



INTERNATIONAL TRADEMARK ASSOCIATION

Existing INTA Policy-Based Proposed Positions/Statements at the World Intellectual Property Organization (WIPO) Diplomatic Conference (DipCon) to Conclude and Adopt a Design Law Treaty (DLT)

November 8, 2024

Summary

Various issues are gaining significance in the days preceding the November 11-22, 2024, WIPO DLT DipCon. INTA representatives attending the DipCon would like to express support for rightsholder-friendly provisions that are identical to or otherwise consistent with prior INTA policy.

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Background

For nearly 20 years, World Intellectual Property Organization (WIPO) member states have discussed a possible Design Law Treaty (DLT) to streamline and otherwise harmonize aspects of pursuing industrial design (ID) protection worldwide. The DLT is a procedure-focused treaty, analogous to the Singapore Treaty on the Law of Trademarks of 2006 and its forerunner, the Trademark Law Treaty of 1994 (and the Patent Law Treaty of 2000 for utility patents). The current DLT draft has 32 articles (See Appendix 1) and 17 supporting rules (See Appendix 2).

Among other things, the DLT proposes outer limits on WIPO member state conditions for ID protection. These outer limits include maximum ID application requirements¹ and minimum grace periods for, e.g., novelty. As stated on WIPO's DLT home page, the goal of the DLT is to "streamline the global system for protecting [ID], making it easier, faster and more affordable for designers to protect their work in home markets as well as overseas."

For many years, the DLT was stalled by some member states' insistence on including Genetic Resources, Traditional Knowledge and Traditional Cultural Expressions (GRTKTCE) disclosure requirements and technical assistance (e.g., financial support) guarantees in the DLT.

In July 2022, the WIPO General Assembly decided to convene the DLT DipCon despite continued disagreement regarding GRTKTCE disclosure and technical assistance guarantees. In October 2023, WIPO announced that the DLT DipCon would convene from November 11-22, 2024 in Riyadh, Saudi Arabia.

In the past few weeks, DLT issues relating to GRTKTCE and technical assistance appear to have receded. GRTKTCE proponents have expressed support for a provision recognizing the importance of GRTKTCE instead of including GRTKTCE disclosure within the outer limits of WIPO member state conditions for ID protection, and appear amenable to resolving technical assistance concerns through the WIPO Assemblies instead of as part of the DLT. This was in part aided by WIPO member states approving a separate treaty directly relating to GRTKTCE in May 2024.

Accordingly, the focus of the DLT DipCon has shifted to other issues in which consensus has not yet been reached relating to the following:

1. Grace Period
2. Minimum Term
3. Electronic Filing, Search and Priority Systems
4. Temporal Extensions, Reinstatements and Restorations
5. License Recording

Prior INTA Policy on ID Protection and Enforcement

INTA Model Design Law Guidelines

In 2017, INTA's Board of Directors approved "Model Design Law Guidelines" for ID protection ("INTA Design Guidelines"). In May 2023, INTA's Board of Directors approved a revised version of

¹ Unlike trademark rights, which may arise automatically with use as common law or other unregistered rights, ID protection generally arises only through filing of ID applications.

the INTA Design Guidelines.

The INTA Design Guidelines are “a minimum set of baseline standards by which INTA can evaluate and comment on new designs legislation, treaties or regulations.” (INTA Design Guidelines at 2). In preparing the INTA Design Guidelines, INTA’s International Design Harmonization Subcommittee of the INTA Design Committee reviewed, *inter alia*, the then-existing DLT draft articles and regulations. (*Id.* at 3).

INTA Guidelines for Examination of Industrial Designs

In 2021, INTA’s Design Law and Practice Subcommittee of the Designs Committee prepared “Guidelines for Examination of Industrial Designs” (“INTA ID Examination Guidelines”).

INTA Comments Regarding the DLT

In 2024, INTA provided comments to various IP offices and governments regarding the DLT, including to the United States Patent and Trademark Office (USPTO) as well as the IP offices of Australia, Canada, the United Kingdom and India’s Ministry of Commerce and Industry.

Summary of Proposed INTA Positions/Statements at the DLT DipCon

The INTA representatives propose to take the following positions at the DLT DipCon. As set forth in more detail below all of these proposed positions of INTA at the DLT DipCon are supported by existing INTA policy.

1. SUPPORT: Required Minimum 12-Month Unconditional Grace Period
2. SUPPORT: Required Minimum 15-Year Term for ID Protection (See Article 9bis)
3. SUPPORT: Required Electronic Filing, Search and Priority Systems (See Articles 9ter and 14bis; *cf.* Article 9qater)
4. SUPPORT: Required Temporal Extensions, Reinstatements and Restorations (See Articles 12-14 and Rules 10-12)
5. SUPPORT: Prohibition of License Recording as Condition for ID Enforcement (See Article 17; *see also* Articles 15-16 and 18-19)
6. SOME CONCERN: Permissive GRTKTCE Disclosure and Other Provisions (See, *e.g.*, Articles 3(1)(a)(ix) and 9quinquies)
7. NO POSITION: Technical Assistance (See, *e.g.*, Article 22)

Attachments to this Memorandum

1. DLT Articles (Current Draft)
2. DLT Rules (Current Draft)
3. INTA Design Guidelines
4. INTA ID Examination Guidelines
5. INTA Comments to the Australian IP Office (IP Australia)
6. INTA Comments to the Canadian IP Office (CIPO)
7. INTA Comments to the Indian IP Office (DPIIT)
8. INTA Comments to the United States IP Office (USPTO)
9. DLT Presentation Slides from USPTO Design Day (May 2024)

SUPPORT:
Required 12-Month Unconditional Grace Period

ID protection is typically conditioned on the ID being “new.” The exact definition of “new” varies between jurisdictions but generally means not being already known to the general public. A grace period is a time period, typically six to 12 months, in which prior disclosures of a design by an ID applicant are excused and therefore do not prejudice ID protection. Jurisdictions without grace periods are known as “absolute novelty” jurisdictions. Terms such as “absolute worldwide novelty” mean that disclosures that disqualify ID protection may occur anywhere in the world (versus “local novelty” when the disqualifying disclosures may only occur within the jurisdiction).

While the United States and EU recognize a 12-month period, countries like China and India only offer a limited 6-month grace period under specific circumstances. This discrepancy can place designers at a disadvantage, particularly those in jurisdictions with more stringent requirements.

Exemplary grace period terms:

- One year/12 months: European Union, Japan, Korea, United Kingdom, United States
- Six months: China, India (both subject to specific circumstances)

Competing Proposals Relating to Grace Periods

Article 6 currently requires at least a six-month grace period “without prejudice to the novelty and/or originality, as the case may be, of the industrial design.” A proposed provision allows contracting parties to opt out of the requirement by reservation. In addition, there are three alternative proposals for Article 6 having various terms (e.g., six or 12 months) and conditions (e.g., only for certain exhibitions or if a disclosure was by another without consent).

Especially with the abating of GRTKTCE and technical assistance issues, the grace period issues are likely to be one of the most prominent issues at the DLT DipCon. The current proposals are subject to pre-DipCon discussion and debate, and their exact wording may shift.

INTA argues that this period is crucial for preventing inadvertent loss of rights and enabling designers to gauge the market viability of their designs before committing to formal registration. (c.f. resolutions documents of USA, INDIA and AUS)

From a user standpoint, the lack of a grace period in certain jurisdictions, particularly China (where >60% of ID applications are filed), shapes worldwide ID protection strategies. Applicants must act as if all other jurisdictions have the same absolute worldwide novelty requirement and file somewhere before any disclosures. The situation is exasperated, ironically, by fast-acting design registration systems that sometimes result in published design registrations in days or weeks (the registrations then become disqualifying disclosures).

Prior INTA Policy

Prior INTA Policy supports a minimum 12-month grace period that is not limited to certain acts or circumstances:

INTA Design Guidelines ¶ 9: Grace Period
<i>There should be a 12-month grace period that allows registration of a design within 12</i>

months of an initial use or disclosure of the design by the proprietor or as a result of information obtained from the proprietor (including as a result of an abuse).

Rationale:

Many jurisdictions provide a grace period whereby if an applicant files to protect a design within a certain time after already disclosing or publicly using the design, then the earlier disclosure is not considered to be novelty destroying. For example, the European Union allows a 12-month grace period with respect to Registered Community Designs. This proposal is also consistent with the Hague agreement which provides for recognition of the grace period provided for in the national law of Contracting Parties. A harmonized grace period of 12 months assists designers, and particularly individual designers and SMEs, by avoiding inadvertent loss of rights.

INTA DLT Comments to USPTO (at pp. 5-6): Grace Period

INTA recommends a 12-month grace period that allows registration of a design within 12 months of an initial disclosure of the design by the proprietor or as a result of information obtained from the proprietor including as a result of an abuse. See INTA Model Design Law Guideline, par. 9 (Grace Period). A harmonized grace period of 12 months assists designers, particularly individual designers and small entities, by avoiding inadvertent loss of rights.

Accordingly, we support the proposal by the United States prescribing a broad 12-month grace period. We further agree with the change from “novelty and/or originality” to “eligibility for the registration” in view of the different terms of art under the applicable law of contracting parties.

We oppose limiting the grace period to only certain acts or circumstances as set forth in Article 6(2) proposed by the delegation of China and Article 66 proposed by the delegation of India.

Consistent with the above policy that grace periods not be limited to certain acts or circumstances, grace periods should also not be subject to any conditions or disclosures at the time of filing (*e.g.*, a statement of novelty). In other words, the grace period should automatically apply and should not have to be asserted or otherwise claimed at the time of filing.

This is set forth, for example, in INTA’s comments about the DLT to the Indian Patent Office. In particular, the grace period provisions should eliminate the need for prior notification to the relevant authorities, allowing designers more flexibility in utilizing the grace period without bureaucratic constraints. The association believes that a broader scope for grace periods will not only support domestic designers but also attract foreign applicants who may benefit from similar provisions in their home jurisdictions.

Substance of Proposed Statements at the DLT DipCon

For the reasons stated above, INTA supports a minimum 12-month grace period that is automatically applied (*i.e.*, there are no conditions or disclosures required to assert the grace period) and not limited to certain acts or circumstances.

SUPPORT:
Required Minimum 15-Year Term for ID Protection

Competing Proposals for 15- versus 10-Year Minimum Terms

Proposed Article 9bis requires a DLT contracting party to provide a **minimum 15-year term** for ID protection.² By contrast, an alternate proposed Article 9bis only requires a DLT contracting party to provide a **minimum 10-year term** for ID protection (the current term in TRIPs Article 26(3)).³

Exemplary existing minimum terms:

- 25 years: Brazil, European Union, Israel, Mexico, Switzerland, Turkey, United Kingdom
- 20 years: South Korea
- 15 years (Hague minimum): Canada, China, Nigeria, OAPI, Singapore, United States, Vietnam
- 10 years: Australia

Prior INTA Policy

Prior INTA Policy supports a minimum 15-year term for ID protection. For example:

INTA Design Guidelines ¶ 10: Term of Protection
<p><i>The term of protection shall be at least 15 years from application. The term may be made up of renewals after multiple shorter periods (for example, three terms of five years).</i></p>
<p>Rationale:</p> <p>A minimum 15-year term of protection is consistent with the Hague System for the International Registration of Industrial Designs.</p>
INTA DLT Comments to USPTO (at p. 7): Term of Protection
<p>We support the Article 9bis proposal of a term of protection of at least 15 years, which is consistent with the Hague System for the International Registration of Industrial Designs. The term may be made up of renewals after multiple shorter periods (for example, three terms of five years). See INTA Model Design Law Guideline 10, par. 10 (Term of Protection)</p>

² The United States introduced this version of proposed Article 9bis, supported by the delegations of Canada, Japan, Republic of Korea, Switzerland and the United Kingdom, and not supported by the delegations of Brazil, China, Colombia, Ecuador, Ghana, on behalf of the African Group, Iran, Niger, Nigeria, Peru, Russian Federation, South Africa.

³ Nigeria introduced this version of proposed Article 9bis, supported by the delegations of Brazil, Kyrgyzstan, Mauritania, Niger, Uganda, Yemen, Zambia and Zimbabwe, and not supported by the United Kingdom and the United States.

Substance of Proposed Statements at the DLT DipCon

INTA supports a minimum 15-year term for ID protection, consistent with the Hague System minimum term (and subject to shorter renewal periods) and most jurisdictions worldwide.

SUPPORT:

Requiring DLT Contracting Parties to Provide Electronic Filing, Search and Priority Systems for ID Protection

Competing Proposals for Mandatory versus Optional Electronic Filing, Search and Priority Systems

Proposed Article 9ter requires DLT contracting parties to provide “a system for electronic application” for ID protection and “an online database of registered industrial designs.” Proposed Article 14bis requires DLT contracting parties to provide for the “electronic exchange of priority documents for applications.”⁴

By contrast, proposed Article 9qater makes electronic filing and search systems optional.⁵

Prior INTA Policy

Prior INTA Policy supports requiring DLT contracting parties to provide electronic filing, search and priority systems for ID protection. For example:

INTA Examination of ID Guidelines ¶ 2.1: Pre-Application (Excerpted)
<u>2.1.1 Third Party Searching.</u> Industrial Property Offices should provide access to design rights for which publication is not deferred so applicants may search the records, on a free-of-charge basis.
INTA Examination of ID Guidelines ¶ 2.2: Filing (Excerpted)
Industrial Property Offices should allow for submission of applications and prosecution documents by hand, post, facsimile, and/or electronic transmission (e-filing). INTA recommends, however, due to the loss in quality in transmission by facsimile (fax) and more traditional means, that Industrial Property Offices adopt and encourage the use of filing through secure electronic transmission/e-filing interfaces. *** Industrial Property Offices should promptly provide confirmation of receipt of the application, ideally electronically, providing a receipt date, and an application number. They should also allow for payment of fees by cash, check, credit cards, EFT, and deposit accounts.
INTA Examination of ID Guidelines ¶ 5.2: Convention Priority Claims (Excerpted)
INTA strongly encourages Industrial Property Offices to accede to WIPO Digital Access Service (DAS), an electronic system that allows priority documents and similar documents to be securely exchanged between Industrial Property Offices. WIPO DAS system enables applicants and Industrial Property Offices to meet the requirements of priority documents by only obtaining the DAS Code and eliminating the obligation of requesting and submitting the certified paper copies of documents from one Industrial Property Office

⁴ The United States proposed Article 14bis, supported by Australia, Canada, Republic of Korea, Switzerland and Uruguay, and not supported by Ecuador, Ghana (on behalf of the African Group), Nigeria, Paraguay and the Russian Federation.

⁵ Nigeria proposed Article 9qater, supported by Kyrgyzstan, Mauritania, Niger, Uganda, Yemen, Zambia and Zimbabwe, and not supported by France, United Kingdom and the United States.

and then submitting those documents to other Industrial Property Office(s).

INTA DLT Comments to USPTO (at p. 7): Electronic Filing and Search Systems

We encourage the adoption of this article [9ter]. While we acknowledge that creating an electronic filing system and online database of registered industrial designs may be burdensome on developing Contracting Parties, allowing applications to be electronically filed helps applicants streamline the filing process, and providing access to published design rights allows applicants to search the records on a free-of-charge basis. See INTA Guidelines for Examination of Industrial Designs, 2.1 (Pre-Application) & 2.2 (Filing).

INTA DLT Comments to USPTO (at p. 9): Electronic Priority System

We strongly encourage adopting this article [14bis], and more specifically, that Contracting Parties' offices accede to WIPO Digital Access Service (DAS), an electronic system that allows priority documents and similar documents to be securely exchanged between IP Offices. While we acknowledge that adopting this system may initially be burdensome on developing Contracting Parties, it would ultimately be beneficial for both applicants and offices, as an inexpensive way to satisfy the requirement to provide priority documents when and where required. See INTA Guidelines for Examination of Industrial Designs, par. 5.2 (Convention Priority Claims).

Footnote 12 of the draft DLT Treaty text for Article 9ter states that Article 9ter is not intended to require DLT contracting parties to develop and host their own electronic filing and search systems:

Contracting Parties would not need to supply or develop the technology itself but rather ensure the aforementioned functionality is available with respect to their jurisdiction. With regard to electronic filing, the IP Office of a Contracting Party itself would not need to host or develop the electronic system itself but merely ensure electronic filing is available for their jurisdiction. Likewise, Contracting Parties need not develop or host any database but rather ensure information in relation to designs registered in their jurisdiction is publicly available, such as via an existing database. (See, e.g., WIPO Global Design Database at <https://designdb.wipo.int/designdb/en/index.jsp> and EUIPO's DesignView ID database at <https://www.tmdn.org/tmdsview-web/#/dsview>).

And WIPO has already set up an electronic priority document system known as WIPO DAS (See <https://www.wipo.int/web/das>).

Substance of Proposed Statements at the DLT DipCon

INTA supports proposed Articles 9ter and 14bis, which requiring DLT contracting parties to provide electronic application, searching and priority systems for ID protection, including the use of WIPO DAS, for the reasons set forth in prior INTA policy. INTA does not support proposed Article 9qater, which makes such systems optional.

SUPPORT:
Required Temporal Extensions, Reinstatements and Restorations

Article 12(2) currently contains a provision that DLT contracting parties must provide time extensions for IP office procedures, subject to the conditions in corresponding Rule 10 (e.g., it is not an extension for a renewal fee). Article 13(1) currently contains a similar provision for reinstatement of rights when an applicant’s failure to respond is “unintentional,” subject to conditions in Rule 11. Finally, Article 14(2) currently contains a similar provision for restoration of priority claims, subject to conditions in Rule 12. Competing amendments state that DLT contracting parties “may” provide these temporal extensions, reinstatements and restorations.

Prior INTA Policy

Prior INTA Policy supports extension of deadlines, remedies for missed deadlines and restoration of priority claims. For example:

INTA ID Examination Guidelines ¶ 2.3 Response Time/Extensions/Delay Remedies (Excerpted)
*** The applicant should be provided a reasonable time period, of at least four weeks, within which to respond to any objections or rejections issued by the Industrial Property Office. Such deadline should be extendible at least once. In view of the fact that the consequences of missed deadlines in relation to designs can be drastic, we recommend the provision of a (limited time) remedy for missed deadlines, such as “continuation of proceedings”, upon payment of a fee.
INTA ID Design Guidelines ¶ 20 Restoration of Priority Claims
<i>Applicants should be permitted to correct or add a priority claim by submitting a request within 6 months from the priority date where the failure to properly claim priority was unintentional. Where an application that could have claimed priority is filed later than the date on which priority expired, priority should be restored if a proper request is submitted within a time frame not less than 1 month from the expiry of the priority.</i> Rationale: As failure to properly claim priority may result in a loss of right or a lapse in the protection of an industrial design, relief measures should exist such that an applicant may cure the unintentional lapse in priority.

INTA DLT Comments to USPTO (at p. 7): Temporal Extensions
It is our position that deadlines for an action in a procedure before an office should be extendible at least once, and in view of the fact that the consequences of missed deadlines in relation to designs can be drastic, there is a remedy for missed deadlines allowing for the reinstatement of rights. See INTA Guidelines for Examination of Industrial Designs, 2.3 (Response time, extensions and remedies for missed deadlines). Therefore,

we advocate for making the provision of continuing processing mandatory in Article 12(2), particularly since the provision of extensions of time is only optional under Article 12(1).

INTA DLT Comments to USPTO (at p. 8): Temporal Reinstatement (Unintentionality)

It is our position that, in view of the fact that the consequences of missed deadlines in relation to designs can be drastic, there is a remedy for missed deadlines allowing for the reinstatement of rights. See INTA Guidelines for Examination of Industrial Designs 2.3 (Response time, extensions and remedies for missed deadlines). Therefore, we advocate making the procedure for the reinstatement of rights mandatory in Article 13.

INTA DLT Comments to USPTO (at p. 8): Temporal Restoration of Priority Right

Applicants should be permitted to correct or add a priority claim by submitting a request within 6 months from the priority date where the failure to properly claim priority was unintentional. Where an application that could have claimed priority is filed later than the date on which priority expired, priority should be restored if a proper request is submitted within a time frame not less than 1 month from the expiry of the priority. See INTA Model Design Law Guidelines, par. 20 (Correction or Addition of Priority Claim; Restoration of Priority Right). Therefore, we advocate making the procedure for restoring the right of priority mandatory in Article 14(2).

INTA DLT Comments to USPTO (at p. 11-12): Representative May Sign Temporal Extension, Reinstatement and Restoration Requests

We propose to add that the Representative can also sign the above-mentioned requests in the name of the applicant to speed up this process. Indeed, this is a necessary terminology clarification in line with local practices, to avoid different treatments when it comes to requests for extensions of deadlines. Most requests of those types are usually indeed signed and filed by Applicant's or Holder's professional representatives.

(similar statements made for reinstatement and restoration).

INTA's jurisdictional comments to the DLT all address similar themes. The documents suggest that a flexible approach to time limits is essential for accommodating the realities faced by applicants who may inadvertently miss deadlines due to unforeseen circumstances.

INTA supports the inclusion of provisions allowing a limited remedy for missed deadlines, such as the option for "continuation of proceedings" upon payment of a fee. Such measures would prevent undue loss of rights, particularly for small and medium-sized enterprises (SMEs) that may not have the same resources as larger corporations to navigate strict deadlines effectively. (*cf.* resolutions documents of USA & INDIA)

The comments also stress that the potential for relaxing time limits would align with recent reforms in other intellectual property areas, such as patents, indicating a trend toward more user-friendly processes across the board. INTA believes that adopting such measures would significantly improve the experience of applicants and foster greater participation in the design registration process. (*cf.* resolutions document of AUS)

INTA emphasizes the importance of restoring priority rights for applicants who may fail to claim

priority within the designated timeframe. (c.f. resolutions document of INDIA). The association supports provisions that would allow applicants to make a priority claim after the expiry of the priority period if the failure to do so was unintentional.

This flexibility is crucial, as a lapse in priority can have devastating consequences for an applicant's rights. By permitting restoration of priority claims, jurisdictions can encourage more filings and enhance the protection of design rights. INTA proposes a mechanism where applicants could submit a request for priority restoration within a set timeframe following the unintentional lapse, thereby preventing the loss of rights due to administrative oversights. (cf. resolutions documents of USA & INDIA)

Substance of Proposed Statements at the DLT DipCon

INTA supports requiring DLT contracting parties to provide time extensions for IP office procedures, reinstatement of rights based on due care and/or unintentionality standards and restoration of priority rights consistent with the specifics in prior INTA policy (and for the reasons set forth therein), namely:

- Requiring time extensions as set forth in Rule 10;
- Requiring reinstatement of rights in view of due care or unintentionality as set forth in Rule 11;
- Requiring restoration of priority claims as set forth in Rule 12 (*i.e.*, within six months of the priority date for unintentional delay, or else one month from expiration of the priority period if an application was timely filed during the priority period); and
- If possible, requiring that the applicant's representative may sign corresponding requests.

SUPPORT:
Prohibition of License Recording as Condition for ID Enforcement

Article 17 currently contains a provision that DLT contracting parties may not require license recordation as a condition for ID enforcement. A competing amendment allows DLT contracting parties to continue to require license recordation as a condition for ID enforcement.

Prior INTA Policy

Prior INTA Policy supports not requiring license recordation as a condition for ID enforcement. For example:

INTA Design Guidelines ¶ 19: Recordation of Assignment
<p><i>There should be optional (but not mandatory) recordation for security interests and assignments. There should be no mandatory requirement to record licenses of designs. Recordation should give notice to the world of the interest or transaction but should not be the determinant date from which the interest or transaction takes effect.</i></p> <p>Rationale:</p> <p>Given the value of design rights and the importance of establishing who owns them and what encumbrances may exist over them, for example, in relation to the taking of security, a system for recording those interests is desirable. A non-mandatory system is preferred, as a mandatory system could unfairly penalize inadvertent or delayed noncompliance.</p>

Substance of Proposed Statements at the DLT DipCon

INTA supports prohibiting DLT contracting parties for making license recording a condition for ID enforcement for the reasons set forth in prior INTA policy.

**SOME CONCERN:
GRTKTCE Disclosure and Other GRTKTCE-Related Provisions**

Article 3 currently contains a proposed provision that allows DLT contracting parties to require GRTKTCE disclosure. Proposed Article 9quinquies requires DLT contracting parties to, *inter alia*, implement systems to allow indigenous peoples and local communities to object to and control the inclusion of designs based on traditional knowledge and traditional cultural expressions.⁶

As stated previously, GRTKTCE issues have been significantly disputed during the 20-year development of the DLT, but such disputes appear to be abating. To the extent GRTKTCE issues remain at the DLT DipCon, INTA has limited policy centered around concerns that GRTKTCE disclosure and other related positions may be unclear, unduly burdensome and contrary to the harmonizing and streamlining purpose of the DLT.

Prior INTA Policy

INTA DLT Comments to USPTO (at p. 4): GRTKTCE Disclosure
No substantive comments or observations are provided regarding the disclosure of the origin or source of traditional cultural expressions, traditional knowledge or biological/genetic resources utilized or incorporated in designs other than this concern: if a contracting party mandates this disclosure as a requirement in its jurisdiction, applicants would encounter additional hurdle to obtaining design rights, which is counter to the purposes of implementing the DLT. However, to the extent that such disclosures are considered for inclusion in the DLT, see, e.g., DLT Article 3(1)(ix), we would advocate that the scope of disclosure be clearly defined and that the requirements for the disclosure not be unduly burdensome. Applicants should be provided with a reasonable and extendable period of time to comply with such disclosure requirements, in accordance with INTA Guidelines for Examination of Industrial Designs 2.3 (Response time, extensions and remedies for missed deadlines).

Substance of Proposed Statements at the DLT DipCon (if GRTKTCE remains at issue)

INTA believes the Article 3 GRTKTCE disclosure provision allows imposition of an additional requirement for ID protection, and that imposing such an additional requirement is contrary to the harmonizing and streamlining purposes of the DLT. Any GRTKTCE requirement should be clearly defined (including defining exactly what constitutes a “genetic resource,” “traditional knowledge” or “traditional cultural expression” and exactly how an ID can embody GRTKTCE.⁷ Any GRTKTCE disclosure should not be unduly burdensome. Moreover, applicants encountering GRTKTCE issues should be provided with a reasonable and extendable period of time to comply with GRTKTCE requirements.

To the extent proposed Article 9quinquies remains at issue at the DLT DipCon, INTA has the same concerns as with GRTKTCE disclosure.

⁶ Nigeria proposed Article 9quinquies, supported by Brazil, Kyrgyzstan, Mauritania, Niger, Uganda, Yemen, Zambia and Zimbabwe, and not supported by France, Japan, Sweden, United Kingdom and the United States.

⁷ In the spirit of a picture speaks 1000 words, ID protection is often defined by figures of the design. Such figures are often line figures. From a practical standpoint, it may be difficult to see how, e.g., GRTKTCE is embodied in line figures of a widget.

NO POSITION:

Technical Assistance-Related Provisions

Article 22 discusses technical assistance (e.g., financial support) and capacity building for implementing the DLT, particularly to developing countries and Least Developed Countries. As stated previously, technical assistance issues have been discussed in the leadup to the DLT, but disputed issues appear to be subsiding.

Regardless, as INTA has no policy relating to technical assistance and the DLT, and because such matters appear to be an issue for WIPO member states to resolve, INTA would not make any statements about technical assistance at the DLT DipCon.

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

Riyadh, November 11 to 22, 2024

BASIC PROPOSAL FOR THE DESIGN LAW TREATY (DLT)

submitted by the Director General of WIPO

1. The present document contains the basic proposal for the Design Law Treaty (DLT). It includes an Annex listing the proposals presented at the Third Special Session of the World Intellectual Property Organization (WIPO) Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT), held in Geneva from October 2 to 6, 2023, as per the decision of the SCT (see document [SCT/S3/9](#), paragraph 37), as well as, for ease of reference, the proposals made at the Preparatory Committee of the Diplomatic Conference to Conclude and Adopt a Design Law Treaty (DLT) (Preparatory Committee), held from October 9 to 11, 2023 (see document [DLT/2/PM/7](#) paragraph 89). Together with document DLT/DC/4, which contains the basic proposal for the Regulations under that Treaty, this document constitutes the Basic Proposal mentioned in Rule 29(1)(a) of the draft Rules of Procedures of the Diplomatic Conference. Notes on the provisions of the draft Treaty and Regulations are contained in documents DLT/DC/5 and 6.

2. The basic proposal for the Treaty and the basic proposal for the Regulations are the result of the work undertaken by the SCT from 2005 to 2023. The convening of the Diplomatic Conference to Conclude and Adopt a Design Law Treaty (DLT) was approved by the fifty-fifth (30th extraordinary) session of the WIPO General Assembly in July 2022 (see document [WO/GA/55/12](#), paragraph 309).

DESIGN LAW TREATY (DLT)

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Article 1 **Abbreviated Expressions**

For the purposes of this Treaty, unless expressly stated otherwise:

- (i) “Contracting Party” means any State or intergovernmental organization party to this Treaty;
- (ii) “Office” means the agency of a Contracting Party entrusted with the registration of industrial designs;
- (iii) “registration” means the registration of an industrial design, or the grant of a patent for an industrial design, by an Office;
- (iv) “application” means an application for registration;
- (v) “applicable law” means, where the Contracting Party is a State, the law of that State and, where the Contracting Party is an intergovernmental organization, the legal enactments under which that intergovernmental organization operates;
- (vi) references to “industrial design” shall be construed as references to “industrial designs”, where the application or the registration includes more than one industrial design;
- (vii) references to a “person” shall be construed as references to both a natural person and a legal entity;
- (viii) “procedure before the Office” means any procedure in proceedings before the Office with respect to an application or registration;
- (ix) “communication” means any application, or any request, declaration, document, correspondence or other information, relating to an application or a registration, which is filed with the Office;
- (x) “records of the Office” means the collection of information maintained by the Office, relating to, and including the contents of, applications and registrations, irrespective of the medium in which such information is stored;
- (xi) “applicant” means the person whom the records of the Office show, pursuant to the applicable law, as the person who is applying for registration, or as another person who is filing or prosecuting the application;
- (xii) “holder” means the person shown in the records of the Office as the holder of the registration;
- (xiii) “Paris Convention” means the Paris Convention for the Protection of Industrial Property, signed on March 20, 1883, as revised and amended;
- (xiv) “license” means a license for the use of an industrial design under the law of a Contracting Party;
- (xv) “licensee” means the person to whom a license has been granted;
- (xvi) “Regulations” means the Regulations referred to in Article 23;
- (xvii) “Diplomatic Conference” means the convocation of Contracting Parties for the purpose of revising the Treaty;

- (xviii) “Assembly” means the Assembly referred to in Article 24;
- (xix) references to an “instrument of ratification” shall be construed as including references to instruments of acceptance and approval;
- (xx) “Organization” means the World Intellectual Property Organization;
- (xxi) “International Bureau” means the International Bureau of the Organization;
- (xxii) “Director General” means the Director General of the Organization;
- (xxiii) references to an “Article” or to a “paragraph”, “subparagraph” or “item” of an Article shall be construed as including references to the corresponding rule(s) under the Regulations.
- [(xxiv) time limits expressed in months in the Treaty and Regulations can be calculated by Contracting Parties in accordance with their national law.]¹

Article 1bis General Principles

- (1) *[No Regulation of Substantive Industrial Design Law]* Nothing in this Treaty or the Regulations is intended to be construed as prescribing anything that would limit the freedom of a Contracting Party to prescribe such requirements of the applicable substantive law relating to industrial designs as it desires.
- (2) *[Relation to Other Treaties]* Nothing in this Treaty shall derogate from any obligations that Contracting Parties have to each other under any other treaties.

