

Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications

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INDUSTRIAL DESIGN LAW AND PRACTICE – DRAFT ARTICLES

Document prepared by the Secretariat

INTRODUCTION

1. At its twenty-sixth session, held in Geneva from October 24 to 28, 2011, the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (hereinafter referred as “the Standing Committee” or “the SCT”) considered a set of draft provisions on industrial design law and practice (see document SCT/26/2). At that session, the Chair concluded that “the Secretariat was requested to prepare revised working documents for consideration of the SCT at its twenty-seventh session, which should reflect all comments made at the present session and highlight the different proposals put forward by delegations by using square brackets, strikethrough, underlining or footnotes, as appropriate” (paragraph 6 of document SCT/26/8).

2. Accordingly, the Secretariat has prepared the present document, as well as document SCT/27/3, which revise documents SCT/26/2 and 3. Adopting the structure already followed by documents submitted at the twenty-fifth and twenty-sixth sessions of the SCT, the present document includes an Annex with draft Articles on industrial design law and practice, i.e. provisions of a general nature. Document SCT/27/3 contains an Annex with draft Regulations. This two-level structure is intended to facilitate the analysis of the issues under consideration and to establish a dynamic and flexible framework for the subsequent development of design law, so as to keep pace with future technological, socio-economic and cultural changes.

3. With a view to highlighting the different proposals put forward by delegations, without affecting the readability of the text, proposals made by individual delegations are shown in a footnote. New text appears in underlining and deleted text in strikethrough. Square brackets are used to indicate two or more different options that are put forward for consideration.

4. The SCT is invited to consider the present document, and to:

(i) comment upon the draft Articles;

(ii) review the draft Articles, amend them, add further draft Articles, or omit any of them; and

(iii) indicate how it wishes to pursue its work on design law and practice.

[Annex follows]

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ARTICLES

Article 1 **Abbreviated Expressions**

For the purposes of these Articles, unless expressly stated otherwise:

- (i) “Party” means any State or intergovernmental organization that applies these Articles;
- (ii) “Office” means the agency of a 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 ~~the registration of an industrial design or an application for the grant of a patent for an industrial design~~;
- (v) “initial application” means an application which includes two or more industrial designs and which may be divided by the applicant at the request of the Office;
- (vi) “divisional applications” means applications resulting from the division of an initial application;
~~(v) “divisional application” means an application as referred to in Article 8;~~
- (vii) “applicable law” means, where the Party is a State, the law of that State and, where the Party is an intergovernmental organization, the legal enactments under which that intergovernmental organization operates;
- (viii) references to “industrial design” shall be construed as references to “industrial designs”, where the application or the registration includes two or more industrial designs;
- (ix) references to a “person” shall be construed as references to both a natural person and a legal entity;
- (x) “procedure before the Office” means any procedure in proceedings before the Office with respect to an application or registration;
- (xi) “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;
- (xii) “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;
- (xiii) “applicant” means the person whom the records of the Office show, pursuant to the applicable law, as the person who is applying for ~~the design registration~~, or as another person who is filing or prosecuting the application;
- (xiv) “holder” means the person shown in the records of the Office as the holder of the registration;

(xv) “Paris Convention” means the Paris Convention for the Protection of Industrial Property, signed on March 20, 1883, as revised and amended;

(xvi) “license” means a license for the use of an industrial design under the law of a Party ;

(xvii) “licensee” means the person to whom a license has been granted;

(xviii) “Regulations” means the Regulations referred to in Article 21.

Notes on Article 1

- Note 1.01 *Item (i).* The term “Party” is used throughout the document, not to prejudice the nature of the outcome of the work on industrial design law and practice.
- Note 1.02 *Items (iii) and (iv).* The term “application” comprises applications both for registration of an industrial design and for the grant of a patent for an industrial design under those systems in which industrial designs are protected under patent law. Similarly, the term “registration” comprises both registrations of industrial design and grants of a patent for an industrial design under those systems which protect industrial designs under patent law.
- Note 1.03 *Items (v) and (vi).* At the twenty-sixth session of the SCT, it was proposed to delete the definition of “divisional applications” since these terms are defined in Article 8. However, the words “divisional applications” appear for the first time in Article 2, and the words “initial application” are also used as such in Rule 2(2)(b). It would therefore be useful to maintain a definition of “divisional applications” in Article 1 and to add a definition of “initial application”.
- Note 1.04 *Item (xi).* The term “communication” is used to refer only to matter which is filed with the Office. Accordingly, a notification or other correspondence sent by the Office to an applicant, holder or other interested person does not constitute a “communication” as defined in this item. The term “communication” as defined in this item covers, *inter alia*, any document which is filed with the Office, relating to an application or a registration, including powers of attorney.
- Note 1.05 *Item (xii).* Following the comments made at the twenty-fifth session of the SCT, the term “records of the Office” is used instead of the term “register of industrial designs”, which was used in document SCT/25/2. The term “records of the Office” is used in the Patent Law Treaty (hereinafter the “PLT”). Information referred to under this item includes the contents of applications and registrations, as well as corrections of mistakes referred to in Article 20 and changes referred to in Articles 18 and 19. It does not have to include data that, although relating to an application or registration, is not considered by an Office as “information”.
- Note 1.06 *Items (xiii), (xvii) and (xviii).* Definitions of “applicant”, “license” and “licensee” were included following the comments made at the twenty-fifth session of the SCT.

Article 2
Applications and Industrial Designs to Which These Articles Apply

(1) *[Applications]* These Articles shall apply to national and regional applications which are filed with, or for, the Office of a Party, and to divisional applications thereof.

(2) *[Industrial Designs]* These Articles shall apply to industrial designs that can be registered as industrial designs under the applicable law.

