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Third Special Session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (the SCT Special Session), and to the Preparatory Committee of the Diplomatic Conference to Conclude and Adopt a Design Law Treaty (DLT) (the Preparatory Committee) GRUR comments on the proposal for the Design Law Treaty - SCT/S3/4

Dear Sir or Madam,

In further preparation of the Diplomatic Conference to Conclude and Adopt a Design Law Treaty (DLT) we take the opportunity to submit our comments to Art. 6 DLT as discussed during the Third Special Session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (the SCT Special Session), and to the Preparatory Committee of the Diplomatic Conference to Conclude and Adopt a Design Law Treaty (DLT) (the Preparatory Committee).

I. Introduction

The German Association for Intellectual Property Law ("Deutsche Vereinigung für gewerblichen Rechtsschutz und Urheberrecht e.V.", in the following "GRUR") is a non-profit association with an academic focus. Its statutory purpose is the academic advancement and development of industrial property, copyright and competition law at the German, European and international level. For fulfilling these tasks, GRUR provides assistance to the legislative bodies and to authorities competent for issues of intellectual property law, organizes conferences, workshops and continued education courses, provides financial funding of selected university chairs and research projects and also publishes five leading German professional IP law journals (GRUR, GRUR International, GRUR-RR, GRUR-Prax and GRUR Patent). With over 5,000 members coming from 60 countries, GRUR offers an umbrella for a wide range of IP professionals: lawyers, patent attorneys, judges, academics, representatives of the specific public authorities and of the international organizations as well as enterprises dealing with issues of intellectual property.

II. Comments

GRUR strongly supports the harmonization of the grace period according to the proposed regulation in Article 6 DLT. It has proven to be a helpful element for users, especially in an international context.

1. With regard to the regulation of the grace period in Article 6 DLT, there are four different wording proposals. These concern the following questions:
   - Duration of the grace period (uniformly 12 months or possibly only 6 months)
   - The grace period is only granted if the pre-disclosure has taken place at an exhibition notified as per the applicable laws of the Contracting Party
   - Freezing of the national status of the legal regulation on the grace period existing at the time of accession
   - Replacement of "novelty and originality" with "eligibility for the registration".

2. With regard to the **duration of the grace period**, we support the proposals that provide for a uniform grace period of 12 months.

   Setting a uniform duration of the grace period will achieve a high degree of simplification and streamlining for users. Different durations of the grace period of either 6 month or 12 months in different jurisdictions lead to a degree of uncertainty for applicants and especially for SMEs without in depths knowledge of IP application procedures.

   In addition, we consider a duration of 12 months to be sensible in view of the regulations on priority. With a grace period of only 6 months, the grace period would expire together with the 6-month priority period in cases where the first filing and first disclosure by the applicant take place almost simultaneously, whether due to the applicant's own first disclosure or an immediate publication after registration of the first filing. In these cases, the 6-month priority period and a 6-month grace period would run concurrently.

3. We cannot support the proposals according to which the grace period is only granted if the first disclosure has taken place at an officially announced exhibition.

   In countries that only rarely announce exhibitions officially, the grace period would be totally ineffective. Moreover, the proposal does not take into account the fact that in many cases, or even the majority of cases, the first disclosure of a design no longer takes place at large and well-known exhibitions, but in many other ways, including online disclosure via the Internet.

4. Nor can we support the proposal that the national status of the legal regulation on the grace period existing at the time of accession can be retained. Simplifying and streamlining the rules on the grace period cannot be achieved in this way.

5. Regarding the proposal to **replace the part "novelty and originality**" with "eligibility for the registration" we would like to point out that the terms "novelty" and "originality" refer to the wording of TRIPS in Article 25(1), sentence 1 where it reads: "*Members shall provide for the protection of independently created industrial designs that are new or original.*"

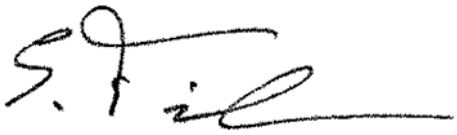
   In terms of substance, this means that design registrations shall only be granted for new designs that have at least a certain degree of originality compared to the previously known design heritage (arg ex Article 1(1), second sentence). These substantive protection requirements for granting registration are implemented with different terms in the individual jurisdictions. In harmonized EU law, for example, these terms are implemented as "novelty and individual character".

Considering the existing case law based on the TRIPS Agreement and in the interests of coherence in international treaties for the protection of IP rights, we support retaining the TRIPS terms. We are aware that these terms, as legal terms under international law, are subject to national interpretation. However, this would apply to the same extent to the term "eligibility for registration" as a new legal term.

The alternative wording therefore does not achieve the objective of streamlining and harmonization. On the contrary, this new legal term could give rise to new interpretation problems. In our understanding, for example, the term "registrability for the registration" goes beyond the regulatory content of "novelty and originality" in the above-mentioned sense.

Overall, we therefore support the proposal made at the SCT/S3 by the Delegation of Japan with regard to Art. 6, i.e. the deletion of "six or" in the basic proposal.

Sincerely yours



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