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 [and to divisional applications thereof].
- (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.

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;

¹ Proposal made at the SCT/S3 by the Delegation of Brazil. Proposal supported by the Delegations of Egypt, Nigeria and Peru.

- (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;

ALTERNATIVE 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;]

ALTERNATIVE B²

[(ix) an indication of any prior application or registration, or of other information³, of which the applicant is aware, that is relevant to the eligibility for registration of the industrial design;]

(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.

² The text of item (ix) under this option, along with the corresponding footnote, was proposed by Ambassador Socorro Flores Liera (Mexico) to the fifty-first (24th ordinary) session of the WIPO General Assembly, held in Geneva from September 30 to October 9, 2019.

³ Other information could include, among other things, information relating to traditional knowledge and traditional cultural expressions.

Article 4
Representatives; Address for Service or Address for Correspondence

(1) *[Representatives Admitted to Practice]* (a) A Contracting Party may require that a representative appointed for the purposes of any procedure before the Office

(i) have the right, under the applicable law, to practice before the Office in respect of applications and registrations;

(ii) provide, as its address, an address in a territory prescribed by the Contracting Party.

(b) An act, with respect to any procedure before the Office, by or in relation to a representative who complies with the requirements established by the Contracting Party under subparagraph (a), shall have the effect of an act by or in relation to the applicant, holder or other interested person who appointed that representative.

(2) *[Mandatory Representation]* (a) Subject to subparagraph (b), a Contracting Party may require that, for the purposes of any procedure before the Office, an applicant, holder, or other interested person who has neither a domicile nor a real and effective industrial or commercial establishment in its territory appoint a representative.

(b) An applicant, holder, or other interested person who has neither a domicile nor a real and effective industrial or commercial establishment in the territory of the Contracting Party may act himself/herself before the Office for the filing of an application, for the purposes of the filing date, and for the mere payment of a fee.

(3) *[Address for Service or Address for Correspondence]* A Contracting Party may, to the extent that it does not require representation in accordance with paragraph (2), require that, for the purposes of any procedure before the Office, an applicant, holder, or other interested person who has neither a domicile nor a real and effective industrial or commercial establishment in its territory, shall have an address for service, or an address for correspondence, in a territory prescribed by the Contracting Party.

(4) *[Appointment of a Representative]* A Contracting Party shall accept that the appointment of a representative be filed with the Office in a manner prescribed in the Regulations.

(5) *[Prohibition of Other Requirements]* Subject to the requirements of Article 10, no Contracting Party may demand that requirements, other than those referred to in paragraphs (1) to (4), be complied with in respect of the matters dealt with in those paragraphs.

(6) *[Notification]* Where one or more of the requirements applied by the Contracting Party under paragraphs (1) to (4) is or are not complied with, the Office shall notify the applicant, holder or other interested person, giving the opportunity to comply with any such requirement within the time limit prescribed in the Regulations.

(7) *[Non-Compliance with Requirements]* Where one or more of the requirements applied by the Contracting Party under paragraphs (1) to (4) is or are not complied with within the time limit prescribed in the Regulations, the Contracting Party may apply such sanction as is provided for in its law.

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;
- [(v) any further indication or element as prescribed under the applicable law].

(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 [and indications allowing the identity of the applicant to be established]⁴, 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 used;
- (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 Proposal made at the SCT/S3 by the Delegation of the European Union (EU). Proposal supported by the Delegations of Canada, Denmark, Georgia, Germany, Japan, Nigeria, Poland, on behalf of the CEBS Group, and Ukraine.

(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.

Article 6 **Grace Period for Filing in Case of Disclosure**

[(1)] 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:

- (i) by the creator or his/her successor in title; or
- (ii) 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.

[(2)(a)] A Contracting Party whose law, at the time it becomes party to this Treaty, provides that the grace period under paragraph (1) is triggered by acts other than those referred to in paragraph (1) may, in a declaration, notify the Director General that the grace period shall be triggered in the territory of that Contracting Party only by those acts.

- (b) The acts that may be notified pursuant to subparagraph (a) are the following:
 - (i) A disclosure of the industrial design made for the first time for the purpose of public interest when a state of emergency or an extraordinary situation occurred in the country;
 - (ii) A disclosure of the industrial design made for the first time at an international exhibition, at prescribed academic or technological activities;
 - (iii) A disclosure of the industrial design by another person without the consent of the applicant.
- (c) Any declaration notified under subparagraph (a) may be withdrawn at any time.]

[Article 6⁵ **Grace Period for Filing in Case of Disclosure**

A disclosure of the industrial design during a period of 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:

⁵ Proposal made at the SCT/S3 by the Delegation of Japan. Proposal supported by the Delegations of Australia, Canada, Republic of Korea, Switzerland, United Kingdom and the United States of America. Proposal not supported by the Delegations of Brazil, China, Ghana, on behalf of the African Group, India, Iran (Islamic Republic of) and the Russian Federation.

- (i) by the creator or his/her successor in title; or
- (ii) 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.]

[Article 6⁶
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:

- (i) by the creator or his/her successor in title at an exhibition notified as per the applicable laws of the Contracting Party; or
- (ii) 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, without the consent of the creator or his/her successor in title].

[Article 6⁷
Grace Period for Filing in Case of Disclosure

A public disclosure of the industrial design during a period of 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 eligibility for the registration of the industrial design, where the disclosure was made:

- (i) by the creator or his/her successor in title; or
- (ii) by a person who obtained the disclosed information directly or indirectly, including as a result of an abuse, from the creator or his/her successor in title.]

Article 7
Requirement to File the Application in the Name of the Creator

(1) *[Requirement That the Application Be Filed in the Name of the Creator]* A Contracting Party may require that the application be filed in the name of the creator of the industrial design.

(2) *[Formality Where There Is a Requirement to File the Application in the Name of the Creator]* Where a Contracting Party requires that the application be filed in the name of the creator of the industrial design, such requirement shall be satisfied if the name of the creator of the industrial design is indicated, as such, in the application, and:

- (i) that name corresponds to the name of the applicant, or
- (ii) the application is accompanied by, or contains, a statement of assignment from the creator to the applicant, signed by the creator of the industrial design.

⁶ Proposal made at the SCT/S3 by the Delegation of India. Proposal supported by the Delegations of China, Nepal and Niger. Proposal not supported by the Delegations of Canada, France, Japan, Republic of Korea, Ukraine, United Kingdom and the United States of America.

⁷ Proposal made at the SCT/S3 by the Delegation of the United States of America. Proposal supported by the Delegations of Australia, Canada, Republic of Moldova, Switzerland, Ukraine and the United Kingdom. Proposal not supported by the Delegations of China, India, Nigeria and the Russian Federation.

Article 8 **Amendment or Division of Application** **Including More Than One Industrial Design**

(1) *[Amendment or Division of Application]* If an application that includes more than one industrial design (hereinafter “initial application”) does not comply with the conditions prescribed by the Contracting Party concerned in accordance with Article 3(3), the Office may require the applicant, at the option of the applicant, to either:

(i) amend the initial application to comply with those conditions; or

(ii) divide the initial application into two or more applications (hereinafter “divisional applications”) that comply with those conditions by distributing among the latter the industrial designs for which protection was claimed in the initial application.

(2) *[Filing Date and Right of Priority of Divisional Applications]* Divisional applications shall preserve the filing date of the initial application and the benefit of the claim of priority, if applicable.

(3) *[Fees]* The division of an application may be subject to the payment of fees.

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.

[Article 9bis⁸ **Term of Protection**

A Contracting Party shall provide a term of protection for industrial designs of at least 15 years⁹ from either: (a) the filing date, or (b) the date of grant or registration.]

⁸ Proposal made at the SCT/S3 by the Delegation of the United States of America. Proposal supported by the Delegations of Canada, Japan, Republic of Korea, Switzerland and the United Kingdom. Proposal not supported by the Delegations of Brazil, China, Colombia, Ecuador, Ghana, on behalf of the African Group, Iran (Islamic Republic of), Niger, Nigeria, Peru, Russian Federation and South Africa.

⁹ Taking into account the varied industrial design systems, this provision may be flexibly implemented, for example, through three (3) successive five-year terms with renewals, a single fifteen-year term, etc.

**[Article 9bis¹⁰
Term of Protection**

Contracting Parties shall have the option to comply with Article 17 of the Hague Convention or Article 26 of the TRIPS Agreement.]

**[Article 9ter¹¹
Electronic Industrial Design System**

A Contracting Party shall provide¹²:

- (a) a system for electronic application; and
- (b) a publicly available electronic information system, which must include an online database of registered industrial designs.]

**[Article 9quater¹³
Electronic Industrial Design System**

- (1) A Contracting Party may provide a system for electronic applications.
- (2) Contracting Parties shall not be required to provide a publicly available electronic information system, nor an online database of registered industrial designs.]

**[Article 9quinquies¹⁴
Exceptions for Publicly Accessible Design Databases**

- (1) Designs that incorporate or are based on traditional knowledge or traditional cultural expressions shall only be included in any publicly accessible database with the permission of the IPLC owners of the traditional knowledge or traditional cultural expressions.
- (2) A Contracting Party which provides a publicly accessible database of registered industrial designs shall provide a mechanism by which Indigenous Peoples and Local Communities (IPLCs) may object to the inclusion of any design based on traditional knowledge or traditional cultural expressions.]

¹⁰ Proposal made at the SCT/S3 by the Delegation of Nigeria. Proposal supported by the Delegations of Brazil, Kyrgyzstan, Mauritania, Niger, Uganda, Yemen, Zambia and Zimbabwe. Proposal not supported by the Delegations of United Kingdom and the United States of America.

¹¹ Proposal made at the SCT/S3 by the Delegation of the United States of America. Proposal supported by the Delegations of Australia, Canada, Republic of Korea, Switzerland, United Kingdom and Uruguay. Proposal not supported by the Delegations of Egypt, Ghana, on behalf of the African Group, Iran (Islamic Republic of), Morocco, Nigeria, Russian Federation, Uganda and Zimbabwe.

¹² Contracting Parties would not need to supply or develop the technology itself but rather ensure the aforementioned functionality is available with respect to their jurisdiction. With regard to electronic filing, the IP Office of a Contracting Party itself would not need to host or develop the electronic system itself but merely ensure electronic filing is available for their jurisdiction. Likewise, Contracting Parties need not develop or host any database but rather ensure information in relation to designs registered in their jurisdiction is publicly available, such as via an existing database. (E.g., WIPO Global Design Database (<https://designdb.wipo.int/designdb/en/index.jsp>), DesignView (<https://www.tmdn.org/tmdsview-web/#/dsvview>)).

¹³ Proposal made at the SCT/S3 by the Delegation of Nigeria. Proposal supported by the Delegations of Kyrgyzstan, Mauritania, Niger, Uganda, Yemen, Zambia and Zimbabwe. Proposal not supported by the Delegations of France, United Kingdom and the United States of America.

¹⁴ Proposal made at the SCT/S3 by the Delegation of Nigeria. Proposal supported by the Delegations of Brazil, Kyrgyzstan, Mauritania, Niger, Uganda, Yemen, Zambia and Zimbabwe. Proposal not supported by the Delegations of France, Japan, Sweden, United Kingdom and the United States of America.

Article 10 Communications

(1) *[Means of Transmittal and Form of Communications]* A Contracting Party may choose the means of transmittal of communications and elect whether to accept communications on paper, communications in electronic form, or any other form of communication.

(2) *[Language of Communications]* (a) A Contracting Party may require that any communication be in a language admitted by the Office.

(b) A Contracting Party may require that, where a communication is not in a language admitted by its Office, a translation of that communication by an official translator or a representative, into a language admitted by the Office, be supplied within a reasonable time limit.

(c) No Contracting Party may require the attestation, notarization, authentication, legalization or any other certification of any translation of a communication, except in those cases prescribed in this Treaty.

(d) Notwithstanding subparagraph (c), a Contracting Party may require that any translation of a communication be accompanied by a statement that the translation is true and accurate.

(3) *[Address for Correspondence, Address for Service and Contact Details]* A Contracting Party may, subject to any provisions prescribed in the Regulations, require that an applicant, holder, or other interested person, indicate in any communication:

- (i) an address for correspondence;
- (ii) an address for service;
- (iii) any other address or contact details provided for in the Regulations.

(4) *[Signature of Communications on Paper]* (a) A Contracting Party may require that a communication on paper be signed by the applicant, holder or other interested person. Where a Contracting Party requires a communication on paper to be signed, that Contracting Party shall accept any signature that complies with the requirements prescribed in the Regulations.

(b) No Contracting Party may require the attestation, notarization, authentication, legalization or other certification of any signature, except in respect of any quasi-judicial proceedings or in those cases prescribed in the Regulations.

(c) Notwithstanding subparagraph (b), a Contracting Party may require that evidence be filed with the Office where the Office may reasonably doubt the authenticity of any signature of a communication on paper.

(5) *[Communications Filed in Electronic Form or by Electronic Means of Transmittal]* Where a Contracting Party permits the filing of communications in electronic form or by electronic means of transmittal, it may require that any such communications comply with the requirements prescribed in the Regulations.

(6) *[Prohibition of Other Requirements]* No Contracting Party may demand that, in respect of paragraphs (1) to (5), requirements other than those referred to in this Article be complied with.

(7) *[Indications in Communications]* A Contracting Party may require that any communication contain one or more indications prescribed in the Regulations.

(8) *[Means of Communication with Representative]* Nothing in this Article regulates the means of communication between an applicant, holder or other interested person and the representative of any such person.

Article 11 Renewal

(1) *[Request for Renewal; Fee]* (a) Where a Contracting Party provides for renewal of the term of protection, it may require that the renewal be subject to the filing of a request and that such request contain some, or all, of the following indications:

- (i) an indication that renewal is sought;
- (ii) the name and address of the holder;
- (iii) the number(s) of the registration(s) concerned by the renewal;
- (iv) an indication of the term of protection for which renewal is requested;
- (v) where the holder has a representative, the name and address of that representative;
- (vi) where the holder has an address for service or an address for correspondence, such address;
- (vii) where it is permitted that renewal be made for some only of the industrial designs contained in the registration, and such a renewal is requested, an indication of the industrial design number(s) for which the renewal is, or is not, requested;
- (viii) where it is permitted that a request for renewal may be filed by a person other than the holder or its representative, and the request is filed by such a person, the name and address of that person.

(b) A Contracting Party may require that, in respect of the renewal, a fee be paid to the Office.

(2) *[Period for Presentation of the Request for Renewal and Payment of the Fee]* A Contracting Party may require that the request for renewal referred to in paragraph (1)(a) be presented, and the corresponding fee referred to in paragraph (1)(b) be paid, to the Office within a period fixed by the law of the Contracting Party, subject to the minimum periods prescribed in the Regulations.

(3) *[Prohibition of Other Requirements]* No Contracting Party may demand that requirements other than those referred to in paragraphs (1) and (2) and in Article 10 be complied with in respect of the request for renewal.

Article 12 Relief in Respect of Time Limits

(1) *[Extension of Time Limits]* A Contracting Party may provide for the extension, for the period prescribed in the Regulations, of a time limit fixed by the Office for an action in a procedure before the Office, if a request to that effect is filed with the Office in accordance with the requirements prescribed in the Regulations, and the request is filed, at the option of the Contracting Party:

- (i) prior to the expiry of the time limit; or
- (ii) after the expiry of the time limit, and within the time limit prescribed in the Regulations.

(2) *[Continued Processing]* Where an applicant or holder has failed to comply with a time limit fixed by the Office of a Contracting Party for an action in a procedure before the Office, and that Contracting Party does not provide for the extension of a time limit under paragraph (1)(ii), the Contracting Party **[shall]** **[may]** provide for continued processing with respect to the application or registration and, if necessary, reinstatement of the rights of the applicant or holder with respect to that application or registration, if:

- (i) a request to that effect is made to the Office in accordance with the requirements prescribed in the Regulations;
- (ii) the request is filed, and all of the requirements for the said action, in respect of which the time limit applied, are complied with, within the time limit prescribed in the Regulations.

(3) *[Exceptions]* There shall be no requirement to provide for the extension of time limits under paragraph (1) or continued processing under paragraph (2) with respect to the exceptions prescribed in the Regulations.

(4) *[Fees]* A Contracting Party may require that a fee be paid in respect of a request under paragraph (1) or (2).

(5) *[Prohibition of Other Requirements]* No Contracting Party may demand that requirements other than those referred to in paragraphs (1) to (4) be complied with in respect of the relief provided for under paragraph (1) or (2), except where otherwise provided for by this Treaty or prescribed in the Regulations.

(6) *[Opportunity to Make Observations in Case of Intended Refusal]* A request under paragraph (1) or (2) may not be refused without the applicant or holder being given the opportunity to make observations on the intended refusal within a reasonable time limit.

Article 13

Reinstatement of Rights After a Finding by the Office of Due Care or Unintentionality

(1) *[Reinstatement of Rights]* A Contracting Party **[shall]** **[may]** provide that, where an applicant or holder has failed to comply with a time limit for an action in a procedure before the Office, and that failure has the direct consequence of causing a loss of rights with respect to an application or a registration, the Office shall reinstate the rights of the applicant or holder with respect to that application or registration, if:

- (i) a request to that effect is made to the Office in accordance with the requirements prescribed in the Regulations;
- (ii) the request is filed, and all of the requirements for the said action, in respect of which the time limit applied, are complied with, within the time limit prescribed in the Regulations;
- (iii) the request states the reasons for the failure to comply with the time limit; and

(iv) the Office finds that the failure to comply with the time limit occurred in spite of due care required by the circumstances having been taken or, at the option of the Contracting Party, that any delay was unintentional.

(2) *[Exceptions]* There shall be no requirement to provide for the reinstatement of rights under paragraph (1) with respect to the exceptions prescribed in the Regulations.

(3) *[Fees]* A Contracting Party may require that a fee be paid in respect of a request under paragraph (1).

(4) *[Evidence]* A Contracting Party may require that a declaration or other evidence in support of the reasons referred to in paragraph (1)(iii) be filed with the Office within a time limit fixed by the Office.

(5) *[Opportunity to Make Observations in Case of Intended Refusal]* A request under paragraph (1) may not be refused, totally or in part, without the requesting party being given the opportunity to make observations on the intended refusal, within a reasonable time limit.

Article 14

Correction or Addition of Priority Claim; Restoration of Priority Right

(1) *[Correction or Addition of Priority Claim]* A Contracting Party shall provide for the correction or addition of a priority claim with respect to an application (“the subsequent application”), if:

- (i) a request to that effect is made to the Office in accordance with the requirements prescribed in the Regulations;
- (ii) the request is filed within the time limit prescribed in the Regulations; and
- (iii) the filing date of the subsequent application is not later than the date of the expiration of the priority period calculated from the filing date of the earliest application whose priority is claimed.

(2) *[Delayed Filing of the Subsequent Application]* A Contracting Party [shall] [may] provide that, where an application (“the subsequent application”) which claims or could have claimed the priority of an earlier application has a filing date which is later than the date on which the priority period expired, but within the time limit prescribed in the Regulations, the Office shall restore the right of priority, if:

- (i) a request to that effect is made to the Office in accordance with the requirements prescribed in the Regulations;
 - (ii) the request is filed within the time limit prescribed in the Regulations;
 - (iii) the request states the reasons for the failure to comply with the priority period;
- and

(iv) the Office finds that the failure to file the subsequent application within the priority period occurred in spite of due care required by the circumstances having been taken or, at the option of the Contracting Party, was unintentional.

(3) *[Fees]* A Contracting Party may require that a fee be paid in respect of a request under paragraph (1) and in respect of a request under paragraph (2).

(4) *[Evidence]* A Contracting Party may require that a declaration or other evidence in support of the reasons referred to in paragraph (2)(iii) be filed with the Office within a time limit fixed by the Office.

(5) *[Opportunity to Make Observations in Case of Intended Refusal]* A request under paragraph (1) or (2) may not be refused, totally or in part, without the requesting party being given the opportunity to make observations on the intended refusal within a reasonable time limit.

[Article 14bis¹⁵
Electronic Priority Document Exchange

A Contracting Party shall provide for electronic exchange of priority documents for applications.]

Article 15
Request for Recording of a License or a Security Interest

(1) *[Requirements Concerning the Request for Recording of a License]* Where the law of a Contracting Party provides for the recording of a license, that Contracting Party may require that the request for recording:

- (i) be filed in accordance with the requirements prescribed in the Regulations,
- and
- (ii) be accompanied by the supporting documents prescribed in the Regulations.

(2) *[Fees]* In respect of the recording of a license, the Office may require the payment of a fee.

(3) *[Single Request]* A single request shall be sufficient even where the license relates to more than one registration, provided that the registration numbers of all registrations concerned are indicated in the request, the holder and the licensee are the same for all registrations, and the request indicates the scope of the license with respect to all registrations.

(4) *[Prohibition of Other Requirements]* (a) No requirement other than those referred to in paragraphs (1) to (3) and in Article 10 may be demanded in respect of the recording of a license. In particular, the following may not be required:

- (i) the furnishing of the registration certificate of the industrial design which is the subject of the license;
- (ii) an indication of the financial terms of the license contract.

(b) Subparagraph (a) is without prejudice to any obligations existing under the law of a Contracting Party concerning the disclosure of information for purposes other than the recording of the license.

(5) *[Evidence]* It may be required that evidence be furnished to the Office where the Office may reasonably doubt the veracity of any indication contained in the request, or in any supporting document.

¹⁵ Proposal made at the SCT/S3 by the Delegation of the United States of America. Proposal supported by the Delegations of Australia, Canada, Republic of Korea, Switzerland and Uruguay. Proposal not supported by the Delegations of Ecuador, Ghana, on behalf of the African Group, Nigeria, Paraguay and the Russian Federation.

(6) *[Requests Relating to Applications]* Paragraphs (1) to (5) shall apply, *mutatis mutandis*, to requests for recording of a license in respect of an application, where the law of a Contracting Party provides for such recording.

(7) *[Request for Recording of a Security Interest]* With the exception of paragraph (4)(a)(ii), paragraphs (1) to (5) shall apply, *mutatis mutandis*, to requests for recording of a security interest in respect of an application or registration.

Article 16 **Request for Amendment or Cancellation of the Recording of a License or a Security Interest**

(1) *[Requirements Concerning the Request for Amendment or Cancellation of the Recording of a License]* Where the law of a Contracting Party provides for the recording of a license, that Contracting Party may require that the request for amendment or cancellation of the recording of a license:

- (i) be filed in accordance with the requirements prescribed in the Regulations,
- and
- (ii) be accompanied by the supporting documents prescribed in the Regulations.

(2) *[Requirements Concerning the Request for Cancellation of the Recording of a Security Interest]* Paragraph (1) shall apply, *mutatis mutandis*, to requests for cancellation of the recording of a security interest.

(3) *[Other Requirements]* Article 15(2) to (7) shall apply, *mutatis mutandis*, to requests for amendment or cancellation of the recording of a license and to requests for cancellation of the recording of a security interest.

Article 17 **Effects of the Non-Recording of a License**

(1) *[Validity of the Registration and Protection of the Industrial Design]* The non-recording of a license with the Office or with any other authority of a Contracting Party shall not affect the validity of the registration of the industrial design which is the subject of the license, nor the protection of that industrial design.

(2) *[Certain Rights of the Licensee]* A Contracting Party [may] [may not] require the recording of a license as a condition for any right that the licensee may have under the law of that Contracting Party to join infringement proceedings initiated by the holder or to obtain, by way of such proceedings, damages resulting from an infringement of the industrial design which is the subject of the license.

Article 18 **Indication of the License**

Where the law of a Contracting Party requires an indication that the industrial design is used under a license, full or partial non-compliance with that requirement shall not affect the validity of the registration of the industrial design which is the subject of the license, nor the protection of that industrial design.

Article 19

Request for Recording of a Change in Ownership

(1) *[Requirements Concerning the Request for Recording]* (a) Where there is a change in the person of the holder, a Contracting Party shall accept that a request for the recording of the change be made either by the holder or by the new owner.

(b) A Contracting Party may require that the request contain some, or all, of the indications prescribed in the Regulations.

(2) *[Requirements Concerning Supporting Documents for Recording of a Change in Ownership]* (a) Where the change in ownership results from a contract, a Contracting Party may require that the request be accompanied, at the option of the requesting party, by one of the elements prescribed in the Regulations.

(b) Where the change in ownership results from a merger, a Contracting Party may require that the request be accompanied by a copy of a document, which originates from a competent authority and evidences the merger, such as a copy of an extract from a register of commerce, and that that copy be certified by the authority which issued the document or by a notary public or any other competent public authority, as being in conformity with the original document.

(c) Where there is a change in one or more, but not all, of several co-holders, and such change in ownership results from a contract or a merger, a Contracting Party may require that any co-holder in respect of which there is no change in ownership give its express consent to the change in ownership, in a document signed by such co-holder.

(d) Where the change in ownership does not result from a contract or a merger but from another ground, for example, by operation of law or a court decision, a Contracting Party may require that the request be accompanied by a copy of a document evidencing the change and that that copy be certified as being in conformity with the original document by the authority which issued the document, or by a notary public or any other competent public authority.

(3) *[Fees]* A Contracting Party may require that, in respect of the request, a fee be paid to the Office.

(4) *[Single Request]* A single request shall be sufficient even where the change relates to more than one registration, provided that the holder and the new owner are the same for each registration, and that the numbers of all registrations concerned are indicated in the request.

(5) *[Change in the Ownership of an Application]* Paragraphs (1) to (4) shall apply, *mutatis mutandis*, where the change in ownership concerns an application, provided that, where the application number of the application concerned has not yet been issued or is not known to the applicant or its representative, the request identifies the application as prescribed in the Regulations.

(6) *[Prohibition of Other Requirements]* No Contracting Party may demand that requirements other than those referred to in paragraphs (1) to (5) and in Article 10 be complied with in respect of a request for the recording of a change in ownership.

(7) *[Evidence]* A Contracting Party may require that evidence, or further evidence where paragraph (2)(b) or (d) applies, be furnished to the Office where the Office reasonably doubts the veracity of any indication contained in the request or in any document referred to in the present Article.

Article 20 **Changes in Names or Addresses**

(1) *[Changes in the Name or Address of the Holder]* (a) Where there is no change in the person of the holder but there is a change in its name and/or address, each Contracting Party shall accept that a request for the recording of the change by the Office be made by the holder in a communication indicating the registration number of the registration concerned and the change to be recorded.

(b) A Contracting Party may require that the request contain some, or all, of the indications prescribed in the Regulations.

(c) A Contracting Party may require that, in respect of the request, a fee be paid to the Office.

(d) A single request shall be sufficient even where the change relates to more than one registration, provided that the registration numbers of all registrations concerned are indicated in the request.

(2) *[Change in the Name or Address of the Applicant]* Paragraph (1) shall apply, *mutatis mutandis*, where the change concerns an application or applications, or both an application or applications and a registration or registrations, provided that, where the application number of any application concerned has not yet been issued or is not known to the applicant or its representative, the request otherwise identifies that application as prescribed in the Regulations.

(3) *[Change in the Name or Address of the Representative or in the Address for Service]* Paragraph (1) shall apply, *mutatis mutandis*, to any change in the name or address of the representative, if any, and to any change relating to the address for service, if any.

(4) *[Prohibition of Other Requirements]* No Contracting Party may demand that requirements other than those referred to in paragraphs (1) and (2) and in Article 10 be complied with in respect of the request referred to in this Article. In particular, the furnishing of any certificate concerning the change may not be required.

(5) *[Evidence]* A Contracting Party may require that evidence be furnished to the Office where the Office may reasonably doubt the veracity of any indication contained in the request.

Article 21 **Correction of a Mistake**

(1) *[Request]* (a) Where an application, a registration or any request communicated to the Office in respect of an application or a registration contains a mistake, not related to search or substantive examination, which is correctable by the Office under the applicable law, the Office shall accept that a request for correction of that mistake in the records and publications of the Office be made in a communication to the Office signed by the applicant or holder.

(b) A Contracting Party may require that the request be accompanied by a replacement part or part incorporating the correction or, where paragraph (3) applies, by such a replacement part or part incorporating the correction for each application and registration to which the request relates.

(c) A Contracting Party may require that the request be subject to a declaration by the requesting party stating that the mistake was made in good faith.

(d) A Contracting Party may require that the request be subject to a declaration by the requesting party stating that the said request was made without undue delay or, at the option of the Contracting Party, that it was made without intentional delay, following the discovery of the mistake.

(2) *[Fees]* (a) Subject to subparagraph (b), a Contracting Party may require that a fee be paid in respect of a request under paragraph (1).

(b) The Office shall correct its own mistakes, *ex officio* or upon request, for no fee.

(3) *[Single Request]* Article 19(4) shall apply, *mutatis mutandis*, to requests for correction of a mistake, provided that the mistake and the requested correction are the same for all applications and registrations concerned.

(4) *[Evidence]* A Contracting Party may only require that evidence in support of the request be filed with the Office where the Office may reasonably doubt that the alleged mistake is in fact a mistake, or where it may reasonably doubt the veracity of any matter contained in, or of any document filed in connection with, the request for correction of a mistake.

(5) *[Prohibition of Other Requirements]* No Contracting Party may require that formal requirements other than those referred to in paragraphs (1) to (4) be complied with in respect of the request referred to in paragraph (1), except where otherwise provided for by this Treaty or prescribed in the Regulations.

(6) *[Exclusions]* A Contracting Party may exclude the application of this Article in respect of any mistake which must be corrected in that Contracting Party under a procedure for reissue of the registration.

[[Article 22] [Resolution] Technical Assistance and Capacity Building¹⁶

[(1)] *[Principles]* The Organization shall, subject to availability of resources and with a view to facilitating the implementation of the Treaty, provide technical assistance, in particular to developing countries and Least Developed Countries. Such technical assistance shall

(i) be development-oriented, demand-driven, transparent, targeted and adequate for the strengthening of the capacity of beneficiary countries to implement the Treaty;

(ii) take into account the priorities and the specific needs of receiving countries for enabling the users to take full advantage of the provisions of the Treaty.

