

The Hague Agreement Concerning the International Registration of Industrial Designs

Report by INTA Designs Committee

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1. INTRODUCTION

1.1 General remarks on the Hague System

The Hague System for the International Registration of Industrial Designs (hereafter the Hague System) provides for the possibility of filing a 'multi-country' design application to replace the national filing before a national Intellectual Property Office (IPO). An International Design Application (IDA) can be submitted, either through the national office, including regional agencies such as the Benelux Office of Intellectual Property (BOIP), the European Union Intellectual Property Office (EUIPO) or the African Intellectual Property Organization (OAPI), or directly at the International Bureau of World Intellectual Property Organization (WIPO). Such an IDA is based on the rules and regulations of the Hague System.

i. The legal framework

The Hague System consists of several separate international treaties, the most important of which are: the London Act (1934), the application of which has been frozen since January 1, 2010, the 1960 Hague Act and the 1999 Geneva Act. Each treaty has different provisions and they exist independently of each other. The 1960 and 1999 Acts are supplemented by the "Common Regulations" and the "Administrative Instructions".

ii. Purpose and goal

The Hague Agreement Concerning the International Registration of Industrial Designs (the Hague Agreement) provides a mechanism for acquiring, maintaining and managing design rights in countries and intergovernmental organizations that are members of the Hague Union through a single international application filed with the International Bureau of the WIPO that results in a single international registration with individual effect in each of the Contracting Parties (States or intergovernmental organizations) designated therein.

iii. Centralized filing system vs. harmonization of design laws

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 are that the Hague System lowers transaction costs for design registrations.

The assessment of whether a design can be registered is, however, tested nationally. But the formal examination takes place at WIPO and is therefore uniform.

The purpose of the System is that the assessment of the design application against formal requirements is carried out centrally by WIPO. The material assessment of the IDA is then made by each IPO of the designated countries, on the basis of their local laws and regulations, as well as on the basis of any research into 'prior art' (when applicable). As mentioned in the WIPO website, the Hague System allows for "One application, one set of fees, and all in one language - Industrial design registration made easy!".

iv. An easier route to filing internationally

Acceding to the Hague System would enable small to large businesses to file directly to any of the 74 Contracting Parties (91 countries) that are currently part of the Hague system, with other major countries likely to join soon, including China. The US, the EU, Japan, Korea, and the UK are already part of the Hague System. The Hague System is a one-stop-shop solution that will reduce costs for local businesses and, more importantly, allow local businesses to expand internationally and compete on a global stage.

v. An easier route for international filers to file in a given country

While acceding to the Hague System can be perceived as an indirect cost to local designers and consumers, due to more "foreign" designs being protected in the concerned country, one needs to consider the flow-on effects of having foreign products, protected by designs, sold in the concerned country. This includes the sales tax collected on the design's product, the marketing and advertising spend in the concerned country to promote that product, the employees employed in the concerned country to sell that product, the distribution of the product in the concerned country, etc., all of which leads to more money being invested into the local economy from non-resident businesses to create more jobs and more economic growth.

1.2 INTA supports the Hague System

The Hague System contributes to facilitate the simultaneous protection of designs in the different member jurisdictions and thus the introduction of new products and technologies in different territories. The Hague System can thereby strengthen the countries' integration into the global economy. Designs or design patents are becoming a central element in the innovation toolbox of companies, as far as both marketing and technology innovations are concerned.

INTA supports international harmonization, which makes filing for design registration considerably easier and more cost-effective, particularly for individual designers and small to medium sized enterprises ("SMEs")

INTA believes that the protection of registered designs is a key component of today's economy. It therefore strongly supports the Hague System and will actively participate in its development in the future.

Under its [Board Resolution from November 15, 2016](#), INTA 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. Furthermore and under the same Board Resolution, INTA advocates that countries and intergovernmental organizations acceding to the Hague Agreement should enact implementing legislation on the registration and enforcement of design rights.

