

Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications

**Third Special Session - Preparation of the Basic Proposal for the Diplomatic
Conference to Conclude and Adopt a Design Law Treaty (DLT)
Geneva, October 2 to 6, 2023**

PROPOSAL BY THE DELEGATION OF JAPAN

Document prepared by the Secretariat

In a communication dated September 13, 2023, the Delegation of Japan transmitted to the International Bureau of the World Intellectual Property Organization (WIPO) the proposal contained in the Annex to the present document.

[Annex follows]

PROPOSALS BY JAPAN ON INDUSTRIAL DESIGN LAW AND PRACTICE – DRAFT ARTICLES, REGULATIONS, NOTES AND UNDERSTANDING¹

I. INTRODUCTION

This document presents Japan's proposals for changing or adding the articles, rules, notes or understanding for consideration by the Third Special Session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) from October 2 to 6, 2023.

The purpose of the document is mainly to clarify Japan's arguments and comments that were made during the previous sessions of the SCT, or to further clarify matters provided for in the draft Articles and Regulations of the DLT.

II. PROPOSALS

1. Article 1(viii) – Proposed note and understanding about “procedure before the Office”

Considering that the DLT has the same structure and purposes as the Patent Law Treaty (PLT) and the Singapore Treaty on the Law of Trademarks (STLT), it is our opinion that the phrase “procedure before the Office” in Article 1(viii) of the DLT would not cover judicial procedures under the applicable law or the Contracting Parties' legislation. This is in line with the understandings adopted at both the Diplomatic Conference for the Adoption of the Patent Law Treaty (PLT) and the Diplomatic Conference for the Adoption of a Revised Trademark Law Treaty.

It is proposed that an additional note on Article 1 be included in the Basic Proposal of the DLT, which reads, for example,

“It is understood that the words “procedure before the Office” would not cover judicial procedures under the applicable law. It takes account of the variety of legal systems between offices. In particular, in many countries, there is a distinct division between the “Courts” and the “Office.” In others the distinction is less clear in that judicial bodies are formally part of the Office. The words “judicial procedures” are intended to include the procedures of internal bodies where those bodies are covered by the general administrative law but not where they are covered by the general judicial law.

This proposed wording is modeled on Note 1.06 on Article 1 of the Revised Trademark Law Treaty and the Regulations Thereunder, and paragraph 2402 of the Records of the Diplomatic Conference for the Adoption of the Patent Law Treaty.

Furthermore, it is proposed that the same or similar agreement or understanding appear in the Resolution by the Diplomatic Conference Supplementary to the Design Law Treaty, following Paragraph 2 of Resolution by the Diplomatic Conference Supplementary to the Singapore Treaty on the Law of Trademarks and the Regulations Thereunder², as well as Paragraph 1 of

¹ DISCLAIMER: Japan may make additional proposals or amendments based on further consideration at a later stage.

² RESOLUTION BY THE DIPLOMATIC CONFERENCE SUPPLEMENTARY TO THE SINGAPORE TREATY ON THE LAW OF TRADEMARKS AND THE REGULATIONS THEREUNDER

(...)

2. When adopting the Treaty, the Diplomatic Conference agreed that the words “procedure before the Office” in Article I(viii) would not cover judicial procedures under the Contracting Parties' legislation.

(...)

the Agreed Statements by the Diplomatic Conference Regarding the Patent Law Treaty and the Regulations under the Patent Law Treaty³.

2. Article 9 and Rule 6 – Proposed change in details of the minimum period for the deferment of the publication

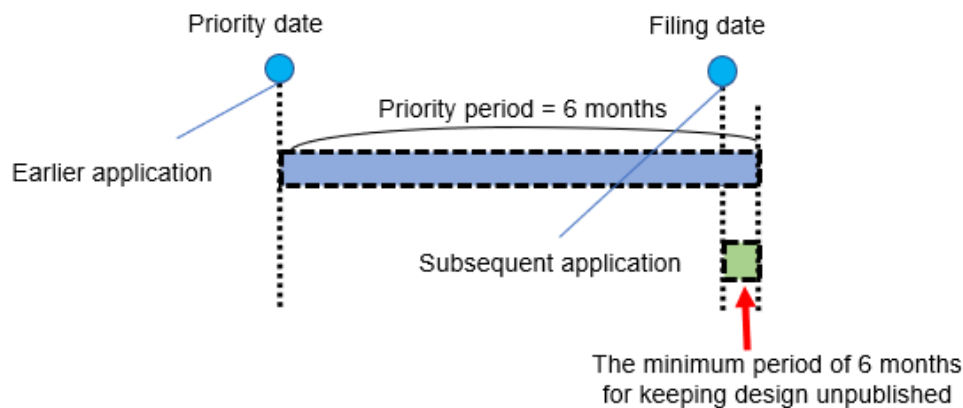
Japan proposes amending the text in Rule 6 as follows:

“Rule 6 Details Concerning Publication

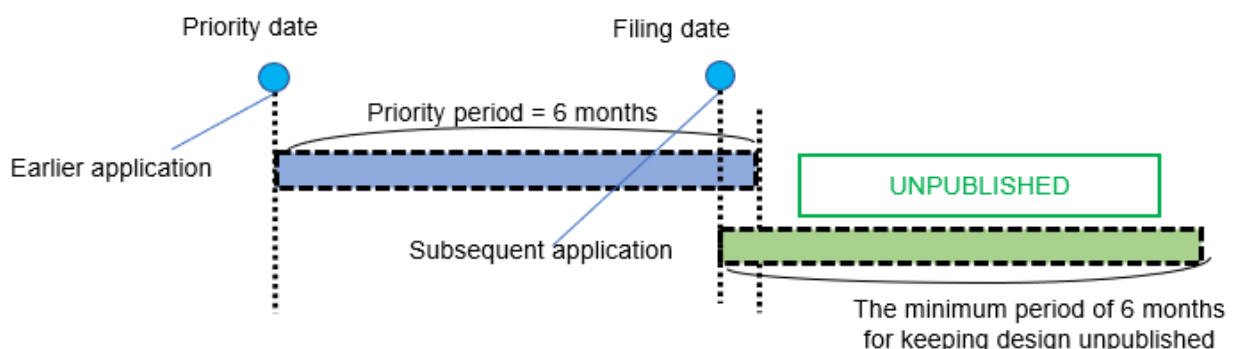
The minimum period referred to in Article 9(1) shall be six months from the filing date ~~or, where priority is claimed, from the priority date.~~”

Recalling Japan’s arguments made at the 30th and 31st session of the SCT⁴, images are shown below for clarification.

Under the current text of Rule 6, applicants are not able to fully take advantage of what Article 9 intends to achieve, due to the limited short period of the publication deferment as shown below, if a subsequent application is filed just before the expiration of six months from the priority date.



Under the above-mentioned proposal for amendment to Rule 6, users would be able to benefit from the system referred to in Article 9.



³ AGREED STATEMENTS BY THE DIPLOMATIC CONFERENCE REGARDING THE PATENT LAW TREATY AND THE REGULATIONS UNDER THE PATENT LAW TREATY

1. When adopting Article 1(xiv), the Diplomatic Conference understood that the words “procedure before the Office” would not cover judicial procedures under the applicable law.

(...)

⁴ See Paragraph 127 of SCT/30/9 and Paragraph 65 of SCT/31/10

3. Article 6 – Proposed change in grace period

Instead of having the current two options of six or 12 months, Japan would like to pursue the single period of 12 months, for the benefit of users. Therefore, Japan proposes to amend the text of Article 6 as follows:

“Article 6 Grace Period for Filing in Case of Disclosure

A disclosure of the industrial design during a period of ~~six or~~ 12 months preceding the date of filing of the application or, if priority is claimed, the date of priority, shall be without prejudice to the novelty and/or originality, as the case may be, of the industrial design, where it was made:

- (a) by the creator or his/her successor in title; or*
- (b) by a person who obtained information about the industrial design directly or indirectly, including as a result of an abuse, from the creator or his/her successor in title.”*

4. Article 14(1) and Rule 12(2) – Proposed change to or addition of texts concerning the addition or correction of priority claim

(1) Treatment of requests filed after the completion of substantive examination

Referring to an exception concerning the correction or addition of a priority claim under Rule 14 of the Regulations Under the Patent Law Treaty⁵, Japan proposes adding a new paragraph to Rule 12 and a new note as follows:

“Rule 12 Details Concerning Correction or Addition of Priority Claim and Restoration of Priority Right Under Article 14

- (1) [Requirements Under Article 14(1)(i)] A Contracting Party may require that a request referred to in Article 14(1)(i) be signed by the applicant.*
- (2) [Time Limit Under Article 14(1)(ii)] The time limit referred to in Article 14(1)(ii) shall not be less than six months from the priority date or, where the correction or addition would cause a change in the priority date, six months from the priority date as so changed, whichever six-month period expires first, provided that the request may be submitted until the expiration of two months from the filing date.*
- (3) [Exception] No Contracting Party shall be obliged to provide for the correction or addition of a priority claim under Article 14(1), where the request referred to in Article 14(1)(i) is received after the substantive examination of the application has been completed.*
- ~~(34)~~ [Time Limits Under Article 14(2)] The time limits referred to in Article 14(2), introductory part, and Article 14(2)(ii) shall expire not less than one month from the date on which the priority period expired.*
- ~~(45)~~ [Requirements Under Article 14(2)(i)] A Contracting Party may require that a request referred to in 14(2)(i):*
 - (i) be signed by the applicant; and*
 - (ii) be accompanied, where the application did not claim the priority of the earlier application, by the priority claim.”*

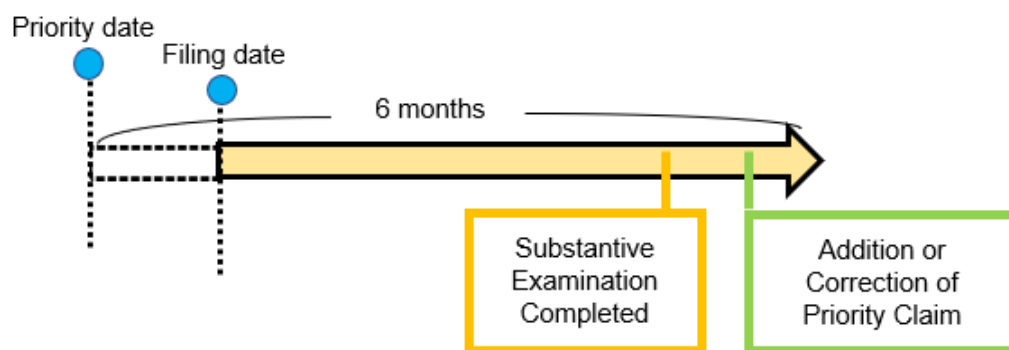
⁵ Rule 14 of the Regulations Under the Patent Law Treaty

“Details Concerning Correction or Addition of Priority Claim and Restoration of Priority Right Under Article 13 (1) [Exception Under Article 13(1)] No Contracting Party shall be obliged to provide for the correction or addition of a priority claim under Article 13(1), where the request referred to in Article 13(1)(i) is received after the applicant has made a request for early publication or for expedited or accelerated processing, unless that request for early publication or for expedited or accelerated processing is withdrawn before the technical preparations for publication of the application have been completed.”

“Notes on Article 14

Note 14.0X Paragraph (1). This paragraph does not necessarily intend to affect the result of substantive examination, that is, a judgement made by the Office on whether or not the industrial design can be registered. A Contracting Party may disregard the request for the correction or addition of a priority claim with respect to a subsequent application for which its Office finished substantive examination (- see Rule 12(3) [Exception]). Otherwise, some Offices would have to wait for the period of priority referred to in the Paris Convention to expire with respect to all applications, as the correction or addition of priority claims which can be filed during this period could affect the registrability of industrial designs. Such Office’s choice of practice would not benefit applicants who would like to receive the result of substantive examination from the Office, and have their industrial design registered as early as possible.”

Recalling Japan’s arguments made at the 29th and 30th sessions of the SCT⁶, an image is provided below to clarify Japan’s concern.



Where a subsequent application is filed shortly after the priority date, it would be difficult for some Offices that conduct substantive examinations to reopen and re-examine cases after the completion of their substantive examination.

As mentioned in the proposed note, some Offices would have to wait for the period of priority referred to in the Paris Convention to expire with respect to all applications, as the correction or addition of a priority claim which can be filed during this period could affect the registrability of industrial designs. Such Office’s choice of practice would not benefit applicants who would like to have their industrial design protected and registered as early as possible.