Notes on Article 2

- Note 2.01 *Paragraph (1)*. These provisions would apply to national applications which are filed with the Office of a State, as well as to applications, filed with, or for, the Office of a regional intergovernmental organization. The latter are referred to in this paragraph as “regional applications”. Examples of Offices of intergovernmental organizations are the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)¹, the African Intellectual Property Organization (OAPI)², the African Regional Intellectual Property Organization (ARIPO)³, and the Benelux Office for Intellectual Property (BOIP)⁴.
- Note 2.02 The provisions are intended to apply to applications, as defined in Article 1(iv), as well as to initial and divisional applications as defined in Article 1(v) and (vi). However, while it would not have to do so, a Party could apply some, or all, of these provisions to any specific type of application not covered by paragraph (1), such as “converted”, “amended”, or “continuation” applications.
- Note 2.03 As mentioned in Note 2.02, these provisions would also apply to divisional applications. This follows from Article 8, which provides that the applicant may request the division of the application.
- Note 2.04 *Paragraph (2)*. These provisions do not contain a definition of industrial design. They would apply to any industrial design that can be registered as an industrial design, or for which a design patent can be granted, under the applicable law. Accordingly, the question as to what matter can be protected as an industrial design remains an issue to be determined by the law of each Party.

¹ OHIM registers designs with effect in the 27 member States of the European Union.

² OAPI registers designs with effect in the 16 member States of the Bangui Agreement.

³ ARIPO registers designs with effect in up to 16 States party to the Lusaka Agreement.

⁴ BOIP registers designs with effect in the three Benelux countries.

Article 3 Application

- (1) [Contents of Application; Fee]⁵ (a) A Party may require that an application contain some, or all, of the following indications or elements:
- (i) a request for registration;
 - (ii) the name and address of the applicant;
 - (iii) where the applicant has a representative, the name and address of that representative;
 - (iv) where an address for service or an address for correspondence is required under Article 4(3), such address;
 - (v) a representation of the industrial design, as prescribed in the Regulations;
 - (vi) 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;
 - (vii) 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;
 - (viii) 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.

⁵ At the twenty-sixth session of the SCT, the Delegation of Brazil proposed that the following items under Rule 2(1) be transferred to Article 3(1):

- (iii) a claim;
- (iv) a statement of novelty;
- (vi) indications concerning the identity of the creator of the industrial design;
- (viii) where the applicant is not the creator of the industrial design, a statement of assignment or other evidence of the transfer of the design to the applicant;
- (x) 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.

At the twenty-sixth session of the SCT, the Delegation of Japan proposed that the following item under Rule 2(1) be transferred to Article 3(1):

- (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.

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

(4) [Evidence] Any 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.

Notes on Article 3

- Note 3.01 This Article and the corresponding Rules of the Regulations propose a closed list of indications or elements that may be required in an application. While paragraph (1) sets out the maximum contents of an application that may be required by a Party, paragraph (2) makes it clear that no further element may be required by a Party in an application, except those elements that may be required under Article 10 (“Communications”).
- Note 3.02 At the twenty-fifth session of the SCT, two delegations considered that this Article should contain an indicative list of elements only, and suggested to delete paragraph (2). Other delegations said, however, that this provision was of the outmost importance, with a view to simplifying and streamlining industrial design procedures. Establishing a closed list of elements contributes to create a predictable framework of industrial design formalities.
- Note 3.03 This provision does not aim at creating a uniform content of applications, but at establishing a maximum content, so that anyone wishing to file an application knows exactly what are the elements that may be required. However, a Party may require some only, rather than all, of the elements listed. For instance, no Party would be obliged to require a claim (see Rule 2(1)(iii)). A claim would presumably not be required by a Party that protects industrial designs under a registration system, as opposed to a system of protection under patent law.
- Note 3.04 As suggested by a number of delegations, this Article sets out the elements of general nature in an application, those required by virtually all Parties. Elements of more detailed nature have been transferred to the Regulations. The proposed scheme is intended to establish a dynamic and flexible framework for the subsequent development of design law.
- Note 3.05 *Paragraph (1)(a). Item (ii).* Each Party would be free to determine the details concerning the name and address. For example, a Party could permit that, for privacy considerations, the applicant provide only an address for correspondence, and not necessarily a home address.
- Note 3.06 *Item (v).* Details concerning the representation of industrial designs are prescribed in Rule 3. The Regulations provide a more flexible framework to amend and adopt further requirements concerning this matter, which may be justified in the future by the development of new reproduction techniques.
- Note 3.07 *Paragraph (3).* This paragraph sets out the principle that applications including more than one industrial design, so-called “multiple applications”, may be filed by an applicant. From the point of view of users, multiple applications provide a clear benefit in terms of simplification of filing, which is evidenced by the fact that the facility is largely availed of by applicants in those jurisdictions which offer the facility. From the point of view of examining offices, however, multiple

applications entail the need to undertake searches for each industrial design included in the application. In this regard, a major concern for offices, particularly those which carry out a novelty examination, lies in the ability to adequately recover search and examination costs⁶.

Note 3.08 In order to balance the interests of users and offices, acceptance of “multiple applications” by a Party is subject to compliance, by the applicant, with the conditions prescribed in the Party’s applicable law. This provision does not prescribe the conditions under which multiple applications are to be admitted. Each Party would be free to determine under what conditions it admits multiple applications. For example, a Party may prescribe that it accepts multiple applications only where all the designs in the application apply to, or are constituted by, products which belong to the same class of the Locarno Classification, or only where all the designs in the application conform to the requirement of unity of design or unity of invention or when the products to which the design is applied belong to a set or are intended for the same purpose.

Note 3.09 With respect to a given application, a Party will be able to process it as a multiple application if the application conforms to the conditions prescribed in the Party’s law, or to request the applicant to divide the application into two or more applications, under Article 8 if the application does not conform to the conditions prescribed in the Party’s law.

Article 4

Representatives; Address for Service or Address for Correspondence

(1) *[Representatives Admitted to Practice]* (a) *A 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 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 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.*

Option 1

[(2) [Mandatory Representation] (a) Subject to subparagraph (b), a 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 ~~its~~ the territory of the Party may act himself before the Office for the filing of an application, for the purposes of the filing date.]

⁶ See document SCT/21/4.

Option 2

[(2) [Mandatory Representation] A 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.]

