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Discriminating treatment of Hague designs extended to RUSSIA as the Russian PTO does not allow Hague design holders to respond to refusals which is non-compliance with Article 12(3)(b) of Geneva Act 1999

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When deciding whether to opt for the Hague International Design System or go the national route, it is tempting to choose to go with the Hague International Design System for all the conveniences that are involved, namely the streamlined administrative filing process via **a single application** that can be filed through the national office of the basic design (or directly through the International Bureau of WIPO (hereinafter WIPO)) in **one** language. This single filing provides the applicant with **one** effective filing date. All formal requirements are reviewed by the WIPO first and, if satisfied, WIPO publishes the application and then sends it to each designated country.

According to Article 12(3)(b) of Geneva Act 1999 (with the following text: “*The holder shall enjoy the same remedies as if any industrial design that is the subject of the international registration had been the subject of an application for the grant of protection under the law applicable to the Office that communicated the refusal. Such remedies shall at least consist of the possibility of a re-examination or a review of the refusal or an appeal against the refusal.*” (our underlining)), the holder enjoys the same rights whether or not the holder applies nationally or through WIPO.

As Russia is a party to the Hague International Design System and Geneva Act 1999, one would expect the IPO to comply with rules laid out in the Hague Agreement and the Geneva Act.

Unfortunately, when designating Russia through the Hague Design System, the applicant is not given the option to defend or file responses to provisional refusals, whereas applicants of national design applications are legally allowed to respond to provisional refusals within a three-month term following the date of issuance of the provisional refusal, and this term is extendable up to 10 months. Such responses are considered by the Design department of the relevant Russian authorities (hereinafter Rospatent). This procedure is regulated by the Russian national legislation, in particular, Articles 1393.3 and 1386.6 of the Civil Code.

Unfortunately, Rospatent does not accept responses to refusals issued in Hague design registrations extended to Russia inside of the Design department. Instead, Rospatent issues **final (not provisional) refusals** upfront and thereby forces the holders of international design registrations to

file objections at the Chamber for Patent Disputes which involves extra costs (both official fees and professional fees) and attending oral hearings like in court.

Equal rights for the holders of international design registrations to defend their designs against provisional refusals during examination are inherently embodied in Geneva Act 1999. However, Rospatent does not comply with Article 12(3)(b) of Geneva Act 1999.

In view of the existing situation, applicants interested in obtaining protection of their industrial designs in Russia are recommended to file national design applications rather than applying through Hague to have a chance to counter-argue a provisional refusal issued by Rospatent.

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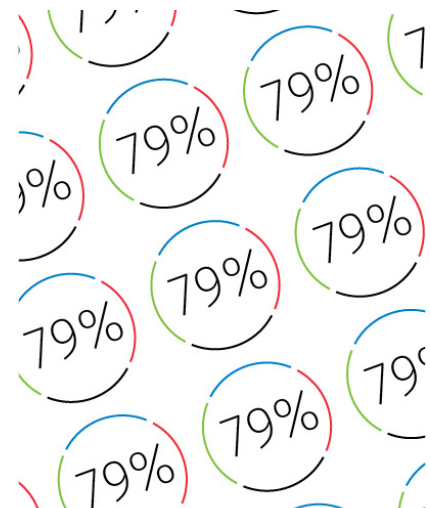
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