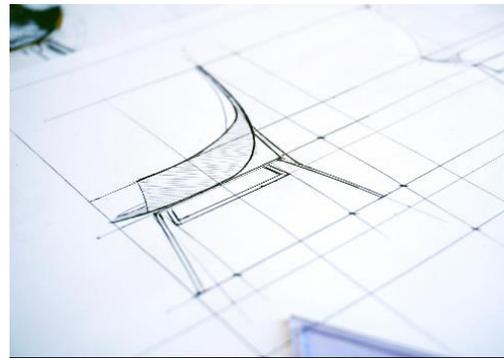


Protecting Designs Internationally: Making The Hague System Work For You

Background

Despite areas of harmonization, the (sometimes) painful reality is that intellectual property laws vary significantly between different countries. This introduces inherent complexities and challenges for portfolio management.



Of course, the Patent Cooperation Treaty (PCT) addresses this challenge by providing a centralized procedure for the processing of **patent** applications across 154 countries¹. The popularity of the PCT system - with over 277,000 applications² filed in 2021 – is understandable.

Why then has the corresponding international Hague **design** system – with just under 29,000 applications³ in 2021 - failed to prove as attractive to those seeking design protection across international boundaries? Are we all missing a trick?

What is the Hague System?

The Hague system allows applicants to centrally secure and manage design rights across 77 contracting states covering 94 countries⁴, including the whole of Europe, the United States, and (as of May 2022) China.

Like its counterpart for patents, the Hague system eliminates the need to file multiple national design applications whilst navigating local laws, languages, and currencies.

Instead, a single application filed in English can cover up to 100 designs. The time-consuming process of coordinating the appointment of local attorneys in each

¹ https://www.wipo.int/pct/en/pct_contracting_states.html

² <https://www3.wipo.int/ipstats/pmindex.htm?tab=pct>

³ <https://www3.wipo.int/ipstats/pmindex.htm?tab=hague>

⁴ <https://www.wipo.int/export/sites/www/treaties/en/documents/pdf/hague.pdf>



designated contracting state is avoided. The official fee structure is simple and consists of a Basic Fee, a Publication Fee, and Designation Fees in respect of each of the designated contracting states selected. Indeed, the Designation Fees payable via a Hague application are typically less than the official fees payable when applying at a national level.

How Does it Work?



An intuitive, guided electronic filing platform named **eHague** is provided by the World Intellectual Property Organization (WIPO).

Once filed, a Hague application is examined centrally for compliance with basic formalities. Once those basic checks are complete (and any objections overcome), a certificate of international registration will be issued.

Thereafter, the international registration is published in the weekly international designs bulletin⁵. Applicants can request immediate or deferred publication consistent with local laws in the relevant designated contracting states.

Publication triggers a 6-month period within which each designated contracting state may issue a notice of refusal via WIPO, i.e. on the basis that, following local substantive examination, the international registration fails to meet local laws or requirements. Some offices (notably the US Patent Office and China's State Intellectual Property Administration) are "Examining Offices" which perform full novelty examination. Those offices are afforded an extended 12-month period for issuing a notice of refusal.

Refusals may be contested directly with the relevant national office(s). Refusal by one designated contracting state does not adversely affect the validity of the international registration in other jurisdictions. In the absence of a notice of refusal received within the 6 or 12-month deadline, the international registration takes effect in the relevant designated contracting state.