(3) *[Address for Service or Address for Correspondence] A 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, have an address for service, or an address for correspondence, in that territory.*

(4) *[Appointment of a Representative] A 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 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 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 Party under paragraphs (1) to (4) is or are not complied with within the time limit prescribed in the Regulations, the Party may apply such sanction as is provided for in its law.*

Notes on Article 4

- Note 4.01 This Article is modeled, to a large extent, on Article 7 of the PLT and Article 4 of the Singapore Treaty on the Law of Trademarks (hereinafter “the Singapore Treaty”).
- Note 4.02 *Paragraph (1)(a). Item (i)* of this paragraph permits a Party to require that the appointed representative be a person who is admitted to practice before the Office in respect of applications and registrations, such as, for example, a registered patent attorney. It also permits a Party to have a less strict requirement.
- Note 4.03 A Party may apply the requirement under *item (ii)* of paragraph 1(a) instead of, or in addition to, the requirement that the appointed representative have the right to practice before the Office, under item (i). A Party may, in particular, require that the address be in its own territory.
- Note 4.04 *Paragraph (1)(b).* As regards the expression “interested person” used in this and other provisions, it could be, for example, in the case of a transfer of an application or registration, the new owner of the application or registration.
- Note 4.05 *Paragraph (2).* Following the twenty-sixth session of the SCT, two options concerning this paragraph are submitted for discussion.

- Note 4.06 Under the first, this paragraph is divided into two subparagraphs. *Subparagraph (a)* permits, but does not oblige, a Party to require representation for any procedure before the Office except for filing an application as far as the purpose of obtaining a filing date is concerned. The ability for a Party to require representation is, in any event, limited to the cases where the applicant, holder or other interested person has neither a domicile nor a real and effective industrial or commercial establishment in the territory of the Party. This limitation is modeled on Article 4(2)(a) of the Singapore Treaty.
- Note 4.07 *Subparagraph (b)* is modeled on Article 7(2) of the PLT and aims at reducing the barriers for users to seek industrial design protection abroad. This subparagraph provides for an exception to the principle established in subparagraph (a). It permits an applicant who has neither a domicile nor a real and effective industrial or commercial establishment in the territory of a Party to file an application for the purposes of the filing date without appointing a representative. In other words, if an application contains the elements which are required under Article 5(1), it will be accorded a filing date, even if it was filed by an applicant who has neither a domicile nor a real and effective industrial or commercial establishment on the territory of the Party and even if the Party concerned requires that such applicant appoint a representative to file an application. After the filing date, the Party may require that a representative be appointed, within a given time limit, to continue the procedure. If no representative is appointed within the time limit, the Party may apply a sanction provided for in its law, including, for example, considering the application to be abandoned.
- Note 4.08 In the absence of agreement at the twenty-sixth session of the SCT concerning the approach described above, a second option is submitted to the Committee for discussion. Under Option 2, there is no exception to the principle whereby a Party may require representation for the purposes of any procedure before the Office. In other words, a Party may require the appointment of a representative for the purpose of filing an application, including for obtaining a filing date.
- Note 4.09 *Paragraph (3)*. A Party may, instead of requiring the appointment of a representative where the applicant is not domiciled or established in its territory, require that the applicant have an address for service or an address for correspondence in its territory. What constitutes an address for correspondence or an address for service is a matter for the applicable law of the Party concerned. This requirement is viewed as less stringent than the appointment of a representative.

Article 5 Filing Date

(1) *[Permitted Requirements]*⁷ (a) Subject to subparagraph (b) and paragraph (2), a Party shall accord as the filing date of an application the date on which the Office receives the following indications and elements, in the language required under Article 10(2):

- (i) an express or implicit indication to the effect that the elements are intended to be an application;
- (ii) indications allowing the identity of the applicant to be established;
- (iii) a sufficiently clear representation of the industrial design;
- (iv) indications allowing the applicant or the applicant's representative, if any, to be contacted.

(b) Any Party may accord as the filing date of an application the date on which the Office receives, together with a sufficiently clear representation of the industrial design, some only, rather than all, of the other indications and elements referred to in subparagraph (a), or receives them in a language other than a language required under Article 10(2).

(2) *[Permitted Additional Requirement]* (a) A Party may provide that no filing date shall be accorded until the required fees are paid.

(b) A Party may apply the requirement referred to in subparagraph (a) only if it applied such requirement at the time it began to apply these provisions.

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

(4) *[Notification and Time Limits]* Where the application does not, at the time of its receipt by the Office, comply with one or more of the applicable requirements under paragraphs (1) and (2), the Office shall notify the applicant and give the opportunity to comply with such requirements within the time limit prescribed in the Regulations⁸.

(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 Party under paragraphs (1) and (2) are received by the Office. Otherwise, the application shall be treated as if it had not been filed.

⁷ At the twenty-sixth session of the SCT, the Delegation of Brazil proposed to add "indications concerning the identity of the creator of the industrial design" to the list of filing-date requirements in paragraph (1).
At the twenty-sixth session of the SCT, the Delegation of Canada proposed to add "a description" to the list of filing-date requirements in paragraph (1).
At the twenty-sixth session of the SCT, the Delegation of Japan proposed to add an indication of the product or products which incorporate the industrial design, or in relation to which the industrial design is to be used" to the list of filing-date requirements in paragraph (1).
At the twenty-sixth session of the SCT, the Delegation of the United States of America proposed to add "a claim" to the list of filing-date requirements in paragraph (1).

⁸ At the twenty-sixth session of the SCT, the Delegation of Brazil proposed to replace the words "within the time limit prescribed in the Regulations" by "within a reasonable time limit" and to delete Rule 5.

