AIPPI Comments on

Industrial Design Law and Practice – Draft Articles (DLT/DC/3)

Industrial Design Law and Practice – Draft Regulations (DLT/DC/4)

AIPPI submits the following position relating to the above captioned topic, which is of paramount relevance to the matters our Association.

INTRODUCTION TO AIPPI

AIPPI, the International Association for the Protection of Intellectual Property, was founded in 1897, and is dedicated to the development, improvement, and legal protection of intellectual property. The acronym of the organization was derived from its name in French: Association Internationale pour la Protection de la Propriété Intellectuelle. AIPPI is a non-affiliated, non profit, politically neutral organization headquartered in Switzerland, having over 8,000 members representing over 130 countries. The members of AIPPI include lawyers, attorneys, and agents working across all fields of intellectual property in corporate and private practice throughout the world, as well as academics, judges, government officials and other persons interested in intellectual property. AIPPI is organized into 68 National and 2 Regional Groups. The objective of AIPPI is to improve and promote the protection of intellectual property at both national and international levels. It does this by studying and comparing existing and proposed laws and policies relating to intellectual property and working with both government and non-government organizations for the development, expansion and improvement of international and regional treaties and agreements, and national laws.

Industrial Design Law and Practice – Draft Articles (DLT/DC/3)

Article 2 Applications and Industrial Designs to Which This Treaty Applies
(1) [Applications] This Treaty shall apply to national and regional applications which are filed with, or for, the Office of a Contracting Party.

(2) [Industrial Designs] This Treaty shall apply to ~~industrial~~ designs that can be registered as industrial designs, or for which patents can be granted, under the applicable law.

AIPPI Comment:
AIPPI is generally in favor of this provision. However, in provision Article 2(2), AIPPI suggests using the term "designs" rather than "industrial designs." The term "industrial design" is traditionally used for the design of *physical* products, such as furniture, appliances, and vehicles. Design rights are now commonly used to protect appearances of product beyond such physical products, including protection for GUIs, icons and virtual designs. Indeed, designs other than traditional industrial designs are contemplated by the DLT, as expressed in Rule 3(1)(iii), where there is mention of "any other visual representations." AIPPI notes that Note R3.02 specifically mentions that "'any other visual representations' are intended to cover forms of representations, such as computer-animated representations, or forms which are not currently known, but which may develop in the future." With this understanding, instead of the outdated and restrictive term "industrial design," AIPPI recommends using the umbrella term "designs."

Furthermore, the term "designs" better aligns with the name of the treaty "*Design* Law Treaty".

Article 3 Application

(1) [Contents of Application; Fee] (a) A Contracting Party may require that an application contain some, or all, of the following indications or elements:

(i) a request for registration;

(ii) the name and address of the applicant;

(iii) where the applicant has a representative, the name and address of that representative;

(iv) where an address for service or an address for correspondence is required under Article 4(3), such address;

(v) a representation of the industrial design, as prescribed in the Regulations;

(vi) an indication of the product or products which incorporate the industrial design, or in relation to which the industrial design is to be used;

(vii) where the applicant wishes to take advantage of the priority of an earlier application, a declaration claiming the priority of that earlier application, together with indications and evidence in support of the declaration that may be required pursuant to Article 4 of the Paris Convention;

(viii) where the applicant wishes to take advantage of Article 11 of the Paris Convention, evidence that the product or products which incorporate the industrial design or in relation to which the industrial design is to be used have been shown at an official, or officially recognized, international exhibition;

~~Option A~~

~~***[****(ix) a disclosure of the origin or source of traditional cultural expressions, traditional knowledge or biological/genetic resources utilized or incorporated in the industrial design;****]****9***~~

~~Option B~~

~~***[****(ix) an indication of any prior application or registration, or of other information, of which the applicant is aware, that is relevant to the eligibility for registration of the industrial design****]*** *[Footnote: Other information could include, among other things, information relating to traditional knowledge and traditional cultural expressions.]*~~

~~*(x) any further indication or element prescribed in the Regulations.*~~

~~*(b) In respect of the application, the payment of a fee may be required.*~~

(2) [Prohibition of Other Requirements] No indication or element, other than those referred to in paragraph (1) and in Article 10, may be required in respect of the application.

(3) [Several Industrial Designs in the Same Application] Subject to such conditions as may be prescribed under the applicable law, an application may include more than one industrial design.

(4) [Evidence] A Contracting Party may require that evidence be furnished to the Office where, in the course of the examination of the application, the Office may reasonably doubt the veracity of any indication or element contained in the application.