(2) *[Technical Assistance and Capacity Building]* (a) Technical assistance and capacity building activities provided under this Treaty shall be for the implementation of this Treaty and, where requested, include [assistance with]:

(i) establishing the required legal framework and revising administrative practices and procedures of design registration authorities;

¹⁶ The proposal made by Ambassador Socorro Flores Liera (Mexico) to the fifty-first (24th ordinary) session of the WIPO General Assembly, held in Geneva from September 30 to October 9, 2019, contained an item whereby the WIPO General Assembly “agreed that the Diplomatic Conference will consider a provision on technical assistance and capacity building”.

(ii) building up the necessary capacity of the Offices, including but not limited to providing training of human resources[, and providing appropriate equipment and technology as well as the required infrastructure].

(b) The Organization shall provide, subject to allocation and availability of resources financing for WIPO activities and measures that are required to implement the Treaty in accordance with paragraph (2)(a), (3)(a) [and Article 24(1)(c)]. [Moreover, the Organization shall seek to enter into agreements with international financing organization, intergovernmental organizations and governments of receiving countries in order to provide financial support for technical assistance pursuant to this Treaty.]

(3) [Other Provisions] (a) The World Intellectual Property Organization is urged to encourage the participation of Contracting Parties into the existing digital libraries for registered designs, as well as to ensure the access to them. Contracting Parties shall endeavor to communicate published registered design information through such systems. The Organization shall support Contracting Parties in their efforts to exchange information through those systems.

[(b) Contracting Parties to this Treaty [shall endeavor] [are encouraged] to establish a fee reduction system to the benefit of design creators [(natural persons and small and medium enterprises (SMEs))]. [Such fee reduction system if implemented shall apply to those who are nationals of and reside in a developing country or an LDC.]]¹⁷

Article 23 Regulations

(1) [Content] [(a)] The Regulations annexed to this Treaty provide rules concerning:

- (i) matters which this Treaty expressly provides to be prescribed in the Regulations;
- (ii) any details useful in the implementation of the provisions of this Treaty;
- (iii) any administrative requirements, matters or procedures.

[(b) The Regulations also provide for the publication of Model International Forms to be established by the Assembly.]

(2) [Amending the Regulations] Subject to paragraph (3), any amendment of the Regulations shall require three-fourths of the votes cast.

(3) [Requirement of Unanimity] (a) The Regulations may specify provisions of the Regulations which may be amended only by unanimity.

(b) Any amendment of the Regulations resulting in the addition of provisions to, or the deletion of provisions from, the provisions specified in the Regulations pursuant to subparagraph (a) shall require unanimity.

(c) In determining whether unanimity is attained, only votes actually cast shall be taken into consideration. Abstentions shall not be considered as votes.

¹⁷ Proposal to put the whole Article 22/Resolution in brackets, made at the SCT/S3 by the Delegation of the United States of America. Proposal supported by the Delegations of Australia and Switzerland. Proposal not supported by the Delegations of Brazil, Egypt, Ghana, on behalf of the African Group, India, Iran (Islamic Republic of), Morocco, Russian Federation, Uganda, Venezuela (Bolivarian Republic of), on behalf of GRULAC, Zambia and Zimbabwe.

(4) *[Conflict Between the Treaty and the Regulations]* In the case of conflict between the provisions of this Treaty and those of the Regulations, the former shall prevail.

Article 24 Assembly

(1) *[Composition]* (a) The Contracting Parties shall have an Assembly.

(b) Each Contracting Party shall be represented in the Assembly by one delegate, who may be assisted by alternate delegates, advisors and experts. Each delegate may represent only one Contracting Party.

[ALTERNATIVE A

[(c) The expenses of each delegation shall be borne by the Contracting Party that has appointed the delegation. The Assembly may ask the Organization to grant financial assistance to facilitate the participation of delegations of Contracting Parties that are regarded as developing countries in conformity with the established practice of the General Assembly of the United Nations or LDCs or that are countries in transition to a market economy.]

ALTERNATIVE B

[(c) Contracting Parties that are regarded as developing countries or LDCs or that are countries in transition to a market economy shall be granted adequate financial assistance by the Organization to facilitate the participation of at least one delegate of such Contracting Party in all ordinary and extraordinary sessions of the Assembly, and any inter sessional meeting, working group, revision conference or diplomatic conference in relation to the Treaty and the Regulations.]]

(2) *[Tasks]* The Assembly shall

(i) deal with matters concerning the development of this Treaty;

[(ii) establish Model International Forms, referred to in Article 23(1)(b);]

[(iii) amend the Regulations;]¹⁸

(iv) determine the conditions for the date of application of each amendment referred to in item (iii);

(v) monitor, at every ordinary session, the technical assistance provided [under this Treaty] [for implementation of this Treaty];

(vi) perform such other functions as are appropriate to implementing the provisions of this Treaty.

(3) *[Quorum]* (a) One-half of the members of the Assembly which are States shall constitute a quorum.

(b) Notwithstanding subparagraph (a), if, in any session, the number of the members of the Assembly which are States and are represented is less than one-half but equal to or more than one-third of the members of the Assembly which are States, the Assembly may make decisions but, with the exception of decisions concerning its own procedure, all such decisions

¹⁸ Proposal made at the Preparatory Committee by the Delegation of Nigeria. Proposal supported by the Delegations of Togo, Zambia and Zimbabwe. Proposal not supported by the Delegations of Canada, Japan, the United Kingdom and the United States of America.

shall take effect only if the conditions set forth hereinafter are fulfilled. The International Bureau shall communicate the said decisions to the members of the Assembly which are States and were not represented and shall invite them to express in writing their vote or abstention within a period of three months from the date of the communication. If, at the expiration of this period, the number of such members having thus expressed their vote or abstention attains the number of the members which was lacking for attaining the quorum in the session itself, such decisions shall take effect, provided that at the same time the required majority still obtains.

(4) *[Taking Decisions in the Assembly]* (a) The Assembly shall endeavor to take its decisions by consensus.

(b) Where a decision cannot be arrived at by consensus, the matter at issue shall be decided by voting. In such a case,

(i) each Contracting Party that is a State shall have one vote and shall vote only in its own name; and

(ii) any Contracting Party that is an intergovernmental organization may participate in the vote, in place of its Member States, with a number of votes equal to the number of its Member States *[which are party to this Treaty]*¹⁹. No such intergovernmental organization shall participate in the vote if any one of its Member States exercises its right to vote and *vice versa*. In addition, no such intergovernmental organization shall participate in the vote if any one of its Member States party to this Treaty is a Member State of another such intergovernmental organization and that other intergovernmental organization participates in that vote.

(5) *[Majorities]* (a) Subject to Article 23(2) and (3), the decisions of the Assembly shall require two-thirds of the votes cast.

(b) In determining whether the required majority is attained, only votes actually cast shall be taken into consideration. Abstentions shall not be considered as votes.

(6) *[Sessions]* The Assembly shall meet upon convocation by the Director General and, in the absence of exceptional circumstances, during the same period and at the same place as the General Assembly of the Organization.

(7) *[Rules of Procedure]* The Assembly shall establish its own rules of procedure, including rules for the convocation of extraordinary sessions.

Article 25 International Bureau

(1) *[Administrative Tasks]* (a) The International Bureau shall perform the administrative tasks concerning this Treaty.

(b) In particular, the International Bureau shall prepare the meetings and provide the Secretariat of the Assembly and of such committees of experts and working groups as may be established by the Assembly.

(2) *[Meetings Other than Sessions of the Assembly]* The Director General shall convene any committee and working group established by the Assembly.

¹⁹ Proposal made at the Preparatory Committee by the Delegation of the European Union on behalf of its member states. Proposal supported by the Delegation of Germany.

(3) *[Role of the International Bureau in the Assembly and Other Meetings]* (a) The Director General and persons designated by the Director General shall participate, without the right to vote, in all meetings of the Assembly, the committees and working groups established by the Assembly.

(b) The Director General or a staff member designated by the Director General shall be *ex officio* Secretary of the Assembly, and of the committees and working groups referred to in subparagraph (a).

(4) *[Conferences]* (a) The International Bureau shall, in accordance with the directions of the Assembly, make the preparations for any revision conferences.

(b) The International Bureau may consult with Member States of the Organization, intergovernmental organizations and international and national non-governmental organizations concerning the said preparations.

(c) The Director General and persons designated by the Director General shall take part, without the right to vote, in the discussions at revision conferences.

(5) *[Other Tasks]* The International Bureau shall carry out any other tasks assigned to it in relation to this Treaty.

Article 26 **Revision**

This Treaty may only be revised by a diplomatic conference. The convocation of any diplomatic conference shall be decided by the Assembly.

Article 27 **Becoming Party to the Treaty**

(1) *[Eligibility]* The following entities may sign and, subject to paragraphs (2) and (3) and Article 28(1) and (3), become party to this Treaty:

(i) any State member of the Organization in respect of which industrial designs may be registered or patented with its own Office;

(ii) any intergovernmental organization which maintains an Office in which industrial designs may be registered with effect in the territory in which the constituting treaty of the intergovernmental organization applies, in all its Member States or in those of its Member States which are designated for such purpose in the relevant application, provided that all the Member States of the intergovernmental organization are members of the Organization;

(iii) any State member of the Organization in respect of which industrial designs may be registered only through the Office of another specified State that is a member of the Organization;

(iv) any State member of the Organization in respect of which industrial designs may be registered only through the Office maintained by an intergovernmental organization of which that State is a member;

(v) any State member of the Organization in respect of which industrial designs may be registered only through an Office common to a group of States members of the Organization.

- (2) *[Ratification or Accession]* Any entity referred to in paragraph (1) may deposit
- (i) an instrument of ratification, if it has signed this Treaty,
 - (ii) an instrument of accession, if it has not signed this Treaty.
- (3) *[Effective Date of Deposit]* The effective date of the deposit of an instrument of ratification or accession shall be,
- (i) in the case of a State referred to in paragraph (1)(i), the date on which the instrument of that State is deposited;
 - (ii) in the case of an intergovernmental organization, the date on which the instrument of that intergovernmental organization is deposited;
 - (iii) in the case of a State referred to in paragraph (1)(iii), the date on which the following condition is fulfilled: the instrument of that State has been deposited and the instrument of the other specified State has been deposited;
 - (iv) in the case of a State referred to in paragraph (1)(iv), the date applicable under item (ii), above;
 - (v) in the case of a State member of a group of States referred to in paragraph (1)(v), the date on which the instruments of all the States members of the group have been deposited.

Article 28
Entry into Force;
Effective Date of Ratifications and Accessions

- (1) *[Instruments to Be Taken into Consideration]* For the purposes of this Article, only instruments of ratification or accession that are deposited by entities referred to in Article 27(1) and that have an effective date according to Article 27(3) shall be taken into consideration.
- (2) *[Entry into Force of the Treaty]* This Treaty shall enter into force three months after [10] [30] States or intergovernmental organizations referred to in Article 27(1)(ii) have deposited their instruments of ratification or accession.
- (3) *[Entry into Force of Ratifications and Accessions Subsequent to the Entry into Force of the Treaty]* Any entity not covered by paragraph (2) shall become bound by this Treaty three months after the date on which it has deposited its instrument of ratification or accession.

Article 29
Reservations

Article 30
Denunciation of the Treaty

- (1) *[Notification]* Any Contracting Party may denounce this Treaty by notification addressed to the Director General.

(2) *[Effective Date]* Denunciation shall take effect one year from the date on which the Director General has received the notification. It shall not affect the application of this Treaty to any application pending or any industrial design registered in respect of the denouncing Contracting Party at the time of the expiration of the said one-year period, provided that the denouncing Contracting Party may, after the expiration of the said one-year period, discontinue applying this Treaty to any registration as from the date on which that registration is due for renewal.

Article 31 **Languages of the Treaty; Signature**

(1) *[Original Texts; Official Texts]* (a) This Treaty shall be signed in a single original in the English, Arabic, Chinese, French, Russian and Spanish languages, all texts being equally authentic.

(b) An official text in a language not referred to in subparagraph (a) that is an official language of a Contracting Party shall be established by the Director General after consultation with the said Contracting Party and any other interested Contracting Party.

(2) *[Time Limit for Signature]* This Treaty shall remain open for signature at the headquarters of the Organization for one year after its adoption.

Article 32 **Depositary**

The Director General shall be the depositary of this Treaty.

[Annex follows]

PROPOSALS PRESENTED AT THE THIRD SPECIAL SESSION OF THE SCT AND AT THE PREPARATORY COMMITTEE

Article 1 – Abbreviated Expressions

[...]

[(xxiv) time limits expressed in months in the Treaty and Regulations can be calculated by Contracting Parties in accordance with their national law.]¹

Article 5 – Filing Date

(1) [Permitted Requirements]

[...]

(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 [and indications allowing the identity of the applicant to be established]⁴, 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.

[Article 6 – Grace Period for Filing in Case of Disclosure⁵

A disclosure of the industrial design during a period of 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:

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

(ii) 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.]

[Article 6 – Grace Period for Filing in Case of Disclosure⁶

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:

(i) by the creator or his/her successor in title at an exhibition notified as per the applicable laws of the Contracting Party; or

¹ Proposal made at the SCT/S3 by the Delegation of Brazil. Proposal supported by the Delegations of Egypt, Nigeria and Peru.

⁴ Proposal made at the SCT/S3 by the Delegation of the European Union (EU). Proposal supported by the Delegations of Canada, Denmark, Georgia, Germany, Japan, Nigeria, Poland, on behalf of the CEBS Group, and Ukraine

⁵ Proposal made at the SCT/S3 by the Delegation of Japan. Proposal supported by the Delegations of Australia, Canada, Republic of Korea, Switzerland, United Kingdom and the United States of America. Proposal not supported by the Delegations of Brazil, China, Ghana, on behalf of the African Group, India, Iran (Islamic Republic of) and the Russian Federation.

⁶ Proposal made at the SCT/S3 by the Delegation of India. Proposal supported by the Delegations of China, Nepal and Niger. Proposal not supported by the Delegations of Canada, France, Japan, Republic of Korea, Ukraine, United Kingdom and the United States of America.

(ii) 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, without the consent of the creator or his/her successor in title.】

[Article 6 – Grace Period for Filing in Case of Disclosure⁷

A public disclosure of the industrial design during a period of 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 eligibility for the registration 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 directly or indirectly, including as a result of an abuse, from the creator or his/her successor in title.】

[Article 9bis – Term of Protection⁸

A Contracting Party shall provide a term of protection for industrial designs of at least 15 years⁹ from either: (a) the filing date, or (b) the date of grant or registration.】

[Article 9bis – Term of Protection¹⁰

Contracting Parties shall have the option to comply with Article 17 of the Hague Convention or Article 26 of the TRIPS Agreement.】

[Article 9ter – Electronic Industrial Design¹¹

A Contracting Party shall provide:¹²

- (a) a system for electronic application; and
- (b) a publicly available electronic information system, which must include an online database of registered industrial designs.】

⁷ Proposal made at the SCT/S3 by the Delegation of the United States of America. Proposal supported by the Delegations of Australia, Canada, Republic of Moldova, Switzerland, Ukraine and the United Kingdom. Proposal not supported by the Delegations of China, India, Nigeria and the Russian Federation.

⁸ Proposal made at the SCT/S3 by the Delegation of the United States of America. Proposal supported by the Delegations of Canada, Japan, Republic of Korea, Switzerland and the United Kingdom. Proposal not supported by the Delegations of Brazil, China, Colombia, Ecuador, Ghana, on behalf of the African Group, Iran (Islamic Republic of), Niger, Nigeria, Peru, Russian Federation and South Africa.

⁹ Taking into account the varied industrial design systems, this provision may be flexibly implemented, for example, through three (3) successive five-year terms with renewals, a single fifteen-year term, etc.

¹⁰ Proposal made at the SCT/S3 by the Delegation of Nigeria. Proposal supported by the Delegations of Brazil, Kyrgyzstan, Mauritania, Niger, Uganda, Yemen, Zambia and Zimbabwe. Proposal not supported by the Delegations of the United Kingdom and the United States of America.

¹¹ Proposal made at the SCT/S3 by the Delegation of the United States of America. Proposal supported by the Delegations of Australia, Canada, Republic of Korea, Switzerland, United Kingdom and Uruguay. Proposal not supported by the Delegations of Egypt, Ghana, on behalf of the African Group, Iran (Islamic Republic of), Morocco, Nigeria, Russian Federation, Uganda and Zimbabwe.

¹² Contracting Parties would not need to supply or develop the technology itself but rather ensure the aforementioned functionality is available with respect to their jurisdiction. With regard to electronic filing, the IP Office of a Contracting Party itself would not need to host or develop the electronic system itself but merely ensure electronic filing is available for their jurisdiction. Likewise, Contracting Parties need not develop or host any database but rather ensure information in relation to designs registered in their jurisdiction is publicly available, such as via an existing database. (E.g., WIPO Global Design Database (<https://designdb.wipo.int/designdb/en/index.jsp>), DesignView (<https://www.tmdn.org/tmdsview-web/#/dsview>)).

[Article 9^{quater} – Electronic Industrial Design¹³

- (1) A Contracting Party may provide a system for electronic applications.
- (2) Contracting Parties shall not be required to provide a publicly available electronic information system, nor an online database of registered industrial designs.]

[Article 9^{quinquies} – Exceptions for Publicly Accessible Design Databases¹⁴

- (1) Designs that incorporate or are based on traditional knowledge or traditional cultural expressions shall only be included in any publicly accessible database with the permission of the IPLC owners of the traditional knowledge or traditional cultural expressions.
- (2) A Contracting Party which provides a publicly accessible database of registered industrial designs shall provide a mechanism by which Indigenous Peoples and Local Communities (IPLCs) may object to the inclusion of any design based on traditional knowledge or traditional cultural expressions.]

[Article 14^{bis}¹⁵ – Electronic Priority Document Exchange

A Contracting Party shall provide for electronic exchange of priority documents for applications.]

[[Article 22] [Resolution] – Technical Assistance and Capacity Building¹⁶

[(1)] [Principles] The Organization shall, subject to availability of resources and with a view to facilitating the implementation of the Treaty, provide technical assistance, in particular to developing countries and Least Developed Countries. Such technical assistance shall

- (i) be development-oriented, demand-driven, transparent, targeted and adequate for the strengthening of the capacity of beneficiary countries to implement the Treaty;
- (ii) take into account the priorities and the specific needs of receiving countries for enabling the users to take full advantage of the provisions of the Treaty.

(2) [Technical Assistance and Capacity Building] (a) Technical assistance and capacity building activities provided under this Treaty shall be for the implementation of this Treaty and, where requested, include [assistance with]:

- (i) establishing the required legal framework and revising administrative practices and procedures of design registration authorities;

¹³ Proposal made at the SCT/S3 by the Delegation of Nigeria. Proposal supported by the Delegations of Kyrgyzstan, Mauritania, Niger, Uganda, Yemen, Zambia and Zimbabwe. Proposal not supported by the Delegations of France, United Kingdom and the United States of America.

¹⁴ Proposal made at the SCT/S3 by the Delegation of Nigeria. Proposal supported by the Delegations of Brazil, Kyrgyzstan, Mauritania, Niger, Uganda, Yemen, Zambia and Zimbabwe. Proposal not supported by the Delegations of France, Japan, Sweden, United Kingdom and the United States of America.

¹⁵ Proposal made at the SCT/S3 by the Delegation of the United States of America. Proposal supported by the Delegations of Australia, Canada, Republic of Korea, Switzerland and Uruguay. Proposal not supported by the Delegations of Ecuador, Ghana, on behalf of the African Group, Nigeria, Paraguay and the Russian Federation.

¹⁶ The proposal made by Ambassador Socorro Flores Liera (Mexico) to the fifty-first (24th ordinary) session of the WIPO General Assembly, held in Geneva from September 30 to October 9, 2019, contained an item whereby the WIPO General Assembly “agreed that the Diplomatic Conference will consider a provision on technical assistance and capacity building”.

(ii) building up the necessary capacity of the Offices, including but not limited to providing training of human resources, [and providing appropriate equipment and technology as well as the required infrastructure].

(b) The Organization shall provide, subject to allocation and availability of resources financing for WIPO activities and measures that are required to implement the Treaty in accordance with paragraph (2)(a), (3)(a) [and Article 24(1)(c)]. [Moreover, the Organization shall seek to enter into agreements with international financing organization, intergovernmental organizations and governments of receiving countries in order to provide financial support for technical assistance pursuant to this Treaty.]

(3) [Other Provisions] (a) The World Intellectual Property Organization is urged to encourage the participation of Contracting Parties into the existing digital libraries for registered designs, as well as to ensure the access to them. Contracting Parties shall endeavor to communicate published registered design information through such systems. The Organization shall support Contracting Parties in their efforts to exchange information through those systems.

[(b) Contracting Parties to this Treaty [shall endeavor][are encouraged] to establish a fee reduction system to the benefit of design creators [(natural persons and small and medium enterprises (SMEs))]. [Such fee reduction system if implemented shall apply to those who are nationals of and reside in a developing country or an LDC.]]¹⁷

Article 24 – Assembly

(2) [Tasks] The Assembly shall

[...]

[(iii) amend the Regulations;]¹⁸

[...]

(4) [Taking Decisions in the Assembly]

[...]

(ii) any Contracting Party that is an intergovernmental organization may participate in the vote, in place of its Member States, with a number of votes equal to the number of its Member States [which are party to this Treaty]¹⁹. No such intergovernmental organization shall participate in the vote if any one of its Member States exercises its right to vote and *vice versa*. In addition, no such intergovernmental organization shall participate in the vote if any one of its Member States party to this Treaty is a Member State of another such intergovernmental organization and that other intergovernmental organization participates in that vote.

[End of Annex and of document]

¹⁷ Proposal made at the SCT/S3 by the Delegation of the United States of America. Proposal supported by the Delegations of Australia and Switzerland. Proposal not supported by the Delegations of Brazil, Egypt, Ghana, on behalf of the African Group, India, Iran (Islamic Republic of), Morocco, Russian Federation, Uganda, Venezuela (Bolivarian Republic of), on behalf of GRULAC, Zambia and Zimbabwe

¹⁸ Proposal made at the Preparatory Committee by the Delegation of Nigeria. Proposal supported by the Delegations of Togo, Zambia and Zimbabwe. Proposal not supported by the Delegations of Canada, Japan, the United Kingdom and the United States of America.

¹⁹ Proposal made at the Preparatory Committee by the Delegation of the European Union on behalf of its member states. Proposal supported by the Delegation of Germany.

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

Riyadh, November 11 to 22, 2024

BASIC PROPOSAL FOR THE REGULATIONS UNDER THE DESIGN LAW TREATY (DLT)

submitted by the Director General of WIPO

The present document contains the basic proposal for the Regulations under the Design Law Treaty (DLT). It includes an Annex listing the proposals presented at the Third Special Session of the World Intellectual Property Organization (WIPO) Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT), held in Geneva from October 2 to 6, 2023, as per the decision of the SCT (see document [SCT/S3/9](#), paragraph 37).

REGULATIONS UNDER THE DESIGN LAW TREATY (DLT)

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Rule 1 Abbreviated Expressions

(1) *[Abbreviated Expressions Defined in the Regulations]* For the purposes of these Regulations, unless expressly stated otherwise:

- (i) “Treaty” means the Design Law Treaty;
- (ii) “Article” refers to the specified Article of the Treaty;
- (iii) “Locarno Classification” means the classification established by the Locarno Agreement Establishing an International Classification for Industrial Designs, signed at Locarno on October 8, 1968, as revised and amended;
- (iv) “exclusive license” means a license which is only granted to one licensee and which excludes the holder from using the industrial design and from granting licenses to any other person;
- (v) “sole license” means a license which is only granted to one licensee and which excludes the holder from granting licenses to any other person but does not exclude the holder from using the industrial design;
- (vi) “non-exclusive license” means a license which does not exclude the holder from using the industrial design or from granting licenses to any other person.

(2) *[Abbreviated Expressions Defined in the Treaty]* The abbreviated expressions defined in Article 1 for the purposes of the Treaty shall have the same meaning for the purposes of these Regulations.

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;

[ALTERNATIVE A

(x) a disclosure of the origin or source of traditional cultural expressions, traditional knowledge or biological/genetic resources utilized or incorporated in the industrial design;

ALTERNATIVE B¹

(x) an indication of any prior application or registration, or of other information², of which the applicant is aware, that is relevant to the eligibility for registration of the industrial design];³

(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.

¹ The text under Alternative B, along with the corresponding footnote, was proposed, with respect to Article 3(1)(a)(ix) by Ambassador Socorro Flores Liera (Mexico) to the fifty-first (24th ordinary) session of the WIPO General Assembly, held in Geneva from September 30 to October 9, 2019.

² Other information could include, among other things, information relating to traditional knowledge and traditional cultural expressions.

³ Proposal to move Alternatives A and B from Article 3(1)(a)(ix) to Rule 2(1), made at the SCT/S3 by the Delegation of the United States of America. Proposal supported by the Delegation of the United Kingdom. Proposal not supported by the Delegations of Algeria, Ghana, on behalf of the African Group, India, Iran (Islamic Republic of), Nigeria, Uganda and Venezuela (Bolivarian Republic of), on behalf of GRULAC.

[(3) *Partial Design*] A Contracting Party shall permit the application to be directed to a design embodied in a part of an article or product.]⁴

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 copies where the application is filed on paper.

⁴ Proposal made at the SCT/S3 by the Delegation of the United States of America. Proposal supported by the Delegation of Canada, Japan, Republic of Korea, Switzerland and the United Kingdom. Proposal not supported by the Delegations of China, Colombia, Ecuador, Ghana, on behalf of the African Group, Iran (Islamic Republic of), Nigeria, Peru, Russian Federation and Zambia.

Rule 4
Details Concerning Representatives, Address for Service or Address for Correspondence

(1) *[Appointment of Representative Under Article 4(4); Power of Attorney]* (a) Whenever a Contracting Party allows or requires an applicant, a holder or any other interested person to be represented by a representative before the Office, it may require that the representative be appointed in a separate communication (hereinafter referred to as “power of attorney”) indicating the name of the applicant, holder, or other interested person, as the case may be, as well as the name and address of the representative.

(b) The power of attorney may relate to one or more applications and/or registrations identified in the power of attorney or, subject to any exception indicated by the appointing person, to all existing and future applications and/or registrations of that person.

(c) The power of attorney may limit the powers of the representative to certain acts. A Contracting Party may require that any power of attorney under which the representative has the right to withdraw an application or to surrender a registration contain an express indication to that effect.

(2) *[Time Limit Under Article 4(6)]* The time limit referred to in Article 4(6) shall be not less than one month* from the date of the notification referred to in that Article where the address of the applicant, holder or other interested person is on the territory of the Contracting Party making the notification, and not less than two months from the date of the notification where such address is outside the territory of that Contracting Party.

(3) *[Evidence]* A Contracting Party may require that evidence be filed with the Office where the Office may reasonably doubt the veracity of any indication contained in any communication referred to in paragraph (1).

Rule 5
Details Concerning Filing Date

The time limit referred to in Article 5(4) shall be not less than one month from the date of the notification referred to in that Article.

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.]

Rule 7
Details Concerning Communications

(1) *[Details Concerning Article 10(3)]* (a) A Contracting Party may require that the address for correspondence referred to in Article 10(3)(i) and the address for service referred to in Article 10(3)(ii) be in a territory prescribed by that Contracting Party.

* The SCT understands that time limits expressed in months in the Treaty and Regulations can be calculated by Contracting Parties in accordance with their national law.

(b) A Contracting Party may require that the applicant, holder, or other interested person, include some, or all, of the following contact details in any communication:

- (i) a telephone number;
- (ii) a telefacsimile number;
- (iii) an email address.

(2) *[Indications Accompanying Signature of Communication on Paper]* A Contracting Party may require that the signature of the natural person who signs be accompanied by:

- (i) an indication, in letters, of the family or principal name and the given or secondary name or names, of that person or, at the option of that person, of the name, or names, customarily used by the said person;
- (ii) an indication of the capacity in which that person signed, where such capacity is not obvious from reading the communication.

(3) *[Date of Signing]* A Contracting Party may require that a signature be accompanied by an indication of the date on which the signing was effected. Where that indication is required, but is not supplied, the date of signing shall be deemed to be the date on which the communication bearing the signature was received by the Office or, if the Contracting Party so allows, a date earlier than the latter date.

(4) *[Signature of Communications on Paper]* Where a communication to the Office of a Contracting Party is on paper and a signature is required, that Contracting Party:

- (i) shall, subject to item (iii), accept a handwritten signature;
- (ii) may permit, instead of a handwritten signature, the use of other forms of signature, such as a printed or stamped signature, or the use of a seal or of a bar-coded label;
- (iii) may, where the natural person who signs the communication is a national of the Contracting Party concerned and such person's address is in its territory, or where the legal entity on behalf of which the communication is signed is organized under its law and has either a domicile or a real and effective industrial or commercial establishment in its territory, require that a seal be used instead of a handwritten signature.

(5) *[Attestation, Notarization, Authentication, Legalization or Other Certification of a Signature of Communications on Paper]* A Contracting Party may require the attestation, notarization, authentication, legalization or other certification of any signature of a communication on paper, under Article 10(4)(b), if the communication concerns the withdrawal of an application or the surrender of a registration.

(6) *[Signature of Communications on Paper Filed by Electronic Means of Transmittal]* A Contracting Party that provides for communications on paper to be filed by electronic means of transmittal shall consider any such communication signed if a graphic or other representation of a signature accepted by that Contracting Party under paragraph (4) appears on the communication as received.

(7) *[Original of a Communication on Paper Filed by Electronic Means of Transmittal]* A Contracting Party that provides for communications on paper to be filed by electronic means of transmittal may require that the original of any such communication be filed with the Office:

- (i) accompanied by a letter identifying that earlier transmission; and

(ii) within a time limit which shall be at least [one month] [15 days] from the date on which the Office received the communication by electronic means of transmittal.

(8) *[Authentication of Communications in Electronic Form]* A Contracting Party that permits the filing of communications in electronic form may require that any such communication be authenticated through a system of electronic authentication, as prescribed by that Contracting Party.

(9) *[Date of Receipt]* A Contracting Party shall be free to determine the circumstances in which the receipt of a document or the payment of a fee shall be deemed to constitute receipt by or payment to the Office in cases in which the document was actually received by or payment was actually made to:

- (i) a branch or sub-office of the Office;
- (ii) a national Office on behalf of the Office of the Contracting Party, where the Contracting Party is an intergovernmental organization;
- (iii) an official postal service;
- (iv) a delivery service, or an agency, specified by the Contracting Party;
- (v) an address other than the nominated address(es) of the Office.