Notes on Article 5

- Note 5.01 Following a suggestion made during the twenty-fifth session of the SCT, paragraphs (1) and (2) are modeled on Article 5(1) and (2) of the Singapore Treaty.
- Note 5.02 *Paragraph (1)(a)* sets out the requirements that may be established by a Party for the purpose of assigning a filing date. During the twenty-fifth session of the SCT, several delegations reiterated the importance of keeping the list of filing-date requirements to the minimum, as in the field of industrial designs, postponement of the filing date may result in a definitive loss of rights. Filing-date requirements should be of such significance that, without them, it would not be possible for an Office to know “who” filed “what”.
- Note 5.03 At the twenty-sixth session of the SCT, one delegation requested adding the claim to the list of filing-date requirements. Another delegation requested adding the description. A third requested adding an indication of the product, and a fourth requested adding an indication of the identity of the creator. Those proposals are shown in a footnote to paragraph (1).
- Note 5.04 It is made clear in the provision that a Party may require that the application be filed in the language required under Article 10(2), in order to be given a filing date. Inclusion of this requirement in this paragraph is justified by the fact that an Office may not be in a position to ascertain “who” filed “what” if the information is not provided in a language admitted by the Office.
- Note 5.05 The drafting of *paragraph (1)(b)* makes it clear that, while a Party may accord a filing date when some only, rather than all, of the indications and elements listed in subparagraph (a) are filed, it may not accord a filing date if a sufficiently clear representation of the industrial design is missing. In other words, a representation of the industrial design should always be a filing date requirement. This was requested by a number of delegations at the twenty-fifth session of the SCT.
- Note 5.06 *Paragraph (2)*. Consistent with the underlying rationale of this Article, as explained in Note 5.02, the payment of fees had not been included in the list of filing-date requirements in document SCT/25/2. Note 4.03 on Article 4 of document SCT/25/2 suggested that, when an Office received an application for which the fees had not been paid on the date of receipt of the application, it could decide not to further examine the application until the fees had been paid. If the fees were then paid within the applicable time limit, nothing would appear to prevent the Office from according the application an earlier filing date. In other words, an Office could dissociate the payment of the fees from the grant of a filing date.
- Note 5.07 However, at the twenty-fifth session of the SCT, six delegations were of the view that the possibility should be given to Parties to require the payment of fees for the purpose of according a filing date. Consequently, under paragraph (2), a Party may require the payment of fees in order to accord a filing date, but only where such payment already constitutes a filing-date requirement under its law.

- Note 5.08 *Paragraph (3) makes it clear that the list provided for in paragraphs (1)(a) and (2)(a) is the maximum list of filing-date requirements. Other elements or indications may be required in an application, but they may be filed subsequently without the filing date being affected.*
- Note 5.09 *Paragraph (4) provides that, where an application does not contain all the elements or indications which are required to obtain a filing date, a time limit shall be afforded to the applicant to complete the application. The time limit is prescribed in the Regulations, so as to facilitate any change that may be justified in the future. The proposal of one delegation to replace “within the time limit prescribed in the Regulations” by “within a reasonable time limit” is shown in a footnote to paragraph (4).*
- Note 5.10 *Paragraph (5) addresses the issue of what is the filing date when the application did not comply with all the filing-date requirements at first, but there was subsequent compliance with all of such requirements. Usually, the filing date is the date on which all the indications and elements required by the Party are received by the Office. In other words, the filing date is postponed until all the filing-date requirements are complied with. However, two delegations indicated at the twenty-sixth session of the SCT that, in their legislation, the date of filing of the “irregular” application is maintained as the filing date, provided that the missing filing-date requirements are complied with within a given time limit. In order to accommodate this approach, one delegation, supported by a number of other delegations, proposed that the filing date shall be “no later” than the date on which all the indications and elements required by the Party under paragraphs (1) and (2) are received by the Office.*

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

A disclosure of the industrial design during a period of [12 months] [at least six 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:*

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

*(b*ii*) by a person informed of the industrial design, and authorized to disclose it⁹, by the creator or his/her successor in title; or*

*(c*iii*) as a result of an abuse in relation to the creator or his/her successor in title¹⁰.*

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

⁹ At the twenty-sixth session of the SCT, the Representative of the European Union suggested to delete the words “and authorized to disclose it”.

¹⁰ At the twenty-sixth session of the SCT, the Delegation of the Philippines suggested to add a fourth item, namely a disclosure made “by a third party who obtained information directly or indirectly.”

At the twenty-sixth session of the SCT, the Delegation of Brazil suggested to make the items (i), (ii) and (iii) optional.

Notes on Article 6

- Note 6.01 It is understood that, while most jurisdictions provide for a grace period to file, further to a disclosure made by the creator, his/her successor in title or another person, some jurisdictions do not. In those jurisdictions which do provide for a grace period, the duration of such grace period varies between six and 12 months. It is also understood, however, that the existence of different grace periods, and more generally the fact that some jurisdictions do not provide for a grace period, may cause an applicant to lose the possibility of obtaining protection for the industrial design abroad. A harmonized grace period, coupled with agreement on which disclosure gives rise to the grace period, would avoid this risk for applicants.
- Note 6.02 At the twenty-fifth and twenty-sixth sessions of the SCT, several delegations expressed the view that the grace period should be six months from the disclosure of the industrial design, as opposed to 12 months. Therefore, the revised draft of this provision puts forward two options for discussion, namely a grace period of “12 months” or of “at least six months” from the disclosure of the industrial design. The options are shown in brackets. With respect to the second option, it should be noted that, at the twenty-sixth session of the SCT, a number of users’ organizations expressed the view that such option would not be an optimum solution, as it would give the impression of a legal certainty which would not exist in reality.
- Note 6.03 This provision establishes a grace period to file in case of disclosure made by the creator or his/her successor in title, or by another person who has had access to the industrial design as a result of information provided by the creator or his/her successor in title. The proposal as it stands requires, in addition, that the other person should have been authorized by the creator or his/her successor in title to disclose the industrial design. At the twenty-sixth session, one delegation and the representative of a users’ association expressed concern about the second requirement, as it could limit the benefit of the grace period.
- Note 6.04 One delegation suggested adding a fourth situation of disclosure that would give rise to a grace period, namely disclosure made by a third party who obtained information about the industrial design directly or indirectly from the creator or his/her successor in title. This situation could be merged with the situation referred to in item (ii), provided that the requirement that the third person should have been authorized to disclose by the creator or his/her successor in title, be suppressed, as suggested by a delegation.
- Note 6.05 In addition to the two situations referred to in the previous notes, the provision establishes a grace period to file in case of a disclosure made as a result of an abuse in relation to the creator or his/her successor in title. An example of abusive disclosure could be a disclosure made without the authorization of the creator, or his/her successor in title, by a person who had been informed of the industrial design under conditions of confidentiality.
- Note 6.06 At the twenty-sixth session of the SCT, one delegation suggested to delete item (iii), while another delegation considered that the situation described in that item would be an instance of unfair competition, in respect of which it would be useful to provide for a grace period, to protect the right of the applicant.