(2) Ensuring an opportunity for filing priority documents when the priority date has changed as a result of requests for the correction or addition of a priority claim

Japan proposes adding a new note to Article 14.

For example,

“Notes on Article 14

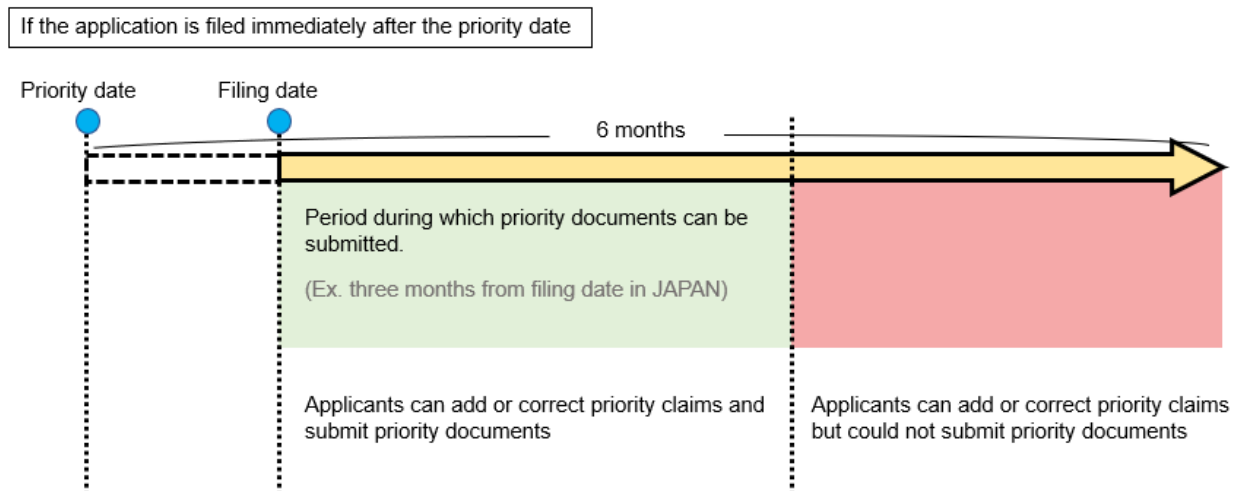
Note. 14.0X

Paragraph (1). A Contracting Party should note the relationship between the time limit prescribed in Rule 12(2) for filing a request for the correction or addition of a priority claim under this provision and the time limit prescribed under its own law for filing evidence in support of the declaration that may be required pursuant to Article 4 of the Paris Convention (see Article 3(1) (vii)) such as priority documents, and, if necessary, take an appropriate action by taking into account the purpose of this provision. For example, when the correction

⁶ See Paragraph 156 of SCT/29/10 and the second sentence in Paragraph 139 of SCT/30/9

or addition of a priority claim under this provision causes a change in the priority date, the priority claim should not be disregarded on the grounds that the time limit for filing such evidence has expired. Otherwise, there is no point in allowing the correction or addition of a priority claim in the above-mentioned example.”

Recalling Japan’s comment made at the 30th session of the SCT⁷, an image is provided below to further explain Japan’s concern in relation to Article 14(1) and Rule 12(2).



Although the current draft DLT does not prescribe any time limit for filing priority documents, the period for doing so must cover the period for filing a request to correct or add a priority claim. Otherwise, an applicant might not be able to enjoy the priority of an earlier application, due to the lack of evidence or documents in support of the priority.

5. Article 15 (Recording of a License), Article 16 (Amendment or Cancellation of the Recording of a License), and Article 19 (Recording of a Change of Ownership) – Proposed addition of new notes for a specific design protection system

Japan proposes adding new notes to Articles 15, 16 and 19, respectively, to confirm that Offices are permitted to require users to make a collective request for recording in respect of several industrial designs for a specific design protection system. Such confirmation would be essential for countries that have “Related Design System” (see the explanation below) or other similar system.

For example,

“Notes on Article 15

Note 15.0x Paragraph (4) does not exclude the possibility of requiring a collective request for several “related” registrations in offices. A Contracting Party may, as provided for under its applicable law, require the collective request for recording an exclusive license in respect of several “related” designs.

