

The UK joins the Hague System for International Industrial Designs

The UK has joined the Geneva Act under the Hague Agreement Concerning the International Registration of Industrial Designs (“Hague Agreement”) with effect from 13th June 2018.



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The Hague Agreement, which is similar to the PCT for patents and the Madrid Protocol for trade marks, provides a mechanism for acquiring design rights in member countries of the Hague Union by way of a single international application (which can cover as many as 100 designs provided the designs are in the same Locarno class) filed with the International Bureau of the World Intellectual Property Organization (WIPO). That results in a single international registration with effect in each of the designated countries and can provide considerable cost savings over filing national applications.

Subsequent dealings such as renewals, assignments and the recordal of changes of name are also handled centrally by WIPO which can again provide considerable cost savings compared to national design registrations.

The fate of each of the national designations under a Hague registration is independent of the other designations such that rejection in one

country has no effect in others. Furthermore holders of design registrations can choose after filing to abandon certain designs and/or certain designated countries if they so wish.

A list of the various countries which can be designated is shown [\[here\]](#), with applicants in the UK being able to designate any of the countries which are also party to the Geneva Act, i.e. the UK together with important jurisdictions such as the EU, the US, Japan, Korea, Russia and Switzerland. It is hoped that other important jurisdictions will join the Hague system in the near future such as China and Canada.

Unlike the Madrid Protocol, Hague applications are not based on an application or registration filed in the applicant’s home jurisdiction. A Hague application can therefore serve as a priority application for further applications elsewhere.

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In order to file a Hague application under the Geneva Act, an applicant must meet one of the four following qualifying criteria:

- a) be a national of a Contracting Party, or**
- b) have a domicile in the territory of a Contracting Party, or**
- c) have a real and effective industrial or commercial establishment in the territory of a Contracting Party; or**
- d) be habitually resident in the territory of a Contracting Party**

UK applicants have since 2008 been able to use the Hague system by virtue of the UK's membership of the European Union. However, the fact that the UK has now acceded to Hague will ensure that UK applicants continue to be able to file Hague applications and own existing Hague registrations under the Geneva Act irrespective of the UK's withdrawal from the EU.

The UK has decided that it will not re-publish Hague registrations designating the UK in order to make the procedure as streamlined as possible.

While the accession to the Hague Agreement is to be welcomed, there may be cases in which it is still preferable to file national applications depending on various factors including geographical spread, cost, whether it is intended to defer publication of the designs etc. Moreover, if protection is required in countries which are not yet party to the Hague system, then it will remain necessary to file national applications. We will of course be

happy to advise on the best strategies to protect your designs both in the UK and internationally.

If you have any questions about matters in the Newsletter, please get in touch with your usual Abel & Imray contact, or e-mail to ai@abelimray.com.