

Hague System

The Hague System for the International Registration of Industrial Designs (Hague system) provides a procedure for obtaining registered design protection in several countries based on one application, filed in a single language at a single office. This can save time and effort, as the separate application, fees and languages involved in obtaining protection in the same countries are no longer required.

Advantages

If you want to obtain registered design protection in a number of countries, the normal procedure would be for Barker Brettell to engage attorneys in each country, to file separate applications. Each application is then processed separately.

Under the Hague system, a single application can be filed. The single application can be made to have effect in all the countries you are interested in. This means that there is no need to have lots of different applications, and use lots of different foreign attorneys to file your application.

Furthermore, after the application process is complete, the single registered design can be managed centrally, further reducing cost and complication. Renewal fees and changes in ownership are managed by a central office. Under the normal procedure, with lots of separate registrations, this type of management needs to be done on each individual design.

These differences mean that using the Hague system to obtain registered design protection in a number of countries may be simpler and less expensive.

Procedure

An application for design protection under the Hague system is filed at the World Intellectual Property Office (WIPO). The application must include drawings of the design that you want to protect, and a designation of which countries you want protection in.

After the application is filed, WIPO check it to make sure it complies with their formal requirements. The application is then sent to the Intellectual Property Offices of the countries designated in the application, where it is checked against local requirements. The local Intellectual Property Offices have a fixed period (six months for some countries, twelve for others) to forward any objections they have to WIPO. WIPO forwards the objections to the applicant.

In some territories, for example, for a European Community application, there are no significant formal requirements to meet, beyond what is required by WIPO. However, in other countries, the design may undergo substantive examination.

Where objections are received, it does not mean that the application has been refused, but it is necessary to file a response. At this stage, it may be necessary to appoint a local attorney to interact with the local Intellectual Property Office. The application can still be granted, if the objections raised can be overcome.

However, if the objections are not overcome, the application is refused. Refusal in one country does not necessarily mean that the application is refused in all the designated countries.

Some countries provide a positive indication that they do not have any objection, and that the design has been registered there. However, other countries do not, and it is simply the absence of any objections within the fixed period that lets you know the design has been registered there.

Coverage

The Hague system can be used to obtain protection in, for example, the EU, the US, Japan, and South Korea. The list of countries where you can obtain protection through the Hague system is constantly changing, as more countries sign up. The full list can be found on the WIPO website, at <http://www.wipo.int/export/sites/www/treaties/en/documents/pdf/hague.pdf>.

There are some countries where design applications are commonly filed (including, for example, Australia, Canada and China) which are not currently signed up to the Hague system. In these cases national applications would need to be filed instead.

The UK has not signed up for the Hague system, but protection can be obtained in the UK through an EU design.

Multiple Designs

In some countries covered by the Hague system, multiple designs can be filed in the same design application, provided all the designs relate to similar products. In other countries, separate applications must be filed for each design.

A Hague design registration can include multiple designs. However, for countries where local requirements do not permit multiple designs, separate applications will need to be filed, to get protection for all the different designs. A Hague application can provide at least a deferral of these filing costs, and, in some cases, reduce the overall filing costs.

Who can file?

An individual or company can file an application under the Hague system if:

- They are a national of a state that has signed up to the Hague system or a state that is a member of an intergovernmental organisation that has signed up to the Hague system (such as the EU);
- They are domiciled in a state that has signed up to the Hague system or a state that is a member of an intergovernmental organisation that has signed up to the Hague system (such as the EU); or
- They have "real and effective industrial or commercial establishment" in a state that has signed up to the Hague system or a state that is a member of an intergovernmental organisation that has signed up to the Hague system (such as the EU)

Possible problems

There can be certain problems with the Hague system, which mean that it may not be the best option in all situations.

Each country has its own requirements for how drawings should look, for example, what is meant when a drawing includes dashed lines, or whether shading in drawings is permissible. Given the varying requirements in different countries, contacting or using a local attorney in the preparation/filing stage can be beneficial and can avoid irremediable problems later on.

In some situations, it can be relatively straightforward to prepare a set of drawings that comply with all the requirements of the designated countries, and which show the design in sufficient detail. However, in other situations, different drawings may be required for different countries.

Where different drawings are required in different countries, it can be very difficult, or even impossible, to alter the drawings after the application is filed. This means that in some scenarios, it can be better to file separate applications with different drawings.

There are also other aspects of local law (for example whether a design is valid) that may be important, which the attorneys filing the Hague design may not be aware of. This may mean the protection may not be as broad as it could be. These issues are particularly important for more complex cases, and there is some benefit in using a local attorney.

Whilst some territories, for example, the European Community and the US provide a grace period in which public disclosures prior to filing are not prejudicial, many countries do not. Although such issues may not be apparent when filing an application, it is still worthwhile to consider this prior to filing to ensure filing costs are not incurred unnecessarily and that actions are taken at the correct time to ensure valid and adequate protection.

What can be protected is also a matter of national law. For example, whilst computer icons, cartoon characters and the like are freely registrable in Europe, the same is not true in the US or Japan. Therefore, there may be a problem with a Hague registration covering countries having different law.

Another consideration is when the application will be published. WIPO publishes the application after filing. This provides provisional protection (which was not previously available for US applications). Deferred publication is an option for some countries, but not the US. If an application designates Europe and the US, even though Europe provides for deferring publication, the fact the US is designated means deferral is not possible, which may be undesirable in some situations.

Costs

The cost of filing an application under the Hague system varies widely, depending on how many countries are to be covered, what countries are to be covered, how many different designs there are, and how many drawings there are. If you want to obtain protection in the US, the cost can also vary depending on whether the owner of the application is an individual, a small company, or a large company. Some example approximate costs for different applications under the Hague system:

Example application	Filing cost
1 design, 6 drawings total, covering: the EU and the US (owned by an individual)	£1500 / \$2050
1 design, 6 drawings total, covering: the EU and the US (owned by an SME)	£1650 / \$2250
1 design, 6 drawings total, covering: the EU and the US (owned by a large company)	£1900 / \$2600
3 designs, 20 drawings total, covering: the EU and the US (owned by an SME)	£2250 / \$3100
1 design, 6 drawings total, covering: the EU, the US (owned by an SME), Switzerland, Turkey, Norway, Japan, and Korea	£2850 / \$3900
3 designs, 20 drawings total, covering: the EU, the US (owned by an SME), Switzerland, Turkey, Norway, Japan, and Korea	£4800 / \$6600

The costs will also vary with exchange rates, as official fees are calculated in Swiss Francs. The above costs are based on the exchange rate correct as of January 2018.

It is also worth bearing in mind that, as with national design registrations, the Hague registration has to be renewed. The Hague application is renewed every five years. The renewal fee is based on the number of designs, and the countries designated. In some cases, depending on the number of designs and the designated countries, the renewal fee for the Hague registration may be higher than the cost for renewing separately applications. This may offset any savings in the filing fee.

At Barker Brettell, we have a large group dedicated to designs and copyright, made up of a mix of patent and trade mark attorneys. Please contact designs@barkerbrettell.co.uk if we can be of any assistance.