- Note 6.07 The question as to whether disclosure of an industrial design made in a bulletin published by a domestic or a foreign Office would give rise to a grace period remains a matter for the applicable law of each Party. A Party could consider that disclosure made in a bulletin by an Office does not fall within any of the situations referred to in items (i) to (iii) of Article 6 and, consequently, does not give rise to a grace period.
- Note 6.08 A statement that time limits expressed in “months” can be calculated by Parties in accordance with their national law has been added as a footnote in this Article. This is the first time in the draft Articles that reference is made to a period expressed in months. The statement has been added to address the concerns by one delegation at the twenty-sixth session of the SCT, as to the way to calculate time limits expressed in months.

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 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 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.*

Notes on Article 7

- Note 7.01 In some jurisdictions, there is a requirement that the application be filed in the name of the creator. That means that, if the applicant is not the creator, a statement of assignment, or other evidence of the transfer of the design to the applicant, must be provided.
- Note 7.02 This provision does not generalize the requirement that the application be filed in the name of the creator. The provision applies only to those Parties that do have that requirement in their applicable law. The provision aims at simplifying the procedure, where the requirement exists under the applicable law, by allowing the applicant to file a simple statement of assignment as evidence of the transfer. The statement may be in a separate document, accompanying the application, or pre-printed in the application. In order to safeguard the rights of creators, the statement of assignment must, in any event, be signed by the creator.

Article 8 **Division of Application**

(1) [Division of Application] Any initial application ~~which includes two or more industrial designs (hereinafter referred to as “initial application”)~~ may be divided by the applicant, at the request of the Office, into two or more divisional applications ~~(hereinafter referred to as “divisional applications”)~~ 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 any applicable.

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

[(b)] The sum of the fees due for the initial and divisional applications shall not exceed the sum of the fees that would have been due in the case of separate initial for filing the appropriate number of applications.]

Notes on Article 8

- Note 8.01 The aim of this provision is to enable an applicant who seeks protection for several industrial designs in a single application to divide the application and maintain the date of the original filing in the applications resulting from the division.
- Note 8.02 This provision should be read in conjunction with Article 3(3). That Article provides that, subject to such conditions as may be prescribed under the applicable law, an application may include two or more industrial designs. If an application containing two or more industrial designs does not fulfill the applicable conditions, then the Office would be in a position to request the applicant to divide the initial application into two or more applications that fulfill the conditions. It follows from the term “division of application” that division should be possible only as long as the initial application is pending.
- Note 8.03 Division of an application does not exempt an applicant from fulfilling the formalities, or from paying the fees, with respect to the divisional applications. The interest of division is, however, that divisional applications maintain the filing date and, if applicable, the priority date, of the initial application. Therefore, division may be perceived as a mechanism that softens the effects of a “mistake” made by the applicant in an initial application, while not entailing any negative impact on offices.
- Note 8.04 *Paragraph (1).* Following the discussion at the twenty-sixth session of the SCT, the words “at the request of the Office” have been added, in order to make it clear that the type of division envisaged in this provision is one requested by the Office, as explained in Note 8.02, above. This provision does not cover the situation in which an applicant divides the application on his/her own initiative. Parties can provide for such type of division in their legislation, if they so wish, but are not required to do so under this provision.
- Note 8.05 In order to explain the words “by distributing among the latter the industrial designs for which protection was claimed in the initial application”, the following example may be useful. Let us imagine that an initial application covering

three industrial designs was filed in a Party. Two industrial designs belong in class 7 of the International Classification for Industrial Designs under the Locarno Agreement, while one belongs in class 9. Let us further imagine that, under the applicable law of the Party, multiple applications are admitted, subject to all the industrial designs in the application belonging in the same class of the International Classification. In the example, therefore, the Office would request the applicant to divide the initial application into two divisional applications, one covering the two industrial designs that belong in class 7 and a second covering the industrial design that belongs in class 9.

- Note 8.06 *Paragraph (3)(b)*. This provision was included following the twenty-fourth session of the SCT. Following the twenty-sixth session of the SCT, two delegations requested that this paragraph be put between square brackets.
- Note 8.07 The intention of this provision is that, if the initial application is divided, the fees to be eventually paid by the applicant for the initial application and all the divisional applications should not exceed the total amount of fees that the applicant would have paid if he had filed, from the start, the correct number of applications. The amount of fees to be paid for the divisional applications may be higher than the amount of fees paid for the initial application, but it should not be higher than the amount for the correct number of applications. The wording of paragraph (3)(b) has been amended to capture in a clearer way the intention of this provision.
- Note 8.08 The following example can help to illustrate the situation provided for in paragraph (3)(b). Let us imagine that, in a Party, the cost of filing an application for one industrial design is 10 and the cost of an application for two industrial designs that belong in the same Locarno class is 15. An applicant files an application for two designs, for which he pays 15. However, he then is requested to divide the initial application into two divisional applications, as the industrial designs do not belong in the same class. If the applicant had filed two separate applications from the beginning, he would have had to pay 20. The gist of paragraph (3)(b) is that, as a result of the division, the applicant should pay no more than 20. This amount corresponds to the fees that the applicant would have paid if he had “correctly” filed the applications from the beginning. As the applicant has already paid the fees for the initial application for two industrial designs (*i.e.*, 15), the Office should take that payment into account and deduce it from the amount of fees due after division. By consequence, in this example, the applicant should eventually pay to the Office the difference between 20 (fees to be paid for the divisional applications) and 15 (fees already paid for the initial application), *i.e.*, 5.

