

The Hague System: How it Can Benefit Industrial Design Registration

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1. Overview of the Hague System

The Hague Agreement Concerning the International Registration of Industrial Designs, or the Hague Agreement Concerning the International Deposit of Industrial Designs, also known as the "**Hague System**", was first adopted on 6th November 1925, revised in London on 2nd June 1934 and in the Hague on 28th November 1960, and includes three Acts: the 1934 London Act (which has stopped its operation since 1 January 2010), the 1960 Hague Act and the 1999 Geneva Act (both of which are currently in operation). In principle, a country can freely choose the Act to which it wishes to become a party. However, intergovernmental organisations, such as the European Union Intellectual Property Office (EUIPO) or the African Intellectual Property Organization, may become a party to the 1999 Geneva Act only. Administering the Hague System, the World Intellectual Property Organization (WIPO) maintains the International Register, publishes the International Designs Bulletin and governs the international registration of industrial designs.

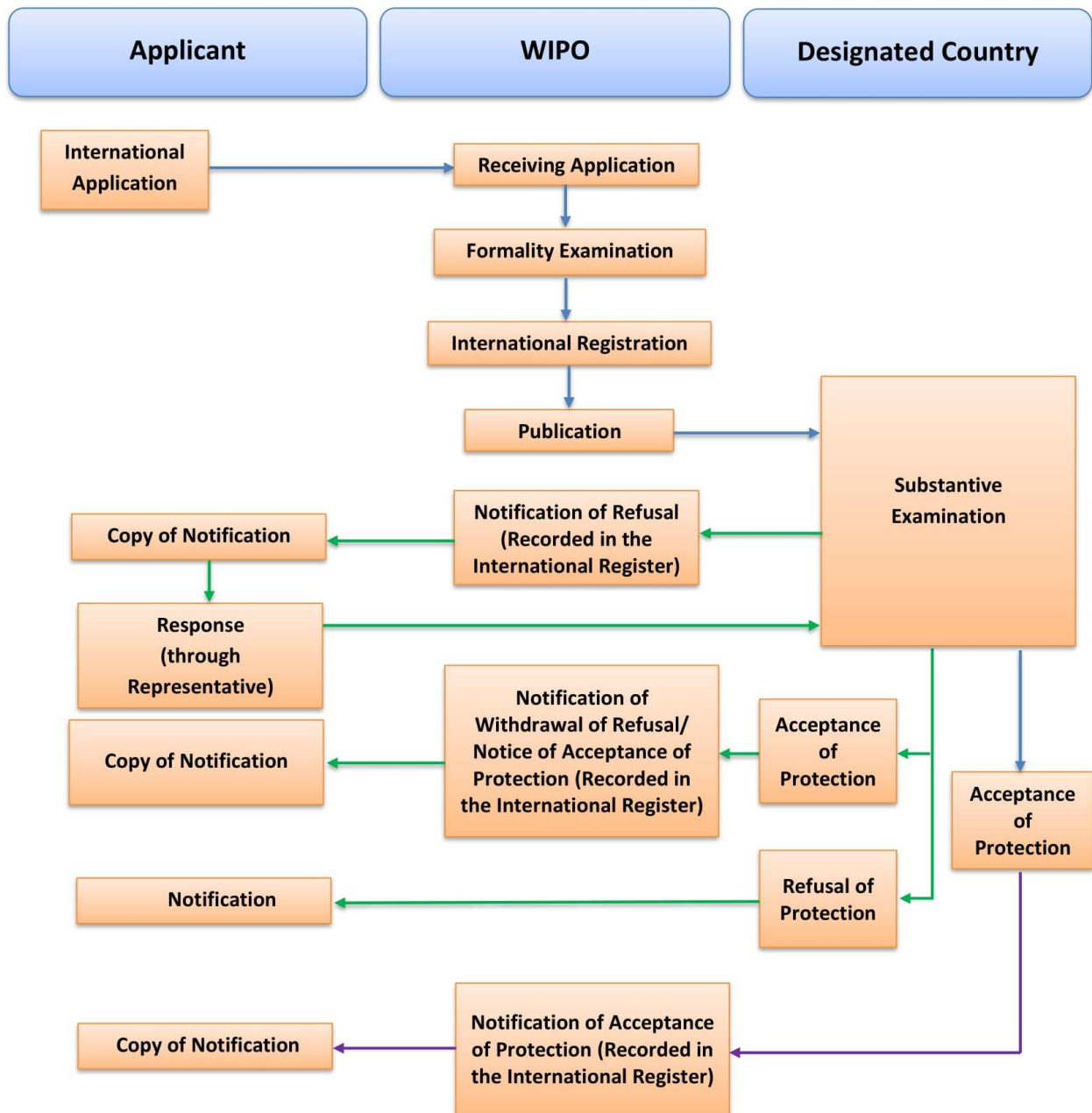
The main goals of the Hague System are to create a simple and economical mechanism for international registration of industrial designs, and to address the difficulties of applying for the same industrial design in many countries. With the Hague System, industrial design owners (the "**Owners**") must not submit separate applications in individual countries. Instead, they shall submit a single international application in a single language either directly to the International Bureau of WIPO (the "**International Bureau**") or indirectly through the IP office of their States or intergovernmental organizations which are the contracting parties of the Hague System (hereinafter collectively the "**Contracting Parties**" or individually a "**Contracting Party**"). In contrast to the Madrid Protocol, neither national application nor registration is required as a base for an international application. In other words, the Owners can file their industrial design applications for the first time through the Hague System¹.

