

Hague Agreement Concerning the International Registration of Industrial Designs

November 15, 2016

Sponsoring Committee: Designs Committee

Resolution

WHEREAS, registered designs are a powerful tool in intellectual property protection and enforcement. They are the natural means to protect the form of products, in particular given that trademark owners are unable to register 3D trademarks in many countries; and

WHEREAS, the Hague System is the designs counterpart of the Madrid System for trademarks. Working as an agreement for international procedure, the Hague System offers an efficient and cost-effective process to protect registered designs in the 65 countries and intergovernmental organizations that are currently members of the Hague System. As such, it clearly facilitates the access of rights owners to intellectual property rights; and

WHEREAS, with the recent accession by the United States, Japan, and the Republic of Korea (South Korea), the use of the Hague system continues to increase; and

WHEREAS, greater flexibility would be afforded to design-right holders if the individual member countries of an intergovernmental organization also become members of the Hague System; and

WHEREAS, it is critical for countries and intergovernmental organizations acceding to the Hague Agreement to enact implementing legislation for the registration and enforcement of design rights;

BE IT RESOLVED, that the International Trademark Association encourages countries, intergovernmental organizations, and non-member countries whose citizens are covered by the adherence of an intergovernmental organization to accede to the Hague Agreement Concerning the International Registration of Industrial Designs.

BE IT FURTHER RESOLVED, that countries and intergovernmental organizations acceding to the Hague Agreement should enact implementing legislation on the registration and enforcement of design rights.

Background

The Hague Agreement consists of three independent Acts: the London (1934) Act (frozen since January 2010; the London Act will terminate on 18 October 2016); the Hague (1960) Act (in decrease) and the Geneva (1999) Act.

The major advantage of the Hague System is to standardize formal requirements and centralize all administrative issues for international registered design applications: ONE single application, in ONE language (English, French or Spanish), with ONE fee in ONE currency resulting in ONE registration with ONE number, covering ONE OR MORE countries or intergovernmental organizations.

The consequence and major advantage is that the Hague System lowers transaction costs for design registrations. Although the benefit of the System is limited to the current members of the 65 countries and intergovernmental organizations (e.g., the European Union and the African Intellectual Property Organization or "OAPI"), coverage is expected to grow as more members join.

Unlike trademarks under the Madrid System, an international design application under the Hague System does not require a prior national (or intergovernmental) application or registration. This provides increased flexibility to the owner for the management of their portfolios of registered designs.

International registrations are published in the International Designs Bulletin six months after their date of registration, but applicants can request an immediate publication or a deferral of publication. The publication of international registrations can be deferred for up to 12 months or 30 months. Many countries have a deferment procedure, which entitles the applicants to provisional rights and makes designs quickly profitable and valuable.

A single application may include up to 100 different designs, but all must belong to the same class of the Locarno Classification for industrial designs.

The term of protection of an international registration is five years from the date of the international registration (i.e. the filing date). An international registration may be renewed for one or more additional terms of five years in respect of each country, up to the expiry of the total term of protection allowed under the national laws of those countries.

In summary, the Hague System provides a simplified way of obtaining design registrations in multiple jurisdictions. The International Design Harmonization Subcommittee of the Designs Committee has prepared an **accompanying Report** to describe in more details the Hague System, its procedures, and pros and cons.

With the recent accession of the Republic of Korea, the United States and Japan, the Hague System is becoming a very important tool to obtain registered design protection around the world. With its recent growth and future development potential, and considering the many legislations involved, the Hague System more than ever needs the support of the intellectual property community. Moreover, greater flexibility would be available to design-right holders if individual countries of an intergovernmental organization which is or becomes a member of the Hague Agreement also join the System.

Accordingly, the International Design Harmonization Subcommittee of the Designs Committee recommends that the Board of Directors adopts this resolution setting forth INTA's support for

the Hague System, and noting that INTA will actively participate in its development in the future, in particular in new countries and intergovernmental organizations. INTA also will assist the users of the System to find ways to simplify and harmonize procedures for industrial design registrations, in line with INTA's core mission of promoting further harmonization of trademark rights and related rights