



*The Trusted Voice of Brand Owners*

## **MARQUES** Comments on outstanding matters

### **concerning the Design Law Treaty (DLT)**

In the context of the **Diplomatic Conference to Conclude and Adopt a Design Law Treaty (DLT)**, to be held from 11 to 22 November 2024 in Riyadh, Saudi Arabia, **MARQUES** wishes to submit the following comments in relation to Basic Proposal for the Design Law Treaty (document DLT/DC/3 of 10 May 2024) and Basic Proposal for the Regulations under the Design Law Treaty (document DLT/DC/4 dated 10 May 2024).

#### **1. Disclosure requirement for traditional knowledge, traditional cultural expressions, and genetic resources (TK/TCE/GR) (Article 3 (ix))**

It is **MARQUES'** view that a disclosure provision for TK/TCE/GR may not find proper consideration into a formalities' treaty such as the DLT. Instead, it is a subject matter that may have to be addressed and regulated in the domestic law by the relevant jurisdictions.

However, given that this is one of the main outstanding issues in the draft DLT, **MARQUES** has preference for the first, more specific, wording represented in Alternative A for Article 3 (ix) of the Basic Proposal for the Design Law Treaty - document DLT/DC/3 of 10 May 2024 -as set out below:

*[(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;]*

To require the disclosure of such a broad category as '*other information*' – as suggested by Alternative B for Article 3 (ix) in document DLT/DC/3 of 10 May 2024 – could take risk to undermine the DLT's stated aims of harmonisation and simplification of the design protection system. It would also be important to have a clear definition of each element of the TK/TCE/GR to avoid divergence and confusion between territories, once the DLT is implemented. The scope of disclosure should be clearly defined and the requirements for the disclosure should not be unduly burdensome for the applicants. A reasonable and extendable period of time to comply with disclosure requirements should also be provided to the applicants.

#### **2. Grace Period for Filing in Case of Disclosure (Article 6)**

**MARQUES** holds the view that the current lack of harmonization in the duration period and other formal requirements for invoking the grace period is a major hindrance for international design filing programs. **MARQUES** would like to emphasise that users –

particularly SMEs and individual designers – would greatly benefit from a harmonized 12-month grace period that can allow 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) without the constraints of any further formal requirements to take advantage of the grace period.

**MARQUES** also considers that the prescription of such broader 12-month grace period could substantially increase international design filings. **MARQUES** strongly supports therefore the proposal under Article 6<sup>7</sup> of the Basic Proposal for the Design Law Treaty - document DLT/DC/3 of 10 May 2024 - as set out below:

#### **Article 6<sup>7</sup>**

##### **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.*

**MARQUES** does not support the proposal for Article 2 (a) of the Basic Proposal for the Design Law Treaty - document DLT/DC/3 of 10 May 2024 - which limits the triggering of the grace period to certain acts or circumstances, like disclosure on international exhibitions and similar.

### **3. Electronic Industrial Design System (Article 9ter/9quater)**

**MARQUES** strongly supports the proposal for a mandatory system of electronic filing for design applications, as well as a publicly available electronic information system which will contain an online database of registered industrial designs as set out in Article 9ter of the Basic Proposal for the Design Law Treaty - document DLT/DC/3 of 10 May 2024. Our view is that a universal electronic filing system will greatly improve the efficiency and accessibility of the registration process, as it would ensure that the registration process is quicker and easier, while maintaining a uniform standard of image quality. A searchable online database would be of significant benefit to brand owners by providing a more efficient and cost-effective means of identifying registered design rights. We support a central database administered by WIPO.

### **4. Deferment of publication (Article 9(1) and Rule 6)**

**MARQUES** objects to the proposal for a minimum period of 6 months from the filing date for the deferment of a design publication, as this could negatively impact brand

owners (such as a fashion brands, which may be seeking to delay publication only a few days prior to a show) who only want to defer a publication for a more limited period of time. We therefore support the removal of a minimum deferment period altogether.

However, we do support the inclusion of a maximum period of deferment which will be standardised across all contracting parties. Our proposal would be to include a standard maximum period of 30 months from the filing date for the deferment of a publication, in line with current practice across the EU.

#### **5. Term of Protection (Article 9bis)**

**MARQUES** supports the proposal of a minimum term of protection period of 15 years as set out in Article 9bis of the Basic Proposal for the Design Law Treaty - document DLT/DC/3 of 10 May 2024.

#### **6. Extension of time limits and reinstatement of rights (Article 12 and 13)**

**MARQUES** supports the mandatory option for the extension of time limits and reinstatement of rights, as it provides the broadest protection for applicants who may have inadvertently missed deadlines, while also allowing for greater uniformity of formalities requirements across registry offices.