2. International Registration under the Hague System

The process of industrial design registration under the Hague System is shown in the following flowchart:

¹ The Guide for Users on the Hague System: <https://www.wipo.int/hague/en/guide>

Process of Industrial Design Registration under the Hague System



NB: In the flowchart, the purple line represents a procedure that may not need to be performed. In some cases, a designated country may not send a notification of acceptance of protection to WIPO. Accordingly, if the prescribed time limit expires, the international registration of an industrial design shall be automatically protected in that country.

2.1. Filing Application

A natural person or legal entity is entitled to file an international application for an industrial design under the Hague System if fulfilling at least one of the following conditions:

- having a real and effective industrial or commercial establishment in the territory of a Contracting Party;
- having a domicile in the territory of a Contracting Party;

- being a national of a Contracting Party or a member State of an intergovernmental organization which is a Contracting Party;
- being a habitual resident in a Contracting Party (applicable only under the 1999 Geneva Act).

At the applicant's discretion, an application may be filed in English, French, or Spanish. The application must contain one or more reproductions of the industrial designs concerned and can include up to 100 designs provided that the industrial designs all belong to the same class of the International Classification of Industrial Designs under the Locarno Classification.

International design registrations can be searched on the Hague Express Database² or the Global Design Database³.

2.2. Examination and Publication

The Hague System provides for international procedures for obtaining protection of industrial designs in various countries. The International Bureau proceeds to examine formalities of an industrial design application (such as quality of the reproductions of industrial designs, or payment of the required fees), but it does not substantively examine the application. Once the formal requirements have been met, the registration is recorded in the International Register and its details are published electronically in the International Designs Bulletin on the WIPO website⁴. Subject to the Contracting Parties designated, applicants may request for deferment of the publication by a period not exceeding 30 months from the date of the international registration or, where priority is claimed, from the priority date of the application concerned.

The substantive examination, if provided for by their own legislations, is carried out by the offices of the designated Contracting Parties. The scope of protection granted to an industrial design in each jurisdiction completely depends on the law in those jurisdictions

2.3. Refusal or Grant of Protection

Each Contracting Party designated by the applicant may refuse protection of the industrial design concerned within 6 months, or possibly 12 months under the 1999 Geneva Act, from the publication date of the international registration. Such refusal of protection can only be based on requirements of the domestic jurisdiction other than the formalities.

A refusal in a Contracting Party will affect the protection for the territory of that Contracting Party only and not the whole registration. In case of a refusal, the Owners have the same remedies as they would have if they had filed a national application directly in the Contracting Party concerned. And the Owners can submit an appeal to the competent authority of the Contracting Party in accordance with that Contracting Party's own legislation. The empowerment of a representative to act on behalf of the Owners before the IP office of a Contracting Party (in the event that a response, and then possibly an appeal, is filed against a refusal of protection) may be a must under the law and practice of the Contracting Party concerned.