Article 9 **Publication of the Industrial Design**

[(1) *[Request to Maintain~~ing~~ the Industrial Design Unpublished]* ~~Upon request by the applicant, a~~ A Party *[shall] [may] allow an applicant to maintain the industrial design unpublished for a ~~maximum~~ 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 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.]*

Notes on Article 9

- Note 9.01 The discussion at the twenty-sixth session of the SCT confirmed that, while many jurisdictions offer the possibility to applicants of maintaining the industrial design unpublished for a period of time, a number of jurisdictions do not offer that possibility. Therefore, pursuant to the conclusion of the Chair of the twenty-sixth session of the SCT, whereby those positions should be reflected in the next draft submitted to the SCT, this document presents two options concerning this provision.
- Note 9.02 Under the first option, a Party would be required to allow an applicant to maintain the industrial design unpublished for a period fixed by its applicable law, subject to the minimum period prescribed in the Regulations. This provision would be justified by the fact that there is an interest for users in maintaining the industrial design unpublished for some time, as this enables them to control the first release of the product embodying the industrial design. However, maintaining an industrial design unpublished in one jurisdiction serves no purpose if the design is published in another jurisdiction. It is a fact that, nowadays, any matter that is made accessible in one part of the world can easily become accessible everywhere.
- Note 9.03 The article does not provide for a uniform period of time during which the industrial design can be maintained unpublished. It provides for a minimum period, prescribed in the Regulations, and leaves it to each Party to determine the period above the prescribed minimum period during which an industrial design may be maintained unpublished.
- Note 9.04 With regard to the different existing systems for maintaining an industrial design unpublished, the article does not provide for a specific system. Thus, a Party may comply with this article by implementing, for example, a system of deferment of publication, a secret design system, or a system giving the possibility to effectively postpone publication by delaying the payment of the registration fees.
- Note 9.05 Following the twenty-sixth session of the SCT, the language of *paragraph (1)* and the general structure of Article 9 have been modified, with a view to better accommodating the different existing systems for maintaining an industrial design unpublished. Thus, *paragraph (1)* has been drafted in a general manner. It requires a Party to allow an applicant to maintain the industrial design unpublished for some time, but does not require a request by the applicant for that purpose. This approach accommodates those systems where the applicant is in a position to postpone the publication of the industrial design by delaying the payment of the registration fees, without having to file any request as such.

- Note 9.06 Under the proposed structure of this Article, *paragraph (2)* gives the possibility to a Party to require a request by the applicant for maintaining the industrial design unpublished. Such request would be required, for example, in a secret-design or in a deferment-of-publication system.
- Note 9.07 *Paragraph (3)*. This paragraph was introduced following the twenty-fifth session of the SCT. It makes it clear that, where a request for maintaining the industrial design unpublished has been made, the applicant or holder may subsequently request that the industrial design be published before the expiry of the applicable period. The words “the period applicable under paragraph (1)” refer to the period established by the applicable legislation, which cannot be less than a minimum period fixed in the Regulations.
- Note 9.08 Under the second option, Article 9 would be optional.

Article 10 **Communications**

- (1) *[Means of Transmittal and Form of Communications]* A 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 Party may require that any communication be in a language admitted by the Office.
- (b) A 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 Party may require the attestation, notarization, authentication, legalization or any other certification of any translation of a communication, except in those cases prescribed in these Articles.
- (d) Notwithstanding subparagraph (c), any Party may require that any translation of a communication be accompanied by a statement that the translation is true and accurate.
- (3) *[Indications in Communications]* A Party may require that any communication contain one or more indications prescribed in the Regulations.
- (4) *[Address for Correspondence, Address for Service and Contact Details]* A 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.
- (5) *[Signature of Communications on Paper]* (a) A Party may require that a communication on paper be signed by the applicant, holder or other interested person. Where a Party requires a communication on paper to be signed, that Party shall accept any signature that complies with the requirements prescribed in the Regulations.

(b) *No Party may require the attestation, notarization, authentication, legalization or other certification of any signature, except in those cases prescribed in the Regulations.*¹¹

(c) *Notwithstanding subparagraph (b), any 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.*

(6) *[Communications Filed in Electronic Form or by Electronic Means of Transmittal] Where a 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.*

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

(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.*

Notes on Article 10

Note 10.01 Under *paragraph (1)*, an Office may choose the means of transmittal of communications and the form of the communications that it accepts.

Note 10.02 *Paragraph (2)* deals with the language of communications. Under *subparagraph (a)*, an Office may require that any communication be in a language admitted by it. It follows that, where a communication or part of a communication, is not in a language admitted by the Office, a Party may require that the communication be filed in translated form. This is provided for in *subparagraph (b)*. In that case, for the sake of simplification, no attestation, notarization, authentication, legalization or other certification of the translation, for instance by a notary public, may be required, except as prescribed in the Articles. For instance, it is prescribed in Article 18(2) that documents in support of a request to record a change in ownership be certified as being in conformity with the original. This would entail certification of a translation of these documents, where the original documents are not in a language admitted by the Office.

Note 10.03 *Subparagraph (b)*. The question as to who may be a “representative” admitted to make a translation for the purposes of this paragraph is a matter for the applicable law of the Party concerned. A Party may provide that only a representative who is a registered agent is allowed to translate a communication.

Note 10.04 *Subparagraph (d)*. This provision was included following the comments made by delegations at the twenty-fifth session. In order to safeguard certainty, this subparagraph provides that a Party may require a statement that the translation conforms to the original communication. It would be for each Party to determine who can validly make such statement. Such statement could be

¹¹ At the twenty-sixth session of the SCT, the Delegation of Brazil proposed that this paragraph be amended in order to allow parties to allow the authentication, legalization or other certification of any signature where the law of the Party so provided.

made, for example, by a representative admitted to practice before the Office or by an official translator.

- Note 10.05 *Paragraph (3)* has been added following the discussion at the twenty-sixth session of the SCT, so as to allow a Party to require that a communication contain indications prescribed in the Regulations, such as the name and address of the applicant, holder of other interested person, or the number of the application or registration to which the communication relates. The paragraph is modeled on Article 8(5) of the PLT.
- Note 10.06 *Paragraph (4)* is partly modeled on Article 8(6) of the PLT. An indication of an address for correspondence, an address for service, or any other prescribed address or contact details, may be required by any Party in any communication. In particular, indication of an address for correspondence or an address for service may be required where a Party does not require representation, but requires that the applicant have an address for service or an address for correspondence in the territory concerned.
- Note 10.07 Under this provision, a Party may also require the indication, in a communication, of contact details of the applicant, holder, or other interested person. The contact details that may be required, as prescribed in Rule 7(2)(b), are a telephone number, a facsimile number or an email address.
- Note 10.08 *Paragraph (5)* deals with the signature of communications on paper. Consistent with the aim of simplification, this paragraph provides that no attestation, notarization, authentication, legalization or other certification of any signature may be required, except in those cases prescribed in the Regulations. To balance the absence of certification of any signature, the paragraph further provides for the possibility for an Office to require, in cases of reasonable doubt, evidence of the authenticity of a signature.