#### **7. Restoration of a priority right (Article 14(2))**

**MARQUES** notes that the draft text contains two options: a mandatory provision and a permissive provision. **MARQUES** supports the mandatory option, as the priority right attaching to a design application is of paramount importance to applicants and therefore, it should be offered the broadest protection, while ensuring greater harmonisation of formalities requirements.

#### **8. Electronic Priority Document Exchange (Article 14bis)**

**MARQUES** supports the provision of an electronic exchange of priority documents between Contracting Parties. Our view is that this proposal should go further, namely, that it should provide that Contracting Parties should accede to the WIPO Digital Access Service (DAS), as the common access to a central database such as WIPO DAS will allow for an even more efficient and reliable exchange of priority and other documents between national registry offices, ultimately resulting in greater clarity, harmonisation and efficiency for brand owners.

#### **9. (No) Requirement to record a license before a licensee can join infringement proceedings or claim damages from an infringement (Article 17(2))**

**MARQUES** opposes the proposal in Article 17 (2) to make it compulsory to record a license before the licensee has any right to join infringement proceedings initiated by the holder of the design. This does not appear to be a pertinent provision in the framework of a formalities' treaty, such as the DLT.

It also seems an unnecessary formal burden for licensees, as the Courts dealing with such infringement proceedings will be entitled and fully competent to assess the license documents produced before them.

#### **10. Model forms (Article 23(1)(b) and Rule 17)**

**MARQUES** strongly supports the proposal for introducing model forms, as these would be helpful to applicants looking to file internationally and would assist in ensuring greater harmonisation between registry offices, which currently have, and apply varying requirements and standards. **MARQUES** supports therefore, the proposal in Article 23 (b) of the Basic Proposal for the Design Law Treaty - document DLT/DC/3 of 10 May 2024 - as set out below:

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

as well as the proposal for Rule 17 in the Basic Proposal for the Regulations under the Design Law Treaty - document DLT/DC/4 dated 10 May 2024.

#### **11. Formalities – Rules**

##### **Partial designs (Rule 2(3))**

**MARQUES** strongly supports the proposal for Rule 2 (3) in the Basic Proposal for the Regulations under the Design Law Treaty - document DLT/DC/4 dated 10 May 2024 - to permit applications for the registration of a design forming part of an article or product, so long as that partial design meets the relevant requirements for registration.

##### **Contact details (Rule 7(b))**

**MARQUES** holds the view that a telefacsimile (fax) number under proposed Rule 7(b)(ii) in the Basic Proposal for the Regulations under the Design Law Treaty - document DLT/DC/4 dated 10 May 2024 - should be removed as one of the listed options for contact details, as it is widely accepted that this is an outdated form of communication that many applicants or their representatives no longer have nor use.

Communications via fax will very likely take the risk to be missed and put the applicants at a disadvantage. **MARQUES'** position is in line with the current practice of WIPO under the Hague System, as well as of the EUIPO in the European Union.

##### **Signature by a representative on requests for time limit extensions and reinstatement of rights (Rule 10 and 11)**

**MARQUES** notes that the proposed Rules do not allow for a signature by an applicant's representative in requests for a time limit extension under proposed Article 12(1) or in requests for the reinstatement of rights, following a finding of due care or unintentionality by a registry office under Article 13(1). **MARQUES** strongly supports

the implementation of an option for representatives to sign such requests, as this option often allows for greater efficiency in managing these types of processes for design applicants.

**MARQUES** wishes to thank the International Bureau of WIPO and all the Delegations of the WIPO Member States that will take part to the Diplomatic Conference in Riyadh for considering these comments. We remain available to provide any other requested clarifications.

Submitted on behalf of **MARQUES**, the European Association of Trade Mark Owners

7 November 2024

## About **MARQUES**

**MARQUES** is the European Association representing the interest of brand owners. It was established in 1986 and is incorporated in the UK as a not-for-profit company limited by guarantee. **MARQUES** unites European and international brand owners across all market sectors, to address issues associated with the use, protection and value of IP rights, as these are vital to innovation, growth and job creation, which ultimately enhance internal markets. Its current corporate membership includes the owners of many of the best-known brands in the world, covering a wide range of industry sectors. Apart from corporate members owning brands, the membership is also made up of IP professionals and others with an interest in brand management and IP protection. Overall, there are members from more than 80 countries worldwide, including the 27 Member States of the EU, and the UK.

**MARQUES** is an accredited organisation before the European Union Intellectual Property Office (EU IPO), appointed observer at the EUIPO's Management Board and Budget Committee, an official non-governmental observer at the World Intellectual Property Organization and a registered interest representative organisation (ID 97131823590-44) 34 in the Transparency Register set up by the European Parliament and the European Commission, which extends and replaces the former Register of Interest Representatives, opened by the Commission in 2008.

More information about **MARQUES** can be found on its website at [www.marques.org](http://www.marques.org).