If no notification of refusal is issued by the IP office of a designated Contracting Party within the prescribed time limit, or if such refusal has subsequently been withdrawn, the international registration has effect as a grant of protection in that Contracting Party under its own legislation.

² The Hague Express Database: <https://www.wipo.int/designdb/hague/en/>

³ The Global Design Database: <https://www3.wipo.int/designdb/en/index.jsp>

⁴ The International Designs Bulletin: <https://www.wipo.int/haguebulletin/?locale=en>

2.4. Term of Protection

The term of protection is 5 years computed from the date of international registration, which is renewable for at least one 5-year period under the 1960 Hague Act, or two such periods under the 1999 Geneva Act. If the legislation of a Contracting Party provides for a longer period, the Owners can continue to renew their applications up to the maximum time period allowed in that territory.

2.5. Renewal

Six months before the expiry of each 5-year term, the International Bureau sends to the Owners and their representative, if any, a notice on the renewal of the international registration. If the Owners or their representative does not receive this notice, it does not constitute an excuse for failure to comply with any time limit for payment of the renewal fees due. A 6-month grace period following the expiry date is allowable for the Owners to proceed with the renewal. The International Bureau records the renewal in the International Register, and the relevant data related to the renewal is published in the International Designs Bulletin.

3. Benefits of the Hague System

3.1. Simplicity

- Enabling the Owners from a Contracting Party to obtain protection for their industrial designs in many different countries with minimal formalities:
 - Simple dossiers (an application containing at least one reproduction of a design, and designating at least one Contracting Party);
 - Minimum fees (a basic fee; a publication fee; for each designated Contracting Party, either a standard fee or an individual fee);
 - Only one currency (Swiss Francs - CHF).
- Simplifying the management of the application since all administration is handled by one agency, i.e. the International Bureau.
- Only one application, which is paid in one currency and completed in one language, shall be managed.
- Easily monitoring the deadlines for renewal.
- Considerably facilitating related procedures, such as change in the name or address of the Owners, or a change in ownership.

3.2. Flexibility

- Protection of industrial designs can be sought in over 90 countries, including Japan, Korea, the United States and members of EU, etc.
- Allowing applicants to designate their Contracting Party by themselves.
- Permitting applicants to submit 100 different industrial designs in one application (provided that industrial designs belong to the same group of the Locarno International Classification) and to receive a great deal of national rights.
- Allowing optional use of three different languages (English, French or Spanish).

3.3. Economy

- Saving money (a basic fee, a general publication fee, significant reduction in fees for the 2nd design variant; professional, notary and translation fees; no need to hire attorneys or representatives in certain designated Contract Parties in the event of no notification of refusal of protection).
- Saving time for pursuing applications.

- Once protection is granted to an industrial design, it may be renewed in multiple jurisdictions with only one request and fee payment made to the International Bureau.

3.4. Encouragement

- Encouraging the Owners to register their rights, thereby encouraging the manufacture, distribution or licensing of their designs.
- Encouraging protection of commercial rights overseas in favor of global business strategies set forth by the Owners.

4. International Application Designating Vietnam under the Hague System

4.1. Vietnam's Accession

On 30 September 2019, Vietnam acceded to the Hague System under the 1999 Geneva Act. This has made Vietnam the 61st member of the 1999 Geneva Act and the 71st member of the Hague Union. The 1999 Geneva Act has entered into force in Vietnam since 30 December 2019.

Accordingly, as from 30 December 2019, eligible applicants can file application for registration of their industrial designs under the 1999 Geneva Act of the Hague System to have their industrial designs vastly protected in the Contracting Parties.