(10) *[Electronic Filing]* Subject to paragraph (9), where a Contracting Party provides for the filing of a communication in electronic form or by electronic means of transmittal and the communication is so filed, the date on which the Office of that Contracting Party receives the communication in such form, or by such means, shall constitute the date of receipt of the communication.

(11) *[Indications Under Article 10(7)]* (a) A Contracting Party may require that any communication:

- (i) indicate the name and address of the applicant, holder or other interested person;
- (ii) indicate the number of the application or registration to which it relates;
- (iii) contain, where the applicant, holder or other interested person is registered with the Office, the number or other indication under which he/she is so registered.

(b) A Contracting Party may require that any communication by a representative for the purposes of a procedure before the Office contain:

- (i) the name and address of the representative;
- (ii) a reference to the power of attorney on the basis of which the representative acts;
- (iii) where the representative is registered with the Office, the number or other indication under which he/she is registered.

Rule 8

Identification of an Application Without Its Application Number

(1) *[Manner of Identification]* Where it is required that an application be identified by its application number, but such a number has not yet been issued or is not known to the applicant or its representative, the application shall be considered identified if the following is supplied:

- (i) the provisional application number, if any, given by the Office; or
- (ii) a copy of the application; or
- (iii) a representation of the industrial design, accompanied by an indication of the date on which, to the best knowledge of the applicant or the representative, the application was received by the Office, along with any identification number given to the application by the applicant or the representative.

(2) *[Prohibition of Other Requirements]* No Contracting Party may demand that requirements other than those referred to in paragraph (1) be complied with in order for an application to be identified where its application number has not yet been issued or is not known to the applicant or its representative.

Rule 9

Details Concerning Renewal

For the purposes of Article 11(2), the period during which any request for renewal may be presented, and any renewal fee may be paid, shall commence at least six months before the date on which the renewal is due and shall end, at the earliest, six months after that date. If the request for renewal is presented, or the fee is paid, after the date on which the renewal is due, the acceptance of the request for renewal and the payment of the fee may be subject to the payment of a surcharge.

Rule 10

Details Concerning Relief in Respect of Time Limits

(1) *[Requirements Under Article 12(1)]* (a) A Contracting Party may require that a request referred to in Article 12(1):

- (i) be signed by the applicant or holder;
- (ii) contain an indication to the effect that an extension of a time limit is requested, and an identification of the time limit in question.

(b) Where a request for an extension of a time limit is filed after the expiration of the time limit, the Contracting Party may require that all of the requirements for the action in respect of which the time limit applied, be complied with at the same time as the request is filed.

(2) *[Period and Time Limit Under Article 12(1)]* (a) The period of extension of a time limit referred to in Article 12(1) shall be not less than two months from the date of the expiration of the un-extended time limit.

(b) The time limit referred to in Article 12(1)(ii) shall expire not earlier than two months from the date of the expiration of the un-extended time limit.

(3) *[Requirements Under Article 12(2)(i)]* A Contracting Party may require that a request referred to in Article 12(2)(i):

(i) be signed by the applicant or holder;

(ii) contain an indication to the effect that relief in respect of non-compliance with a time limit is requested, and an identification of the time limit in question.

(4) *[Time Limit for Filing a Request Under Article 12(2)(ii)]* The time limit referred to in Article 12(2)(ii) shall expire not earlier than two months after a notification by the Office that the applicant or holder did not comply with the time limit fixed by the Office.

(5) *[Exceptions Under Article 12(3)]* No Contracting Party shall be required under Article 12(1) or (2) to grant:

(i) a second, or any subsequent, relief in respect of a time limit for which relief has already been granted under Article 12(1) or (2);

(ii) relief for filing a request for a relief measure under Article 12(1) or (2) or a request for reinstatement under Article 13(1);

(iii) relief in respect of a time limit for the payment of a renewal fee;

(iv) relief in respect of a time limit for an action before a board of appeal, or other review body, constituted in the framework of the Office;

(v) relief in respect of a time limit for an action in *inter partes* proceedings;

(vi) relief in respect of a time limit referred to in Article 14(1) or (2).

Rule 11

Details Concerning Reinstatement of Rights After a Finding by the Office of Due Care or Unintentionality Under Article 13

(1) *[Requirements Under Article 13(1)(i)]* A Contracting Party may require that a request referred to in Article 13(1)(i) be signed by the applicant or holder.

(2) *[Time Limit Under Article 13(1)(ii)]* The time limit for making a request, and for complying with the requirements, under Article 13(1)(ii), shall be the earlier to expire of the following:

(i) not less than two months from the date of the removal of the cause of failure to comply with the time limit for the action in question;

(ii) not less than 12 months from the date of expiration of the time limit for the action in question, or, where a request relates to non-payment of a renewal fee, not less than 12 months from the date of expiration of the period of grace provided under Article 5*bis* of the Paris Convention.

(3) *[Exceptions Under Article 13(2)]* The exceptions referred to in Article 13(2) are failure to comply with a time limit:

(i) for making a request for relief under Article 12(1) or (2) or a request for reinstatement under Article 13(1);

(ii) for an action before a board of appeal, or other review body, constituted in the framework of the Office;

- (iii) for an action in *inter partes* proceedings;
- (iv) for filing a declaration which, under the law of the Contracting Party, may establish a new filing date for a pending application;
- (v) referred to in Article 14(1) or (2).

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.]⁵

(4) *[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.

(5) *[Requirements Under Article 14(2)(i)]* A Contracting Party may require that a request referred to in Article 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.

Rule 13
Details Concerning the Requirements Concerning the Request for Recording of a License or a Security Interest or for Amendment or Cancellation of the Recording of a License or a Security Interest

(1) *[Content of Request]* (a) A Contracting Party may require that the request for the recording of a license under Article 15(1) or (6) contain some, or all, of the following indications or elements:

- (i) the name and address of the holder;
- (ii) where the holder has a representative, the name and address of that representative;

⁵ Proposal made at the SCT/S3 by the Delegation of Japan. Proposal supported by the Delegations of Canada, Nigeria, Republic of Korea, United Kingdom and the United States of America.

- (iii) where the holder has an address for service or an address for correspondence, such address;
- (iv) the name and address of the licensee;
- (v) where the licensee has a representative, the name and address of that representative;
- (vi) where the licensee has an address for service or an address for correspondence, such address;
- (vii) where the licensee 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;
- (viii) the name of a State of which the licensee is a national, if he/she is the national of any State, the name of a State in which the licensee has his/her domicile, if any, and the name of a State in which the licensee has a real and effective industrial or commercial establishment, if any;
- (ix) the registration number of the industrial design which is the subject of the license;
- (x) where the license is not granted in respect of all the industrial designs contained in a registration, the industrial design number(s) for which the license is granted;
- (xi) whether the license is an exclusive license, a non-exclusive license or a sole license;
- (xii) where applicable, that the license concerns only a part of the territory covered by the registration, together with an explicit indication of that part of the territory;
- (xiii) the duration of the license.

(b) A Contracting Party may require that the request for amendment or cancellation of the recording of a license under Article 16(1) contain some or all of the following indications or elements:

- (i) the indications specified in items (i) to (ix) of subparagraph (a);
- (ii) the nature and scope of the amendment to be recorded or an indication that cancellation is to be recorded.

(2) *[Supporting Documents for Recording of a License]* (a) Where the license is a freely concluded agreement, a Contracting Party may require that the request for the recording of a license be accompanied *[,at the option of the requesting party,]* by one of the following:

- (i) a copy of the agreement, which copy may be required to be certified *[,at the option of the requesting party,]* by a notary public or any other competent public authority or, where permitted under the applicable law, by a representative having the right to practice before the Office, as being in conformity with the original agreement;
- (ii) an extract of the agreement consisting of those portions of that agreement which indicate the parties, as well as the rights licensed and their extent, which extract may be required to be certified, at the option of the requesting party, by a notary public or any other competent authority or, where permitted under the applicable law, by a representative having the right to practice before the Office, as being a true extract of the agreement.

(b) A Contracting Party may require that any co-holder who is not a party to the license agreement give its express consent to the license in a document signed by such co-holder.

(c) Where the license is not a freely concluded agreement, for example, it results from operation of law or a court decision, a Contracting Party may require that the request be accompanied by a copy of a document evidencing the license. A Contracting Party may also require that the copy be certified as being in conformity with the original document, at the option of the requesting party, by the authority which issued the document or by a notary public or any other competent public authority or, where permitted under the applicable law, by a representative having the right to practice before the Office.

(3) *[Supporting Documents for Amendment of Recording of a License]* (a) A Contracting Party may require that the request for amendment of the recording of a license be accompanied, at the option of the requesting party, by one of the following:

(i) documents substantiating the requested amendment of the recording of the license; or

(ii) an uncertified statement of amendment of license, signed by both the holder and the licensee.

(b) A Contracting Party may require that any co-holder who is not a party to the license contract give express consent to the amendment of the license in a document signed by such co-holder.

(4) *[Supporting Documents for Cancellation of Recording of a License]* A Contracting Party may require that the request for cancellation of the recording of a license be accompanied, at the option of the requesting party, by one of the following:

(i) documents substantiating the requested cancellation of the recording of the license; or

(ii) an uncertified statement of cancellation of license, signed by both the holder and the licensee.

(5) *[Security Interests]* Paragraphs (1) to (4) shall apply, *mutatis mutandis*, to requests for the recording, amendment of the recording and cancellation of the recording, of a security interest.

Rule 14

Details Concerning the Request for Recording of a Change in Ownership

(1) *[Content of Request]* A Contracting Party may require that the request for the recording of a change in ownership under Article 19 contain some, or all, of the following indications:

(i) an indication to the effect that a recording of a change in ownership is requested;

(ii) the number of the registration concerned by the change;

(iii) the name and address of the holder;

(iv) the name and address of the new owner;

(v) the date of the change in ownership;

(vi) where the new owner 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;

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

(viii) where the holder has a representative, the name and address of that representative;

(ix) where the new owner has a representative, the name and address of that representative;

(x) where the new owner is required to have an address for service or an address for correspondence, such address;

(xi) the basis for the change requested.

(2) *[Requirements Concerning Supporting Documents for Recording of a Change in Ownership Resulting From a Contract]* A Contracting Party may require that the request for the recording of a change in ownership resulting from a contract be accompanied, at the option of the requesting party, by one of the following:

(i) a copy of the contract, which may be required to be certified by a notary public or any other competent public authority, as being in conformity with the original contract;

(ii) an extract of the contract showing the change in ownership, which may be required to be certified by a notary public or any other competent public authority, as being a true extract of the contract;

(iii) an uncertified certificate of transfer signed by both the holder and the new owner;

(iv) an uncertified transfer document signed by both the holder and the new owner.

Rule 15

Details Concerning the Request for Recording of a Change in Name or Address

A Contracting Party may require that the request for the recording of a change in name and/or address under Article 20 contain some, or all, of the following indications:

(i) the name and address of the holder;

(ii) where the holder has a representative, the name and address of that representative;

(iii) where the holder has an address for service, such address.

Rule 16
Details Concerning the Request for Correction of a Mistake

A Contracting Party may require that the request for correction of a mistake under Article 21 contain some, or all, of the following indications:

- (i) an indication to the effect that a correction of mistake is requested;
- (ii) the number of the application or registration concerned;
- (iii) the mistake to be corrected;
- (iv) the correction to be made;
- (v) the name and address of the requesting party.

[Rule 17
Model International Forms

The International Bureau shall publish the Model International Forms established by the Assembly under Article 24(2)(ii).]

[Annex follows]

PROPOSALS PRESENTED AT THE THIRD SPECIAL SESSION OF THE SCT

Rule 2(1)

[ALTERNATIVE A

(x) a disclosure of the origin or source of traditional cultural expressions, traditional knowledge or biological/genetic resources utilized or incorporated in the industrial design;

ALTERNATIVE B¹

(x) an indication of any prior application or registration, or of other information², of which the applicant is aware, that is relevant to the eligibility for registration of the industrial design]³ [...]

Rule 2(3)

[(3) [Partial Design] A Contracting Party shall permit the application to be directed to a design embodied in a part of an article or product.]⁴

Rule 12(3)

[(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.]⁵

[End of Annex and of document]

¹ The text under Alternative B, along with the corresponding footnote, was proposed, with respect to Article 3(1)(a)(ix) by Ambassador Socorro Flores Liera (Mexico) to the fifty-first (24th ordinary) session of the WIPO General Assembly, held in Geneva from September 30 to October 9, 2019.

² Other information could include, among other things, information relating to traditional knowledge and traditional cultural expressions.

³ Proposal made at the SCT/S3 by the Delegation of the United States of America. Proposal supported by the Delegation of the United Kingdom. Proposal not supported by the Delegations of Algeria, Ghana, on behalf of the African Group, India, Iran (Islamic Republic of), Nigeria, Uganda and Venezuela (Bolivarian Republic of), on behalf of GRULAC.

⁴ Proposal made at the SCT/S3 by the Delegation of the United States of America. Proposal supported by the Delegation of Canada, Japan, Republic of Korea, Switzerland and the United Kingdom. Proposal not supported by the Delegations of China, Colombia, Ecuador, Ghana, on behalf of the African Group, Iran (Islamic Republic of), Nigeria, Peru, Russian Federation and Zambia.

⁵ Proposal made at the SCT/S3 by the Delegation of Japan. Proposal supported by the Delegations of Canada, Nigeria, Republic of Korea, United Kingdom and the United States of America.

MODEL DESIGN LAW GUIDELINES

A REPORT ON CONSENSUS POINTS FOR DESIGN RIGHTS LAWS

**International Trademark Association
Revised May 2023**

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All information provided by the International Trademark Association in this document is provided to the public as a source of general information on design rights and related intellectual property issues. In legal matters, no publication whether in written or electronic form can take the place of professional advice given with full knowledge of the specific circumstances of each case and proficiency in the laws of the relevant country. While efforts have been made to ensure the accuracy of the information in this document, it should not be treated as the basis for formulating business decisions without professional advice. We emphasize that design rights and related intellectual property laws vary from country to country, and between jurisdictions within some countries. The information included in this document will not be relevant or accurate for all countries or states.

1. Introduction

In order to have a minimum set of baseline standards by which INTA can evaluate and comment on new designs legislation, treaties, or regulations, the International Design Harmonization Subcommittee of the Designs Committee developed Model Design Law Guidelines (the “Guidelines”). This project was based heavily on INTA’s Model Law Guidelines for trademarks. It also drew on both existing and proposed design rights treaties and legislation and the expertise of INTA members worldwide.

Designs Committee members from North America, Europe, and Asia reviewed the following documents, which were perceived as providing possible bases for international consensus on key points for the protection of designs:

- The Hague Agreement Concerning the International Registration of Industrial Designs of 2013 (Hague)
- World Intellectual Property Organization Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications Industrial Design Law and Practice – Forty-Fifth Session March 28 to March 30, 2022 (WIPO)
- Legal review on industrial design protection in Europe (European Commission Ref. (2016)2582936)
- The EU Designs Directive 98/71/EC
- Community Design Regulation (EC) No 6/2002
- Community Design Implementing Regulation (EC) No 2245/2002
- The United States Design Patent Regime (35 U.S.C. 171-173, 289)
- Paris Convention on the Protection of Industrial Property

- Proposed Design Law Treaty (including the draft articles and draft regulations of the of the Design Law Treaty)

Making use of these materials and such other national laws or international conventions, as well as additional relevant INTA positions, the Designs Committee identified a set of consensus points and commentary outlining the rationale for each point. The first version of the Guidelines was adopted by INTA's Board of Directors on November 7, 2017.

It is intended to supplement the Guidelines from time to time to reflect new positions taken by INTA in furthering standards for protection of designs. The following version of the Guidelines, approved by INTA's Board of Directors in May 2023, corresponds to the second update (following the 2019 update) and results from the work of the 2022-2023 Designs Law and Practice Subcommittee. The update is based on positions taken and several submissions made by INTA, in the field of designs, since the second version of the Guidelines was adopted, in 2019.

2. Deposit v. Examination System

Proposal:

No recommendation is made regarding the selection of a deposit system as compared to a system of examination of designs for the purpose of registrability or a hybrid version of the two. All of these systems have been effectively used in countries throughout the world.

Rationale:

There are three main types of systems for protecting design rights by registration: (1) deposit systems; (2) examination systems; and (3) hybrid systems.

In a deposit system, an application is reviewed primarily for completeness and procedural requirements. This may also include a consideration of whether the design for which registration is sought corresponds to the definition of design under applicable law. Countries including China, Mexico, South Africa, Switzerland, and the European Union use a deposit system. Obtaining registration in these types of systems is generally quicker and less costly.

In an examination system, such as the United States, Japan, India, and Taiwan, a design application is reviewed both procedurally and for novelty, obviousness, and/or originality. Typically, obtaining protection in an examination system takes longer and has higher fees. Additionally, an examination system will have higher implementation costs for the implementing country.

In a hybrid system, as is used by Australia, a design can be registered without substantive novelty examination. However, it cannot be enforced until after it has been submitted for examination and certified. South Korea has a non-substantive examination process for certain types of designs that have a short lifecycle (such as food products, clothing, accessories, print materials, computers, and screen icons), but other types of designs require substantive examination.

3. Protection of Partial Designs

Proposal:

A part of a product should be registrable as a design provided that it otherwise meets the requirements for registration. This could include either the registration of a part of a product where (a) only such part is represented in the drawing; or (b) part of a product where the whole product is represented but the part or parts in which protection is not claimed are identified by the use of visual disclaimers which may be broken lines, blurring, color shading or by the use of added boundaries.

Rationale:

Some products may include portions that have appearances that by themselves are not new. Therefore, it should be possible to register only the design of the part of the product that is new. Examples of design portions that might not be new include: the blade of a knife; the neck or the bottom of a bottle; and the handle or the brush of a toothbrush. Efforts made in relation to improvement of parts of designs should be protectable and the rights should be enforceable in addition to the design of the product in its entirety if the registrant so chooses. To accomplish this, the rules should permit applicants to show, by way of a visual disclaimer, parts of the design for which protection is not sought. The visual disclaimer must be clear and obvious, meaning the claimed and disclaimed elements of the design should be clearly differentiated. INTA recommends that visual disclaimers be achieved by indicating with broken lines the features of the design for which protection is not sought. The disclaimer may be achieved by other means such as blurring the features of the design for which protection is not sought, and/or including within a boundary the features of the design for which protection is sought. INTA also considers that, as an alternative, it may be permissible to file an application for a part of the product as a complete design where the whole product is not represented in the application.

4. Multiple Design Applications

Proposal:

Applications for multiple designs should be able to be included in a single application even if the designs look different and even if the Locarno classes of each design are different. The applicant should be able to divide the application into multiple applications at the Office's request and maintain the original filing date

Rationale:

The general interest in design protection has been exponentially growing over the years. Therefore, access to design protection should be facilitated, especially for SMEs and multiple design applications are beneficial, particularly, in terms of cost/benefit. In view of the aforesaid, INTA considers that substantial cost and administrative savings can be made to users through the filing of multiple designs in a single application (“multiple application”) and therefore recommends that Intellectual Property (IP) Offices allow the filing of such multiple applications even if the designs will be individually examined and granted. This has the potential to decrease the administrative

burden and costs for applicants, such as the ability to file a single Power of Attorney or Assignment of all designs in the same application. INTA further recommends that IP Offices not require that the designs within a multiple application need to be in the same class.

5. Designs Incorporating Functional Features

Proposal:

Design registrations protect the overall ornamental appearance of a design, not an aggregation of separable features. The fact that a design includes one or more elements or features that serve a functional purpose should not be a bar to protection of the design unless the overall appearance of the design is solely dictated by its function.

Rationale:

Many countries allow protection for designs having features whose appearance is essentially (and even solely) dictated by the technical function, while others deny protection for features of appearance of a product which are solely dictated by its technical function. Features of a design should rarely be excluded from protection for being solely dictated by technical function. And it should be rare for whole design to be invalidated because the overall appearance of that design is dictated by function. Any exclusion for features of a design solely dictated by technical function should be narrowly construed and the threshold of “solely dictated by technical function” is not met in the case of mere functionality of a design or some of its features. Design protection should be afforded unless the appearance of the design as a whole is solely dictated by its technical function, even if individual features of the design or the design as a whole serves a function. A design applicant should be afforded the opportunity to respond to any objection made on the ground that the appearance of the design itself, or that the appearance of elements of the design, is dictated by their technical function.

6. Visibility

Proposal:

A product or part of a product should be protectable regardless of whether the design is visible at any time, provided there is some period in the life of the product or part thereof when its appearance is a matter of concern to a purchaser.

Rationale:

Design law protects the appearance of a product or part of a product, but the design does not need to be visible at any particular point in time or in any particular situation. INTA recognizes that in some jurisdictions, including the European Union, there is an exception that the design of a component part of a complex product, such as complex machinery, must be visible while the product is in normal use in order to be protected by design law. In such cases, INTA encourages that such exception be limited to the spare parts market for complex machinery.

7. Protection of Icons, Graphical User Interfaces, and Projected, Holographic, and/or Virtual Augmented Reality (PHVAR) Designs

Proposal:

Icons and graphical user interfaces (GUI) and projected, holographic, and/or virtual augmented reality designs (PHVAR designs) should be registrable as a design provided that they otherwise meet the requirements for registration.

Rationale:

In many instances, GUI, icons, and PHVAR designs have become a key aspect of a company's overall brand. They should therefore be considered an important part of the company's overall IP portfolio. INTA considers that design protection of the visual appearance of GUIs, icons, animations, and projected, holographic, and/or virtual augmented reality designs (PHVAR designs) should be provided (i) independent of any other form of IP protection available;(ii) regardless of the technical means of creating it, and (iii) whether such designs are integral to the operation of a (electronic) device, interactive with a user or (electronic) device, or placed or embodied in a physical article or electronic device, e.g., projected onto a screen, monitor, or other display; projected on to a surface or into a medium (including air); or otherwise only appear when technology is activated.

Moreover, creators should be able to obtain protection for the design independently of the (electronic) device used to make the design perceptible.

Because the lifespan of such designs can be very short, to the extent that GUIs, icons, and PHVAR designs may be eligible for overlapping protection, INTA believes that design law is a good tool to provide short-term protection. Also, this should be without prejudice to protection appropriately provided under other laws, such as copyright, trademark, or the law of unfair competition/passing off.

8. Novelty

Proposal:

A design should not be protected if an identical design was disclosed to the public earlier, subject to the grace period set out below.

Rationale:

Design law protects designs that are new. Novelty can be assessed against prior designs on a local, regional or global basis. Many systems currently require global novelty, so as not to enable re-monopolization of existing designs.

9. Grace Period

Proposal:

There should be a 12 month grace period that allows registration of a design within 12 months of an initial use or disclosure of the design by the proprietor or as a result of information obtained from the proprietor (including as a result of an abuse).

Rationale:

Many jurisdictions provide a grace period whereby if an applicant files to protect a design within a certain time after already disclosing or publicly using the design, then the earlier disclosure is not considered to be novelty destroying. For example, the European Union allows a 12-month grace period with respect to Registered Community Designs. This proposal is also consistent with the Hague agreement which provides for recognition of the grace period provided for in the national law of Contracting Parties. A harmonized grace period of 12 months assists designers, and particularly individual designers and SMEs, by avoiding inadvertent loss of rights.

10. Term of Protection

Proposal:

The term of protection shall be at least 15 years from application. The term may be made up of renewals after multiple shorter periods (for example, three terms of five years).

Rationale:

A minimum 15-year term of protection is consistent with the Hague System for the International Registration of Industrial Designs.

11. No Impact on Trademark or Other Intellectual Property Rights

Proposal:

The grant or expiration of design rights should not preclude or alter trademark or other intellectual property rights, so long as the requirements for enforceable trademark or such other intellectual property rights are satisfied.

Rationale:

A range of intellectual property protections may be available for a single product including utility patents for functional innovations, registered designs for aesthetic innovations, copyrights for artistic creations, and trademarks for signs which distinguish products sold in commerce.

Trademark rights may accrue on such features as they are recognized by the public as distinguishing the goods or services of one entity from another.

The bases, functions, purposes, and intents of these diverse intellectual property rights (including design rights, utility patents, copyright, and trademarks) are different and stand independent of one another. Therefore, in order to spur innovation and creativity, intellectual property rights owners should be free to pursue any and all available sources of protection, both limited-term protection in the form of designs, and unlimited-term protection in the form of trademark and other intellectual property rights.

12. Deferral of Publication

Proposal:

It should be possible to defer publication of a design application for a period not less than 12 months after the date of application.

Rationale:

Designers often wish to retain secrecy of their designs until the product is ready to launch. The existence of varying grace periods (or none) in different jurisdictions requires provisions allowing secrecy of a design, for at least 12 months (many jurisdictions already provide in excess of this).

13. Requirements for Registration

Proposal:

As a minimum, an applicant for design registration should be required to provide the following:

- (a) an express or implicit request for registration;*
- (b) indications allowing the applicant to be identified;*
- (c) a sufficiently clear representation of the design; and*
- (d) indications allowing the applicant or the applicant's representative (if any) to be contacted.*

Rationale:

If a design application is rejected for failure to comply with administrative requirements, rights may be lost forever. Therefore, requirements to obtain a filing date should be kept to a minimum, to avoid inadvertent loss of rights.

14. Declarations of invalidity

Proposal:

Administrative proceedings should be available to enable third parties to apply to have a registered design declared invalid.

Rationale:

Regardless of whether an examination or deposit system is in force in a jurisdiction, there will inevitably be designs on the register that are invalid. Therefore, to enable third parties to “clear the way” before launching a product which might otherwise infringe the design, inexpensive, swift administrative proceedings should be available, rather than third parties having to commence court proceedings.

15. Grounds for Infringement

Proposal:

Infringement shall be found where an unauthorized third party makes, sells, offers for sale, uses, imports or exports articles bearing or embodying the protected design.

Rationale:

This formulation adopts the language of the Community Design Directive. However, it is also substantively similar to tests for infringement elsewhere in the world, including in the United States which applies an ordinary observer test asking whether an ordinary observer would think that the accused design is substantially the same as the patented design when the two designs are compared in the context of that which existed previously.

16. Standing for Action

Proposal:

Apart from the registered owner/assignee, there should be a presumption that exclusive licensees may sue infringers, but subject to contrary agreement with the assignee.

Rationale:

An exclusive licensee has a substantial interest and investment to protect and therefore it should be able to enforce the relevant design if the owner/assignee elects not to do so. Exclusive in this context means to the exclusion of the design owner/assignee and all third parties. Subject to an agreement to the contrary, both the registered owner/assignee and the exclusive licensee should have standing to sue infringers.

17. Remedies

Proposal:

At a minimum, Provisional and final civil remedies should be provided for, including injunctive relief, compensatory damages, statutory damages, and/or punitive damages, as well as fees and costs arising from the enforcement of the IP rights. Such remedies should be expeditious and effectively enforceable. Border controls, administrative, criminal procedures, and sanctions should also be considered to effectively stop and deter intellectual property infringements.

Rationale:

Enforcement of remedies is a key factor for their practical effectiveness. Remedies should be implemented expeditiously and effectively, to ensure that they are effective in restoring the design patent holder's rights and deterring further infringement.

In most jurisdictions, remedies for design infringement include civil remedies and criminal remedies. Administrative remedies are also available in some countries. Civil remedies include the possibility of seeking an injunction against infringement. Compensatory damages should be based on either actual lost profit, restitution for unfair profits or a reasonable licence fee.

Criminal remedies involve imprisonment that can effectively deter future IP infringement. In addition, customs seizures are also available in a number of countries, although enforcement approaches vary considerably.

On the other hand, in those countries where the possibility of administrative remedies are available, these include the possibility to seek an injunction order against the infringement.

Additionally, relief can also be sought through customs seizure in various countries, though enforcement approaches vary considerably.

Finally, the effectiveness of enforcement of judgments should be granted by considering the implementation of a system containing a mix of criminal, civil and administrative punishments that impose penalties or increase the original liability of the non-complying party.

18. Licensing and Assignment

Proposal:

Licensing, including sublicensing, and assignment of registered designs should (but compulsory licensing should not) be permitted.

Rationale:

The laws of most countries provide for the ability to assign and license designs. Given the short term of design rights, compulsory sub-licensing is not considered appropriate.

19. Recordation of Assignment

Proposal:

There should be optional (but not mandatory) recordation for security interests and assignments. There should be no mandatory requirement to record licenses of designs. Recordation should give notice to the world of the interest or transaction but should not be the determinant date from which the interest or transaction takes effect.

Rationale:

Given the value of design rights and the importance of establishing who owns them and what encumbrances may exist over them, for example, in relation to the taking of security, a system for recording those interests is desirable. A non-mandatory system is preferred, as a mandatory system could unfairly penalize inadvertent or delayed noncompliance.

20. Correction or Addition of Priority Claim; Restoration of Priority Right

Proposal:

Applicants should be permitted to correct or add a priority claim by submitting a request within 6 months from the priority date where the failure to properly claim priority was unintentional. Where an application that could have claimed priority is filed later than the date on which priority expired, priority should be restored if a proper request is submitted within a time frame not less than 1 month from the expiry of the priority.

Rationale:

As failure to properly claim priority may result in a loss of right or a lapse in the protection of an industrial design, relief measures should exist such that an applicant may cure the *unintentional* lapse in priority.

21. Unregistered designs

Proposal:

If protection for unregistered designs is considered, it should be protected from copying from the first publication of a design regardless of where the publication occurs, and it should be available for a shorter term of protection than for registered designs, such as three years.

Rationale:

A protectable design should, as far as possible, serve the needs of all sectors of industry.

Some of those sectors produce large numbers of designs for products frequently having a short market life where protection without the burden of registration formalities is an advantage and the duration of protection is of lesser significance. On the other hand, there are sectors of industry which value the advantages of registration for the greater legal certainty it provides and which require the possibility of a longer term of protection corresponding to the foreseeable market life of their products.

This calls for two forms of protection, one being a short-term unregistered design and the other being a longer-term registered design.

The exclusive nature of the right conferred by the registered design is consistent with its greater legal certainty. It is appropriate that the unregistered design should, however, constitute a right only to prevent copying for a short term from first disclosure of the design. Protection could not therefore extend to design products which are the result of a design arrived at independently by a second designer.

Those sectors of industry producing large numbers of possibly short-lived designs over short periods of time of which only some may be eventually commercialized will find advantage in the unregistered design.