Article 11 **Renewal**

(1) *[Request for Renewal; Fee]* (a) *Where a 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;*

(vi) 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;

(vii) 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 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 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 Party, subject to the minimum periods prescribed in the Regulations.

(3) [Prohibition of Other Requirements] No 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.

Notes on Article 11

- Note 11.01 It will be recalled that document SCT/24/3 contained draft provisions concerning the structure of the duration of the protection of an industrial design, which established an initial term of protection of five years, renewable for additional five-year terms, up to the maximum period prescribed by the applicable law.
- Note 11.02 The present document does not include such provisions, as the discussion that took place at the twenty-fourth session confirmed that SCT members have very different positions concerning the structure of the protection.
- Note 11.03 This Article deals exclusively with the contents of a request for renewal and the period for presenting such request or for paying the renewal fees. As explicitly indicated in *paragraph (1)*, the provision will only apply to those Parties which provide for renewal in their law.
- Note 11.04 *Item (iv)* was added following the twenty-fifth session of the SCT, as in some countries, renewal can be requested for one or several further terms of protection, at the option of the holder.

Article 12 **Relief in Respect of Time Limits**

(1) [Extension of Time Limits] A 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 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]¹² Where an applicant or holder has failed to comply with a time limit fixed by the Office for an action in a procedure before the Office, and the applicable law does not provide for the extension of a time limit under paragraph (1)(ii), the applicable law shall 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) 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 Party may require that a fee be paid in respect of a request under paragraph (1) or (2).*

(5) *[Prohibition of Other Requirements] No 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 these Articles 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.*

Notes on Article 12

Note 12.01 Both the Singapore Treaty and the PLT contain provisions on relief measures. Those provisions are intended to add some flexibility to the consequences that derive from the non-observance of a time limit. Without any relief measure, missing a time limit generally results in a loss of rights, which, in the case of patents and industrial designs, is irreparable.

Note 12.02 Because of the irreparable nature of a patent loss, the approach to relief measures is different in the Singapore Treaty and in the PLT. A trademark may be filed again; a lost patent, as a lost industrial design, is irretrievable.

Note 12.03 Under the Singapore Treaty, while a Contracting Party is free to provide for the extension of a time limit prior to the expiry of such time limit, it has an obligation to provide for one or more of the following relief measures after the expiry of a time limit: extension of the time limit, continued processing, or reinstatement of rights.

Note 12.04 Under the PLT, prior to the expiry of a time limit fixed by the Office, a Contracting Party is free to provide for the extension of such time limit. After the expiry of a time limit fixed by the Office, a Contracting Party is obliged to

¹² [At the twenty-sixth session of the SCT, the Delegation of Brazil proposed to make paragraph \(2\) of Article 12 optional.](#)

provide for a relief measure in the form of either an extension of the time limit, or continued processing.

- Note 12.05 In addition, a Contracting Party is obliged to provide for reinstatement of rights in case of failure of the applicant or holder to comply with a time limit entailing a loss of rights, where the Office concerned finds that such failure occurred in spite of due care having been taken or that the delay was unintentional.
- Note 12.06 The provisions presented in this document follow the approach of the PLT to relief measures, considering that loss of an industrial design is, as in the case of patents, irretrievable. This feature warrants an approach which makes available reinstatement of rights in case of failure of the applicant or holder to comply with a time limit entailing a loss of rights, under certain circumstances.
- Note 12.07 *Article 12* requires a Party to provide relief in respect of time limits. Such relief may be in the form of an extension of a time limit under paragraph (1) and/or continued processing under paragraph (2). The relief that a Party has to provide under paragraphs (1) and (2) is restricted to time limits “fixed by the Office for an action in a procedure before the Office.” The term “procedure before the Office” is defined in Article 1(x). As regards the term “time limit fixed by the Office”, it is for each Party to decide which time limits, if any, are fixed by the Office. It follows that Article 12 does not apply to time limits that are not fixed by the Office, in particular, time limits established by national legislation or under a regional treaty. Neither does Article 12 apply to time limits for actions that are not before the Office, for example, actions before a court. Consequently, in respect of such other time limits, a Party would be free to apply the same requirements, apply other requirements, or make no provision for relief (other than reinstatement of rights under Article 13).
- Note 12.08 *Paragraph (2)*. This paragraph obliges a Party to provide for relief in the form of continued processing, after the applicant or owner has failed to comply with a time limit fixed by the Office, where that Party does not provide for the extension of time limits under paragraph (1)(ii). The effect of such continued processing is that the Office continues with the procedure concerned as if that time limit had been complied with. Also, the Office must, if necessary, reinstate the rights of the applicant or holder with respect to the application or registration concerned.
- Note 12.09 Exceptions to the applicability of relief measures and reinstatement of rights are provided for in *paragraph (3)*. Such exceptions are intended to prevent an applicant or holder from abusing a system of relief measures, for example by obtaining double relief in respect of a procedure.

Article 13

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

Option 1

[(1) *[Reinstatement of Rights]* A Party shall 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 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 Party may require that a fee be paid in respect of a request under paragraph (1).
- (4) [Evidence] A 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.]

Option 2

(1) [Reinstatement of Rights] A Party 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 Party, that any delay was unintentional.

(2) [Exceptions] A Party that provides for the reinstatement of rights under paragraph (1) shall not be required to provide for such reinstatement with respect to the exceptions prescribed in the Regulations.

(3) [Fees] A Party that provides for reinstatement of rights under paragraph (1) may require that a fee be paid in respect of a request under paragraph (1).

(4) [Evidence] A Party that provides for reinstatement of rights under paragraph (1) 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.]

