

Diplomatic Conference to Conclude and Adopt a Design Law Treaty (DLT)

Riyadh, November 11 to 22, 2024

**RESOLUTIONS SUPPLEMENTARY TO THE TREATY PROPOSED FOR ADOPTION
BY THE DIPLOMATIC CONFERENCE**

Proposal by the Delegations of Japan and of the Republic of Korea

The Delegations of Japan and of the Republic of Korea transmitted to the Secretariat of the Diplomatic Conference the proposal contained in the Annex to the present document.

[Annex follows]

RESOLUTION ON ARTICLE 1(VIII)
CONCERNING “PROCEDURE BEFORE THE OFFICE”

Proposal by the Delegations of Japan and the Republic of Korea

FURTHER CLARIFICATION ON “PROCEDURE BEFORE THE OFFICE” IN LINE WITH THE PLT AND THE STLT

Considering that the basic proposal for the Design Law Treaty (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 statement and the resolution adopted at both the Diplomatic Conference for the Adoption of the Patent Law Treaty (PLT)^{1,2} and the Diplomatic Conference for the Adoption of a Revised Trademark Law Treaty.³

Therefore, the following Resolution by the Diplomatic Conference Supplementary to the Treaty is proposed:

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

¹ 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.”

² For further clarification made on “procedure before the Office” at the Diplomatic Conference for the Adoption of the Patent Law Treaty, see paragraphs 2401 to 2408 of its Records.

RECORDS OF THE DIPLOMATIC CONFERENCE FOR THE ADOPTION OF THE PATENT LAW TREATY

https://www.wipo.int/export/sites/www/treaties/en/docs/prep-docs/2000_june_Geneva_327-en.pdf

“2402. Mr. HERALD (Australia) stated that the delegations which had expressed interest in the Agreed Statement proposed by the Delegation of Switzerland wish to propose the following language: “When adopting Article 1(viii) to (xiv) of this Treaty, it was understood that the words ‘procedure before the Office’ would not cover judicial procedures under the applicable law.” This statement took account of the variety of legal systems between offices. In particular, in many countries, there was a distinct division between the “Courts” and the “Office.” In others the distinction was less clear in that judicial bodies were formally part of the Office. The words “judicial procedures” were intended to include the procedures of internal bodies where those bodies were covered by the general administrative law but not where they were covered by the general judicial law.

³ 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 1(viii) would not cover judicial procedures under the Contracting Parties’ legislation.”

RESOLUTION ON ARTICLES 15, 16 AND 19

Proposal by the Delegations of Japan and the Republic of Korea

ONLY FOR CONTRACTING PARTIES WITH RELATED DESIGN SYSTEM

It is stressed that the following proposal for resolution could, once adopted, provide supplementary elements of clarification in interpreting Article 15, 16 and 19 of the Design Law Treaty (DLT) only in respect of Contracting Parties which have “Related Design System¹” and a similar protection system in their jurisdictions, while it would not affect the application or effect of the DLT in respect of Contracting Parties without such a system.

PROPOSED RESOLUTION BY THE DIPLOMATIC CONFERENCE SUPPLEMENTARY TO THE TREATY

The following Resolution by the Diplomatic Conference Supplementary to the Design Law Treaty regarding Article 15 (Request for Recording of a License), Article 16 (Request for Amendment or Cancellation of the Recording of a License), and Article 19 (Request for Recording of a Change in Ownership) is proposed.

“When adopting Articles 15(4), 16(3) and 19(6), the Diplomatic Conference confirmed that these paragraphs do not exclude the possibility that a Contracting Party which has Related Design System requires a collective request for related registrations to be made in accordance with its applicable law.”

BACKGROUND

The reason why the collective request is required in certain jurisdictions is due to the presence of a “Related Design System²” or a similar design protection system under their applicable laws.

¹ Information on Related Design System in certain countries can also be found in the Guide to the Hague System.

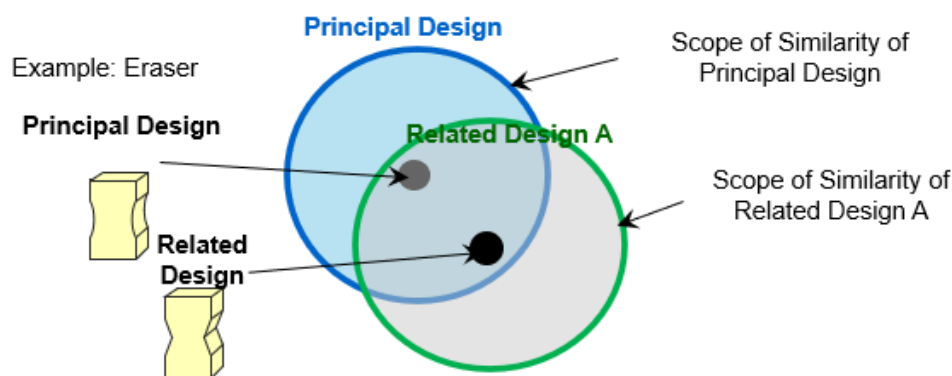
<https://www.wipo.int/hague/en/guide/ia.html#r16>

How to Submit an International Application to the International Bureau – e-filing or form DM/1, Item 16, Japan and/or the Republic of Korea: Principal and related designs

² 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.

In Japan, for instance, the system protects 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, however, “double-patenting” is prohibited under Japan’s Design Act, or a similar design is to be rejected based on the prior similar design. As shown in the image below, the scopes of the two industrial designs (the principal design and the related design) stand in conflict with each other. Therefore, a “Related Design System” is an exception to this prohibition.



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.

[End of Annex and of document]