“Notes on Article 16

Note 16.0x Paragraph (3) does not exclude the possibility of requiring a collective request for several “related” registrations in offices (see Note 15.0X).”

“Notes on Article 19

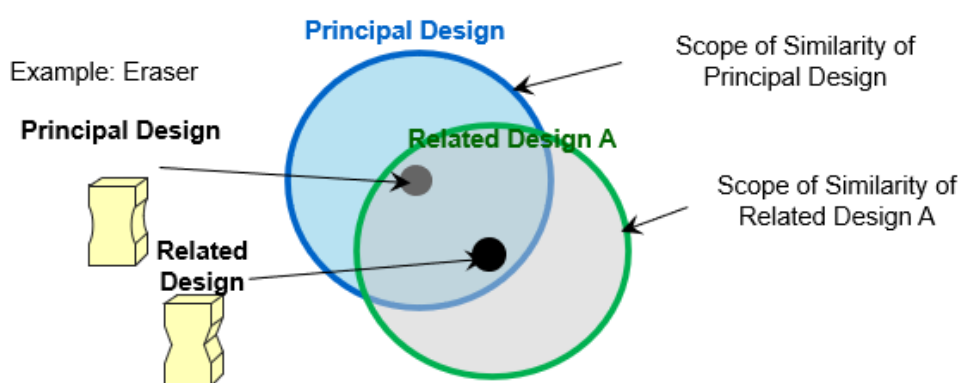
⁷ See the first sentence in Paragraph 139 of SCT/30/9

Note 19.0x Paragraph (6) does not exclude the possibility of requiring a collective request for several “related” registrations in offices.

The reason why the collective request is required in Japan is due to the presence of a “Related Design System”⁸ under Japan’s Design Act. The system is to protect multiple variations created based on a single concept of designs having equivalent value. Creators or holders can take advantage of the system to expand the scope of protection.

In principle, “double-patenting” is prohibited under Japan’s Design Act, or a similar design is to be rejected based on the prior similar design. Therefore, a “Related Design System” is an exception to this prohibition.

As shown in the image below, the scopes of the two industrial designs (principal and related) conflict with each other.



This specific system comes with certain restrictions. The principal design and its related designs are not allowed to be separated for the duration of their lifespan. In other words, the principal design and its related designs must always be registered under the name of the same holder, and the principal design must not be transferred separately from its related designs. This is why countries which have this system must require the collective request of recording in respect to the principal design and its related designs.

6. Article 3 (Application), Article 10 (Communications), and Article 11 (Renewal) – Proposed addition of a new note

Referring to note 6.15 on Article 6 of the PLT⁹, Japan proposes adding a new note on Article 10 to confirm that the DLT allows the Contracting Parties to require users to include within communications the indications which are necessary for the Offices to collect fees.

⁸ Designers often create several variations of a design simultaneously or in stages, and in such cases the designer's creations cannot be adequately protected if the second and subsequent designs are not protected because of the prohibition of "double-patenting". For this reason, Japan provides for a Related Design System to permit the registration of such variations in order to prevent the adverse effects of the prohibition of "double-patenting", with certain restrictions.

⁹ Notes on Article 6 of the PLT

"6.15 Paragraph (4). This paragraph permits, but does not oblige, a Contracting Party to charge fees in respect of applications. However, it does not regulate to whom the fee is paid, for example, whether it is paid to the Office, another agency of the government or a bank. It also does not regulate the method of payment, so that each Contracting Party is free to decide whether to allow payments made, for example, from a deposit account with the Office or by electronic transaction, or whether to require, for example, in the case of applications filed electronically, that fees be paid by using a deposit account. A Contracting Party is also permitted to require the amount of the fee and/or its method of payment to be indicated, for example, on a fee sheet as prescribed under PCT Rule 3.3(a)(ii)."

For example,

“Notes on Article 10

Note 10.XX

Paragraph (7). A Contracting Party is permitted to require indications which are necessary for Offices to collect fees, such as the amount of fees and the method of payment, to be contained in communications which are referred to in Article 1(1)(a)(ix), including applications and requests for renewal. In practice, such information is necessary for Offices to collect required fees.”

[End of Annex and of document]