INTA will also assist the users of the Hague System and IPOs to find ways to simplify and harmonize procedures for industrial design registrations, notably by means of its [Guidelines for Examination of Industrial Designs](#).

2. ASSESSMENT OF THE KEY PRACTICAL FEATURES OF THE HAGUE SYSTEM

2.1 Formal review of the reproductions at WIPO

The formal review at WIPO also includes the assessment of the reproductions used to represent the design. WIPO assesses whether the International Design Application meets the requirements of the Hague Agreement. These requirements are set out in Rule 9 of the Common Rules under the 1999 Law and 1960 Law of The Hague Agreement.

Rule 9 states that a design can be displayed with photos or other graphics, that the design can be viewed from different angles, but that a separate reproduction must be included for each view. The reproductions must also be of sufficient quality and all details of the design must therefore be clearly distinguishable.

For contracting countries that have different requirements for the number or type of reproductions for correct design representation, it is possible to make a specific statement in this regard. On May 1, 2019, Japan revoked its original statement regarding the requirement of six orthographic views, and only South Korea currently has additional requirements for article series and font reproductions. For regular designs, therefore, there do not seem to be any other requirements for reproductions than the aforementioned set by the Hague Agreement.

2.2 Disclosure under local examination

The choice or selection of reproductions can, however, prompt national IPOs to refuse an IDA. This is because, under Rule 9 sub 4 of the Common Rules, contracting countries should not refuse an IDA on the grounds that the reproductions used in the application do not comply with national laws or regulations. The exception made in this article is that refusal with regard to the reproductions is permitted if these are deemed insufficient to fully disclose the design. A substantial proportion of IDAs in various countries face a refusal on this ground.

2.3 Full disclosure

The principle of full disclosure is a requirement in several countries that are part of the Hague System, especially those where design registration is part of the legal system of patent registration and protection. The requirement of full disclosure entails that the set of reproductions that is included in the application provides full disclosure of the design. The result is that if no reproduction is included of a feature of a design, the application is rejected unless the applicant adds a reproduction showing the feature in question within a certain timeframe.

Full disclosure is not a requirement in all jurisdictions. In many countries, anything that is not shown in the set of reproductions that is included in the application is not included in the protection obtained by the registration. If no reproduction is included of the backside or bottom of a design, the bottom or backside is not part of the design protection and will be disregarded in case of an infringement.

2.4 Popular jurisdictions

The United States, European Union (EU), Japan and South Korea are among the most selected jurisdictions in the Hague System. Several of the topics discussed in this Report are therefore specific to these jurisdictions.

2.5 Number of views

In order to visualize a three-dimensional design, views from different angles will be required. How many views are required or allowed and which views are considered essential may vary depending on the country.

An Application for a Registered Community design (RCD) that is filed directly with EUIPO allows a maximum of seven views per design. If more views are submitted, the other views will be completely disregarded with respect to assessment, registration, publication and design rights. The Hague system does not have a maximum number of views. If the EU is designated in an IDA and more than seven views are included in the application, EUIPO's review of the IDA - including the assessment of the validity of the design - will consider only the first seven views. The numbering of the reproductions is decisive on which views belong to the first seven.

One of the strictest IPOs in terms of assessing the reproductions used in a design application is the United States Patent and Trademark Office (USPTO). In the US, full disclosure of a design is required. Therefore, an IDA with a set of reproductions that does not fully disclose all aspects and all sides of a design will not be accepted. The same is true in Japan, South Korea and Russia. This means that the IDA should also include reproductions of e.g. the completely featureless and un-decorated bottom of a plant pot, the back of a cabinet and bottom view of a table.

In many countries it will be possible to add such reproductions after receiving an Office Action to this effect or provisional refusal on this ground. There is, however, one condition, namely, the additional reproduction may not be "new material". This means that if there is anything visible on the additional reproduction that was not already evident from the reproductions included in the

original application, the additional reproduction will not be accepted and the refusal will become final.

