



AIPPI SUPPLEMENTAL Comments on Article 6 - Grace Period (the “Gem of the DLT”)

[Note: AIPPI Delegate, Christopher Carani, is on-site at the Conference in Riyadh and available for discussion. Please feel free to reach out at ccarani@mcandrews-ip.com; WhatsApp: +18474949469.]

Main Points:

- 1) Without doubt, grace period is the most important and anticipated provision in the DLT for users and stakeholders. Read all the blogs, read the scholarship, read the comments, talk to designers. No matter the region, designers and stakeholders the world over have expressed a strong desire for a grace period for industrial designs. There are no palpable views to the contrary. This body has the power to make this happen. All eyes are watching.
- 2) To those countries, such as Brazil, Ghana, Iran, Peru, Russia, that have “full” grace period provisions (as opposed to “exhibition-only” grace periods), we respectfully ask that you lend a helping hand and encourage others without this crucial provision to meet the strong desire of users and stakeholders. For instance, Brazil long has had a 6-month full grace period for industrial designs. Better yet, Ghana, Iran, Russia, Peru long have had 12-month full grace periods for industrial designs. All are provide excellent examples of “full” grace period provisions. These provisions are “battle-tested” and have served well the public, offices and designers alike.
- 3) As to specifics, there are two main issues for a grace period provision: (1) What does disclosures does it exclude? and (2) For what time period? Below are AIPPI comments on each issue, which supplement AIPPI’s comments previously posted on the DLT main documents page. At the end of this document, AIPPI provides 4 viable paths forward that are far superior to giving up and deleting Article 6.

a. What does grace period exclude? (i.e. scope of grace of grace period)

Here we have great flexibility to achieve the intended goal, namely, a “full” grace period. AIPPI says “full” grace period to distinguish from those jurisdictions that offer a “narrow” exhibition-only grace period for those disclosures occurring at international exhibitions. That narrow limitation comes from Article 11 of the Paris Convention. By way of background, in the

1880's, new products most often were introduced at international exhibitions. Article 11 of the Paris Convention wisely gave creators the ability to test the market, without destroying novelty for their creation. But in this day and age, initial public disclosures aren't typically made at international exhibitions. Rather, now most initial product disclosures are made via the internet, via social medial, via crowd sourcing or during investor meetings and fairs. What designers now are asking for is simply to expand and modernize that antiquated approach to make it meaningful to today's world. Let's show the same wisdom of the drafters of the Paris Convention who rose to the needs of the day by adopting a meaningful "full" grace period provision in the DLT. So what language would achieve this goal? This is the easy part. We have many, many real-world examples of statutory phrasing that achieves a "full" grace period, see for example: Brazil, Ghana, Peru, Russia, Iran, New Zealand, Morocco, South Africa, Mexico, Canada, Japan, Korea, Australia, Singapore, Turkey, Italy, France, Switzerland, United Kingdom, European Union, U.S. Talk to any of the delegations from these jurisdictions and they will let you know how well it has worked. Any of the grace period provisions in these jurisdictions would do the trick in the DLT. Attached are some excerpts from those countries' national laws on "full" grace period. For example;

1. Brazil law says that the grace period disclosure "will not be considered"
2. Ghana law says that the grace period disclosure "shall not be taken into consideration"
3. Australia law says that the grace period disclosure must "be disregarded"
4. U.S. law says the grace period disclosure "shall not be prior art"
5. Alternatively, the DLT could also use any of these other phraseologies to get at the same effect, namely, that the grace period disclosure is:
 - a. "without prejudice to the registrability of the industrial design"
 - b. "without prejudice to the registrability and validity of the industrial design" or
 - c. "without prejudice to novelty, originality, non-obviousness, individual character, or other requirements for registrability"
6. ANY of these would achieve the goal for a "full" grace period. If parties are willing to engage, there is no doubt we can find wording. Easy.

b. For what time period? (i.e. length of grace of grace period)

Relative to Issue #1, the importance of the length of the grace period is a distant second. Yes, AIPPI has long advised for a 12-month period, as the length of time strikes the right balance between the needs of designers vs. needs of public. Indeed, the international trend is 12 months. For these reasons, 12-months would make most sense in a Design Law Treaty trying to make it easier for designers to navigate. **But to be clear**, even a 6-month grace period would be extremely helpful to users, *so long* as the provision was a “full” grace period, and not just the narrow “exhibition-only exception” of Article 11 of the Paris Convention. (See comments above.)

NEXT STEPS: So where to we go from here? First and foremost, please don't give up. This is very doable and designers want this provision.