AIPPI Comment:

AIPPI favors "the extension and improvement of the international protection of designs and models would be greatly enhanced by a harmonization of the systems of national protection" (see AIPPI Resolution, Q73, Legal and Economic Significance of Design Protection, Rio de Janeiro, 1985, para. II-1). As a general matter, AIPPI is in favor of establishing a closed list of elements that may be required for a design application in an effort to provide simplicity and efficiency. AIPPI is supportive of Article 3, but without paragraph (ix), whether Option A or B. Paragraph (ix) is not consistent with the DLT's stated goal of simplifying and streamlining design right procedures. While AIPPI recognizes the importance of interests in traditional cultural expression, traditional knowledge and genetic resource, the provision in the minimal list of Article 3 seems misplaced. Inclusion of paragraph (ix) would serve to complicate and obfuscate matters.

Further, the addition of paragraph (ix) is not needed and inconsistent with the concept of novelty. A design right only protects the novel overall appearance of a product. A design right does not independently protect any constituent visual portions of that overall appearance (see AIPPI Resolution, Requirement for protection of designs, Milan, 2016, para. 6: "a Registered Design should protect the Appearance of a Product, but should not protect separately or independently any constituent visual portions of that Appearance."- emphasis added). Thus, whether a constituent element is found in the prior art, and thus not novel, is irrelevant to whether the overall appearance of the design is novel. Stated differently, the only operative question is whether the overall appearance of the design is novel, not the novelty of any individual elements.

Article 5 Filing Date

(1) [Permitted Requirements] (a) Subject to subparagraph (b) and paragraph (2), a Contracting Party shall accord as the filing date of an application the date on which the Office receives the following indications and elements, in a language admitted by the Office:

(i) an express or implicit indication to the effect that the elements are intended to be an application;

(ii) indications allowing the identity of the applicant to be established;

(iii) a sufficiently clear representation of the industrial design;

(iv) indications allowing the applicant or the applicant's representative, if any, to be contacted.

(b) A Contracting Party may accord as the filing date of an application the date on which the Office receives, together with a sufficiently clear representation of the industrial design, some only, rather than all, of the other indications and elements referred to in subparagraph (a), or receives them in a language other than a language admitted by the Office.

[*(2) [Permitted Additional Requirements] (a) A Contracting Party whose law, at the time it becomes party to this Treaty, requires that an application comply with any of the requirements specified in subparagraph (b) in order for that application to be accorded a filing date may, in a declaration, notify the Director General of those requirements.*

(b) The requirements that may be notified pursuant to subparagraph (a) are the following:

(i) an indication of the product or products which incorporate the industrial design, or in relation to which the industrial design is to be used15;

~~*(ii) a brief description of the reproduction or of the characteristic features of the industrial design;*~~

(iii) a claim;

(iv) the payment of the required fees.

*(c) Any declaration notified under subparagraph (a) may be withdrawn at any time.****]***

*(3) [Prohibition of Other Requirements] No indication or element other than those referred to in paragraph****[****s****]*** *(1)(a)* ***[****and (2)(b)****]*** *may be required for the purpose of according a filing date to an application.*

*(4) [Notification and Time Limits] Where the application does not, at the time of its receipt by the Office, comply with one or more of the applicable requirements under paragraph****[****s****]*** *(1)* ***[****and (2)(b)****]****, the Office shall notify the applicant and give the opportunity to comply with such requirements within the time limit prescribed in the Regulations.*

(5) [Filing Date in Case of Subsequent Compliance with Requirements] If, within the time limit referred to in paragraph (4), the applicant complies with the applicable requirements,

*the filing date shall be no later than the date on which all the indications and elements required by the Contracting Party under paragraph**[**s**]** (1) **[**and (2)(b)**]** are received by the Office. Otherwise, the application shall be treated as if it had not been filed.*

AIPPI Comment:

AIPPI support the language of Article 5, including the provisions of paragraph (2), except 2 b) ii) because the scope of a design is best communicated visually where verbal description run the risk of being too broad or too narrow.

The language of paragraph (2) directed at the indication of the product or products which incorporates the industrial design, or in relation to which the industrial design is to be used, is particularly important in some jurisdictions as the scope of the design right is directly tied to the product or products identified.

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 not be deemed prior art to ~~without prejudice to the novelty and/or originality, as the case may be, of~~ the industrial design, where ~~it~~ the disclosure was made:

(i) by the creator of the industrial design or his/her successor in title; or

(ii) by a person who obtained the disclosed information ~~about the industrial design~~ directly or indirectly, including as a result of an abuse, from the creator or his/her successor in title.

AIPPI Comment:

AIPPI supports a 12-month grace period. Specifically, AIPPI supports a 12-month grace period whereby any public disclosures made during the 12 months immediately prior to the effective filing date of a design right *shall not be deemed prior art* to the design right provided that the disclosure is either (i) made by, or through, the designer, applicant or owner, or (ii) made by a third person as a consequence of a wrongful or illegitimate act in relation to the designer, applicant or owner (see AIPPI Resolution, Q 278, Industrial Designs and the Role of Prior Art, 2021, para. 6).

