the International Bureau shall refund any designation fee paid in respect of that Contracting Party.

[...]

SCHEDULE OF FEES*
(as in force on [.....])

Swiss francs

[...]

II. *Miscellaneous Procedures Subsequent to International Application*

6.1 Addition of a priority claim 100

6.2 Extension of time limit 200

[...]

[Annex II follows]

* Section II (Miscellaneous Procedures Subsequent to International Application) of the Schedule of Fees for addition of a priority claim under proposed Rule 22*bis* was adopted by the Assembly of the Hague Union in its forty-first (23rd ordinary) session in 2021, and its date of entry into force would be decided by the International Bureau. See paragraph 12(ii) of document [H/A/41/2](#).

**Common Regulations
Under the 1999 Act and the 1960 Act
of the Hague Agreement**

(as in force on [.....])

*Rule 14
Examination by the International Bureau*

(1) [*Time Limit for Correcting Irregularities*] (a) If the International Bureau finds that the international application does not, at the time of its receipt by the International Bureau, fulfill the applicable requirements, it shall invite the applicant to make the required corrections within three months from the date of the invitation sent by the International Bureau.

(b) Notwithstanding subparagraph (a), where the amount of the fees received at the time of receipt of the international application is less than the amount corresponding to the basic fee for one design, the International Bureau may first invite the applicant to make the payment of at least the amount corresponding to the basic fee for one design within two months from the date of the invitation sent by the International Bureau.

(c) The time limit referred to in subparagraph (a) or (b), as the case may be, may be extended by an additional period of two months upon payment of an extension of time limit fee specified in the Schedule of Fees at any time prior to expiry of this additional period.

(2) [*Irregularities Entailing a Postponement of the Filing Date of the International Application*] Where the international application has, on the date on which it is received by the International Bureau, an irregularity which is prescribed as an irregularity entailing a postponement of the filing date of the international application, the filing date shall be the date on which the correction of such irregularity is received by the International Bureau. The irregularities which are prescribed as entailing a postponement of the filing date of the international application are the following:

- (a) the international application is not in one of the prescribed languages;
- (b) any of the following elements is missing from the international application:
 - (i) an express or implicit indication that international registration under the 1999 Act or the 1960 Act is sought;
 - (ii) indications allowing the identity of the applicant to be established;
 - (iii) indications sufficient to enable the applicant or its representative, if any, to be contacted;
 - (iv) a reproduction, or, in accordance with Article 5(1)(iii) of the 1999 Act, a specimen, of each industrial design that is the subject of the international application;
 - (v) the designation of at least one Contracting Party.

(3) [*Failure to Correct Irregularities Within the Prescribed Time Limit*] (a) Where an irregularity, other than an irregularity referred to in Article 8(2)(b) of the 1999 Act, is not remedied within the time limit referred to in paragraph (1), the international application shall be considered abandoned.

(b) Where an irregularity referred to in Article 8(2)(b) of the 1999 Act is not remedied within the time limit referred to in paragraph (1), the international application shall be deemed not to contain the designation of the concerned Contracting Party.

(4) [*Withdrawal*] The applicant may withdraw the international application or the designation of a Contracting Party at any time prior to the international registration.

(5) [*Refund of Fees*] (a) Where the international application is considered abandoned in accordance with paragraph (3)(a), or is withdrawn under paragraph (4), the International Bureau shall refund any fees paid in respect of that international application, after deduction of an amount corresponding to the basic fee and the extension of time limit fee, if any.

(b) Where the international application is deemed not to contain the designation of a Contracting Party in accordance with paragraph (3)(b), or the designation of a Contracting Party is withdrawn under paragraph (4), the International Bureau shall refund any designation fee paid in respect of that Contracting Party.

[...]

SCHEDULE OF FEES
(as in force on [.....])

Swiss francs

[...]

II. *Miscellaneous Procedures Subsequent to International Application*

6.1	Addition of a priority claim	100
6.2	Extension of time limit	200

[...]

[End of Annex II and of document]