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13 October 1998

**INTERNATIONAL DEPOSIT OF INDUSTRIAL DESIGNS
THE HAGUE AGREEMENT**

UNICE COMMENTS

1. GENERAL REMARKS

UNICE has taken note of the draft new WIPO proposals on the above subject (draft Act H/DC/3 Prov. and draft Regulations H/DC/4 Prov.) and is pleased to note that this document reflects the results of the seventh session of the Committee of Experts.

UNICE notes that some of the provisions dealt with in the seventh session within the framework of the new Act have been transferred to the draft Regulations and can accept this transfer provided that all important rules in the Regulations are governed by the clause of unanimity.

UNICE supports organisation of a Diplomatic Conference in 1999 in view of final adoption of the whole project but would like to stress the importance that the present draft new Act and the draft Regulations do not undergo further modifications to the disadvantage of users, in particular:

- provisions concerning TRIPs;
- effects of the international registration;
- deposit of specimen instead of reproductions in the case of deferred publication;
- deferment of publication;
- secrecy of designs with deferred publication;
- additional mandatory contents of the international application.

A weakening of users' position on these aspects would make the new Act worthless for them.

2. COMMENTS ON SPECIFIC PROVISIONS

2.1. DRAFT NEW ACT

-Article 10 (3)(ii)

This provision sets up rules in cases where an international application is accompanied by specimens instead of reproductions. Article 10(3)(ii) now stipulates that in such cases the International Bureau shall disregard the designation of that Contracting Party, a solution which UNICE considers disadvantageous for users. Furthermore it may occur that only one Contracting Party is designated in an application, which does not allow any deferment of publication. The proposed provision does not give a clear answer about what would happen in such a case. In UNICE's view, there is no reason to deal with this irregularity in a different way from those in Article 8 or Article 10 (3)(i).

In the light of the above, UNICE would suggest amendment of proposed Article 10 (3)(ii) as follows:

“Where deferment of publication has been requested and any of the Contracting Parties designated in the international application has made a declaration under paragraph (1)(b) that deferment of publication is not possible under its law,

(i) *unchanged wording*;

(ii) where, instead of being accompanied by reproduction of the industrial design, the international application was accompanied by specimens of the industrial design, the International Bureau ***-new wording- shall invite the applicant to present the prescribed number of copies of a reproduction. If the applicant does not comply with the invitation within the prescribed time limit, the International Bureau shall disregard the designation of the said Contracting Party.***

2. 2. DRAFT REGULATIONS

-Rule 30 ; Requirement of Unanimity

UNICE firmly believes that the following Rules should be added to the list of Rules already enumerated in Rule 30:

Rule 7 (6)

During the discussions at Expert level there were proposals to admit only designs belonging to the same sub-class. UNICE would like to recall that it was demonstrated on the basis of concrete examples that this would cause serious problems in many cases. It might occur that this idea, namely the limitation to sub-classes, is discussed again and decided at a later stage with incomplete knowledge of practical implications. UNICE would therefore strongly recommend that it is ensured that this provision (designs have to belong to the same class of the international classification) cannot be changed without unanimity.

Rule 9

In UNICE's view, it must be ensured that the number of reproductions which Contracting Parties may request cannot be modified without unanimity. In the contrary case, modifications to the disadvantage of the users might easily occur.

Rule 12

Any modification of the structure of the fees should require unanimity.

Rule 12 - Fees concerning the International Application - Payment of Fees in Case of Deferment of Publication

In previous drafts, in case of deferment of publication only a portion of the international fee was to be paid with the International Application. UNICE regrets to note that this rule has been canceled on the basis of the argument that the same result may be obtained by adjusting the basic fee and the publication fee (see footnote 8, page 22, draft Act).

The aforesaid and now canceled rule was justified by the following considerations. A design not published after the expiry of the period of deferment is canceled from the International Registration and left without any protection. Through collection of only a portion of the basic fee under the above conditions, the period of protection will be limited to a portion of the first full period of protection of 5 years. Theoretically this could indeed be taken into consideration by an appropriate relationship between the basic fee and the publication fee, but the present documents do not contain any provision making such a differentiation compulsory and this very important principle could be disregarded at any time.

Therefore UNICE is of the opinion that the following sub-paragraph (v) containing the provisions of the former Article 13 (5) should be added to Rule 12 (1):

(v) “ *Where the international application contains a request for deferment of publication, only a prescribed portion of the international registration fee shall be paid at the time of filing the international application.* “

3. CONCLUDING REMARKS

UNICE has time and again stressed how important it is for European industry to have a simple and cost-effective international registration system to which as many countries as possible would adhere. UNICE believes that rapid adoption of the latest WIPO proposals taken in tandem with current developments at EU level, where creation of a Community design is looming, are positive steps in the direction of Design Law harmonisation. These developments might constitute a way towards a Design Law Treaty, which UNICE would welcome in principle.