AIPPI notes that the current draft language of Article 6 for the grace period appears unduly limited to excepting the disclosure from consideration of just "novelty and/or originality." The grace period should apply to *all areas* of validity affected by applicant's own prior art disclosures during the grace period, including, for example, individual character, non-obviousness, distinctiveness, etc. To ensure the intent and expansiveness of the grace period is effectuated, the provision should be expressed as an exception to what public disclosures are considered "prior art" to the design right.

AIPPI is in favor of a grace period that is automatically applied (i.e. there are no preconditions or disclosures required by the applicant during registration to assert the grace period) and not limited to certain acts or circumstances. (e.g. only excepting public disclosures made by the applicant at international trade shows or trade fairs)

AIPPI note that the trigger language "who obtained information about the industrial design" is too broad, in that the "information about the industrial design" may not be related to the appearance of the design. (e.g. "information" can related to many things, including dates, names, places etc.)"

Article 9 Publication of the Industrial Design

(1) [Maintaining the Industrial Design Unpublished] A Contracting Party shall allow the industrial design to be maintained unpublished for a period fixed by its applicable law, subject to the minimum period prescribed in the Regulations.

(2) [Request to Maintain the Industrial Design Unpublished; Fee] (a) A Contracting Party may require that, for the purposes of maintaining the industrial design unpublished under paragraph (1), the applicant make a request to the Office.

> *(b) In respect of a request for maintaining the industrial design unpublished under subparagraph (a), the Office may require the payment of a fee.*

(3) [Request to Publish Further to a Request to Maintain Unpublished] Where a request to maintain the industrial design unpublished has been made under paragraph (2)(a), the applicant or holder, as the case may be, may, at any time during the period applicable under paragraph (1), request the publication of the industrial design.

AIPPI Comment:

AIPPI is supportive of a deferral period of 1 year (see AIPPI Resolution, Q73, Legal and Economic Significance of Design Protection, Paris 1983, para. 3(f): “The deposit can be kept secret for a period which should be short but at least one year”.) A 1-year deferral period fairly balances the user’s desire to control the first release of a product embodying the industrial design against the public’s legitimate need to know designs for which protection has been claimed. Harmonization on a deferral period is particularly important as maintaining an industrial design unpublished in one jurisdiction serves no purpose if the design is published in another jurisdiction.

Rule 2 Details Concerning the Application

(1) [Further Requirements Under Article 3] In addition to the requirements provided for in Article 3, a Contracting Party may require that an application contain some, or all, of the following indications or elements:

(i) an indication of the class of the Locarno Classification to which belongs the product which incorporates the industrial design, or in relation to which the industrial design is to be used;

(ii) a claim;

~~*(iii) a statement of novelty;*~~

~~*(iv) a description;*~~

(v) indications concerning the identity of the creator of the industrial design;

(vi) a statement that the creator believes himself/ herself to be the creator of the industrial design;

(vii) where the applicant is not the creator of the industrial design, a statement of assignment or, at the option of the applicant, other evidence of the transfer of the design to the applicant admitted by the Office;

(viii) where the applicant is a legal entity, the legal nature of that legal entity and the State, and, where applicable, the territorial unit within that State, under the law of which the said legal entity has been organized;

(ix) the name of a State of which the applicant is a national if he/she is the national of any State, the name of a State in which the applicant has his/her domicile, if any, and the name of a State in which the applicant has a real and effective industrial or commercial establishment, if any;

(x) an indication of any prior application or registration, or other information, of which the applicant is aware, that could have an effect on the eligibility for registration of the industrial design;

(xi) where the applicant wishes to maintain the industrial design unpublished for a period of time, a request to that effect;

(xii) where the application includes more than one industrial design, an indication of the number of industrial designs included;

(xiii) an indication of the term of protection for which the application is filed;

(xiv) where a Contracting Party requires payment of a fee in respect of an application, evidence that the payment was made;

(xv) where applicable, an indication of partial design;

(xvi) where applicable, a request for earlier publication.

(2) [Requirements in Case of Divisional Applications] A Contracting Party may require that, where an application is to be treated as a divisional application, the application contain the following: (i) an indication to that effect;

(ii) the number and filing date of the initial application.

AIPPI Comment:

AIPPI is generally supportive of Regulation 2, save for the addition of (iii) "a statement of novelty" and (iv) "a description."