For certain designs, the bottom view is almost always relevant, like for instance sports shoes. It is therefore almost never allowed to add a view of the bottom of a sports shoe at a later stage.

In order to ensure full disclosure of the design it is recommended to include six orthographic views as well as several perspective views. Orthographic views are views 'straight to the eye', from the front, rear, top and bottom, as well as from the left and right sides. Perspective views show the design at an angle. At the USPTO, seven views are an absolute minimum and the examiner generally will prefer at least eight to ten reproductions. Especially so if the design is slightly more complex and a cross-section, exploded or detailed view must also be included to fully show the design and to obtain full disclosure.

If both the EU and the United States are selected in an IDA, the application will have to consider the discrepancy in the approach of the number of allowed or advised reproductions between these two jurisdictions, especially in case, to meet the requirements in the US, more than seven reproductions are deemed essential. As the perspective view mostly provide the best understanding of the design, it is advisable to place the reproductions with the perspective views at the front with a low number (1 to 7), followed by the most essential orthographic views as well as further explanatory views like cross-section, exploded or detailed views. The lesser informative orthographic views like those of the flat and undecorated bottom or back of a product should be last and given the higher numbers.

2.6 Reproduction type

As mentioned, an IDA is allowed to display the design with photos in color or black and white, Computed-Aided Design (CAD) drawing, line drawing or other graphics. If photos are used, the central condition is that the background is neutral and that no other objects are visible in the foreground. For any type of reproduction, it is not allowed to include numbering, geometric or other information in the reproduction.

For national design applications, the USPTO only accepts line drawings to represent the design. Only in case a photo is the only usable medium to reproduce the design is it allowed to use black and white photos. Color reproductions or photos are only accepted with a special petition explaining why it is necessary to use color. Due to the very stringent requirements, USPTO examiners tend to be somewhat preconditioned and seem to prefer line drawings photos or CAD drawings. If the United States is designated in an IDA, it is therefore advisable to opt for line drawings, of course, provided that a line drawing presents a suitable means for representing the design.

2.7 Surface shading

When using line drawings, surface shading is advised to clearly show the contours of all surfaces of the design and to distinguish between solid and open elements. The most common types of allowed surface shading are rectilinear shading, dotted shading or a combination of both. In most

cases, it is not possible to add surface shading to an already filed IDA later due to this being regarded as “adding new matter”, resulting – as a minimum – in a shift of the application date.

Due to the very stringent requirements imposed by the USPTO on nationally filed designs, USPTO-approved line drawings are often suitable for use worldwide for an IDA. The EUIPO and the Japanese Bureau also accept line drawings with shadow lines and shading. An important exception in this regard is South Korea, where hatching or shading is not allowed in the reproductions showing the mandatory views, being the six orthographic reproductions. Shading may be applied to the additional reproductions, such as the perspective views.

2.8 Visual disclaimers and use of dotted lines

If an applicant wants to claim protection for only a part of a product, a visual disclaimer can be used in many countries for design registration. By means of a disclaimer it is possible to protect the design of a part of a product, apart from the design of the rest of the product: for example, the application of a certain decoration on the outside of a sneaker. By protecting the application of the decoration as an independent design, action can be taken against third parties who use a very similar decoration on a (sports) shoe, regardless of the further design of that shoe. This can considerably broaden the scope of protection.

Internationally, the most common and accepted way is to represent the parts of the product that are excluded from protection by means of a dotted line. The Hague Agreement states that visual disclaimers can be displayed using dotted lines or using "color shading". By displaying the rest of the product in dotted line or in color shadow, the protected part can be visualized in the context of the entire object or product, while at the same time making clear that protection is claimed only for the non-dotted or uncolored part.

