

INTRODUCTION TO THE HAGUE AGREEMENT



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Design can have a great impact on the commercial success of a product. For some products, design may be the only distinguishing feature. Therefore, it is important for businesses that depend upon design to ensure that they have legal protection for the appearance of their products. The Hague Agreement provides one route for achieving registered design protection simultaneously in many countries around the world.

The Hague Agreement allows applicants based in one so-called 'Contracting Party' to the Agreement to seek design protection in one or more other Contracting Parties at one time. In order to obtain an international design registration under the Hague Agreement, it is necessary to make an application which is filed at the International Bureau (IB) of the World Intellectual Property Organization (WIPO). The application should include information about the applicant, representations of the design or designs to be protected, and a designation of those Contracting Parties in which registration is desired to take effect. There are currently 65 Contracting Parties (a full list is available [here](#)) including the European Union, Iceland, Norway and Switzerland, Japan, South Korea and the US. Notable exceptions, in which protection under the Hague Agreement is not possible, include Australia, Brazil, Canada, China, India, Mexico and Russia.

Advantages

A Hague application can significantly reduce the initial filing fees associated with registering a design in multiple countries simultaneously when compared with the alternative of filing multiple individual



national design applications. In addition, a granted international design registration is renewed centrally at the IB, rather than in each designated state, which further reduces costs where multiple countries are designated. The entire international registration may be assigned as one entity (and that assignment may be recorded centrally at the IB), and any changes to the names or addresses of proprietors may also be filed directly at the IB. Applicants may apply to limit the scope of protection conferred by the international design registration through a central limitation process at the IB.

Disadvantages

The main downside of an international registration is that not all commercially important territories are currently covered. In addition, there can be some complexity involved with planning an application to ensure that the resultant registration is enforceable in each designated territory. In particular, it is important to study the requirements of each territory in which protection is being sought before filing an application. Professional assistance in filing an application is generally recommended and one of our attorneys can assist you in planning the best approach.

The Application

An application may include up to 100 individual designs for products relating to the same Locarno class (an international system of classification also used by the EU Intellectual Property Office when processing Community registered designs).

The application may designate any number of Contracting Parties. It is not possible to add further countries once an application has been filed, and so it is important to determine the most commercially relevant countries before proceeding. It is possible to file an initial national application for design registration (for example, a UK or Community registered design application) and within 6 months file a subsequent international application under the Hague Agreement, claiming priority from the earlier application. This route to registration may be more expensive, but it does buy you up to an additional 6 months to choose in which countries you wish to proceed.

Each design should be illustrated by one or more representations. The representations have to be considered on a case by case basis, as it is necessary to take into account both the design for which protection is sought and the national drawing requirements of each designated Contracting Party. In practice, if protection in the US is sought, we may recommend filing a separate US design patent application due to its divergent representation requirements. An application may require other information, such as a brief description of each design, dependent on the Contracting Parties designated.



International Examination and Publication

Each application undergoes formal examination by the IB, which then publishes the application at around 6 months after filing. Publication of the application may be deferred for up to 30 months, depending on which Contracting Parties are designated, if it is desirable to keep the design secret for as long as possible. However, if any one designated territory does not permit deferment of publication, deferred publication of the international application will not be possible.

National Examination

After the application is published, each designated Contracting Party examines the application nationally. The nature of examination differs from country to country. For example, in Europe designs are generally registered without extensive examination, whereas in Japan an examiner will search for similar existing designs and will then examine each claimed design according to Japanese legal requirements for novelty and innovation.

An international registration may not be refused nationally on grounds of non-compliance with any formal requirements because these requirements must be considered satisfied following international examination by the IB. Nevertheless, although the IB formally permits registration of up to 100 designs in the same application, some countries (notably Japan and the US) require each application to relate to only one design. The national offices of such countries may object to applications concerning two or more designs and may require the application to be 'divided' into two or more so-called divisional applications. The cost benefit of filing multiple designs simultaneously may therefore be lost in such countries.

Each designated Contracting Party must notify the IB of any decision to refuse protection within either 6 months (if the national office does not carry out examination) or 12 months (if the office carries out previous design searching or examination) of the international publication date. It may be necessary to respond to any objections raised by national design offices during these periods. Any responses must be prepared bearing the respective national law in mind and this typically requires engaging the services of a national representative. Accordingly, an international registration may be more cost effective in respect of territories which do not carry out local examination, since no local representative need be appointed.

Registration

If a given designated Contracting Party does not notify the IB of a decision to refuse protection within the prescribed time limit, the international registration automatically takes effect in that territory under



its national law. The original international filing date of the application becomes the international registration date.

Duration

The initial design registration lasts for five years from the date of international registration, after which it can be renewed on payment of a fee for either one or more further five year periods up to the expiry of the total term of protection allowed under each national design law. For example, an international design registration designating the EU would be renewable for up to 25 years in total. A US designation, on the other hand, would only last for up to 15 years. If renewal fees are not paid within a prescribed period, the international registration may lapse.

Enforcement

The scope of protection provided by an international design registration is determined according to local national laws. The international registration must therefore be enforced through the local courts and it is necessary to appoint local professional legal representation. If a competitor wishes to oppose, or attempt to invalidate, the international design registration, this must also be done at the national level. The international registration is not vulnerable to any form of third-party central attack at the IB.

For more information, please visit our [website](#).

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