Industrial property: international registration of industrial designs, accession to the Geneva Act of the Hague Agreement, adopted in Geneva on 2 July 1999

2005/0273(CNS) - 22/12/2005 - Legislative proposal

PURPOSE : to approve the accession of the European Community to the Geneva Act of the Hague Agreement concerning the international registration of industrial designs.

PROPOSED ACT : Council Regulation.

CONTENT : the Community Designs Regulation (Regulation 6/2002/EC) establishes the Community design system, which provides for the acquisition of protection for designs with unitary effect for the whole territory of the Community. According to the Regulation, a design may be protected either by an unregistered Community design, if the design is made available to the public in the manner provided for in the Regulation, or by a registered Community design, if registered under the procedure provided for in the Regulation.

The Community Designs Regulation entrusts the Office for the Harmonization in the Internal Market (Trade Marks and Designs), ("the Office")to handle the administration of the Community design. On 23 December 2003, the 1999 Act of the Hague Agreement concerning the international registration of industrial designs, adopted in Geneva on 2 July 1999 ("the Geneva Act") entered into force. The Geneva Act allows designers to obtain design protection in a number of countries through a single international deposit. Thus, under the Geneva Act, a single international application filed with the International Bureau of the World Intellectual Property Organization (WIPO) replaces a whole series of applications which, otherwise, should have been effected with different national or regional Offices.

One of the main innovations of the Geneva Act is that intergovernmental organizations which have a regional office for the purpose of registering designs with effect in the territory in which the constituting treaty of the organization applies, may accede. This innovation was introduced into the Geneva Act with the specific intention of allowing the Community to adhere to the international registration system after the entry into force of the Community design system.

The objective of this proposal is to establish a link between the Community design system and the international registration system established under the Geneva Act. This link will enable designers to file a single international application at the International Bureau of WIPO designating, amongst other Contracting Parties, the EC in order to obtain protection under the Community design system.

A second proposal contains the measures which are necessary to give effect to the accession of the Community to the Geneva Act. (Please see CNS/2005/0274). The adoption of the Geneva Act in 1999 had a twofold objective, namely:

- to make the Hague System more attractive for applicants and to extend the system to new members; to that end, the 1999 Act has introduced a number of features into the Hague system with a view to facilitating the accession to the Hague Union of countries which administer design examination systems (such as USA and Japan);

- to provide for the establishment of a linkbetween the international registration system and regional systems by providing that intergovernmental organizations may become a party to the Act.

The second objective opens the door for the accession of the EC to the Hague System. The territory of the EU would then be regarded as a single country for the purposes of the Geneva Act, with the Community design rules as the relevant domestic legislation. The OHIM would become the Office responsible for the substantive examination of international applications in which the Community has been designated.

The Community design system and the international registration system as established by the Hague Agreement can be considered as being complementary. The Community design system provides for a complete and unified regional designs registration system which covers the whole territory of the EU. The Hague Agreement constitutes a treaty centralizing the procedures for obtaining protection of designs in the territory of the designated Contracting Parties.

The Geneva Act system became fully operational on 1 April 2004.

The proposal describes the procedure for the accession of the EC to the Geneva Act, and states that the Community will deposit the instrument of accession.

The Commission proposes that declarations to the Director-General of WIPO be made on the following matters:

- The EC should exclude the filing of an application through the Office in order to avoid useless duplication of work. Direct filing at WIPO is also to be preferred in order to avoid confusion by applicants between applications for registering Community designs and applications for international registrations. Such confusion would be all the more problematic in case of payment of the basic fee for an international application, which has to be paid in any event directly to the International Bureau and which is payable at the time of filing. If applicants would erroneously pay the fee to OHIM, this Office would have to return the fee. It is significant that at present WIPO does not receive applications filed through national offices even from those Contracting Parties who would permit such a procedure.

- The Geneva Act provides that the prescribed fees shall include a standard designation fee that has to be paid for each designated Contracting Party. In addition, any Contracting Party that is an intergovernmental organisation may declare that, for each application and for each renewal of an international registration in which it is designated, the standard designation fee is replaced by an individual designation fee, whose amount shall be indicated in the declaration and can be changed in further declarations. The fixed amount may not be higher than the equivalent of the amount which the Contracting Party would be entitled to receive for a national application and renewal, that amount being diminished by the savings resulting from the international procedure. The designation fee shall be transferred by the International Bureau to the respective Contracting Party.

In terms of income, the choice between the standard designation fee and the individual designation fee will have budgetary consequences for the Office. The EC should therefore take advantage of this option and determine its own individual designation fee.

Such determination will have to be made on the basis of a number of elements. Fees will have to be sufficient to cover the costs incurred by the procedures relating to designs the protection of which is requested in the EU. This means not only the costs relating to examination of such designs in OHIM but also other procedures like invalidities and appeals. Such determination has not yet been made as a prior financial analysis is required. To undertake such an analysis, the major conditions of the accession to the Hague Agreement will have to be examined in detail. The Commission also needs to have a better idea as to the possible number of invalidities and appeals international designations could generate and thus the level of work involved for the OHIM.

- The Geneva Act obliges each Contracting Party to notify the Director-General of the International Bureau of the maximum duration of protection provided by its law. The Community Design Regulation provides for the maximum duration of protection of 25 years. The EC will notify the Director-General accordingly.

FINANCIAL IMPLICATIONS :

Period of application: indefinite period.

Overall financial impact of human resources and other administrative expenditure: EUR 0.324 million

(EUR 0.054 million each year over a period of six years beginning in 2006.)

Number of staff: 0.5 per annum.