GUIDELINES FOR EXAMINATION OF INDUSTRIAL DESIGNS

**A REPORT ON CONSENSUS POINTS FOR
EXAMINATION OF INDUSTRIAL DESIGN APPLICATIONS**

May 2021

GUIDELINES FOR EXAMINATION OF INDUSTRIAL DESIGNS

Design Law and Practice Subcommittee

Designs Committee

May 2021

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All information provided by the International Trademark Association in this document is provided to the public as a source of general information on trademark and related intellectual property issues. In legal matters, no publication whether in written or electronic form can take the place of professional advice given with full knowledge of the specific circumstances of each case and proficiency in the laws of the relevant country. While efforts have been made to ensure the accuracy of the information in this document, it should not be treated as the basis for formulating business decisions without professional advice. We emphasize that trademark and related intellectual property laws vary from country to country, and between jurisdictions within some countries. The information included in this document will not be relevant or accurate for all countries or states.

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INTA GUIDELINES FOR DESIGN RIGHTS EXAMINATION

1. INTRODUCTION/PURPOSE

The purpose of this document is to provide general guidelines on a full range of issues related to examination of applications for industrial designs. These Guidelines are not intended to be limited to the design law of any specific jurisdiction; rather, they follow generalized conceptual lines. The Guidelines are meant to reflect various international systems in an effort to harmonize design law practice. The intention is that these Guidelines be available as a reference document, particularly for Industrial Property Offices.

2. MEANS OF FILING

2.1 Pre-Application

2.1.1 Third Party Searching. Industrial Property Offices should provide access to design rights for which publication is not deferred so applicants may search the records, on a free-of-charge basis.

2.1.2 Classification Systems. INTA strongly recommends that, in the interests of international harmonization, Industrial Property Offices use the Locarno Classification for the classification of goods.

2.2 Filing

Industrial Property Offices should provide an official form in the designated language in which the form should be filed to be used by applicants to file the design application. INTA considers that substantial cost and administrative savings can be made to users through the filing of multiple designs in a single application (“multiple design application”) and therefore strongly recommends that Industrial Property Offices allow the filing of such multiple design applications. INTA further strongly recommends that Industrial Property Offices not require that all designs within a multiple application be in the same (Locarno) class.

Industrial Property Offices should allow for submission of applications and prosecution documents by hand, post, facsimile, and/or electronic transmission (e-filing). INTA recommends, however, due to the loss in quality in transmission by facsimile (fax) and more traditional means, that Industrial Property Offices adopt and encourage the use of filing through secure electronic transmission/e-filing interfaces. Nevertheless, users should not be penalized for failing to file electronically where electronic filing is not possible (for example due to technical problems). We therefore recommend maintaining back-up options

for when e-filing is not possible. Further, we do not support higher fees for paper-based applications or for applications filed other than by e-filing.

Industrial Property Offices should promptly provide confirmation of receipt of the application, ideally electronically, providing a receipt date, and an application number. They should also allow for payment of fees by cash, check, credit cards, EFT, and deposit accounts.

2.3 Response time, extensions and remedies for missed deadlines

Industrial Property Offices should examine the application and issue a notification of objections to registration within a reasonable period after the filing date, i.e., within three to six months after the filing. The applicant should be provided a reasonable time period, of at least four weeks, within which to respond to any objections or rejections issued by the Industrial Property Office. Such deadline should be extendible at least once. In view of the fact that the consequences of missed deadlines in relation to designs can be drastic, we recommend the provision of a (limited time) remedy for missed deadlines, such as “continuation of proceedings”, upon payment of a fee.

2.4 Fast track examination

Industrial Property Offices should provide a process for expedited examination, and may set criteria for qualifying for expedited examination, for example, existing or imminent litigation, or the need to immediately protect the design(s) in the market, and may charge reasonable additional fees for expedited examination.

2.5 Representation

Industrial Property Offices should determine when an applicant may represent itself and when an applicant must have a representative in proceedings before that Office and the qualifications of the professional representative.

3. MULTI-NATIONAL APPLICATIONS

Existing mechanisms that allow for the submission of a single application resulting in registrations that provide protection in multiple territories are encouraged. INTA strongly encourages countries, intergovernmental organizations, and non-member countries whose citizens are covered by the adherence of an intergovernmental organization to accede to the Hague Agreement Concerning the International Registration of Industrial Designs, enacting implementing legislation on the registration and enforcement of design rights. INTA can provide assistance to countries in their consideration of adherence to the system.

4. MANDATORY REQUIREMENTS OF A DESIGN APPLICATION

INTA recommends that design applications be required to provide the following mandatory elements:

- Identification of the applicant, in such a way that allows them to be identified and contacted;
- A sufficiently clear representation of the design; and
- Indication of the product.

4.1 Identification of the Applicant

The applicant should be required to provide sufficient information so as to enable it to be identifiable to third parties and for it (or its representative, where appropriate) to be contacted in relation to the design. It is recommended that the applicant be required to provide its name (including, where appropriate, its legal status) and physical address (not PO Box) for correspondence purposes. In principle, no more than one address should be given for each applicant. Applications should be capable of being filed in the name of more than one applicant. Where the Industrial Property Office uses identification numbers for owners for administrative purposes, it should be sufficient in the application to mention that number.

4.2 Representation of Design

4.2.1 Quality of the Representation








The representation of the design should be of sufficient quality to clearly identify the design for which registration is sought and enable it to be compared to other designs. The representation should be permitted in black and white or color, and should consist of a graphic or photographic reproduction of the design. INTA is in favor of not combining different types such as graphic and photographic in one set of single design representation, as well as not combining the design's representations in black and white and in color.

The Industrial Property Office may specify requirements for the resolution and size of the representation.

INTA welcomes the possibility of filing dynamic views (e.g. 3D digital representations and video files) as an optional representation tool. Search tools and databases should be updated accordingly to reflect these kinds of representations and make them searchable. INTA does not encourage the use of specimens.

The design should be represented on a neutral background, and there should not be non-design elements showing in the representation. Industrial Property Offices should permit applicants to show, by way of contour shading, details of the contour of the design. Contour shading may be in the form of line shading, stipple shading (dots), or both.

Examples of static representation types in graphic and photographic reproductions, in both black and white, and color are given below.

Graphic reproduction examples			Photographic reproduction examples	
Black and white line drawing	Black and white 3D drawing	Colored 3D drawing	Black and white photograph	Colored photograph
<p>1.1</p>  <p><u>DM/205 602</u></p>	<p>1.1</p>  <p><u>DM/206 505</u></p>	<p>1.1</p>  <p><u>DM/093 868</u></p>	<p>1.1</p>  <p><u>DM/204 148</u></p> <p>Alternatively;</p> <p>1.1</p>  <p><u>DM/207 055</u></p>	<p>1.1</p>  <p><u>DM/201 388</u></p> <p>Alternatively;</p> <p>1.1</p>  <p><u>DM/203 251</u></p>

In many jurisdictions, typeface/type font designs are registered as a set. Regarding typographic typeface/type font design representations, INTA suggests that all characters including letters in both upper and lower cases, numerals, punctuation marks and any other special characters designed by that particular typeface/type font should be shown in the representations. It is advisable to show the characters at the minimum size of 16 Point in order to show details. Four lines of text comprising all typographic characters can also be added to show the typeface in text format.

An example is given below.

DM/206
155

1.1

**ABCDEFGH
IJKLMNOP
OPQRSTU
VWXYZ
abcdefghij
klmnopqr
stuvwxyz**

1.2

**The quick
brown fox
jumps
over the
lazy dog**

The quick brown fox jumps over
the lazy dog

1.3

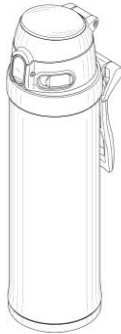
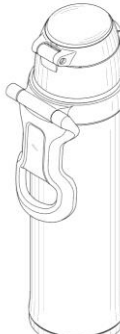
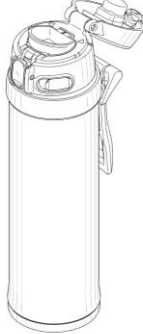
**H a
R e
S g**

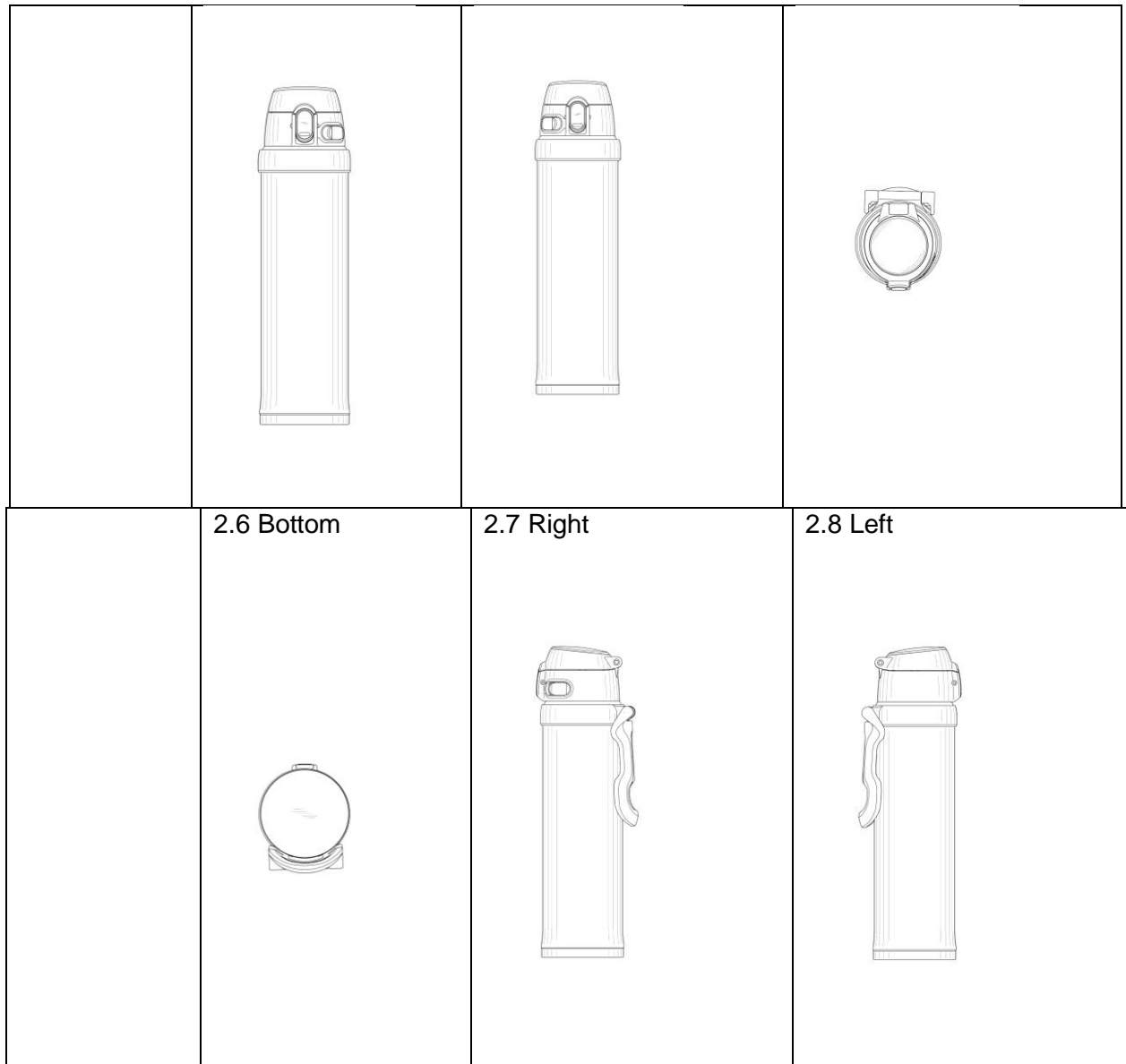
4.2.2 Number of Views

There should be no minimum number of views to depict the design in question, and it should be possible to file as many representations as may reasonably be required to fully disclose the design. A sufficient number of views showing the design from different angles and alternative positions such as open/closed positions, if any, should be included in order to provide a better understanding of the design.

It is suggested to use perspective and orthogonal views (front, back, top, bottom, right side and left) of a three-dimensional design. Design applications should, however, be concise so as to avoid creating excessive work at the Industrial Property Office, resulting in backlog issues. In this regard, repeated views should not be included, and it is noted that mirrored images, flat bottoms, and unornamented surfaces can be clearly indicated in the description (where provided).

Below are examples of representations showing the design from different angles.

	DM/206 296		
Perspective views	2.1 Perspective 	2.2 Perspective 	2.6 Perspective 
Orthogonal views	2.3 Front	2.4 Back	2.5 Top



4.2.3 Consistency of Views

4.2.3.1 Different Formats of Representations for the Same Design

The scope of protection will often vary depending on whether the representation of a design is in the form of a simple line drawing, a greyscale image, or a color photograph. To avoid doubts as to the scope of protection, representations of a single design should all be in the same format.

4.2.3.2 Consistency of Visual Content Contained in Representations

All representations of a single design should relate to the same design. Levels of detail and colors should be consistent between representations.

If two or more representations are inconsistent with each other regarding the level of detail shown in them, colors used, etc., the applicant should be given a reasonable period of time to withdraw representations (without affecting the filing date of the other representations) or submit amended representations that are consistent.

If inconsistent representations are filed which support different designs, the applicant should be given an opportunity to convert the application into a multiple or separate design application for the different designs as shown in the different representations. The multiple or separate design application(s) should retain the original filing date or priority date (where applicable).

4.2.3.3 Consistency Between Representation and Classification for Whole Design

The Industrial Property Office should be entitled to object if the classification/indication of product clearly does not match the design as shown in the representation(s). The applicant should be given a reasonable period of time to file amended representations or an amended classification to correct the inconsistencies.

4.2.3.4 Consistency Between Representation and Classification for Parts of Designs.

The Industrial Property Office should be entitled to object where it is uncertain whether the representation(s) of the design is/are consistent with the classification if the product identified is not the whole article shown in the representation, or when the classification/indication of the product describes the whole object when the representation only shows part of the object. The applicant should then be given a reasonable period of time to file amended representations or an amended classification to correct the inconsistency.

4.2.4 Visual Disclaimers

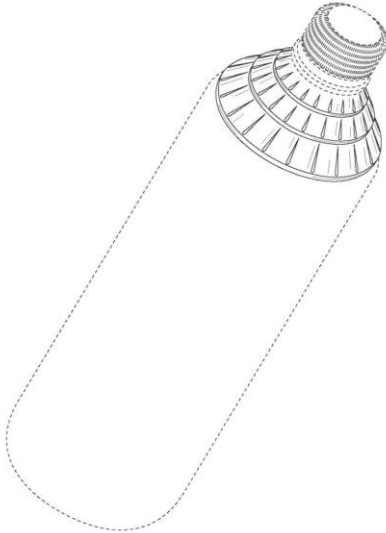

All Industrial Property Offices should permit applicants to show, by way of a visual disclaimer, parts of the design for which protection is not sought. The visual disclaimer must be clear and obvious, meaning the claimed and disclaimed design elements should be clearly differentiated. The Industrial Property Offices should issue clear guidelines for such disclaimers.

INTA prefers that visual disclaimers be achieved by indicating with broken lines the features of the design for which protection is not sought, especially when the design is shown in line drawing format. The disclaimer may be achieved by other means such as blurring the features of the design for which protection is not sought, and/or including within a boundary the features of the design for which protection is sought.

4.2.4.1 Broken Lines

Broken lines consist of a trace made up of dots and/or dashes, and are used to indicate that no protection is sought for the features shown using an uninterrupted trace. A visual disclaimer consisting of broken lines will usually be combined with continuous lines reflecting what is claimed. To be accepted, the features for which protection is not sought should be clearly indicated with broken lines, and the parts for which protection is sought should be indicated with continuous lines.

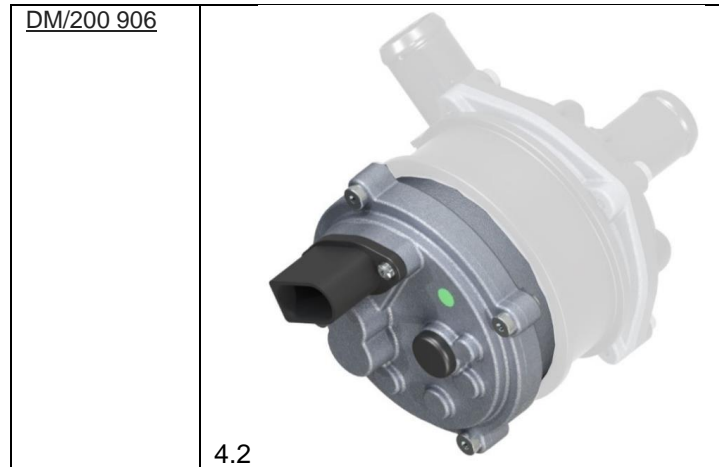
Below are examples of representations of design registrations in which a partial disclaimer is shown with broken lines.

<u>DM/201 443</u>	 <p>1.1</p>
<u>DM/210 273</u>	 <p>1.1</p>

4.2.4.2 Blurring

Blurring is a type of visual disclaimer that consists of obscuring the features for which protection is not sought in the drawings or photographs of a design application. The blurred features to be disclaimed should be clearly distinguishable from the rest of the design for which protection is claimed.

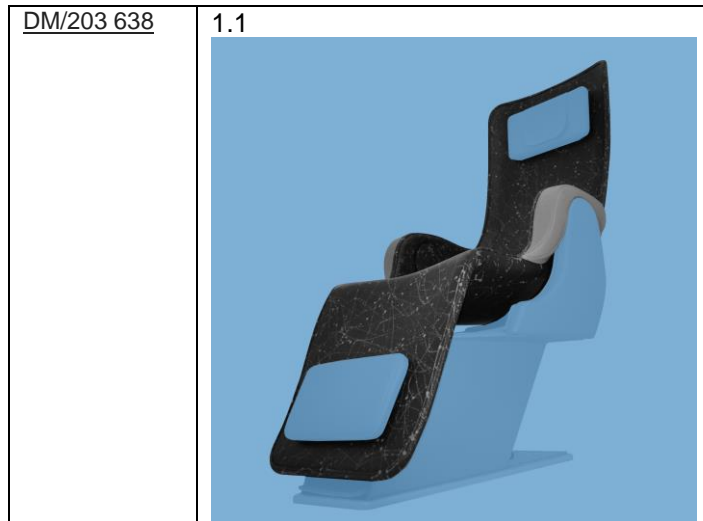
Below is an example of a representation of a design registration in which a partial disclaimer is shown with blurring technique.



4.2.4.3 Color Shading

Color shading is a type of visual disclaimer that consists of using contrasting tones to sufficiently obscure the features for which protection is not sought in the drawings or photographs of a design application. The color-shaded features to be disclaimed should be clearly distinguishable from the rest of the design for which protection is claimed.

Below is an example of a representation of a design registration in which a partial disclaimer is shown with color shading technique.



4.2.4.4 Boundaries

Some jurisdictions allow boundaries as a type of visual disclaimer used in drawings or photographs of a design application to indicate that no protection is sought for the features not contained within the boundary. To be accepted, the features for which protection is sought should be clearly indicated within the boundary. All features outside of the confines of the boundary are disclaimed and will not be protected.

4.3 Identification of Product

The applicant should identify the object to which the design is applied or is made perceptible in such a way to specify clearly the nature of the product. In order to facilitate the searching of designs, INTA strongly recommends that the Industrial Property Office either classify, or require the applicant to classify, the product in accordance with the Locarno classification.

4.4 GUIs, PHVARs and Interior Designs

INTA recognizes the commercial importance of graphical user interfaces (GUIs), icons, fonts and animations, as well as projected, holographic and/or virtual/augmented reality (PHVAR) designs, and accordingly recommends that these be capable of registration in and of themselves without requiring them to be placed on a physical article. Similarly, INTA recognizes the commercial importance of interior designs, whether real or virtual, and considers that they should also be capable of registration in and of themselves.

5. OPTIONAL ELEMENTS OF A DESIGN APPLICATION

5.1 Description

A description can help clarify the features being claimed for protection or other aspects of the design, and it can also help users of the system and enforcement bodies interpret the scope of protection of a design (although any description should not define such scope of protection in and of itself).

For example, a description can be helpful to clarify the design where different views of the same design display different colors or where the nature of a product causes it to adopt different positions in use. A complementary description can also provide better understanding of the nature or purpose of some features of the design. Industrial Property Offices should provide that the applicant can include a written description to be submitted with the application. The description should only relate to features that appear in the representations of the product design. It should not contain statements concerning non-visual features, protection requirements, or value of the design (e.g. novelty, individual character, non-obviousness, or technical value). The description should not define the scope of protection of a design.

5.2 Convention Priority Claims

The priority declaration should contain the date, number, and country of the first application and should be submitted no later than one month from the date of filing of the design application. The details and the certified copy of the previous application, where required, should be permitted to be filed after the filing of the application or the declaration of priority, e.g. within three months.

INTA strongly encourages Industrial Property Offices to accede to WIPO Digital Access Service (DAS), an electronic system that allows priority documents and similar documents to be securely exchanged between Industrial Property Offices. WIPO DAS system enables applicants and Industrial Property Offices to meet the requirements of priority documents by only obtaining the DAS Code and eliminating the obligation of requesting and submitting the certified paper copies of documents from one Industrial Property Office and then submitting those documents to other Industrial Property Office(s).

5.3 Exhibition Priority

The effect of exhibition priority is that the date on which the design was first displayed at an exhibition, or was in any other way made available to the public (collectively, “display”), is deemed to be the date of filing of the application for a registered design. The applicant may claim exhibition priority only within six months of the first display. Evidence of the display must be filed. Exhibition priority cannot extend the six-month period of ‘Convention priority.’

Exhibition priority may be claimed at filing or after filing a design application. Where the applicant wishes to claim exhibition priority after filing, the declaration of priority, indicating the name of the exhibition if applicable, the nature of the display, including disclosure of the product in which the design was incorporated or means by which the design was made perceptible, and the date of first display, should be submitted within a period of one month of the filing date.

If a certificate is required, it should be permitted to be filed after the declaration of priority, e.g. within three months. The certificate should state the nature of the display, including disclosure of the product in which the design was incorporated or made perceptible, and date of the first display. The certificate should be duly certified by the exhibition authority and accompanied by identification of the actual display of the design.

5.4 Request for Deferral of Publication

Industrial Property Offices should permit the deferment of publication of the design, if the applicant elects to do so. The permitted deferment period should be up to 30 months after the date of application. A request for deferment, if desired, should be made in the application. The applicant may be required to pay a fee for deferment of publication along with the application. Payment of the publication fee should be optional at the filing stage. An application for publication should be filed and payment of the publication fee made at a time of the applicant’s choosing before the end of the deferment period in order for the design to be published. Claiming priority from an earlier design application should not change the available term of deferment of publication of the design filed.

In the case of a multiple design application, a request for deferment of publication should be permitted to concern only some of the designs of the multiple design application.

5.5 Identification of Designer

The application may include an indication of the designer(s), a collective designation for a team of designers, or an indication that the designer(s) or team of designers has/have waived the right to be cited. Information as to the designer(s) may also be added by the applicant at a later date, after filing the application. Industrial Property Offices should not have a requirement under which the applicant has to prove that the designer has assigned

her/his rights to the applicant, nor should Industrial Property Offices have a requirement that naming of the designer be mandatory.

5.6 Signature

INTA recommends that, where a signature is required in the application, it should not be required to be a “wet ink” signature, and that Industrial Property Offices should allow electronic forms of signature.

6. PROCEDURAL MATTERS

6.1 Examination Procedure

6.1.1 Scope of Examination

The scope of examination, as well as the criteria by reference to which examination is conducted, will be determined by the substantive law under which an Industrial Property Office operates. Each Office should publish its requirements and make them available to users. Although the wording of a given jurisdiction’s design law may vary, there are three main elements of examination: formalities, absolute grounds, and relative grounds.

A formalities examination should be conducted by each Office prior to registration. However, the extent of absolute and relative examination may vary widely. In some jurisdictions there are no examinations on relative grounds, although a search may be carried out to make the applicant aware of possible relative objections.

6.1.2 Formalities Examination

Industrial Property Offices should examine applications to confirm that they contain the essential minimum data specified by design law. This should include: applicant details, representation of the design suitable for reproduction, compliance with the definition of design, compliance with the number of views permitted under the law, consistency of the views, and indication of products. Optional data that may be specified under design law should, as above, include classification, claims of priority, description of the design(s), and request for deferral of publication.

6.1.2 Absolute Grounds Examination

If an Industrial Property Office conducts an absolute grounds examination, a design applicant should be afforded the opportunity to respond, within a reasonable period of time, to any objection made. Specifically in relation to any possible ground for refusal based on

technical function, no objection should be raised unless the appearance of the design as a whole is solely dictated by its technical function, even if individual features of the design or the design as a whole serves a technical function. Such technical function ground for refusal should apply in rare cases only.

6.1.3 Relative Grounds Examination

If an Industrial Property Office conducts a relative grounds examination, the examination of the designs should include an analysis of actual conditions in which the public will encounter the designs rather than based solely on classification.

6.1.4 Registration, Publication, and Certificates

Unless a request for a deferment of publication is made and granted, once examination of grounds for non-registrability, formalities, required information is confirmed, all fees are paid, and no deficiency is found, those Industrial Property Offices that issue registrations prior to publication should issue the registration followed by publication.

Unless a request for deferment of publication is made and granted, those Offices that publish designs prior to registration should proceed to publication of the design and issue the registration certificate if no objection is raised during the opposition/publication period.

In either case, publication should be made in a timely fashion not exceeding three months. Likewise, issuance of the registration should be in a timely manner.

7. AMENDMENTS OF AN APPLICATION/REGISTRATION

7.1 Corrections/Other Changes

Amendments to the application should be permitted for the purpose of correcting errors and overcoming objections. Industrial Property Offices may determine that certain elements cannot be amended or corrected, without affecting the filing date. Where amendments concern features of the design, it should be possible to proceed with the amended design with a new filing date rather than the design being rejected. Depending on the circumstances, an amendment may be requested in writing, by telephone followed by confirmation sent in writing to the applicant, or electronically. Generally, if an amendment is required to correct an administrative error of the Industrial Property Office, it should be allowed at any time.

7.2 Changes with Respect to Design Owner

The applicant should be entitled, at any time, to request a change of name or address, or record a transfer, in respect of designs. It is recommended that Industrial Property Offices allow design owners to seek updated registration certificates reflecting any changes, if appropriate upon payment of a fee.

7.3 Withdrawal/Surrender

Withdrawal of a single or multiple design application, or of any view, should be permitted at any time prior to registration. In the case of multiple design applications, applicants should be permitted to withdraw some of the designs any time prior to registration.

Surrender of a single or multiple design application should be permitted at any time after registration. In the case of multiple design applications, holders should be permitted to surrender some of the designs any time after registration.

7.4 Licenses/Security Interests

The applicant should be entitled, at any time, to request the recordal of a license or security interest in respect of the design or particular design(s) in a multiple design application. The Industrial Property Office shall publish the fact of such license or security interest, and shall include a link or other cross-reference to such recordal(s) in the official files of the affected application or registration.

INTERNATIONAL TRADEMARK ASSOCIATION COMMENTS ON

IP Australia’s notice and request for comments on the WIPO Diplomatic Conference on the Design Law Treaty (“DLT”)

September 22, 2024

The International Trademark Association (INTA) would like to thank IP Australia for the opportunity to provide comments in response to the IP Australia’s notice and request for comments on the WIPO Diplomatic Conference on the Design Law Treaty, [WIPO Design Law Treaty - IP Australia - Citizen Space](#) dated 23rd August 2024.

The following comments were prepared by INTA’s Designs Committee and Staff.

We hope you will find these comments helpful in view of the diplomatic conference to finalize the DLT and we welcome the opportunity to further engage in discussions on the topic.

The International Trademark Association (INTA) is a global association of brand owners and professionals dedicated to supporting trademarks and complementary intellectual property (IP) to foster consumer trust, economic growth, and innovation, and committed to building a better society through brands. Members include nearly 6,500 organizations, representing more than 34,350 individuals (trademark owners, professionals, and academics) from 185 countries, who benefit from the Association’s global trademark resources, policy development, education and training, and international network. Founded in 1878, INTA, a not-for-profit organization, is headquartered in New York City, with offices in Beijing, Brussels, Santiago, Singapore, and Washington, D.C. Metro Area, and a representative in New Delhi. For more information, visit inta.org.

GENERAL COMMENTS

INTA notes IP Australia’s comment that most of the text is agreed, but the outstanding issues include; (1) grace periods, namely the periods after public disclosure of the product when you can still seek design registration (Article 6); (2) whether a procedural treaty should include substantive law (e.g. proposal for term of protection in Article 9*bis*); (3) the option for an office to require disclosure when a designer has utilized any traditional knowledge, traditional cultural expressions or biological/genetic resources in the design (Article 3); (4) whether IP offices should be required to provide an electronic system for design applications (Article 9*ter* and 9*quater*); and (5) the assistance WIPO should provide to developing countries (e.g. technical assistance and capacity building for the ratification of the treaty) (Article 22). INTA’s comments are outlined herein.

INTA has adopted Model Design Law Guidelines ([Model Design Law Guidelines \(inta.org\)](#)) and Guidelines for Examination of Industrial Designs ([Guidelines for Examination of Industrial Designs \(inta.org\)](#)), which contain INTA’s basic positions on design law and practice and serve as a framework by which INTA analyzes the current working text of the DLT and comments on certain questions raised in the Notice.

SPECIFIC COMMENTS

1. Grace Periods Article 6

INTA agrees with the Article 6 Grace Period.

Lack of Harmonized Grace Period. Although most jurisdictions (e.g., Australia [commencing on 10th March 2022], U.S., Mexico, Canada, the EU, UK, South Korea, and Japan) recognize a 12-month grace period for public disclosures made with or without the applicant’s consent, many jurisdictions do not. For example, China, India, Brazil, and Singapore recognize a 6-month grace period, which is available only for disclosures in certain situations. China’s grace period, for example, applies only to disclosures by the applicant “at a national emergency for public interest,” “at an international exhibition sponsored or recognized by the Chinese Government,” “at a prescribed academic or technological meeting,” or “certain disclosures of the invention obtained by a third party from the applicant or the inventor.” See “Patent Law of the People’s Republic of China,” 2021, Article 24, <https://www.wipo.int/wipolex/en/legislation/details/21027>. India’s grace period is similarly limited to disclosures at an exhibition sanctioned by Section 21 of The Designs Act, 2000. See The Designs Act, 2000, https://www.ipojp.gov.in/system/laws/gaikoku/document/index/india-e_designs_act.pdf and Manual Of Designs Practice & Procedure, 04.03.02.01, https://ipindia.gov.in/writereaddata/Portal/IPOGuidelinesManuals/1_30_1_manual-designs-practice-and-procedure.pdf.