In addition, in the EU and Japan, dotted lines are allowed to show the context of a design in use without actually claiming that context or running the risk of reproduction inconsistency. This improves the understandability of the design application, which is again necessary in the light of full disclosure. The USPTO sees such a reference view as a normal view. The display of context in one of the views, despite the use of dotted lines, produces an inconsistent reproduction of the design and will often give rise to a refusal.

Caution is advised when using dotted lines in reproductions, as dotted lines can be interpreted differently by courts in the US and in Europe. This happened in the Apple v Samsung case in which Apple argued that a certain dotted line was intended to indicate a visible border under the screen, while Samsung claimed that, in accordance with the guidelines in force at the time, the dotted line should be regarded as a disclaimer. In the meantime, the EUIPO Guidelines state that, in addition to a disclaimer, dotted lines can also be seen as part of the design, for example stitching on a garment. If the use of a dotted line can lead to ambiguity, it is wiser to choose a different visual disclaimer.

It is also difficult to use dotted lines when using CAD display. Even then, using a different type of disclaimer, for example, the aforementioned "color shading" which is also accepted by EUIPO, is a better option. In addition, blurring, where the lines of the excluded parts are blurred, or

boundaries where the claimed part is carefully outlined, is a good alternative. What is important with every type of disclaimer is that it indicates in an absolutely clear and obvious way which parts are and are not claimed.

The EUIPO does not accept verbal disclaimers where, for example, an explanation or description may indicate that a particular color in which the design is depicted is not part of the design application. This is in contrast to the United Kingdom Intellectual Property Office (UKIPO).

2.9 Multiple application

An IDA can contain up to 100 designs provided they fall in the same Locarno class. For comparison purposes, a RCD filed directly at the EUIPO does not have a cap on the number of designs that can be included in a single application provided all designs fall in the same Locarno class.

In many countries, however, a so-called multiple application is not allowed. Multiple IDA will be refused in the United States and Russia due to the applicable “Unit of Design” or “Unity of Design” requirement. Under these regimes it is required to submit a separate design application for each design. Some applicants may opt for the filing of national design applications for the second and further designs in the multiple IDA. The applicant in that case should note that these national applications will have to meet with all national requirements, including those that apply to the reproductions. This means that quite possibly the sets of drawings used for the IDA cannot be used for the national design applications. For example, in Russia color shading is only accepted as a disclaimer for an IDA. For the national refiling of the design, drawings with dotted lines will be mandatory. Due to the novelty requirement and the reliance on the priority date of the original IDA, it is essential that the newly made reproductions clearly relate to the same design despite the amended reproduction type.

We see a trend towards the acceptance of multiple design applications. These were previously not allowed in South Korea and Japan in view of the Unity of Design requirement. However, the South Korean Office accepts multiple applications since 2017 and the Japanese Office accepts multiple applications since the entry into force of the new Japanese Designs Act in 2020.

2.10 Registration of a logo as a design

The Locarno classification includes a class 32-00 for graphic symbols and logos, surface patterns and decoration. A now recognized practice in the EU is the registration of logos, i.e. 2-dimensional graphic symbols or emblems, and sometimes even a combination of words and graphic elements, as designs. In the Community Design Register, a large number of trademarks registered as a logo in Class 32 can be found. A design registration of a logo protects the logo as a graphic element and the right holder can take action against unauthorized use of this logo regardless of the product on which it is applied. The protection is of course of a completely different order than the protection that a trademark registration offers: trademark registration allows action to be taken against the

use of similar signs whereas design protection merely protects against the use of a sign that does not give the informed user any other general impression.

Registration of a logo as a design provides relevant additional protection for the use of a logo on e.g. merchandise products, where design registration offers an interesting additional protection, also in light of the obligation to use a registered trademark.

While a large number of countries are members of the Locarno Classification Convention which includes class 32-00 for logos, only very few countries in fact accept registration of a logo as a design. South Korea even excludes registration of class 32-00 designs altogether, even if applied for through WIPO as part of an IDA based on the Hague Agreement.