4.2. Vietnam's Declarations

- Vietnam has made the following declarations related to the industrial design international applications designating Vietnam (the "**International Application**"):
 - For three-dimensional industrial designs, the International Application must contain a perspective view of the design (in light of Rule 9(3)(a) of the Common Regulations under the 1999 Geneva Act and the 1960 Hague Act of the Hague Agreement).
 - The International Application must contain a description covering the shaping features showing the essence of the design (in light of Article 5(2)(b)(ii) of the 1999 Geneva Act).
 - The International Application must contain a claim for protection of an industrial design (the "**Claim**"), in light of Article 5(2)(b)(iii) of the 1999 Geneva Act.
 - Only one industrial design may be claimed in a single International Application (in light of Article 13(1) of the 1999 Geneva Act), except the following cases:
 - Industrial designs belong to the same set of products manifesting the only common inventive idea, used together or to accomplish the same purpose(s); or
 - An industrial design is accompanied by a variant or multiple variants of that design which manifest the only common inventive idea and are not significantly different from that design.
 - The third level of the standard designation fee for an International Application (in light of Rule 12(1)(c)(i) of the Common Regulations) shall be applied.
 - The maximum duration for protection of an industrial design in Vietnam is 15 years (in light of Article 17(3)(c) of the 1999 Geneva Act).
- However, Vietnam does not declare the following:
 - The international application of the applicant whose Contracting Party is Vietnam (the "**Applicant**") may not be filed to the Intellectual Property Office of Vietnam ("**IP Vietnam**"), in light of Article 4(1)(b) of the 1999 Geneva Act.
This means that the Applicant can file his/her international application through IP Vietnam.
 - Any designation of Vietnam in the International Application of the Applicant shall not be valid (in light of Article 14(3)(a) of the 1999 Geneva Act).

This means that the Applicant may designate Vietnam in the International Application by himself/herself.

- The period for issuance of a notification of refusal can be extended to 12 months from the publication date of an international registration (in light of Rule 18(1)(b)). Accordingly, the period for issuance of a notification of refusal is 6 months from the publication date of an international registration.
- The deferment of the publication of the International Application (in light of Article 11(1)(b) of the 1999 Geneva Act) is allowed. The deferment may be allowed in the future upon consideration of demands and development of various manufacture areas in Vietnam, the filing trend of applications to be filed in or designating Vietnam, and so forth.

4.3. Vietnam's Other Requirements

- The indication of any information on creators of industrial designs⁵ is not mandatory, the Claim⁶ is mandatory, for international applications designating Vietnam.
- In the International Application, the Claim needs to be shown in the common form: *"Application for overall protection for industrial design(s) as shown and described"*.
- Any communication from the International Bureau to IP Vietnam must be in English (in light of Rule 6(3)(ii) of the Common Regulations).
- Where an International Application is filed to IP Vietnam, a transmittal fee of 2 million VND (about 87 USD) per design shall be incurred (in light of Rule 13(2) of the Common Regulations).

4.4. Filing and Substantive Examination

All Vietnamese organizations/individuals, foreign organizations/individuals being a habitual resident Vietnam, and foreign organizations/individuals having a domicile or an industrial or commercial establishment in Vietnam can file their international applications directly to the International Bureau or through IP Vietnam, by way of WIPO's online filing system (eHague)⁷ or paper dossiers⁸ to be sent directly to WIPO or by post.

The process of IP Vietnam's substantive examination of the International Application is depicted in the following flowchart:

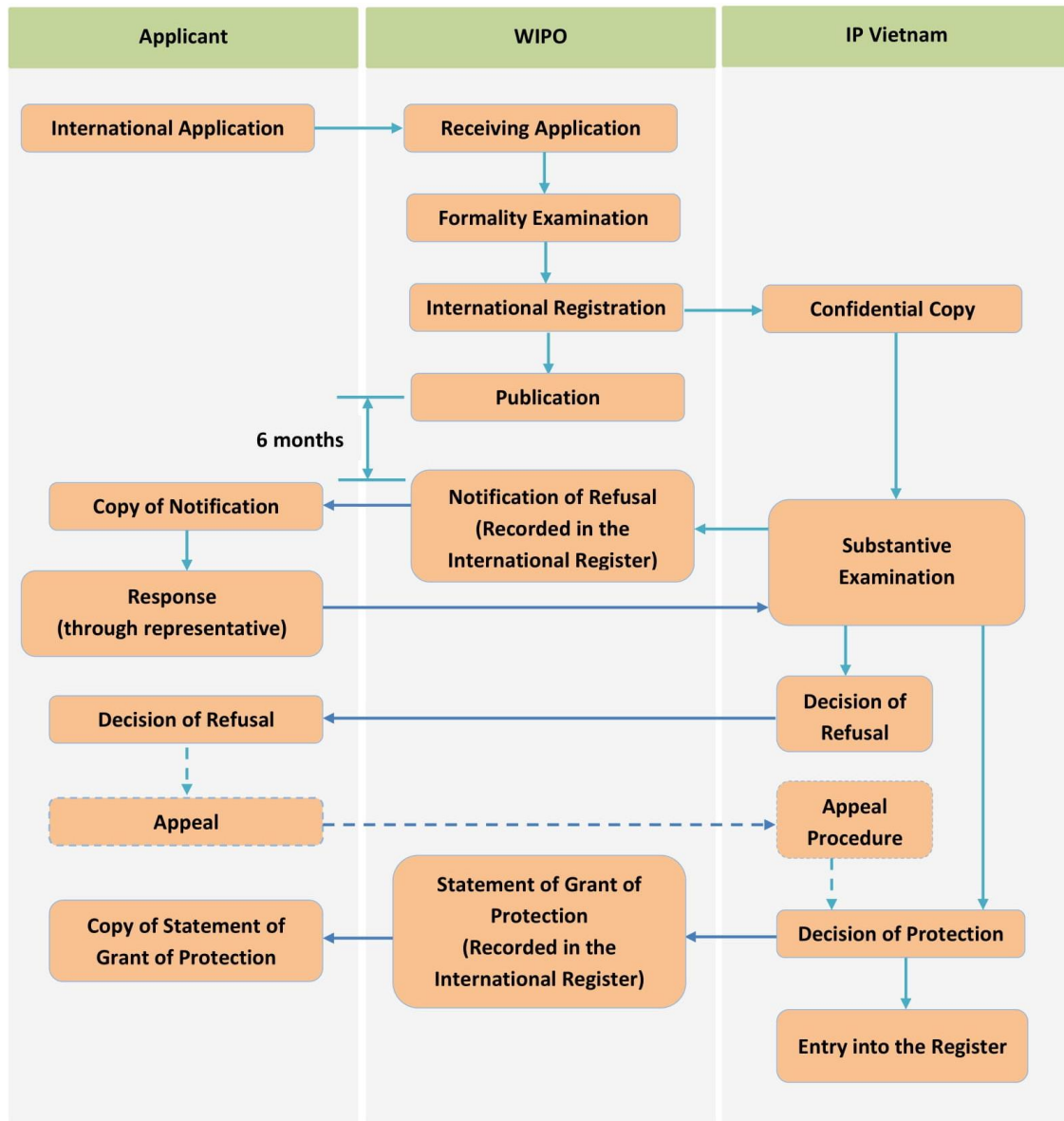
⁵ The information on creators of designs is mandatory for international applications designating such countries as: Bulgaria, Ghana, Iceland, Mexico, Romania, Serbia, Turkey, Finland, Hungary, Japan, Korea, Russia, Tajikistan, the United States of America.

⁶ The Claim is also mandatory for international applications designating the United States of America.

⁷ The link to be assessed for online filing: <https://www.wipo.int/haque/en/e-filing.html> and the online filing tutorial: http://www.wipo.int/haque/en/how_to/efiling_tutorial/index.html

⁸ The application for international registration: <http://www.wipo.int/haque/en/forms>, the Guidance on reproductions: https://www.wipo.int/export/sites/www/haque/en/how_to/pdf/guidance.pdf, and the Hague system fee calculator: <http://www.wipo.int/haque/en/fees/calculator.jsp>

**PROCESS FOR SUBSTANTIVE EXAMINATION
OF INTERNATIONAL APPLICATION DESIGNATING VIETNAM**



The International Application shall be substantively examined in accordance with Vietnamese regulations on substantive examination applicable to Vietnam national applications. IP Vietnam’s notification of refusal shall be sent to the International Bureau within 6 months from the publication date of the international registration. The validity of the refusal shall be limited to the territory of Vietnam only. IP Vietnam can partially or totally refuse the international registration, and such refusal can be a final decision without any further notification by IP Vietnam.

So what are the grounds for refusal of an international registration? It seems to be a matter of great interest to the Owners.

