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

2005/0274(CNS) - 22/12/2005 - Legislative proposal

PURPOSE : to amend Regulations 6/2002/EC and 40/94/EC to give effect to 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.

In order to prepare for the accession of the Community to the Geneva Act, the Commission has elaborated two proposals, which are jointly presented to the Council. The first Commission proposal relates to the accession of the Community to the Geneva Act. (CNS/2005/0273).

This second proposal contains the measures which are necessary to give effect to the accession of the Community to the Geneva Act.

It is proposed that the measures giving effect to the accession of the Community to the Geneva Act be incorporated in the Community Design Regulation through the amendment of existing provisions and addition of a new Title XIa on "International Registration of Designs".

In principle, the substantive provisions applying to the international registration designating the Community are the same as the provisions which apply to Community designs. Thus, international registrations designating the European Community and Community designs shall both be subject to the same law relating to designs (Title II), both shall be objects of property (Title III), may be subject to an application for a declaration of invalidity (Title VI), an appeal shall lie from the decision of the Invalidity Division (Title VII), and the jurisdiction and procedures in legal actions relating to Community designs shall be the same for international registrations designating the European Community as for Community designs (Title IX).

For these reasons, the new Title XIa contains many cross-references to other Articles of the Regulation.

The inclusion of this new title in the Regulation facilitates access to all the provisions which apply to a design protected for the entire territory of the European Community, be it through the registration of the design as a Community design or be it through an international registration of the design designating the European Community under the Geneva Act. By means of the proposed structure, implementing measures, such as laid down in Commission Regulations 2245/2002/EC, 2246/2002/ECand 216/96/ECwill apply in principle mutatis mutandis. Where necessary, the Commission will amend them, for instance regarding the examination as to the grounds for refusal referred to in Article 106 of the proposal.

The Geneva Act forms part of the Hague System, which is based on the Hague Agreement Concerning the International Registration of Industrial Designs. The system of international registration of designs arose from a need for simplicity and economy. In effect, it enables design owners originating from a Contracting State to obtain protection of their designs with a minimum of formality and expense.

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 Agreement, 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 European Union. The Hague Agreement constitutes a treaty centralizing the procedures for obtaining protection of designs in the territory of the designated Contracting Parties.

The Commission’s proposal sets out the details of each amendment to the Regulation.

On the question of filing, it should be noted that the Commission proposes that the Community, in its instrument of accession, declares that international applications may not be filed through its Office, but filed directly at the International Bureau. This is in order to avoid confusion by applicants between applications for registering Community designs and applications for international registrations. (Please refer further to CNS/2005/0273).

On the matter of designation fees, the Commission proposes that the Community, in its instrument of accession, declares that the prescribed designation fees referred to in the Geneva Act in relation to the application and the renewal are replaced by individual designation fees. These fees are payable to the International Bureau and shall be transferred by the International Bureau to OHIM. Since the accession of the Community to the Geneva Act will create a new source of revenues for the Office, Regulation 40/94 /EC should be amended accordingly.

OHIM will need to adapt its internal procedures and working methods in order to deal with the international applications at the International Bureau of WIPO in which the European Community is designated in order to obtain protection under the Community design system.

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.