As for the statement of novelty of Rule 2 (1)(iii), AIPPI is concerned that such a requirement incorrectly shifts the focus of the design right to individual sub-portions of the design rather than the *overall appearance* of the design, which is what design protection affords (see AIPPI Resolution, Requirement for protection of designs, Milan, 2016, para. 6: "Design protection should be available, by way of registration, to protect the overall visual appearance (including ornamentation) of an object or article of manufacture as a whole.") The concept of a "statement of novelty" is misguided as it envisions something less than the novelty of the *overall appearance* of the design (see AIPPI Resolution, Requirement for protection of designs, Milan, 2016, para. 7: "In the assessment of the scope of protection of a Registered Design, no visual portion of the Appearance of the Product should be excluded from consideration …all visual aspects of such portion, including its size, position and spatial relationship relative to the Appearance of the Product, should be taken into account when assessing the scope of protection of the Registered Design.") Thus, AIPPI is not in favor of adding a "statement of novelty" to the closed list of permissible requirements.

AIPPI is also not in favor of adding a "description" to the closed list of permissible requirements. Design rights are best defined by using *visual representations*, such as those set forth in Rule 3 *infra*. If an applicant is required to provide a verbal description of the design in one jurisdiction, it can be used unfairly restrict the scope of the right in other jurisdictions. The better approach is to let the visual representations speak for themselves. As the adage goes, a picture is worth a thousand words.

Rule 3 Details Concerning Representation of the Industrial Design

(1) [Form of Representation of the Industrial Design] (a) The representation of the industrial design shall, at the option of the applicant, be in the form of:

(i) photographs;

(ii) graphic reproductions;

(iii) any other visual representation admitted by the Office;

~~*(iv) a combination of any of the above.*~~

(b) The representation of the industrial design may, at the option of the applicant, be in color or in black and white.

(c) The industrial design shall be represented alone, to the exclusion of any other matter.

(2) [Particulars Concerning Representation] Notwithstanding paragraph (1)(c), the representation of the industrial design may include:

(i) matter that does not form part of the claimed design if it is identified as such in the description and/or it is shown by means of dotted or broken lines;

(ii) shading, to show the contours or volume of a three-dimensional design.

(3) [Views] (a) The industrial design may, at the option of the applicant, be represented by one view that fully discloses the industrial design, or by several different views that fully disclose the industrial design.

(b) Notwithstanding subparagraph (a), additional, specific views may be required by the Office where such views are necessary to fully show the product or products that incorporate the industrial design or in relation to which the industrial design is to be used. However, additional views disclosing new matter affecting the industrial design, which are not derivable from the original view or views, do not have to be admitted.

(4) [Number of Copies of Representation] No more than one copy of any representation of the industrial design may be required where the application is filed electronically, and no more than three copies1 where the application is filed on paper.

AIPPI Comment:

AIPPI generally supports the language of Rule 3, with one exception (see AIPPI Resolution, Partial Designs, ,Cancun, 2018, para. 2'a): "Graphic or photographic representations are preferred.") AIPPI does not support the inclusion of paragraph (1)(iv), as it seems to permit use of a combination of (i) photographs, (ii) graphic reproductions, and (iii) any other visual representations to depict a single design. Using a combinations visual representation formats runs the significant risk of detracting from the clarity of the design for which protections is sought. See Article 5(1)(a)(iii) calling for *"a sufficiently clear representation of the industrial design."* It is very difficult to ensure consistency of disclosure across all views when using different formats, including a design's relative

scale, shape, perspective and visual disclaimers(see AIPPI Resolution, Partial Designs, Cancun, 2018, para. 2(c): “Visual disclaimers of the Unclaimed Part shall be shown *consistently in all the views* in which the Unclaimed Part appears.” -emphasis added). The better approach, and to promote consistency and clarity, an applicant should be limited to choosing one of the enumerated formats for any given design. Accordingly, paragraph (iv) should be removed.

AIPPI supports the provision in paragraph (2)(i), which permits use of dotted or broken lines to depict matter that forms no part of the claimed design (see AIPPI Resolution, Partial Designs, Cancun, 2018, para. 2’d): “Broken lines are the preferred form of visual disclaimer, and may be used to indicate the Unclaimed Part, with the Claimed Part indicated with continuous lines.”)

AIPPI supports the provision in paragraph (2)(ii) permitting use of surface shading to depict the surfaces of a design. For many designs, particularly those with irregular surfaces or indentations, surface shading can help better describe the contour of the design claimed.

AIPPI supports the provisions of paragraph (3)(a) and (3)(b) discussing the number of views permitted to disclose a given design. The language as drafted appreciates and accommodates the wide breadth of potential design subject matter. Some designs can be sufficiently claimed with a single view, while other may be more complicated, with many facets, and thus require many more views. There is no need to set a maximum number of views for a given design. It is up to the applicant to sufficiently disclose and describe their design, whether with a single view or many.