Additionally, each jurisdiction has different formalities that an applicant must follow to take advantage of the jurisdiction’s available grace period. While some jurisdictions (e.g., the EU, Mexico, the UK, and the United States) have no formal requirements to take advantage of the grace period, some jurisdictions require the applicant to submit a declaration and/or supporting evidence detailing the nature of the disclosure. These jurisdictions include, for example, Australia, India, China, Japan, and South Korea. See, e.g., The Designs Act, 2000; Manual Of Designs Practice & Procedure, 04.03.02.01; and Rule 33 of the new Implementing Regulations of China Patent Law, <https://www.wipo.int/wipolex/en/legislation/details/6504>.

Further, the timing of when to fulfill the formal requirements varies by jurisdiction. In China, Japan, and South Korea, this documentation may be submitted with the IDA, or after the IDA is filed through a local representative, within varying periods. See WIPO, “Guide to the Hague System: International Registration of Designs Under the Hague Agreement,” p. 64, <https://www.wipo.int/export/sites/www/hague/en/docs/hague-system-guide.pdf>. In Australia, the requirements for filing a declaration to claim the grace period ranges from at the filing of the design application with IP Australia or at the time of requesting examination/certification with IP Australia.

Article 6 Grace Period for Filing in Case of Disclosure

Article 6⁷: “A public 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 eligibility for the registration 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.”

Comment: This proposal was made at the SCT/S3 by the United States, supported by the delegations of Australia, Canada, Republic of Moldova, Switzerland, Ukraine and United Kingdom, and not supported by the delegations of China, India, Nigeria and the Russian Federation.

INTA recommends a 12-month grace period that allows registration of a design within 12 months of an initial disclosure of the design by the proprietor or as a result of information obtained from the proprietor including as a result of an abuse. See INTA Model Design Law Guideline, par. 9 (Grace Period). A harmonized grace period of 12 months assists designers, particularly individual designers and small entities, by avoiding inadvertent loss of rights.

Accordingly, we support the proposal by the United States prescribing a broad 12-month grace period. We further agree with the change from “novelty and/or originality” to “eligibility for the registration” in view of the different terms of art under the applicable law of contracting parties.

We oppose limiting the grace period to only certain acts or circumstances as set forth in Article 6(2) proposed by the delegation of China and Article 6⁶ proposed by the delegation of India.

2. Whether a Procedural Treaty should include Substantive Law (e.g. proposal for term of protection in Article 9bis).

Article 9bis Term of Protection

Article 9bis⁸: “A Contracting Party shall provide a term of protection for industrial designs of at least 15 years from either: (a) the filing date, or (b) the date of grant or registration.”

Article 9bis¹⁰: “Contracting Parties shall have the option to comply with Article 17 of the Hague Convention or Article 26 of the TRIPS Agreement.”

Comment: Article 9bis⁸ was proposed at the SCT/S3 by the United States, supported by the delegations of Canada, Japan, Republic of Korea, Switzerland and the United Kingdom, and not supported by the delegations of Brazil, China, Colombia, Ecuador, Ghana, on behalf of the African Group, Iran (Islamic Republic of), Niger, Nigeria, Peru, Russian Federation, South Africa. Article 9bis¹⁰ was proposed at the SCT/S3 by Nigeria, supported by the delegations of Brazil, Kyrgyzstan, Mauritania, Niger, Uganda, Yemen, Zambia and Zimbabwe, and not supported by the delegations of the United Kingdom and the United States.

Australia is presently not in harmony regarding the term of registered design protection having a ten (10) years protection. The Australian position is also presently not in harmony with the position of New Zealand of fifteen (15) years of design protection.

INTA supports the Article 9bis⁸ proposal of a term of protection of at least 15 years, which is consistent with the Hague System for the International Registration of Industrial Designs. The term may be made up of renewals after multiple shorter periods (for example, three terms of five years). See INTA Model Design Law Guideline 10, par. 10 (Term of Protection).

The option for an office to require disclosure when a designer has utilised any traditional knowledge, traditional cultural expressions or biological/genetic resources in the design (Article 3).

No substantive comments or observations are provided regarding the disclosure of the origin or source of traditional cultural expressions, traditional knowledge or biological/genetic resources utilized or incorporated in designs other than this concern: if a contracting party mandates this disclosure as a requirement in its jurisdiction, applicants would encounter additional hurdles to obtaining design rights, which is counter to the purposes of implementing the DLT. However, to the extent that such disclosures are considered for inclusion in the DLT, see, e.g., DLT Article 3(1)(ix), we would advocate that the scope of disclosure be clearly defined and that the requirements for the disclosure not be unduly burdensome. Applicants should be provided with a reasonable and extendable period of time to comply with such disclosure requirements, in accordance with INTA Guidelines for Examination of Industrial Designs 2.3 (Response time, extensions and remedies for missed deadlines).

4 Whether IP offices should be required to provide an electronic system for design applications (Article 9ter and 9quater)

INTA praises the adoption of WIPO Digital Access Service (DAS), an electronic system allowing participating intellectual property (IP) offices to exchange priority and similar documents securely. However, the WIPO DAS is only available to 29 offices, with 26 participating only as a depositing office. See Estoesta *et al.*, INTA Feature article titled “[The Hague Design System Is Undoubtedly Useful, but National Formalities Still Exist](https://www.wipo.int/en/web/das/participating_offices/searchresults?optionId=2391&territoryId=undefined),” published last January 25, 2023, https://www.wipo.int/en/web/das/participating_offices/searchresults?optionId=2391&territoryId=undefined.

INTA notes that IP Australia presently adopts the DAS system for designs without any legislative requirement.

Important jurisdictions missing from WIPO DAS include the UK, Switzerland, Taiwan, and Hong Kong. Additionally, some offices, like Mexico, separately require submitting a translated priority document. See *id.* Further, in Mexico, failing to submit the priority document and its

Spanish translation within the specified time limit jeopardizes priority rights without the possibility of reinstatement.

Article 9ter Electronic Industrial Design System

Article 9ter¹¹: “A Contracting Party shall provide: (a) a system for electronic application; and (b) a publicly available electronic information system, which must include an online database of registered industrial designs.”

Comment: We encourage the adoption of this article. While we acknowledge that creating an electronic filing system and online database of registered industrial designs may be burdensome on developing Contracting Parties, allowing applications to be electronically filed helps applicants streamline the filing process, and providing access to published design rights allows applicants to search the records on a free-of-charge basis. See INTA Guidelines for Examination of Industrial Designs, 2.1 (Pre-Application) & 2.2 (Filing).

Article 14 bis Electronic Priority Document Exchange

Article 14 bis: “A Contracting Party shall provide for electronic exchange of priority documents for applications.”

Comment: We strongly encourage adopting this article, and more specifically, that Contracting Parties’ offices accede to WIPO DAS. While we acknowledge that adopting this system may initially be burdensome on developing Contracting Parties, it would ultimately be beneficial for both applicants and offices, as an inexpensive way to satisfy the requirement to provide priority documents when and where required. See INTA Guidelines for Examination of Industrial Designs, par. 5.2 (Convention Priority Claims).

5. The assistance WIPO should provide to developing countries (e.g. technical assistance and capacity building for the ratification of the treaty) (Article 22).

No substantive comments or observations are provided regarding the assistance WIPO should provide to developing countries (e.g. technical assistance and capacity building for the ratification of the treaty) (Article 22).

6. Other Comments on the DTL:

We invite you to review INTA’s comments covering further aspects of the DLT recently filed with the United States Patent and Trademark Office (June 2024) and with India’s Ministry of Commerce and Industry (August 2024), respectively available [here](#) and [here](#).



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INTA would be pleased to answer any questions that the IP Australia may have and is available to discuss our recommendations in more detail. Please contact Walter Chia (wchia@inta.org), Chief Representative Officer for Asia Pacific, or Erica Vaccarello, Senior Advisor, External Relations (evaccarello@inta.org).

Thank you in advance for considering the views of INTA.

Yours sincerely,

Etienne Sanz de Acedo

INTA CEO

International Trademark Association



INTERNATIONAL TRADEMARK ASSOCIATION COMMENTS ON

Canadian Intellectual Property Office's Request for Comments on the WIPO Diplomatic Conference on the Design Law Treaty

September 27, 2024

The International Trademark Association (INTA) would like to thank the Canadian Intellectual Property Office (CIPO) for the opportunity to provide comments on the WIPO Diplomatic Conference on the Design Law Treaty.

The following comments were prepared by INTA's Designs Committee and Staff.

We hope you will find these comments helpful in view of the diplomatic conference to finalize the DLT and we welcome the opportunity to further engage in discussions on the topic.

Please find below INTA's answers to CIPO's request for comments.

1a. Please share your experiences in filing for design protection in Canada. Is the process straightforward? Have you encountered any particular challenges?

While the design filing and prosecution process in Canada is relatively straightforward, the Canadian industrial design regime does present applicants with a number of challenges, as discussed in more detail below.

Section 25(2)(c) of the Regulations – Amending applications to change or add designs.

Section 25(2)(c) prohibits amending drawings “if the addition or amendment would result in the application being for a design that differs substantially from the design that was the subject of the application on its filing date”. In addition to prohibiting the above scenario, this section would prohibit an applicant from amending the as-filed design to one having, for example a different combination of solid and broken lines (i.e. focusing on claiming different portions of the original design or changing the design from a partial one to one that illustrates the entire design in solid lines). This section unfairly prevents the applicant from changing the claimed scope of a design when the entire design is disclosed in the original application (whether in solid or broken lines for example).

In view of the above, we advocate that the applicant be permitted to amend the drawings in an application or add new sets of drawings directed to new variants of a design, provided there is support for the new or amended variants in the as-filed application (or in the case of a divisional

application, the original application). A new variant is considered supported if the original application illustrates all of the features of the new variant in either solid or broken lines.

Requirement for application for electronic/digital icon designs to specify physical device

The Industrial Design Office Practice Manual (IDOPM) currently requires that an application for an electronic icon design identify the “finished article” to which the design is applied (e.g. display screen) - see IDOPM, s. 8.05.07. In our view, given the ever-advancing technologies for presenting computer-generated visual content, such a requirement is outdated. We advocate for eliminating any requirement that the finished article to which an electronic icon is applied be provided. In other words, we advocate for permitting an applicant to obtain a registration for the icon without having to specify the physical device used to make the design perceptible (e.g. eliminate the requirement to identify the finished article as a display screen). See also Section 7 of INTA Model Design Law Guidelines at <https://www.inta.org/wp-content/uploads/public-files/advocacy/model-laws-guidelines/202305-Model-Design-Law-Guidelines.pdf>

1b. Please share your experiences with filing for design protection outside of Canada. Please include the jurisdiction(s) where protection was sought, what difficulties you experienced, what worked well in those jurisdictions compared to Canada. Also indicate whether you filed directly or through the Hague Agreement.

Members of the INTA Designs Committee surveyed several jurisdictions in 2022 on various formalities requirements and summarized those requirements in INTA’s Feature Article “[The Hague Design System Is Undoubtedly Useful, but National Formalities Still Exist.](#)” Many of the national formalities discussed in that article continue to pose challenges to applicants who pursue protection for an industrial design in multiple jurisdictions, and a sampling of those formalities is discussed in further detail below.

Lack of Harmonized Grace Period. Although most jurisdictions (e.g., Canada, the U.S., Mexico, the EU, UK, South Korea, and Japan) recognize a 12-month grace period for public disclosures made with or without the applicant’s consent, many jurisdictions do not. For example, China, India, Brazil, and Singapore recognize a 6-month grace period, which is available only for disclosures in certain situations. China’s grace period, for example, applies only to disclosures by the applicant “at a national emergency for public interest,” “at an international exhibition sponsored or recognized by the Chinese Government,” “at a prescribed academic or technological meeting,” or “certain disclosures of the invention obtained by a third party from the applicant or the inventor.” See “[Patent Law of the People’s Republic of China](#),” 2021, Article 24. India’s grace period is similarly limited to disclosures at an exhibition sanctioned by Section 21 of The Designs Act, 2000. See India’s [Designs Act, 2000](#), and India’s [Manual Of Designs Practice & Procedure](#), 04.03.02.01.

Additionally, each jurisdiction has different formalities that an applicant must follow to take advantage of the jurisdiction’s available grace period. While some jurisdictions (e.g., Canada, the EU, Mexico, the UK, and the United States) have no formal requirements to take advantage of

the grace period, some jurisdictions require the applicant to submit a declaration and/or supporting evidence detailing the nature of the disclosure. These jurisdictions include, for example, India, China, Japan, and South Korea. See, e.g., India's [The Designs Act, 2000](#); Manual Of Designs Practice & Procedure, 04.03.02.01; and China's Rule 33 of the new [Implementing Regulations of China Patent Law](#).

Further, the timing of when to fulfill the formal requirements varies by jurisdiction. In China, Japan, and South Korea, this documentation may be submitted with the IDA, or after the IDA is filed through a local representative, within varying periods. See WIPO, "[Guide to the Hague System: International Registration of Designs Under the Hague Agreement](#)," p. 64.

Lack of Harmonized Drawing Requirements - Number and Types of Views. Certain jurisdictions, like the United Kingdom and the European Union, accept a single view of the claimed design and impose limits on the maximum number of views allowable (e.g., the UK allows for up to twelve views, while the EU allows for up to seven views). See <https://www.gov.uk/register-a-design/prepare-your-application> and <https://guidelines.euipo.europa.eu/1934976/1926312/designs-guidelines/5-1-number-of-views>. However, other jurisdictions allow for an unlimited number of views and might not consider a single view of certain three-dimensional designs to disclose the claimed design sufficiently (e.g., the United States). Still, other jurisdictions (e.g., South Korea, China, and Vietnam) require specific numbers and types of views, such as perspective views. See INTA's Feature Article "[The Hague Design System Is Undoubtedly Useful, but National Formalities Still Exist](#)".

This lack of harmonization is not limited to three-dimensional designs. Many jurisdictions require different types of views for two-dimensional designs like graphical user interface (GUI) and computer icons (together referred to as computer-generated designs). For example, the EU, UK, Japan, and South Korea do not require visual representations to show a device on which a computer-generated design may be displayed, while Canada, the United States and Mexico currently require representations to show a display screen, though it may be drawn in broken lines and unclaimed. See *id.*

Lack of Harmonized Drawing Requirements - Drafting Conventions. "Some jurisdictions prohibit representations including discontinuous shadow lines intended to show contour (e.g., China), while others encourage their inclusion (e.g., Japan), and still others (e.g., the United States) require their inclusion for certain 3D designs." *Id.*

Lack of Harmonized Deferment of Publication Option. "[N]ot all jurisdictions allow deferred publication, and those that do provide differing maximum deferment periods. For example, the maximum period for formal deferment is 30 months (measured from the application filing date or the earliest claimed priority date, if any) in Canada and the EU, three years in China, and 12 months in Denmark, Finland, Israel, Norway, and the UK. Still other jurisdictions, like Mexico, Turkey, and the United States, do not permit deferred publication at all (although U.S. design applications do not publish before issuance as a U.S. design patent)." *Id.*

1c. In your view, are there any provisions or concepts currently considered by the DLT that would, if implemented in Canada, significantly improve its industrial design legislative framework? Alternatively, are there any provisions or concepts whose implementation in Canada could be problematic, or could lead to drawbacks?

Article 13 of the DLT would improve the Canadian legislative framework. The framework currently does not provide for reinstatement in the event of a failure to comply with a time limit where the failure to meet such time limit was unintentional and occurred despite the applicant's due care. Please see our more detailed comments regarding this article below.

Article 14(2) of the DLT would improve the Canadian legislative framework. Neither the Act nor Regulations currently provide for a restoration of a priority claim if a Canadian application is filed after the expiry of the 6-month priority period. Article 14(2) provides for such a right. The loss of priority could have devastating consequences for the applicant's rights, and the applicant should be able to restore such priority claim if its omission was unintentional. Please also see our more detailed comments regarding this article below.

2a. Do you have a position on such a disclosure requirement [relating to designs that use or incorporate traditional knowledge, traditional cultural expressions, or genetic resources] for industrial designs? Specifically, should Canada support its inclusion in the DLT as currently expressed (i.e. as an optional requirement for IP Offices)?

No substantive comments or observations are provided regarding the disclosure of the origin or source of traditional cultural expressions, traditional knowledge or biological/genetic resources utilized or incorporated in designs other than this concern: if a contracting party mandates this disclosure as a requirement in its jurisdiction, applicants would encounter additional hurdle to obtaining design rights, which is counter to the purposes of implementing the DLT. However, to the extent that such disclosures are considered for inclusion in the DLT, *see, e.g.*, DLT Article 3(1)(ix), we would advocate that the scope of disclosure be clearly defined and that the requirements for the disclosure not be unduly burdensome. Applicants should be provided with a reasonable and extendable period of time to comply with such disclosure requirements, in accordance with INTA Guidelines for Examination of Industrial Designs 2.3 (Response time, extensions and remedies for missed deadlines).

2b. Would your position change if that provision [Article 3(1)(ix)] were to become a requirement under the Canadian industrial design legislative framework?

See answer to 2a above.

2c. Do you have any experiences with filing an industrial design application in jurisdictions having a disclosure requirement? If so, please describe your experience, including a characterization of the level of difficulty in complying with such a requirement and a description of the consequences, if any, resulting either from compliance or non-compliance.

See answer to 2a above.

3a. Please share your views on the draft articles (WIPO/DTL/DC/3), particularly on those found in square brackets, or that contain alternative texts.

Article 3 Application; Article 8 Amendment or Division of Application Including More Than One Industrial Design

Article 3(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.”

Article 8: “(1) [Amendment or Division of Application] If an application that includes more than one industrial design (hereinafter “initial application”) does not comply with the conditions prescribed by the Contracting Party concerned in accordance with Article 3(3), the Office may require the applicant, at the option of the applicant, to either: (i) amend the initial application to comply with those conditions; or (ii) divide the initial application into two or more applications (hereinafter “divisional applications”) that comply with those conditions by distributing among the latter the industrial designs for which protection was claimed in the initial application. (2) [Filing Date and Right of Priority of Divisional Applications] Divisional applications shall preserve the filing date of the initial application and the benefit of the claim of priority, if applicable. (3) [Fees] The division of an application may be subject to the payment of fees.”

Comment: It is our position that a single application should be able to include multiple designs, even if the designs look different and even if the Locarno classes of each design are different, and that the applicant should be able to divide the application into multiple applications at the office’s request and maintain the original filing date and the benefit of the claim of priority date. See INTA [Model Design Law Guidelines](#), par. 4 (Multiple design applications); see also INTA [Guidelines for Examination of Industrial Designs](#) 2.2 (Filing). Therefore, we support Article 3(3) only in conjunction with the procedures guaranteed by Article 8, as a safeguard against conditions which may be prescribed under the applicable law of contracting parties.

Article 5 Filing Date

Article 5(1)(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; [(v) any further indication or element as prescribed under the applicable law].”

Comment: We do not object to the minimum requirements (i)-(iv) for obtaining an application filing date. See INTA [Model Design Law Guideline](#), par. 13 (Requirements for Registration). However, we oppose requirement (v) in that it allows a contracting party to mandate, without limit, additional application filing requirements, which is likely to lead to significant differences across jurisdictions, contrary to the DLT’s intended purpose to harmonize and streamline international design law and practice. The proposed requirement (v) would also inherently conflict with Article (5)(2) (“Permitted Additional Requirements”). Therefore, we advocate striking requirement (v) from the text.

Article 6 Grace Period for Filing in Case of Disclosure

Article 6: “A public 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 eligibility for the registration ~~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.”

Comment: This proposal was made at the SCT/S3 by the United States, supported by the delegations of Australia, Canada, Republic of Moldova, Switzerland, Ukraine and United Kingdom, and not supported by the delegations of China, India, Nigeria and the Russian Federation.

INTA recommends a 12-month grace period that allows registration of a design within 12 months of an initial disclosure of the design by the proprietor or as a result of information obtained from the proprietor including as a result of an abuse. See [INTA Model Design Law Guideline](#), par. 9 (Grace Period). A harmonized grace period of 12 months assists designers, particularly individual designers and small entities, by avoiding inadvertent loss of rights.

Accordingly, we support the proposal by the United States prescribing a broad 12-month grace period. We further agree with the change from “novelty and/or originality” to “eligibility for the registration” in view of the different terms of art under the applicable law of contracting parties.

We oppose limiting the grace period to only certain acts or circumstances as set forth in Article 6(2) proposed by the delegation of China and Article 6 proposed by the delegation of India.

Article 9 Publication of the Industrial Design

Article 9: “(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...”

Comment: It is necessary sometimes for the applicant to request to maintain the design unpublished for confidentiality or other purposes. As discussed above, there is significant disagreement among countries regarding the issue of deferment of publication.

Industrial Property Offices should permit the deferment of publication of the design, if the applicant elects to do so. The permitted deferment period should be up to 30 months after the date of application. A request for deferment, if desired, should be made in the application. The applicant may be required to pay a fee for deferment of publication along with the application. Payment of the publication fee should be optional at the filing stage. An application for publication should be filed and payment of the publication fee made at a time of the applicant’s choosing before the end of the deferment period in order for the design to be published. Claiming priority from an earlier design application should not change the available term of deferment of publication of the design filed. In the case of a multiple design application, a request for deferment of publication should be permitted to concern only some of the designs of the multiple design application.

Article 9bis Term of Protection

Article 9bis: “A Contracting Party shall provide a term of protection for industrial designs of at least 15 years from either: (a) the filing date, or (b) the date of grant or registration.”

Article 9bis: “Contracting Parties shall have the option to comply with Article 17 of the Hague Convention or Article 26 of the TRIPS Agreement.”

Comment: Article 9bis was proposed at the SCT/S3 by the United States, supported by the delegations of Canada, Japan, Republic of Korea, Switzerland and the United Kingdom, and not supported by the delegations of Brazil, China, Colombia, Ecuador, Ghana, on behalf of the African Group, Iran (Islamic Republic of), Niger, Nigeria, Peru, Russian Federation, South Africa. Article 9bis was proposed at the SCT/S3 by Nigeria, supported by the delegations of Brazil, Kyrgyzstan, Mauritania, Niger, Uganda, Yemen, Zambia and Zimbabwe, and not supported by the delegations of the United Kingdom and the United States.

We support the Article 9bis proposal of a term of protection of at least 15 years, which is consistent with the Hague System for the International Registration of Industrial Designs. The term may be made up of renewals after multiple shorter periods (for example, three terms of five years). See INTA [Model Design Law Guidelines](#), par. 10 (Term of Protection).

Article 9ter Electronic Industrial Design System

Article 9ter11: “A Contracting Party shall provide: (a) a system for electronic application; and (b) a publicly available electronic information system, which must include an online database of registered industrial designs.”

Comment: We encourage the adoption of this article. While we acknowledge that creating an electronic filing system and online database of registered industrial designs may be burdensome on developing Contracting Parties, allowing applications to be electronically filed helps applicants streamline the filing process, and providing access to published design rights allows applicants to search the records on a free-of-charge basis. See INTA [Guidelines for Examination of Industrial Designs](#), 2.1 (Pre-Application) & 2.2 (Filing).

Article 12 Relief in Respect of Time Limits

Article 12(1) & (2): “(1) [Extension of Time Limits] A Contracting Party may provide for the extension, for the period prescribed in the Regulations, of a time limit fixed by the Office for an action in a procedure before the Office, if a request to that effect is filed with the Office in accordance with the requirements prescribed in the Regulations, and the request is filed, at the option of the Contracting Party: (i) prior to the expiry of the time limit; or (ii) after the expiry of the time limit, and within the time limit prescribed in the Regulations. (2) [Continued Processing] Where an applicant or holder has failed to comply with a time limit fixed by the Office of a Contracting Party for an action in a procedure before the Office, and that Contracting Party does not provide for the extension of a time limit under paragraph (1)(ii), the Contracting Party [shall] [may] provide for continued processing with respect to the application or registration and, if necessary, reinstatement of the rights of the applicant or holder with respect to that application or registration, if: (i) a request to that effect is made to the Office in accordance with the requirements prescribed in the regulations; (ii) the request is filed, and all of the requirements for the said action, in respect of which the time limit applied, are complied with, within the time limit prescribed in the Regulations.”

Comment: It is our position that deadlines for an action in a procedure before an office should be extendable at least once, and since the consequences of missed deadlines in relation to designs can be drastic, there is a remedy for missed deadlines allowing for the reinstatement of rights. See INTA [Guidelines for Examination of Industrial Designs](#), 2.3 (Response time, extensions and remedies for missed deadlines). Therefore, we advocate for making the provision of continuing processing mandatory in Article 12(2), particularly since the provision of extensions of time is only optional under Article 12(1).

Article 13 Reinstatement of Rights After a Finding by the Office of Due Care or Unintentionality

Article 13(1): “[Reinstatement of Rights] A Contracting Party [shall] [may] provide that, where an applicant or holder has failed to comply with a time limit for an action in a procedure before the

Office, and that failure has the direct consequence of causing a loss of rights with respect to an application or a registration, the Office shall reinstate the rights of the applicant or holder with respect to that application or registration, if: (i) a request to that effect is made to the Office in accordance with the requirements prescribed in the Regulations; (ii) the request is filed, and all of the requirements for the said action, in respect of which the time limit applied, are complied with, within the time limit prescribed in the Regulations; (iii) the request states the reasons for the failure to comply with the time limit; and (iv) the Office finds that the failure to comply with the time limit occurred in spite of due care required by the circumstances having been taken or, at the option of the Contracting Party, that any delay was unintentional.”

Comment: It is our position that, since the consequences of missed deadlines in relation to designs can be drastic, there is a remedy for missed deadlines allowing for the reinstatement of rights. See INTA [Guidelines for Examination of Industrial Designs](#), par. 2.3 (Response time, extensions and remedies for missed deadlines). Therefore, we advocate making the procedure for the reinstatement of rights mandatory in Article 13.

Article 14 Correction or Addition of Priority Claim; Restoration of Priority Right

Article 14(2): “[Delayed Filing of the Subsequent Application] A Contracting Party [shall] [may] provide that, where an application (“the subsequent application”) which claims or could have claimed the priority of an earlier application has a filing date which is later than the date on which the priority period expired, but within the time limit prescribed in the Regulations, the Office shall restore the right of priority, if: (i) a request to that effect is made to the Office in accordance with the requirements prescribed in the Regulations; (ii) the request is filed within the time limit prescribed in the Regulations; (iii) the request states the reasons for the failure to comply with the priority period; and (iv) the Office finds that the failure to file the subsequent application within the priority period occurred despite due care required by the circumstances having been taken or, at the option of the Contracting Party, was unintentional.”

Comment: Applicants should be permitted to correct or add a priority claim by submitting a request within 6 months from the priority date where the failure to properly claim priority was unintentional. Where an application that could have claimed priority is filed later than the date on which priority expired, priority should be restored if a proper request is submitted within a time frame not less than 1 month from the expiry of the priority. See INTA [Model Design Law Guidelines](#), par. 20 (Correction or Addition of Priority Claim; Restoration of Priority Right). Therefore, we advocate making the procedure for restoring the right of priority mandatory in Article 14(2).

Article 14 bis Electronic Priority Document Exchange

Article 14 bis: “A Contracting Party shall provide for electronic exchange of priority documents for applications.”

Comment: We strongly encourage adopting this article, and more specifically, that Contracting Parties' offices accede to WIPO Digital Access Service (DAS), an electronic system that allows priority documents and similar documents to be securely exchanged between IP Offices. While we acknowledge that adopting this system may initially be burdensome on developing Contracting Parties, it would ultimately be beneficial for both applicants and offices, as an inexpensive way to satisfy the requirement to provide priority documents when and where required. See [INTA Guidelines for Examination of Industrial Designs](#), par. 5.2 (Convention Priority Claims).

3b. Please share your views on the draft regulations (WIPO/DLT/DC/4), particularly on those found in square brackets, or that contain alternative texts?

Proposed Rule 2(3) Details Concerning Partial Designs

Rule 2(3): "(3) [Partial Design] A Contracting Party shall permit the application to be directed to a design embodied in part of an article or a product.

Comment: We strongly encourage adopting rule 2(3). A part of a product should be registrable as a design if it otherwise meets the requirements for registration. Specifically, a part of an article or a product should be registrable if (a) only the portion sought to be protected is represented in the figure(s), or if (b) the portion sought to be protected is represented in the context of the entire product, where the unclaimed portions of the entire product are represented by the use of visual disclaimers (e.g., broken lines, blurring, color shading, or by the use of added boundaries) and described as unclaimed.

Rule 4 Details Concerning Representatives, Address for Service or Address for Correspondence

Rule 4(2): "[Time Limit Under Article 4(6)] The time limit referred to in Article 4(6) shall be not less than one month* from the date of the notification referred to in that Article where the address of the applicant, holder or other interested person is on the territory of the Contracting Party making the notification, and not less than two months from the date of the notification where such address is outside the territory of that Contracting Party".

Comment: We support Rule 4 in its entirety but propose to increase the time limits as follows: time limits to Article 4(6) to be increased up to two months from the date of the notification and not less than three months. A Contracting Party may require Power of Attorneys to be notarized, and legalized with apostille, which often takes more than a couple of months.

Rule 5 Details Concerning Filing Date

Rule 5: "The time limit referred to in Article 5(4) shall be not less than one month from the date of the notification referred to in that Article".

Comment: Article 5(4) sets the deadline by which an Applicant must complete outstanding requirements to be accorded a filing date. Like our comment above, we support Rule 5 in its entirety, however, we propose to be applicable also for Rule 1(b), as well as the deadline to be at least two months from the date of the notification.

Rule 6 Details Concerning Publication

Rule 5: “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.]”

Comment: See comments on Article 9 above.

Rule 7 Details Concerning Communications

Rule 7(1)(b): “A Contracting Party may require that the applicant, holder, or other interested person, include some, ~~or all~~, of the following contact details in any communication:

- (i) a telephone number;
- (ii) a telefacsimile number;
- (iii) an email address.”

Comment: We support Rule 7 but propose to delete the words “or all” appearing in strike-through. Providing any *one* of the above-mentioned communication means is sufficient, is consistent with the practices of almost all local PTOs, and avoids running afoul of certain jurisdictions’ (e.g., the EU) stringent privacy laws. Additionally, many applicants/holders are individuals who do not own any telefacsimile number. Requiring those applicants/holders to provide a telefacsimile number would force them to incur fees related to owning a telefacsimile number or could prejudice their rights.

Rule 10 Details Concerning Relief in Respect of Time Limit

Rule 10(1)(i): “[Requirements Under Article 12(1)] (a) A Contracting Party may require that a request referred to in Article 12(1): (i) be signed by the applicant or holder;”

Rule 10(3): “[Requirements Under Article 12(2)(i)] A Contracting Party may require that a request referred to in Article 12(2)(i): (i) be signed by the applicant or holder”.