Here are 4 viable paths forward (in order of preference) to explore:

- 1) Adopt “Group” B proposal (with certain countries taking reservations, if need be)**
 - a. *Scope of Grace Period:* Full
 - b. *Length of Grace Period:* 12 mos

- 2) Adopt original text of Article 6 with amendment to scope and time of grace period (see next page for draft amendment)**
 - a. *Scope of Grace Period:* Full (amend text to track Ghana, Brazil and Australia statutes – i.e. grace period disclosure is not considered prior art)
 - b. *Length of time:* Set at 12 mos. (optionally, although not preferably, it could be set at “at least 6 mos” or “6 or 12 mos”)

- 3) Adopt original text of Article 6 adding Note regarding meaning and breadth of term “novelty and originality” to ensure proper scope**
 - a. *Scope of Grace Period:* Full (by adding Note that “novelty and originality” encompass all requirements where prior art affects registrability)
 - b. *Length of Grace Period:* “6 or 12 mos.”

- 4) Adopt Article calling for 12-month grace period, but leaving details of scope of grace period to Regulations**
 - a. *Scope of Grace Period:* Leave scope of grace period details for Regulations (leaving policy space in Article for countries with only narrow exhibition exception grace periods; in time, hopefully they adopt full grace periods.)
 - b. *Length of Grace Period:* 12 month (optionally, although not preferably, it could be set at “at least 6 mos” or “6 or 12 mos”)

Article 6 Grace Period for Filing in Case of Disclosure (Option 2 of 4 above)

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 considered prior art to be 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 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.

Example of 12-month “Full” Grace Period



GHANA INDUSTRIAL DESIGNS ACT, 2003 (ACT 660)

Section 2—Registrable Industrial Design

(1) An industrial design is registrable if it is new.

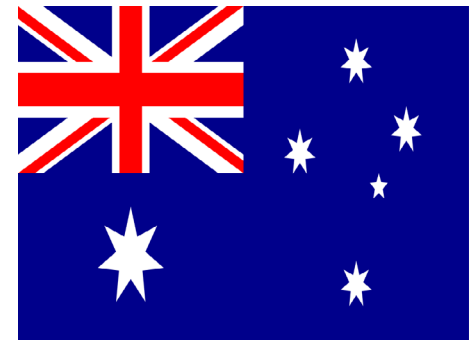
(2) An industrial design is new or original if it significantly differs from known designs or combinations of known design features.

(3) For the purposes of subsection (2), disclosure to the public of an industrial design shall not be taken into consideration if the disclosure

(a) occurred within twelve months preceding the filing date or where applicable, the priority date of the application; and

(b) was as a result of acts committed by the applicant or the applicant's predecessor-in-title or of an abuse committed by a third party with regard to the applicant or the applicant's predecessor in title.

Example of 12-month “Full” Grace Period



Australian Design Act 2003 **(grace period introduced in 2022)**

17 Certain things to be disregarded in deciding whether a design is new and distinctive

- (1) For the purpose of deciding whether a design (the *subject design*) is new and distinctive, the person making the decision must disregard any of the following publications or uses that occur in the period of 12 months ending at the end of the day before the priority date in relation to the subject design:
- (a) a publication or use of a design (which may or may not be the subject design) by a relevant entity;
 - (b) a publication or use of a design (which may or may not be the subject design) by another person or body that derived or obtained the design from a relevant entity.



Example of 6-month “Full” Grace Period

BRAZIL

Patent Regulations

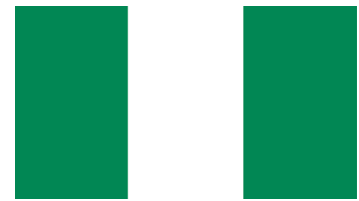
Normative Instruction PR No. 17/2013 Provides for the application of the Industrial Property Law in relation to patents and certificates of invention addition

ENTRY INTO FORCE: March 18, 2013

2. GRACE PERIOD

2.1. The disclosure of the industrial design will not be considered state of the art if it occurs during the period of one hundred eighty (180) days prior to the date of filing or of the priority of the application for registration of the industrial design, when disclosed according to sections I, II and III of article 12 of the LPI (grace period).

Example of 6-Month Narrow Exhibition Grace Period



NIGERIAN PATENTS AND DESIGNS ACT

13. Registrable designs

(1) Subject to this section, an industrial design is registrable if--

- (a) it is new; and
- (b) it is not contrary to public order or morality.

(2) Where application is made for the registration of an industrial design, the design shall be presumed to be new at the time of the application except in so far as the following provisions of this section provide otherwise.

(3) An industrial design is not new if, before the date of application for registration, it has been made available to the public anywhere and at any time by means of description, use or in any other way, unless it is shown to the satisfaction of the registrar that the creator of the design could not have known that it had been made so available.

(4) An industrial design shall not be deemed to have been made available to the public solely by reason of the fact that within the period of six months preceding the filing of the application for registration the creator has exhibited it in an official or officially recognised exhibition.