IP Vietnam shall refuse an international registration on any grounds related to its substance (including any opposition from a third party⁹). No refusal may be issued on the grounds of any formality shortcomings or defects (in light of Article 17(3)(c) of the 1999 Geneva Act), except the following:

- The industrial design concerned does not meet the requirements on its unity (Article 13);
 - The views of the design are not sufficient to fully disclose the design (Rule 9(3)(a)).
- NB: Under Vietnamese legislation, for a three-dimensional industrial design, a set of seven views (i.e. front, back, right, left, top, bottom and perspective views) are required.

Some typical grounds for refusal of an international registration are provided below:

- (i) The design belongs to the group of unpatentable subject matters.
- (ii) The set of photos/drawings is not sufficient to fully disclose the design.
- (iii) The design does not meet the protection criteria (namely, novelty, inventive step and industrial applicability).
- (iv) The International Application does not satisfy the first-to-file principle.
- (v) The International Application does not meet the requirements on the unity of the design.

A notification of refusal issued by IP Vietnam can be partially or totally withdrawn (in light of Rule 18(4)). Such withdrawal can be made as a statement of grant of protection (in light of Rule 18bis(2)).

Where IP Vietnam does not find out any ground for refusal of protection, it may issue a statement of grant of protection before the expiry of the prescribed refusal period.

4.5. Response to Refusal

The Owners are entitled to correct shortcomings or defects of the International Application in the same way as Vietnam national applications, so that the industrial design may be protected in Vietnam. In response to a notification of refusal by IP Vietnam on any loss of novelty of an industrial design, the Applicant can declare an exception¹⁰ for such loss, and submit any supporting documents to IP Vietnam.

Under Vietnam legislation, the Owners have three months from the sending date of the notification of refusal (with one three-month extension being allowed) to file a response to IP Vietnam. Should IP Vietnam issue a decision of refusal after examining a response to its notification of refusal, that decision can be appealed.

4.6. Validity of International Registration

The validity of an international registration is at least the same as that of a Vietnam national application. Where no notification of refusal is issued by IP Vietnam, the international registration has the effect as a grant of protection in Vietnam from the expiry date for issuance of the notification of refusal at the latest.

⁹ It's somewhat different from the opposition procedures for a Vietnam national application, where any opposition will be notified to the Owners for their opinions, and IP Vietnam's examiners may also use information related to such opposition as a reference during their examination work.

¹⁰ Under Article 65(4) of the Law on Intellectual Property of Vietnam:

"The novelty of an industrial design shall not be considered to be lost if the industrial design was published in the following circumstances, provided that an application for registration of the industrial design is filed within six months from the date of publication:

- a) It was published by another person without permission of the person entitled to the registration as stipulated in Article 86 of this Law;
- b) It was published in the form of a scientific report by the person entitled to the registration as stipulated in Article 86 of this Law;
- c) It was exhibited at a national exhibition of Vietnam or at an official or officially recognized international exhibition by the person entitled to the registration as stipulated in Article 86 of this Law".

In the event that a notification of refusal is withdrawn by the international registration shall become valid from the withdrawal date of the notification.

Under Vietnam legislation, the term of industrial design protection is 5 years computed from the date of international registration, which is renewable for two such periods. Therefore, the maximum duration for protection of an industrial design in Vietnam is 15 years.

5. Conclusion

In the current competitive business environment, the outer appearance or design of a product is considered a great advantage which the Owners, from creators to businesses, can take. In view of what the Hague System may benefit the Owners, the international registration of industrial designs is the important step to be initiated by the Owners to protect their commercial interests overseas, and it also constitutes an indispensable part of any global business strategy. Therefore, it is highly advisable that the Owners take prompt action to seek, by way of the Hague System, global protection of their industrial designs, which we believe can afford them a good weapon to combat with the alleged infringers of their legitimate rights.

Contact

KENFOX IP & Law Office

Building No. 6, Lane 12/93, Chinh Kinh Street, Nhan Chinh Ward, Thanh Xuan District, Hanoi, Vietnam

Tel: +84 24 3724 5656

Email: info@kenfoxlaw.com / kenfox@kenfoxlaw.com