Comment: We propose to add that the Representative can also sign the above-mentioned requests in the name of the applicant to speed up this process. Indeed, this is a necessary terminology clarification in line with local practices, to avoid different treatments when it comes to requests for extensions of deadlines. Most requests of those types are usually signed and filed by Applicant’s or Holder’s professional representatives.

Rule 11 Details Concerning Reinstatement of Rights After a Finding by the Office of Due Care or Unintentionality Under Article 13

Rule 11(1): “[Requirements Under Article 13(1)(i)] A Contracting Party may require that a request referred to in Article 13(1)(i) be signed by the applicant or holder”.

Comment: Similarly to the above, we propose to add that the Representative can also sign the above-mentioned requests in the name of the applicant to speed up this process. Indeed, this is a necessary terminology clarification in line with local practices, to avoid different treatments when it comes to requests for continuation of proceedings. Indeed, we humbly suppose almost all these requests are signed and filed by Applicant’s or Holder’s professional representatives.

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

Rule 12(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”.¹²

Rule 12(5): “[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”.

Comment: Similarly to the above, we propose to add that the Representative can also sign the above-mentioned requests in the name of the applicant to speed up these proceedings. Indeed, this is a necessary terminology clarification in line with local practices, to avoid different treatments when it comes to requests for restoration of the priority. Indeed, as above, almost all these requests are signed and filed by Applicant’s or Holder’s professional representatives.

INTA would be pleased to answer any questions that the CIPO may have and is available to discuss our recommendations in more detail.

Please contact Jenny Simmons (jsimmons@inta.org) or Erica Vaccarello (evaccarello@inta.org). Thank you in advance for considering the views of INTA.

Yours sincerely,

Etienne Sanz de Acedo

INTA CEO

International Trademark Association



About INTA

The International Trademark Association (INTA) is a global association of brand owners and professionals dedicated to supporting trademarks and complementary intellectual property (IP) to foster consumer trust, economic growth, and innovation, and committed to building a better society through brands. Members include nearly 6,500 organizations, representing more than 34,350 individuals (trademark owners, professionals, and academics) from 185 countries, who benefit from the Association's global trademark resources, policy development, education and training, and international network. Founded in 1878, INTA, a not-for-profit organization, is headquartered in New York City, with offices in Beijing, Brussels, Santiago, Singapore, and Washington, D.C. Metro Area, and a representative in New Delhi. For more information, visit inta.org.

**INTERNATIONAL TRADEMARK ASSOCIATION COMMENTS ON ISSUES IDENTIFIED DURING
INDIA'S STAKEHOLDER CONSULTATION ON THE DRAFT DESIGN LAW TREATY**

August 15, 2024

To:

Ms. Himani Pande, IAS, Additional Secretary
Department for Promotion of Industry and Internal Trade (DPIIT)
Ministry of Commerce and Industry
INDIA

Subject: Government of India's Stakeholder Consultation on the draft Design Law Treaty.

Dear Additional Secretary,

We contact you to provide our comments on the issues identified in the Agenda and discussed during the Stakeholder Consultation held on August 1, 2024, on the draft Design Law Treaty (DLT).

The following comments were prepared by INTA's Designs Committee members (Ashwani Balayan, Yashwant Grover, Nidhi Anand, Kapil Wadhwa, Anupam Trivedi), INTA Design Committee Leadership, and INTA Staff.

We hope you will find these comments helpful in the context of the analysis of the draft Design Law Treaty and we welcome the opportunity to further engage in discussions on the topic.

General Comments

As per the Agenda and Stakeholder Consultation, we provide comments with respect to:

- (1) Grace Period – Article 6;
- (2) Deferred Publication – Article 9
- (3) Time Limit Relaxations – Article 12 And 13;
- (4) Restoration Of Priority Right – Article 14;
- (5) Renewal - Article 11 Of The Treaty Read With Rule 9 Of Regulations;

- (6) Exceptions for publicly accessible Design Databases – Article 9quinquies;
- (7) Single application for multiple designs; and
- (8) International filing mechanism under Hague System.

INTA has adopted Model Design Law Guidelines ([Model Design Law Guidelines](#)) and Guidelines for Examination of Industrial Designs ([Guidelines for Examination of Industrial Designs](#)), which contain INTA's basic positions on design law and practice and also serve as a framework by which INTA analyzes the current working text of the DLT and comments on the above identified issues.

Specific Comments

AGENDA ITEM 1: GRACE PERIOD – ARTICLE 6

Section 21 of the Designs Act concerns the grace period afforded to applications following the disclosure of a design in exhibitions, contingent upon prior notification to the Controller of Designs. Is there a necessity to broaden the scope of the grace period provision to encompass disclosures of designs by creators under any circumstances, without the prerequisite of prior notification to the Controller?

Would expanding the grace period's scope in the aforesaid manner benefit Indian applicants seeking design protection?

What should be the grace period - 6 months or 12 months?

INTA supports broadening the scope of the grace period provision to encompass use or disclosures of designs by creators under any circumstances, without the prerequisite of prior notification to the Controller.

Expanding the scope of grace period will likely benefit Indian applicants in the following manner:

- (1) *Preventing inadvertent loss of rights.* An unconditional grace period, as proposed, will allow the Applicants to file for and obtain registration of designs which have been published or used, whether inadvertently or otherwise, by the creator / applicant within the grace period.
- (2) *Enabling applicants to test commercial viability of designs before filing.* Applicants can utilise the grace period to their advantage by first gauging the commercial viability of a design before deciding to file design application. If the design / article meets commercial success, it will give the Applicant an impetus to file for design application within grace period. Currently, this is not possible since the design rights are lost as soon as the design is published / used without an application being filed in advance.
- (3) *Harmonization.* Removing current procedural administrative requirements for availing limited grace period would align with filing practices and procedures in many other jurisdictions such as the EU and the U.S.

INTA also supports a 12-month grace period that allows registration of a design within 12 months of an initial use or disclosure of the design by the proprietor or as a result of information obtained from the proprietor. Many jurisdictions such as U.S., European Union, UK, Japan, Canada and South

Korea allow a 12-month grace period for designs. A harmonized grace period of 12 months will assist designers, and particularly individual designers and SMEs in strategizing their launch and preventing inadvertent loss of rights. A 12-month grace period may also potentially increase the number of design filings in India by the Applicants from foreign jurisdictions which have similar grace periods.

Accordingly, INTA supports the provision of grace period under Article 6⁷ of the basic proposal of DLT (dated May 10, 2024).

AGENDA ITEM 2: DEFERRED PUBLICATION – ARTICLE 9

Whether there is a need for deferred publication of design registration at the option of the Applicant? If yes, for how much time should it be deferred?

How would the option of deferred publication impact the interests of domestic applicants?

INTA supports deferment of publication of design registration at the instance of the Applicant. It should be possible to defer publication of a design application for a period of not less than 12 months from the date of application.

Design applications are often desired to be filed at the prototype stage of an article, and designers often wish to retain secrecy of their designs until the product is ready to launch. The existence of varying grace periods (or none) in different jurisdictions requires provisions allowing secrecy of a design, for at least 12 months (while many jurisdictions already provide more than this).

Deferment of publication will be advantageous to the applicants, including domestic applicants and designers, by enabling them to: (1) maintain secrecy of the applied design; (2) optimize the production process of design; (3) prevent the published design from acting as prior art for any underlying inventions; (4) and strategizing the filing of applications for the same design in other jurisdictions. Without an option for deferment of publication, domestic proprietors are deprived of the above advantages that may be available to proprietors / applicants outside India. For instance, the maximum period of formal deferment is 30 months in the EU, 3 years in China, and 12 months in several countries like UK. An option for deferment of publication would also help in improving the Ease of Doing Business in India, as it would help in harmonization and uniformity of Indian design laws with design laws in other jurisdictions, thereby streamlining the design registration strategy for a company operating in multiple jurisdictions alongside India.

A request for deferment, if desired, should be made in the application. The applicant may be required to pay a fee for deferment of publication along with the application. Payment of the publication fee should be optional at the filing stage. An application for publication should be filed and payment of the publication fee made at a time of the applicant's choosing before the end of the deferment period in order for the design to be published. Claiming priority from an earlier design application should not change the available term of deferment of publication of the design filed. In the case of a multiple design application, a request for deferment of publication should be permitted to concern only some of the designs of the multiple design application.

AGENDA ITEM 3: TIME LIMIT RELAXATIONS – ARTICLE 12 AND 13

Whether there should be time limit relaxations as provided under Article 12 and 13? Would it benefit Indian applicants? Are there any apprehensions regarding the inclusion of Article 12 and 13 as mandatory provisions in the final Treaty text, if India accepts them and implements corresponding relaxations in domestic law to comply with the Treaty?

INTA supports time limit relaxations as provided under Article 12 and 13 of DLT. It is recommended that deadlines should be extendible at least once. Since the consequences of missed deadlines in relation to designs can be drastic, we recommend the provision of a (limited time) remedy for missed deadlines, such as “continuation of proceedings”, upon payment of a fee.

Time relaxations and extensions will certainly benefit Indian Applicants, as they prevent undue and inadvertent loss of rights (caused by missed deadlines). Even as per the recent Patents (Amendment) Rules, 2024 in India, the time specified for doing any act or taking any proceeding can be extended and delay may be condoned by the Controller for a period of up to six months. Provision for general extension of time and condonation of delay for design proceedings will also be helpful for domestic applicants.

INTA suggests that India support inclusion of Article 12 and 13 as mandatory provisions in the final Treaty text and implementation of corresponding relaxations in domestic law to comply with the Treaty. INTA also advocates for making the provision of continuing processing mandatory in Article 12(2), particularly since the provision of extensions of time is only optional under Article 12(1).

AGENDA ITEM 4: RESTORATION OF PRIORITY RIGHT – ARTICLE 14

Whether the applicants should be given the option to make a priority claim after the expiry of the priority period? What benefits or concerns to Indian businesses do you perceive if such an option is given to applicants?

INTA supports the provision for an option to make priority claim after the expiry of the priority period. Since failure to properly claim priority may result in a loss of right or a lapse in the protection of an industrial design, relief measures should exist such that an applicant may cure the unintentional lapse in priority.

Applicants should be permitted to correct or add a priority claim by submitting a request within 6 months from the priority date where the failure to properly claim priority was unintentional. Where an application that could have claimed priority is filed later than the date on which priority expired, priority should be restored if a proper request is submitted within a time frame not less than 1 month from the expiry of the priority.

Restoration of priority claim would encourage design filings in India. This may improve new business/products being entered into India which may increase collaborations between businesses and create more opportunities for Indian businesses. This will also prevent undue and unintentional loss of rights.

AGENDA ITEM 5: RENEWAL [ARTICLE 11 OF THE TREATY READ WITH RULE 9 OF REGULATIONS]

Should applicants be allowed the option to file for renewal up to six months after the initial 10-year term of protection expires? Are there any concerns regarding a provision that permits renewal applications both six months before the end of the protection term and up to six months after its expiration, if an additional six-month restoration period is provided to reinstate the design registration following its lapse?

Yes, applicants should be allowed the option to file for renewal within up to six months after the expiry of the initial 10-year term of protection. The request for renewal within 6 months after expiry of the 10-year term should not require any additional compliance or requirement such as statement of reasoning / evidence for delay in filing the renewal. It should be clarified that there will be no loss or gap in rights in the design during the 6 months (after the expiry of 10 years) if the renewal is paid within the period.

In turn, the period of restoration as provided under Section 12 of The Designs Act, 2000 i.e. within one year from the date on which the design ceased to have effect, may be reduced to six months to harmonize the provisions of the Act.

It would be advantageous for the applicant to avoid loss of rights due to an administrative lapse.

AGENDA ITEM 6: Exceptions for publicly accessible Design Databases – Article 9quinquies

Are there any concerns associated with the requirement of including designs incorporating traditional knowledge or traditional cultural expressions in a publicly accessible database of registered designs, with the prior permission of the IPLC owners?

No substantive comments or observations are provided regarding the disclosure of the origin or source of traditional cultural expressions, traditional knowledge or biological/genetic resources utilized or incorporated in designs other than this concern: if a contracting party mandates this disclosure as a requirement in its jurisdiction, applicants would encounter additional hurdle in obtaining design rights, which is counter to the purposes of implementing the DLT. However, to the extent that such disclosures are considered for inclusion in the DLT, see, e.g., DLT Article 3(1)(ix), we would advocate that the scope of disclosure be clearly defined and that the requirements for the disclosure not be unduly burdensome. Applicants should be provided with a reasonable and extendable period of time to comply with such disclosure requirements, in accordance with INTA Guidelines for Examination of Industrial Designs 2.3 (Response time, extensions and remedies for missed deadlines).

AGENDA ITEM 7: SINGLE APPLICATION FOR MULTIPLE DESIGNS

What are the advantages and disadvantages of providing the option to Applicants to file for multiple designs under the single applications [1) multiple designs in the same class or 2) multiple designs in different classes or 3) same design in different classes], provided an option of divisional application is provided on the lines of Article 8 of the Treaty?

INTA recommends that applications for multiple designs should be able to be included in a single application even if the designs look different and even if the Locarno classes of each design are different. The applicant should be able to divide the application into multiple applications at the Office's request and maintain the original filing date. INTA considers that substantial cost and administrative savings can be made to users through the filing of multiple designs in a single application ("multiple application") and therefore recommends that filing of such multiple applications be allowed even if the designs will be individually examined and granted. This has the potential to decrease the administrative burden and costs for applicants, such as the ability to file a single Power of Attorney or Assignment of all designs in the same application. INTA further recommends that designs within such multiple application need not be in the same class. Accordingly, INTA supports inclusion of multiple designs in a single application in all 3 situations envisaged under Agenda Item 7.

INTA supports Article 3(3) of DLT only in conjunction with the procedures guaranteed by Article 8, as a safeguard against conditions prescribed under the applicable law of contracting parties. Accordingly, INTA supports inclusion of provisions under Article 8 of DLT, particularly the provision of division of a design application which is currently not available in India. Currently, owing to lack of an option to divide a design application, the applicants are losing rights in those designs which are required to be deleted from the designs application during prosecution to meet the restriction objection.

AGENDA ITEM 8: INTERNATIONAL FILING MECHANISM UNDER HAGUE SYSTEM

What are the potential advantages and disadvantages for Indian applicants seeking design protection and also our domestic businesses in general, if India joins the Hague System, thereby allowing the applicants to file for design protection in multiple countries through a single international application?

India has recently acceded to the Locarno Classification under Locarno Agreement. Further, India is already a party to both the Patent Cooperation Treaty and Madrid Protocol. INTA recommends that India also accedes to the Hague System concerning the International Registration of Industrial Designs (the Hague Agreement).

Key benefits of India's accession to the Hague System include:

1. **Enhanced Global Protection:** Accession to the Hague Agreement will enable Indian applicants to secure protection for up to 100 designs (within the same class) across 94 countries through a single application. This streamlined process will significantly reduce the complexity and cost associated with obtaining design registrations in multiple jurisdictions.

2. **Increased Foreign Filings:** Foreign applicants will find it easier to file industrial design applications in India by simply designating India in their international applications. This is expected to lead to a substantial increase in the number of design filings from foreign entities in India.
3. **Boost to Design Filings:** The overall number of design filings in India is anticipated to rise, thereby strengthening India's integration into the global intellectual property ecosystem.
4. **Minimal Legislative Impact:** Accession to the Hague System will primarily necessitate amendments to procedural laws, as the substantive aspects of protection remain under the purview of domestic legislation of each Contracting Party. This means that the substantive law governing the examination, appeals, or cancellation of industrial designs in India will remain unaffected.
5. **Procedural Flexibility:** The Geneva Act of the Hague Agreement offers considerable flexibility to Contracting Parties, allowing them to submit Declarations (under Article 30) to ensure compliance with their national laws.
6. **Enhanced Design Enforcement:** The Hague System permits the inclusion of surface shading, dotted lines, dashed lines, and similar features, which can facilitate robust enforcement of registered designs.
7. **Alignment with Leading IP Jurisdictions:** By joining the Hague Agreement, India will align itself with several prominent IP jurisdictions, including the US, EU, UK, Japan, China, Brazil, and South Korea. This alignment is expected to bring significant benefits to India's IP landscape.

In light of these compelling advantages, INTA encourages India to accede to the Hague System.

We invite you to read INTA's 2021 paper "The Hague Agreement Concerning the International Registration of Industrial Designs", available [here](#).

INTA would be pleased to answer any questions that the Ministry of Commerce and Industry may have and is available to discuss our recommendations in more detail. Please contact Gauri Kumar, Senior Consultant, India and South Asia (gkumar.consultant@inta.org) or Erica Vaccarello, Senior Advisor, External Relations (evaccarello@inta.org).

Thank you in advance for considering the views of INTA.

Yours sincerely,



Gauri Kumar
Senior Consultant, India and South Asia
International Trademark Association

About INTA

The International Trademark Association (INTA) is a global association of brand owners and professionals dedicated to supporting trademarks and complementary intellectual property (IP) to foster consumer trust, economic growth, and innovation, and committed to building a better society through brands. Members include nearly 6,500 organizations, representing more than 34,350 individuals (trademark owners, professionals, and academics) from 185 countries, who benefit from the Association's global trademark resources, policy development, education and training, and international network. Founded in 1878, INTA, a not-for-profit organization, is headquartered in New York City, with offices in Beijing, Brussels, Santiago, Singapore, and Washington, D.C., and a representative in New Delhi. For more information, visit www.inta.org.

**INTERNATIONAL TRADEMARK ASSOCIATION COMMENTS ON
USPTO’s Notice and Request for Comments on the WIPO Diplomatic Conference on the
Design Law Treaty**

The International Trademark Association (INTA) would like to thank the United States Patent and Trademark Office (USPTO) for the opportunity to provide comments in response to the USPTO’s notice and request for comments on the WIPO Diplomatic Conference on the Design Law Treaty, 89 Federal Register 60, 21242-44, March 27, 2024 (the “Notice”).

The following comments were prepared by INTA’s Designs Committee and staff.

We hope you will find these comments helpful in view of the diplomatic conference to finalize the DLT and we welcome the opportunity to further engage in discussions on the topic.

The International Trademark Association (INTA) is a global association of brand owners and professionals dedicated to supporting trademarks and complementary intellectual property (IP) to foster consumer trust, economic growth, and innovation, and committed to building a better society through brands. Members include nearly 6,500 organizations, representing more than 34,350 individuals (trademark owners, professionals, and academics) from 185 countries, who benefit from the Association’s global trademark resources, policy development, education and training, and international network. Founded in 1878, INTA, a not-for-profit organization, is headquartered in New York City, with offices in Beijing, Brussels, Santiago, Singapore, and Washington, D.C., and a representative in New Delhi. For more information, visit inta.org.

GENERAL COMMENTS

The Notice requests comments concerning: (I) observations and experiences with filing for design protection outside of the United States; (II) observations and experiences with filing for design protection in a jurisdiction that requires disclosure related to genetic resources, traditional knowledge, or traditional cultural expressions; and (III) the current working text of the Design Law Treaty (DLT) including (a) the “substantive articles,” Articles 1-23 as set forth on pages 3-22 of Annex I to document WIPO/SCTS3/9, (b) the “administrative provisions and final clauses,” Articles 24-32 as set forth on pages 2-6 of the Annex to document WIPO/DLT/2/PM6, and (c) the “draft regulations,” Rules 1-17 as set forth on pages 2-14 of Annex II to document WIPO/SCTS3/9, as well as any additional issues in relation to formalities for designs that should be considered for inclusion in the DLT.

INTA has adopted Model Design Law Guidelines ([Model Design Law Guidelines \(inta.org\)](http://inta.org)) and Guidelines for Examination of Industrial Designs ([Guidelines for Examination of Industrial Designs \(inta.org\)](http://inta.org)), which contain INTA’s basic positions on design law and practice and serve as a framework by which INTA analyzes the current working text of the DLT and comments on certain questions raised in the Notice.

INTA notes that the word/terminology “design” used in this document equally refers to “industrial designs;” both terms have the same meaning and are intended as synonyms.

SPECIFIC COMMENTS

SECTION I—OBSERVATIONS AND EXPERIENCES WITH FILING FOR DESIGN PROTECTION OUTSIDE OF THE UNITED STATES.

1. Please discuss any experiences with filing for industrial design protection outside of the United States, and to the extent possible, please: (a) identify the jurisdiction(s); (b) describe the specific formalities requirements in these jurisdictions; and (c) describe any experiences associated with satisfying the specific formalities requirements in these jurisdictions.

INTA praises the adoption of WIPO Digital Access Service (DAS), an electronic system allowing participating intellectual property (IP) offices to exchange priority and similar documents securely. However, the WIPO DAS is only available to 29 offices, with 26 participating only as a depositing office. See Estoesta *et al.*, INTA Feature article titled “[The Hague Design System Is Undoubtedly Useful, but National Formalities Still Exist](https://www.wipo.int/en/web/das/participating_offices/search-results?optionId=2391&territoryId=undefined),” published last January 25, 2023, https://www.wipo.int/en/web/das/participating_offices/search-results?optionId=2391&territoryId=undefined. Important jurisdictions missing from WIPO DAS include the UK, Switzerland, Taiwan, and Hong Kong. Additionally, some offices, like Mexico, separately require submitting a translated priority document. See *id.* Further, in Mexico, failing to submit the priority document and its Spanish translation within the specified time limit jeopardizes priority rights without the possibility of reinstatement.

2. Please identify any particular challenges encountered in relation to requirements across jurisdictions when pursuing protection for an industrial design in multiple jurisdictions.

Members of the INTA Designs Committee surveyed several jurisdictions in 2022 on various formalities requirements and summarized those requirements in “The Hague Design System Is Undoubtedly Useful, but National Formalities Still Exist.” See *id.* Many of the national formalities discussed in that article continue to pose challenges to applicants who pursue protection for an industrial design in multiple jurisdictions, and a sampling of those formalities is discussed in further detail below.

Lack of Harmonized Grace Period. Although most jurisdictions (e.g., the U.S., Mexico, Canada, the EU, UK, South Korea, and Japan) recognize a 12-month grace period for public disclosures made with or without the applicant’s consent, many jurisdictions do not. For example, China, India, Brazil, and Singapore recognize a 6-month grace period, which is available only for disclosures in certain situations. China’s grace period, for example, applies only to disclosures by the applicant “at a national emergency for public interest,” “at an international exhibition sponsored or recognized by the Chinese Government,” “at a prescribed academic or technological meeting,” or “certain

disclosures of the invention obtained by a third party from the applicant or the inventor.” See “Patent Law of the People’s Republic of China,” 2021, Article 24, <https://www.wipo.int/wipolex/en/legislation/details/21027>. India’s grace period is similarly limited to disclosures at an exhibition sanctioned by Section 21 of The Designs Act, 2000. See The Designs Act, 2000, https://www.jpo.go.jp/e/system/laws/gaikoku/document/index/india-e_designs_act.pdf and Manual Of Designs Practice & Procedure, 04.03.02.01, https://ipindia.gov.in/writereaddata/Portal/IPOGuidelinesManuals/1_30_1_manual-designs-practice-and-procedure.pdf.

Additionally, each jurisdiction has different formalities that an applicant must follow to take advantage of the jurisdiction’s available grace period. While some jurisdictions (e.g., the EU, Mexico, the UK, and the United States) have no formal requirements to take advantage of the grace period, some jurisdictions require the applicant to submit a declaration and/or supporting evidence detailing the nature of the disclosure. These jurisdictions include, for example, India, China, Japan, and South Korea. See, e.g., The Designs Act, 2000; Manual Of Designs Practice & Procedure, 04.03.02.01; and Rule 33 of the new Implementing Regulations of China Patent Law, <https://www.wipo.int/wipolex/en/legislation/details/6504>.

Further, the timing of when to fulfill the formal requirements varies by jurisdiction. In China, Japan, and South Korea, this documentation may be submitted with the IDA, or after the IDA is filed through a local representative, within varying periods. See WIPO, “Guide to the Hague System: International Registration of Designs Under the Hague Agreement,” p. 64, <https://www.wipo.int/export/sites/www/hague/en/docs/hague-system-guide.pdf>.

Lack of Harmonized Drawing Requirements - Number and Types of Views. Certain jurisdictions, like the United Kingdom and the European Union, accept a single view of the claimed design and impose limits on the maximum number of views allowable (e.g., the UK allows for up to twelve views, while the EU allows for up to seven views). See <https://www.gov.uk/register-a-design/prepare-your-application> and <https://guidelines.euipo.europa.eu/1934976/1926312/designs-guidelines/5-1-number-of-views>. However, other jurisdictions allow for an unlimited number of views and might not consider a single view of certain three-dimensional designs to disclose the claimed design sufficiently (e.g., the United States). Still, other jurisdictions (e.g., South Korea, China, and Vietnam) require specific numbers and types of views, such as perspective views. See Estoesta *et al.*

This lack of harmonization is not limited to three-dimensional designs. Many jurisdictions require different types of views for two-dimensional designs like graphical user interface (GUI) and computer icons (together referred to as computer-generated designs). For example, the EU, UK, Japan, and South Korea do not require visual representations to show a device on which a computer-generated design may be displayed, while the United States and Mexico require representations to show a display screen, though it may be drawn in broken lines and unclaimed. See *id.*

Lack of Harmonized Drawing Requirements - Drafting Conventions. “Some jurisdictions prohibit representations including discontinuous shadow lines intended to show contour (e.g., China), while

others encourage their inclusion (e.g., Japan), and still others (e.g., the United States) require their inclusion for certain 3D designs.” *Id.*

Lack of Harmonized Deferment of Publication Option. “[N]ot all jurisdictions allow deferred publication, and those that do provide differing maximum deferment periods. For example, the maximum period for formal deferment is 30 months (measured from the application filing date or the earliest claimed priority date, if any) in the EU, three years in China, and 12 months in Denmark, Finland, Israel, Norway, and the UK. Still other jurisdictions, like Mexico, Turkey, and the United States, do not permit deferred publication at all (although U.S. design applications do not publish before issuance as a U.S. design patent).” *Id.*

SECTION II—OBSERVATIONS AND EXPERIENCES WITH FILING FOR DESIGN PROTECTION IN A JURISDICTION THAT REQUIRES DISCLOSURE RELATED TO GENETIC RESOURCES, TRADITIONAL KNOWLEDGE, OR TRADITIONAL CULTURAL EXPRESSIONS.

No substantive comments or observations are provided regarding the disclosure of the origin or source of traditional cultural expressions, traditional knowledge or biological/genetic resources utilized or incorporated in designs other than this concern: if a contracting party mandates this disclosure as a requirement in its jurisdiction, applicants would encounter additional hurdle to obtaining design rights, which is counter to the purposes of implementing the DLT. However, to the extent that such disclosures are considered for inclusion in the DLT, see, e.g., DLT Article 3(1)(ix), we would advocate that the scope of disclosure be clearly defined and that the requirements for the disclosure not be unduly burdensome. Applicants should be provided with a reasonable and extendable period of time to comply with such disclosure requirements, in accordance with INTA Guidelines for Examination of Industrial Designs 2.3 (Response time, extensions and remedies for missed deadlines).

SECTION III(A)—COMMENTS REGARDING THE WORKING TEXT OF ARTICLES 1-23.

Article 3 Application; Article 8 Amendment or Division of Application Including More Than One Industrial Design

Article 3(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.”

Article 8: “(1) [Amendment or Division of Application] If an application that includes more than one industrial design (hereinafter “initial application”) does not comply with the conditions prescribed by the Contracting Party concerned in accordance with Article 3(3), the Office may require the applicant, at the option of the applicant, to either: (i) amend the initial application to comply with those conditions; or (ii) divide the initial application into two or more applications (hereinafter “divisional applications”) that comply with those conditions by distributing among the latter the industrial designs for which protection was claimed in the initial application. (2) [Filing Date and Right of Priority of Divisional Applications] Divisional applications shall preserve the filing date of the initial application and the benefit of the claim of priority, if applicable. (3) [Fees] The division of an application may be subject to the payment of fees.”

Comment: It is our position that a single application should be able to include multiple designs, even if the designs look different and even if the Locarno classes of each design are different, and that the applicant should be able to divide the application into multiple applications at the office's request and maintain the original filing date and the benefit of the claim of priority date. See INTA Model Design Law Guideline, par. 4 (Multiple design applications); see also INTA Guidelines for Examination of Industrial Designs 2.2 (Filing). Therefore, we support Article 3(3) only in conjunction with the procedures guaranteed by Article 8, as a safeguard against conditions which may be prescribed under the applicable law of contracting parties.

Article 5 Filing Date

Article 5(1)(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; [(v) any further indication or element as prescribed under the applicable law]."

Comment: We do not object to the minimum requirements (i)-(iv) for obtaining an application filing date. See INTA Model Design Law Guideline, par. 13 (Requirements for Registration). However, we oppose requirement (v) in that it allows a contracting party to mandate, without limit, additional application filing requirements, which is likely to lead to significant differences across jurisdictions, contrary to the DLT's intended purpose to harmonize and streamline international design law and practice. The proposed requirement (v) would also inherently conflict with Article (5)(2) ("Permitted Additional Requirements"). Therefore, we advocate striking requirement (v) from the text.

Article 6 Grace Period for Filing in Case of Disclosure

Article 6⁷: "A public 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 eligibility for the registration novelty and/or originality, as the case may be, of the industrial design, where ~~if~~ 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."

Comment: This proposal was made at the SCT/S3 by the United States, supported by the delegations of Australia, Canada, Republic of Moldova, Switzerland, Ukraine and United Kingdom, and not supported by the delegations of China, India, Nigeria and the Russian Federation.

INTA recommends a 12-month grace period that allows registration of a design within 12 months of an initial disclosure of the design by the proprietor or as a result of information

obtained from the proprietor including as a result of an abuse. See INTA Model Design Law Guideline, par. 9 (Grace Period). A harmonized grace period of 12 months assists designers, particularly individual designers and small entities, by avoiding inadvertent loss of rights.

Accordingly, we support the proposal by the United States prescribing a broad 12-month grace period. We further agree with the change from “novelty and/or originality” to “eligibility for the registration” in view of the different terms of art under the applicable law of contracting parties.

We oppose limiting the grace period to only certain acts or circumstances as set forth in Article 6(2) proposed by the delegation of China and Article 6⁶ proposed by the delegation of India.

Article 9 Publication of the Industrial Design

Article 9: “(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...”

Comment: It is necessary sometimes for the applicant to request to maintain the design unpublished for confidentiality or other purposes. As discussed in Section I (2) above, there is significant disagreement among countries regarding the issue of deferment of publication.