3. SUMMARY OF THE MAIN CONCERNS FROM THE USERS' PERSPECTIVE

Despite all the benefits, there are also a few concerns one should be aware of. Most of them can be summarized as “one design application may not meet all different requirements worldwide”, which may lead to a risk of losing rights in certain countries.

First of all, there is no harmonized substantive design law applicable in all the participating countries. While WIPO only checks formalities, the individual IPOs in the participating countries apply their own – diverging – examination rules which may range from limited examination of absolute grounds only in Europe to full examination (including novelty assessment) in countries like the US, Japan and South Korea.

Second, a number of participating countries have very specific rules about the disclosure of the design and the representations being used for that purpose. The following examples are not exhaustive and only serve illustrative purposes:

- While a design application cannot be refused due to its choice of representations in general, an individual IPO in a participating country can refuse an application if it deems the representations insufficient to fully disclose the design.
- Some countries have specific rules about which representations need to be included in an application (e.g. the six “orthographic projection” figures in Japan) and how many views are required as minimum or allowed as maximum, respectively. Other countries simply do not protect those parts of a design not shown in an application.
- In addition, some countries allow showing a design in photos (color or black/white), CAD drawings, line drawings or other forms. However, various countries have strict rules which only allow line drawings (e.g. the US) except for very rare circumstances.
- In line drawings, the use of surface shading lines is allowed in the US, the European Union and Japan – but for example not in South Korea.

- Visual disclaimers are allowed in many countries (but not all) if protection is sought only for parts of a product. This is mostly done by using “dotted lines”, blurring or color shading.
- A written description of the characteristic features of the design is required in some countries and failure to include one may have a negative impact on the filing date in some countries, whereas the included description could have a limiting impact on the scope of protection of the design.

Third, there are different provisions worldwide on the number of designs which may be filed together in a multiple application or on the other related requirements (e.g. same Locarno class required).

Fourth, many countries (like the US) do not provide deferment of publication.

Finally, the Hague System is also quite slow compared at least to the fast registration process at the EUIPO and the overall fees are not necessarily cheaper compared to the national route.

Considering all the above points, filing an IDA provides for a lot of potential pitfalls – which is why legal advice from local counsel in the respective jurisdiction is still recommended and intended cost savings fall away.

In view of the novelty requirement and the priority claims, there is often also only one chance to file a design application correctly and the risk of pitfalls is disproportionately high with international designs. From this point of view and depending on the case at hand, applicants should assess whether or not the international route is the best option compared to a national design filing.

Some of the ways, which, in our opinion, could contribute to maximize the opportunities and minimize the pitfalls from accession to the Hague System, include:

- IPOs providing timely and quality examination of designs;
- Further harmonization with respect to standards for examination of designs. This could be achieved by international cooperation programs, promoted by WIPO, similarly to what is provided by the EUIPO, within the European Union, with its European Cooperation Projects;
- Further awareness raising efforts by governments and IPOs, with the support of the private sector, about the Hague System’s opportunities for local companies, including SMEs that do business abroad.

4. FINAL THOUGHTS

From a worldwide perspective, there is little harmonization of national legislations for design registration. Especially the requirements for the reproductions that are required for valid registration of a design may vary strongly. The Hague System offers the possibility of

internationally registering and protecting designs with a single set of reproductions. This is facilitated by the centralized formal examination of an International Design Application and the reproductions contained therein at WIPO. The formal examination is performed on the basis of the requirements of the Hague Agreement.

Nevertheless, in practice, the International Design Application route may not be as straightforward as it seems.

Like the Madrid System for international trademark registration, the Hague System is growing fast. For the Hague System to become as effective as the Madrid System, further harmonization of the requirements for design registration is required, both in connection with the reproductions, in view of 'incomplete disclosure', as well as with acceptance of applications for multiple designs. The more countries joining the Hague System, the more important these topics will become.

For more information on the work of INTA's Designs Committee, see <https://www.inta.org/committees/designs-committee>.