Post Registration

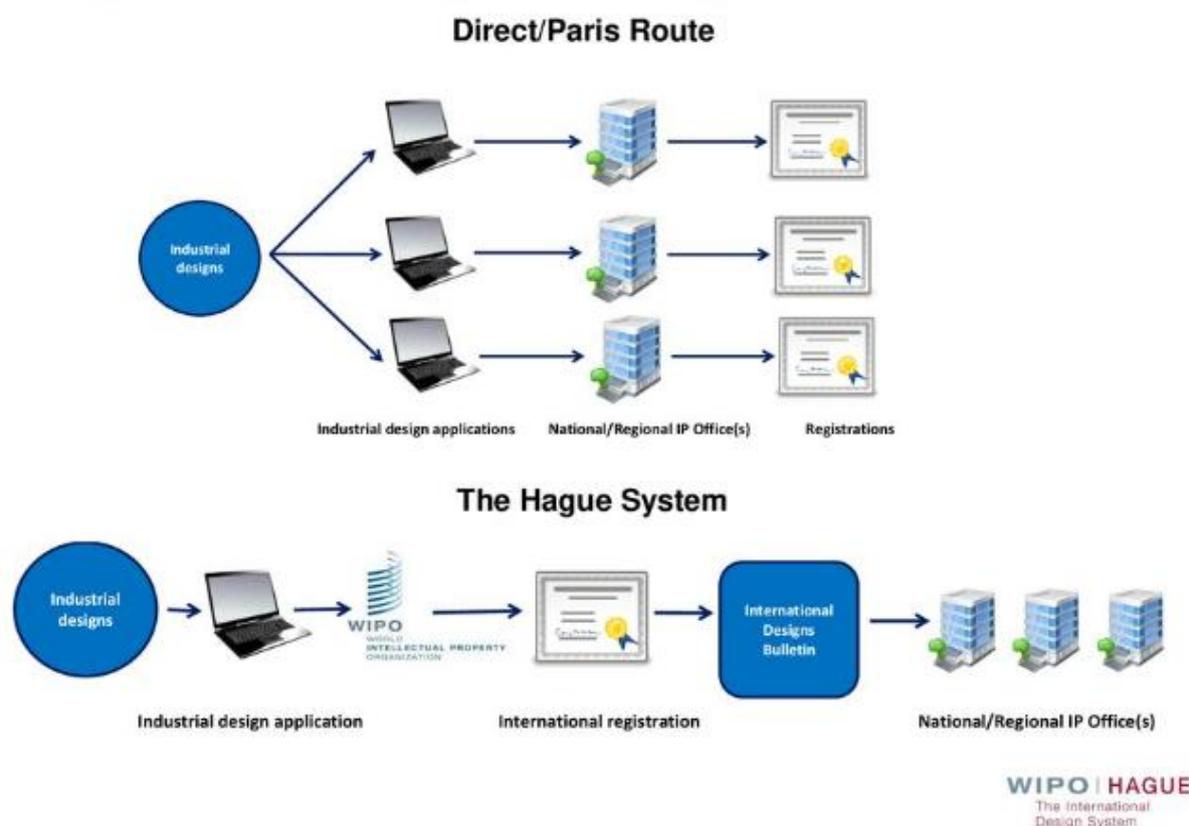
International registrations are valid for an initial period of 5 years. Dependent on local laws, are renewable up to a maximum 15 or 25-year term. Renewals are paid

⁵ <https://www.wipo.int/haguebulletin/>



centrally via the eHague platform only for the designated contracting states where renewal is required.

An Illustration



Hague & Brexit

Since the UK's departure from the European Union (remember "Brexit"), a Registered Community Design issued by the EU Intellectual Property Office (EUIPO) no longer takes effect in the United Kingdom. Consequently, applicants now requiring protection throughout the EU and the United Kingdom face the administrative inconvenience of filing two separate applications via the EUIPO and the UK Intellectual Property Office (UKIPO), with two sets of official fees in different currencies, perhaps via two sets of local attorneys.

Given the benefits of the Hague design system, it is therefore unsurprising that the number of Hague applications designating the United Kingdom increased markedly from circa. 1,100 in 2019 (pre-Brexit) to 3,650 in 2021 (post-Brexit).



Is The System Underutilized?

Despite the recent clear uptick in Hague applications naming the United Kingdom as one of its designated contracting states, it is arguable that the Hague system is, overall, underutilized. Partly, potential users of the system are deterred by a lack of harmonization amongst contracting states concerning issues such as representation requirements, disclaimers, and the fact that multiple designs are not allowable in key contracting states.

The recent (May 2022) addition of China as a contracting state will likely add a significant number of China-originating Hague system filings, and it may also make the system more attractive to design applicants in other contracting states.

Can we help you?

For tailored advice on international design filing strategies, including the international Hague system, please **contact Steven McIlroy**.



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