Industrial Property Offices should permit the deferment of publication of the design, if the applicant elects to do so. The permitted deferment period should be up to 30 months after the date of application. A request for deferment, if desired, should be made in the application. The applicant may be required to pay a fee for deferment of publication along with the application. Payment of the publication fee should be optional at the filing stage. An application for publication should be filed and payment of the publication fee made at a time of the applicant’s choosing before the end of the deferment period in order for the design to be published. Claiming priority from an earlier design application should not change the available term of deferment of publication of the design filed. In the case of a multiple design application, a request for deferment of publication should be permitted to concern only some of the designs of the multiple design application.

Article 9bis Term of Protection

Article 9bis⁸: “A Contracting Party shall provide a term of protection for industrial designs of at least 15 years from either: (a) the filing date, or (b) the date of grant or registration.”

Article 9bis¹⁰: “Contracting Parties shall have the option to comply with Article 17 of the Hague Convention or Article 26 of the TRIPS Agreement.”

Comment: Article 9bis⁸ was proposed at the SCT/S3 by the United States, supported by the delegations of Canada, Japan, Republic of Korea, Switzerland and the United Kingdom, and

not supported by the delegations of Brazil, China, Colombia, Ecuador, Ghana, on behalf of the African Group, Iran (Islamic Republic of), Niger, Nigeria, Peru, Russian Federation, South Africa. Article 9bis¹⁰ was proposed at the SCT/S3 by Nigeria, supported by the delegations of Brazil, Kyrgyzstan, Mauritania, Niger, Uganda, Yemen, Zambia and Zimbabwe, and not supported by the delegations of the United Kingdom and the United States.

We support the Article 9bis⁸ proposal of a term of protection of at least 15 years, which is consistent with the Hague System for the International Registration of Industrial Designs. The term may be made up of renewals after multiple shorter periods (for example, three terms of five years). See INTA Model Design Law Guideline 10, par. 10 (Term of Protection)

Article 9ter Electronic Industrial Design System

Article 9ter¹¹: “A Contracting Party shall provide: (a) a system for electronic application; and (b) a publicly available electronic information system, which must include an online database of registered industrial designs.”

Comment: We encourage the adoption of this article. While we acknowledge that creating an electronic filing system and online database of registered industrial designs may be burdensome on developing Contracting Parties, allowing applications to be electronically filed helps applicants streamline the filing process, and providing access to published design rights allows applicants to search the records on a free-of-charge basis. See INTA Guidelines for Examination of Industrial Designs, 2.1 (Pre-Application) & 2.2 (Filing).

Article 12 Relief in Respect of Time Limits

Article 12(1) & (2): “(1) [Extension of Time Limits] A Contracting Party may provide for the extension, for the period prescribed in the Regulations, of a time limit fixed by the Office for an action in a procedure before the Office, if a request to that effect is filed with the Office in accordance with the requirements prescribed in the Regulations, and the request is filed, at the option of the Contracting Party: (i) prior to the expiry of the time limit; or (ii) after the expiry of the time limit, and within the time limit prescribed in the Regulations. (2) [Continued Processing] Where an applicant or holder has failed to comply with a time limit fixed by the Office of a Contracting Party for an action in a procedure before the Office, and that Contracting Party does not provide for the extension of a time limit under paragraph (1)(ii), the Contracting Party [shall] [may] provide for continued processing with respect to the application or registration and, if necessary, reinstatement of the rights of the applicant or holder with respect to that application or registration, if: (i) a request to that effect is made to the Office in accordance with the requirements prescribed in the Regulations; (ii) the request is filed, and all of the requirements for the said action, in respect of which the time limit applied, are complied with, within the time limit prescribed in the Regulations.”

Comment: It is our position that deadlines for an action in a procedure before an office should be extendable at least once, and in view of the fact that the consequences of missed deadlines in relation to designs can be drastic, there is a remedy for missed deadlines allowing for the reinstatement of rights. See INTA Guidelines for Examination of Industrial

Designs, 2.3 (Response time, extensions and remedies for missed deadlines). Therefore, we advocate for making the provision of continuing processing mandatory in Article 12(2), particularly since the provision of extensions of time is only optional under Article 12(1).

Article 13 Reinstatement of Rights After a Finding by the Office of Due Care or Unintentionality

Article 13(1): “[Reinstatement of Rights] A Contracting Party [shall] [may] provide that, where an applicant or holder has failed to comply with a time limit for an action in a procedure before the Office, and that failure has the direct consequence of causing a loss of rights with respect to an application or a registration, the Office shall reinstate the rights of the applicant or holder with respect to that application or registration, if: (i) a request to that effect is made to the Office in accordance with the requirements prescribed in the Regulations; (ii) the request is filed, and all of the requirements for the said action, in respect of which the time limit applied, are complied with, within the time limit prescribed in the Regulations; (iii) the request states the reasons for the failure to comply with the time limit; and (iv) the Office finds that the failure to comply with the time limit occurred in spite of due care required by the circumstances having been taken or, at the option of the Contracting Party, that any delay was unintentional.”

Comment: It is our position that, in view of the fact that the consequences of missed deadlines in relation to designs can be drastic, there is a remedy for missed deadlines allowing for the reinstatement of rights. See INTA Guidelines for Examination of Industrial Designs 2.3 (Response time, extensions and remedies for missed deadlines). Therefore, we advocate making the procedure for the reinstatement of rights mandatory in Article 13.

Article 14 Correction or Addition of Priority Claim; Restoration of Priority Right

Article 14(2): “[Delayed Filing of the Subsequent Application] A Contracting Party [shall] [may] provide that, where an application (“the subsequent application”) which claims or could have claimed the priority of an earlier application has a filing date which is later than the date on which the priority period expired, but within the time limit prescribed in the Regulations, the Office shall restore the right of priority, if: (i) a request to that effect is made to the Office in accordance with the requirements prescribed in the Regulations; (ii) the request is filed within the time limit prescribed in the Regulations; (iii) the request states the reasons for the failure to comply with the priority period; and (iv) the Office finds that the failure to file the subsequent application within the priority period occurred despite due care required by the circumstances having been taken or, at the option of the Contracting Party, was unintentional.”

Comment: Applicants should be permitted to correct or add a priority claim by submitting a request within 6 months from the priority date where the failure to properly claim priority was unintentional. Where an application that could have claimed priority is filed later than the date on which priority expired, priority should be restored if a proper request is submitted within a time frame not less than 1 month from the expiry of the priority. See INTA Model Design Law Guidelines, par. 20 (Correction or Addition of Priority Claim; Restoration of Priority Right).

Therefore, we advocate making the procedure for restoring the right of priority mandatory in Article 14(2).

Article 14 bis Electronic Priority Document Exchange

Article 14 bis: “A Contracting Party shall provide for electronic exchange of priority documents for applications.”

Comment: We strongly encourage adopting this article, and more specifically, that Contracting Parties’ offices accede to WIPO Digital Access Service (DAS), an electronic system that allows priority documents and similar documents to be securely exchanged between IP Offices. While we acknowledge that adopting this system may initially be burdensome on developing Contracting Parties, it would ultimately be beneficial for both applicants and offices, as an inexpensive way to satisfy the requirement to provide priority documents when and where required. See INTA Guidelines for Examination of Industrial Designs, par. 5.2 (Convention Priority Claims).

[INTA does not comment on Section III(B).]

SECTION III(C)—COMMENTS REGARDING THE WORKING TEXT OF THE REGULATIONS.

Rule 2 Details Concerning the Application

Rule 2(1)(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;

Option A: a disclosure of the origin or source of traditional cultural expressions, traditional knowledge or biological/genetic resources utilized or incorporated in the industrial design;

Option B: 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]”.

Comment: We support rule 2 and, for the sake of clarity, support the proposal to move option A and B from Article 3(1)(a)(ix) to Rule 2(1) as proposed by the Delegation of United States of America and supported by the Delegation of the United Kingdom.

Proposed Rule 2(3) Details Concerning Partial Designs

Rule 2(3): “(3) [Partial Design] A Contracting Party shall permit the application to be directed to a design embodied in part of an article or a product.

Comment: We strongly encourage adopting rule 2(3).

A part of a product should be registrable as a design provided that it otherwise meets the requirements for registration. Specifically, a part of an article or a product should be registrable if (a) only the portion sought to be protected is represented in the figure(s), or if (b) the portion sought to be protected is represented in the context of the entire product, where the unclaimed portions of the entire product are represented by the use of visual disclaimers (e.g., broken lines, blurring, color shading, or by the use of added boundaries) and described as unclaimed.

Rule 4 Details Concerning Representatives, Address for Service or Address for Correspondence

Rule 4(2): “[Time Limit Under Article 4(6)] The time limit referred to in Article 4(6) shall be not less than one month* from the date of the notification referred to in that Article where the address of the applicant, holder or other interested person is on the territory of the Contracting Party making the notification, and not less than two months from the date of the notification where such address is outside the territory of that Contracting Party”.

Comment: We support Rule 4 in its entirety but propose to increase the time limits as follows: time limits to Article 4(6) to be increased up to two months from the date of the notification and not less than three months. A Contracting Party may require Power of Attorneys to be notarized, and legalized with apostille, which often takes more than a couple of months.

Rule 5 Details Concerning Filing Date

Rule 5: “The time limit referred to in Article 5(4) shall be not less than one month from the date of the notification referred to in that Article”.

Comment: Article 5(4) sets the deadline by which an Applicant must complete outstanding requirements to be accorded a filing date. Similar to our comment above, we support Rule 5 in its entirety, however, we propose to be applicable also for Rule 1(b), as well as the deadline to be at least two months from the date of the notification.

Rule 6 Details Concerning Publication

Rule 5: “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.]”

Comment: See comments on Article 9 in Section III(A), above.

Rule 7 Details Concerning Communications

Rule 7(1)(b): “A Contracting Party may require that the applicant, holder, or other interested person, include some, ~~or all~~, of the following contact details in any communication:

- (i) a telephone number;
- (ii) a telefacsimile number;
- (iii) an email address.”

Comment: We support Rule 7 but propose to delete the words “or all” appearing in strike-through. Providing any *one* of the above-mentioned communication means is sufficient, is consistent with the practices of almost all local PTOs, and avoids running afoul of certain jurisdictions’ (e.g., the EU) stringent privacy laws. Additionally, many applicants/holders are individuals who do not own any telefacsimile number. Requiring those applicants/holders to provide a telefacsimile number would force them to incur fees related to owning a telefacsimile number or could prejudice their rights.

Rule 10 Details Concerning Relief in Respect of Time Limit

Rule 10(1)(i): “[Requirements Under Article 12(1)] (a) A Contracting Party may require that a request referred to in Article 12(1): (i) be signed by the applicant or holder;”

Rule 10(3): “[Requirements Under Article 12(2)(i)] A Contracting Party may require that a request referred to in Article 12(2)(i): (i) be signed by the applicant or holder”.

Comment: We propose to add that the Representative can also sign the above-mentioned requests in the name of the applicant to speed up this process. Indeed, this is a necessary terminology clarification in line with local practices, to avoid different treatments when it comes to requests for extensions of deadlines. Most requests of those types are usually indeed signed and filed by Applicant’s or Holder’s professional representatives.

Rule 11 Details Concerning Reinstatement of Rights After a Finding by the Office of Due Care or Unintentionality Under Article 13

Rule 11(1): “[Requirements Under Article 13(1)(i)] A Contracting Party may require that a request referred to in Article 13(1)(i) be signed by the applicant or holder”.

Comment: Similarly to the above, we propose to add that the Representative can also sign the above-mentioned requests in the name of the applicant to speed up this process. Indeed, this is a necessary terminology clarification in line with local practices, to avoid different treatments when it comes to requests for continuation of proceedings. Indeed, we humbly suppose almost all these requests are signed and filed by Applicant’s or Holder’s professional representatives.

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

Rule 12(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”.

Rule 12(5): “[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”.

Comment: Similarly to the above, we propose to add that the Representative can also sign the above-mentioned requests in the name of the applicant to speed up these proceedings. Indeed, this is a necessary terminology clarification in line with local practices, to avoid different treatments when it comes to requests for restoration of the priority. Indeed, as above, almost all these requests are signed and filed by Applicant’s or Holder’s professional representatives.

INTA would be pleased to answer any questions that the USPTO may have and is available to discuss our recommendations in more detail. Please contact Jenny Simmons (jsimmons@inta.org) or Erica Vaccarello (evaccarello@inta.org).

Thank you in advance for considering the views of INTA.

Yours sincerely,



Etienne Sanz de Acedo
INTA CEO
International Trademark Association



The

Design Law Treaty

**Continued Steps Toward
Worldwide Harmonized
Industrial Design Protection**

David
Gerk



Principal Counsel,
Director for Patent Policy,
Office of Policy and Inter-
national Affairs, USPTO

Rich
Stockton



Shareholder,
Banner & Witcoff, Ltd.
(Chicago)

Summary

- What is the DLT?
- DLT Highlights
- What the DLT Is Not





What is the Design Law Treaty?

What is the DLT?

**A (draft) agreement
between nations to
harmonize industrial
design protection
procedures**

What is the DLT's Goal?

“The future treaty aims to streamline the global system for protecting industrial designs, making it **easier, faster and more affordable** for designers to protect their work in home markets as well as overseas.”

Source: WIPO DLT home page (emphasis added)

DLT Anatomy

- 32 Articles
(WIPO Assembly amends articles)
 - 21 substantive
 - 11 procedural
- 17 Rules
(DLT Assembly amends rules)



DLT Provenance

- 20+ years negotiations
- Design equivalent of earlier patent and trademark protection procedure treaties
- Similar framework



2000



1994



2006


DLT: Upcoming Negotiations

2024 Riyadh
Diplomatic Conference
on
Design Law

November 11-22, 2024

DLT: Your Comments Requested!

- USPTO seeks comments
 - Design Prosecution Experiences Abroad
 - DLT Articles/Rules Text
 - Additions/Subtractions
 - Any Other Relevant Insight
- Due June 25, 2024

 21242 Federal Register / Vol. 89, No. 60 / Wednesday, March 27, 2024 / Notices

Please refer to the MCP for projects and activities designed to meet each objective, the evaluative criteria, and priority rankings.

This notice announces that NMFS has reviewed the MCP and determined that it satisfies the requirements of the Magnuson-Stevens Act. Accordingly, NMFS has approved the MCP for the time period from the publication of this notice through August 3, 2026. This MCP supersedes the one approved previously for August 4, 2020, through August 3, 2023 (85 FR 55642, September 9, 2020).

Dated: March 22, 2024.

Everett Wayne Baxter,
Acting Director, Office of Sustainable Fisheries, National Marine Fisheries Service.
(FR Doc. 2024-06495 Filed 3-26-24; 8:45 am)
BILLING CODE 3510-22-P

DEPARTMENT OF COMMERCE
Patent and Trademark Office
[Docket No.: PTO-C-2024-0008]

WIPO Diplomatic Conference on the Design Law Treaty

AGENCY: United States Patent and Trademark Office, Department of Commerce.

ACTION: Notice and request for comments.

SUMMARY: The United States Patent and Trademark Office (USPTO), Department of Commerce, requests public comments on negotiations at the World Intellectual Property Organization (WIPO) regarding a proposed Design Law Treaty (DLT). A diplomatic conference to finalize the DLT will be conducted in Riyadh, Saudi Arabia on November 11-22, 2024. Public comments are requested regarding the DLT.

The negotiations at the Diplomatic Conference will be the culmination of years of discussions at the WIPO Standing Committee on the Law of Trademarks, Industrial Designs, and Geographical Indications (SCT). The provisions of the DLT will pertain to formalities associated with applications for the protection of industrial designs and its adoption by respondent countries.

comments via the portal, enter docket number PTO-C-2024-0008 on the homepage and select "Search." The site will provide a search results page listing all documents associated with this docket. Find a reference to this request for information and select the "Comment" icon, complete the required fields, and enter or attach your comments. Attachments to electronic comments will be accepted in ADOBE® portable document format or MICROSOFT WORD® format. Because comments will be made available for public inspection, information that the submitter does not desire to make public, such as an address or phone number, should not be included.


Visit the Federal eRulemaking Portal (<https://www.regulations.gov>) for additional instructions on providing comments via the portal. If electronic submission of comments is not feasible due to a lack of access to a computer and/or the internet, please submit comments by First-Class Mail or Priority Mail to: Keith M. Mullervy, Patent Attorney, Mail Stop OPIA, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450.

FOR FURTHER INFORMATION CONTACT: Keith M. Mullervy, Patent Attorney, Office of Policy and International Affairs (ODIA) at 571-270-7070.

streamlined and aligned procedures and requirements.

Work on the simplification of procedures for the protection of industrial designs was initially started in the WIPO SCT in 2006 and gradually matured into an initial set of draft Articles (WIPO/SCT/35/2,² the "Industrial Design Law and Practice—Draft Articles") and draft Regulations (WIPO/SCT/35/3,³ the "Industrial Design Law and Practice—Draft Regulations") for a treaty. Similar treaties already exist in the area of patents (Patent Law Treaty of 2000) and trademarks (Trademark Law Treaty of 1994 and Singapore Treaty on the Law of Trademarks of 2006).

In 2006 and 2007, the SCT requested the WIPO Secretariat to develop a set of questionnaires relating to the formalities of industrial design registration and to the differences between all types of marks and industrial designs, with a view to promoting a better understanding of the different design systems. In response, the Secretariat developed a set of questionnaires on industrial design law and practice and circulated them among SCT members. After receiving replies from the SCT members, the Secretariat compiled a summary of replies to the set of questionnaires (WIPO/Strad/INF/2





Design Law Treaty

Highlights

DLT Harmonization Highlights

- Grace Period
- Maximum App Requirements*
(But TCE/TK/GR Disclosure)
- Publication
- Untimeliness
- License Recording
- Minimum Term (proposed)
- Electronic Filing/Searching (proposed)

How to Read the “Official” DLT Text

- Likely
Consensus
- Divergent
- Proposed



Article 6
Grace Period for Filing in Case of Disclosure

[(1)] 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:

- (i) by the creator or his/her successor in title; or
- (ii) 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.

[(2)(a)] A Contracting Party whose law, at the time it becomes party to this Treaty, provides that the grace period under paragraph (1) is triggered by acts other than those referred to in paragraph (1) may, in a declaration, notify the Director General that the grace period shall be triggered in the territory of that Contracting Party only by those acts.

- (b) The acts that may be notified pursuant to subparagraph (a) are the following:
 - (i) A disclosure of the industrial design made for the first time for the purpose of public interest when a state of emergency or an extraordinary situation occurred in the country;
 - (ii) A disclosure of the industrial design made for the first time at an international exhibition, at prescribed academic or technological activities;
 - (iii) A disclosure of the industrial design by another person without the consent of the applicant.
- (c) Any declaration notified under subparagraph (a) may be withdrawn at any time.]

Proposal by the Delegation of Japan

[Article 6⁵
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:

- (i) by the creator or his/her successor in title; or

A2(1): Applicable Applications

(1) Applications

This Treaty shall apply to national and regional applications which are filed with, or for, the Office of a Contracting Party and to divisional applications thereof.

A6(1): Grace Period

Article 6(1)

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:

- (i) by the creator or his/her successor in title; or
- (ii) 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.

A6(2): Declaration re Grace Period

2(a) A Contracting Party whose law, at the time it becomes party to this Treaty, provides that the grace period under paragraph (1) is triggered by acts other than those referred to in paragraph (1) may, in a declaration, notify the Director General that the grace period shall be triggered in the territory of that Contracting Party only by those acts.

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

(i) A disclosure of the industrial design made for the first time for the purpose of public interest when a state of emergency or an extraordinary situation occurred in the country;

(ii) A disclosure of the industrial design made for the first time at an international exhibition, at prescribed academic or technological activities;

(iii) A disclosure of the industrial design by another person without the consent of the applicant.

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

A6: Grace Period Triggering Disclosures

Triggering Disclosure

Comment

<ul style="list-style-type: none">• By creator/successor• By person who obtained directly/indirectly from creator/successor	Current A6(1)
<ul style="list-style-type: none">• Emergency in public interest• International exhibition, at “prescribed ... activities”• Unauthorized	Current A6(2), By declaration may limit “ONLY” to these disclosures
<ul style="list-style-type: none">• By creator at “exhibition notified” per national law• By person who obtained from creator/successor w/o consent	India proposal, supported by China, Nepal, Niger

A6: Minimum Grace Period Length

Length

Support Indicated By

12

months

United States, Australia, Canada, France, Japan, Korea, Moldova, Switzerland, Ukraine, United Kingdom

6

months

Brazil, China, Ghana (on behalf of Africa Group), India, Iran, Nepal, Niger, Russia



A3: “Maximum” App Requirements

Article 3

(1) “A Contracting Party may require that an application contain some, or all, of the following indications or elements:”

Traditional cultural expressions,
traditional knowledge,
biological/genetic resources
disclosure

(2) “No indication or element, other than those referred to in paragraph (1) and in Article 10, may be required in respect of the application.”

A3: TCE/TK/BGR Disclosure

Article 3

(1) “A Contracting Party may require that an application contain some, or all, of the following indications or elements:

a disclosure of the origin or source of traditional cultural expressions, traditional knowledge or biological/genetic resources utilized or incorporated in the industrial design”

What is a Traditional Cultural Expression (TCE)?

A TCE “may include music, dance, art, designs, names, signs and symbols, performances, ceremonies, architectural forms, handicrafts and narratives, or many other artistic or cultural expressions.”

Source: WIPO

What is Traditional Knowledge (TK)?

TK “is knowledge, know-how, skills and practices that are developed, sustained and passed on from generation to generation within a community, often forming part of its cultural or spiritual identity.”

Source: WIPO

What is a Genetic Resource (GR)?

Genetic and other biological resources may “include, for example, microorganisms, plant varieties, animal breeds, genetic sequences, nucleotide and amino acid sequence information, traits, molecular events, plasmids, and vectors.”

Source: WIPO

Parallel Action on GR/Associated TK

Diplomatic Conference

on

**Genetic Resources
and Associated
Traditional
Knowledge**

Geneva, May 13-24, 2024

37 CFR § 1.56: Duty to Disclose

“Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office **all information known to that individual to be material to patentability** as defined in this section.”



A9(1): Pu

Rule 6 Details Concerning Publication

(1) Main Design

“The **minimum period** referred to in Article 9(1) shall be **six months** from the filing date”

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.

A12(2): Untimeliness (Response)

(2) [Continued Processing]

“Where an applicant or holder has failed to comply with a time limit fixed by the Office of a Contracting Party for an action in a procedure before the Office ... the Contracting Party ~~shall~~may provide for continued processing with respect to the application or registration and, if necessary, reinstatement of the rights of the applicant or holder ... if: ... ”

A13(1): Untimeliness (Reinstatement)

(1) [Reinstatement of Rights]

A Contracting Party ~~shall~~may provide that, where an applicant or holder has failed to comply with a time limit for an action in a procedure before the Office, and that failure has the direct consequence of causing a loss of rights with respect to an application or a registration, the Office shall reinstate the rights of the applicant or holder ... if: ...”

A14(2): Untimeliness (Priority Claim)

(2) [Delayed Filing of Later Application]

“A Contracting Party ~~shall~~may provide that, where an application (“the subsequent application”) which claims or could have claimed the priority of an earlier application has a filing date which is later than the date on which the priority period expired, but within the time limit prescribed in the Regulations, the Office shall restore the right of priority, if: ... ”

A17-18: License Recording

Non-recordal “shall not affect the validity of the registration of the industrial design which is the subject of the license, nor the protection of that industrial design.”

“A Contracting Party ~~may not~~may require [recordal] as a condition for” (a) a licensee to join infringement proceedings or (b) “to obtain, by way of such proceedings, damages”



Where required, failure to indicate that the industrial design is used under a license “shall not affect the validity of the registration of the industrial design which is the subject of the license, nor the protection of that industrial design.

A9bis (proposed): Minimum Term

Proposed Article 9bis

By

Comment

<p>Minimum term “of at least 15 years from either: (a) the filing date, or (b) the date of grant or registration.”</p>	<p>US </p>	<p>Hague A17(3)(a): 15 years from int’l registration</p>
<p>Minimum term either “Article 17 of the Hague Convention or Article 26 of the TRIPS Agreement.”</p>	<p>NG </p>	<p>TRIPS A26(3): “The duration of protection available shall amount to at least 10 years.”</p>

A14bis (proposed): Priority Document Exchange

Proposed Article 14bis

By

Comment

“A Contracting Party shall provide for electronic exchange of priority documents for applications.”

US



A9ter (proposed):

Electronic Filing and Searching

Proposed Article 9ter

By

“A Contracting Party shall provide ...
a system for electronic application”

US



“A Contracting Party shall provide ...
a publicly available electronic
information system, which must
include an online database of
registered industrial designs”

A9quater (proposed):

Electronic Filing and Searching

Proposed Article 9quater (redlined to A9ter) By

“A Contracting Party ~~shall~~may provide a system for electronic application”

NG



“Contracting Parties shall not be required to provide ... a publicly available electronic information system, ~~which must include~~nor an online database of registered industrial designs”



**What the
Design Law Treaty
is Not**

What's Missing in the DLT?

- Missing from Subjects *in* the DLT
 - Substantive Harmonization
 - Additional Procedural Harmonization
- Missing Altogether
 - Copendency/Continuations
 - Unity
 - Sufficiency of Disclosure
 - Other Substantive Topics



A1bis(1): No Substantive Convergence Required

DLT does not “limit the freedom of a Contracting Party to prescribe such requirements of the **applicable substantive law** relating to industrial designs as it desires.”

A1bis(2): DLT Does Not “Derogate”

DLT does not “**derogate** from any obligations that Contracting Parties have to each other under any other treaties.”

DLT Novelty-Related Harmonization?

TRIPS A25(1)

DLT

“Members may provide that designs are not new or original if they do not significantly differ from known designs or combinations of known design features.”

...

DLT Novelty-Related Harmonization?

- Maybe...
 - Term
 - Triggering Disclosures
- Maybe Not...
 - Declarations
 - Additive Grace Period
 - Substance...

DM/1/II (E)



ANNEX II

Supporting Document(s) Concerning a Declaration to the Exception to Lack of Novelty under Section 408(c)(ii) of the Administrative Instructions

IMPORTANT

1. This Annex can be used to submit documents in support of a declaration concerning exception to lack of novelty to the **China National Intellectual Property Administration (CNIPA)**, the **Japan Patent Office (JPO)** and/or the **Korean Intellectual Property Office (KIPO)** (refer to form DM/1, item 15). The submitted document(s) will be transmitted by WIPO to the Office(s) concerned.
2. This Annex must be submitted with form DM/1 at the time of filing.
3. Submit only one Annex II per declaration to the exception to lack of novelty, regardless of how many Contracting Parties you have designated.
4. Please note that a declaration concerning exception to lack of novelty might affect the applicant's rights in other jurisdictions. It is the responsibility of the applicant to ensure that their rights are preserved.
5. For detailed information on the procedure when designating Japan, please visit the [JPO website](#).
6. Please number your pages.

For use by the applicant

This Annex concerns the international application number

Reference:

Substance: Toward Novel Novelty: *Curver Luxembourg v. Home Expressions*

938 F.3d 1334 (Fed. Cir. 2019)

“...[W]e hold that claim language can limit the scope of a design patent where the claim language supplies the only instance of an article of manufacture that appears nowhere in the figures.”



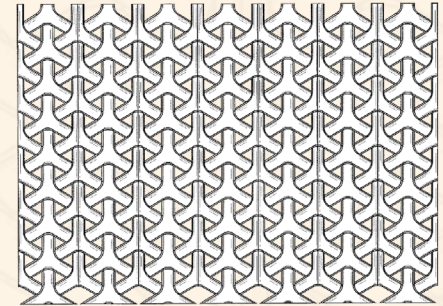
Judge Chen



Judge Hughes



Judge Stoll



D677946

Pattern for a Chair

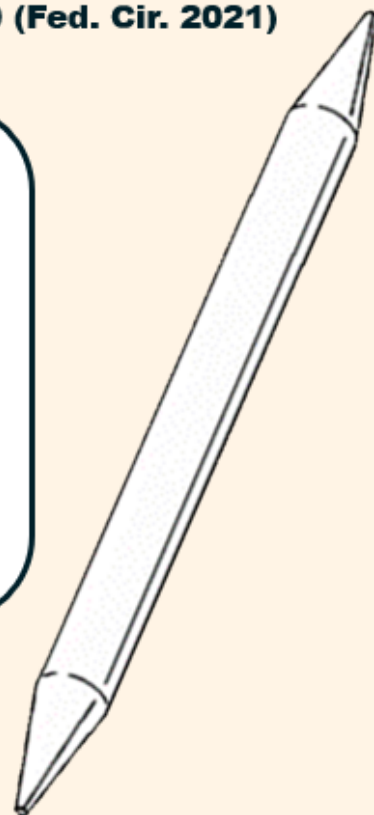


**Accused
Product**

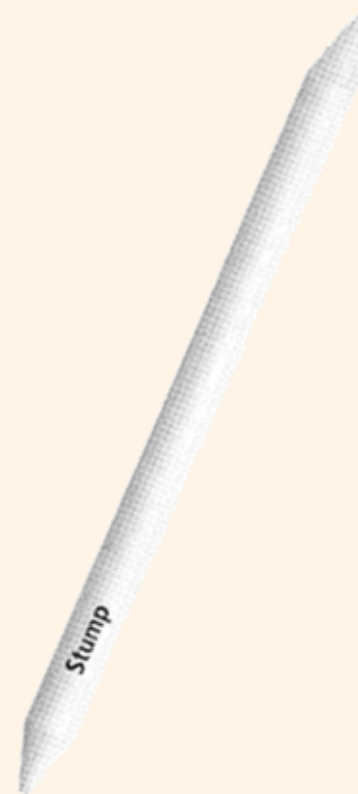
Substance: Arriving at Novel Novelty: *In re SurgiSil* 14 F.4th 1380 (Fed. Cir. 2021)

“A design claim is limited to the article of manufacture identified in the claim”

Thus, lip
implant not
anticipated
by art tool



29/491550
“Lip Implant”



Prior Art
Art Tool

Judge Moore

102 REVERSED

DLT Functionality Harmonization?

TRIPS A25(1)

DLT

“Members may provide that [industrial design] protection shall not extend to designs dictated essentially by technical or functional considerations.”

...

DLT Exceptions Harmonization?

TRIPS A26(2)

DLT

“Members may provide **limited exceptions** to the protection of industrial designs, provided that such exceptions do not **unreasonably conflict** with the normal exploitation of protected industrial designs and do not **unreasonably prejudice** the legitimate interests of the owner of the protected design, taking account of the **legitimate interests** of third parties.”

...

The Sequel...

- Substantive harmonization
- Unity
- Continuity/continuation
- Sufficiency of disclosure
- Other topics...





**Thank
You!**