Notes on Article 13

- Note 13.01 Following the twenty-sixth session of the SCT, two options concerning this Article are submitted for discussion. Under the first option, this Article obliges a Party to provide for the reinstatement of rights with respect to an application or registration following failure to comply with a time limit for an action in a procedure before the Office. In contrast to Article 12, such reinstatement is subject to a finding by the Office that the failure occurred in spite of all due care required by the circumstances or, at the option of the Party, was unintentional. Also in contrast to Article 12, Article 13 is not restricted to time limits fixed by the Office, although it is subject to certain exceptions under paragraph (2) and Rule 11(3). Under the second option, reinstatement of rights becomes optional.
- Note 13.02 *Paragraph (1)*, introductory words. The condition that maintains “that failure has the direct consequence of causing a loss of rights with respect to an application or registration” is intended to avoid circumventing the exclusions provided under Rule 11(3).
- Note 13.03 At the twenty-fifth session of the SCT, one delegation suggested to include a provision on correction or addition of a priority claim and restoration of priority right, modeled on Article 13 of PLT. That provision would permit the applicant to correct or add a priority claim to an application which could have claimed the priority of an earlier application, but did not do so. The provision would also provide for the restoration of the priority right where a subsequent application is filed after the expiration of the priority period, but within a time limit prescribed in the Regulations. It would apply only where the failure to file the application within the priority period occurred in spite of all due care required by the circumstances having been taken, or, at the option of the Party, was unintentional. Considering that no discussion has taken place on this matter in previous sessions of the SCT, the provision in question has not been included in the present draft. However, the SCT, if it so wishes, may initiate a discussion on this matter and request the inclusion of a provision modeled on Article 13 of the PLT.

Article 14

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 Party provides for the recording of a license, that 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]*¹³ (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 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.

(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 Party provides for such recording.

(7) *[Request for Recording of a Security Interest]* Paragraphs (1) to (5) shall apply, mutatis mutandis, to requests for the recording of a security interest in respect of an application or registration¹⁴.

Notes on Article 14

Note 14.01 This Article is based on the provisions on the recording of licenses of the Singapore Treaty and the PLT. Following the twenty-fourth session of the SCT, details on the requirements concerning the request for recording of a license or a security interest, along with those concerning supporting documents, have been transferred to the draft Regulations.

Note 14.02 It follows from the introductory words of *paragraphs (1) and (2)* that there is no obligation for a Party to provide for the recording of licenses. However, it follows from *paragraph (4)(a)* that, where the applicable law provides for such recording, no indication or element other than those prescribed in Rule 12(1), or in Article 10, concerning “communications”, may be required. Similarly, a Party may not require any other document than those listed in Rule 12(2).

¹³ [At the twenty-sixth session of the SCT, the Delegation of Brazil proposed to delete paragraph \(4\).](#)

¹⁴ [At the twenty-sixth session of the SCT, the Delegation of Brazil suggested adding a new paragraph to Article 14, as follows: \[\(8\) The provisions in Articles 14 and 15 are without prejudice of any measures required for the control of potentially anti-competitive practices in contractual licenses\].](#)

- Note 14.03 At the twenty-sixth session of the SCT, one delegation proposed to delete paragraph (4) with a view that the provision stipulate minimum standards rather than maximum. Another delegation said, however, that is was important to set maximum requirements, with a view to simplifying and streamlining procedures.
- Note 14.04 Following the comments made by several delegations during the twenty-fifth session of the SCT, paragraph (4) does not exclude the furnishing of the license contract, or a translation of it. Under Rule 12(2)(a), a Party may require that the request for the recording of a license be accompanied, at the option of the requesting party, by an extract of the agreement or a copy of the license agreement.
- Note 14.05 This provision does not prevent any authorities of a Party, for example tax authorities or authorities establishing statistics, from requiring the parties to a license to furnish information in accordance with the applicable law of that Party.
- Note 14.06 Under *paragraph (6)*, the applicable requirements apply also to the recording of licenses in respect of *applications*, but only where the law of a Party provides for such recording. This provision, which is also contained in the Singapore Treaty, was included following the twenty-fourth session of the SCT.
- Note 14.07 *Paragraph (7)*, concerning a request for the recording of a security interest, is based on Rule 17(9) of the Regulations under the PLT. It relates to the recording of a security interest in an application or registration, acquired by contract for the purpose of securing payment or performance of an obligation, such as a mortgage or a pledge, or for the purpose of indemnifying against loss or liability. As in the case of the recording of a license under paragraph (1), there is no obligation for a Party to provide for the recording of a security interest. Moreover, any Party which does allow for such recording is free to decide which security interests may be recorded.

Article 15
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 Party provides for the recording of a license, that 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 14(2) to (5) 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.*

Note on Article 15

Note 15.01 Articles 15, 16 and 17 are modeled on Articles 18, 19 and 20 of the Singapore Treaty.

Article 16 **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 the 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 Party may not require the recording of a license as a condition for any right that the licensee may have under the law of that 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 license¹⁵.

Notes on Article 16

Note 16.01 *Paragraph (1).* The purpose of this paragraph is to separate the question of the validity of the registration of an industrial design and the protection of the industrial design from the question as to whether a license concerning the said industrial design was recorded. If the law of a Party provides for the mandatory recording of licenses, non-compliance with that requirement may not result in the invalidation of the registration of the industrial design which is the subject of the license, and may not affect in any way the protection afforded to that industrial design. It is to be noted that this paragraph concerns the recording of a license with the Office or any other authority of a Party such as, for example, the tax authority or the authority responsible for the establishment of statistics.

Note 16.02 Moreover, it is to be noted that this provision does not preclude a requirement for the registration of a license as a condition for the validity of the license contract.

Note 16.03 *Paragraph (2).* This provision does not intend to harmonize the question whether a licensee should be allowed to join proceedings initiated by the licensor, or whether it would be entitled to damages resulting from an infringement of the licensed industrial design. This question is left to the applicable law. However, where a licensee has the right under the law of a Party to join infringement proceedings initiated by the holder and to obtain damages resulting from an infringement of the licensed industrial design, the licensee should be able to exercise those rights independently of whether the license is recorded.

¹⁵ At the twenty-sixth session of the SCT, the Delegation of Brazil suggested to delete paragraph (2) or, at least, to make it optional.

Note 16.04 At the twenty-sixth session of the SCT, one delegation suggested to delete paragraph (2) or, at least, to make it optional. However, three other delegations did not support this position, as administrative oversight should not result in the loss of a property right.

Article 17 **Indication of the License**

Where the law of a 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.

Note on Article 17

Note 17.01 Article 17 leaves it to the law of a Party to prescribe whether or not products which are commercialized under a licensed industrial design must bear an indication of the fact that the industrial design is used under a license contract. However, where such indication is required by the applicable law, non-compliance with that obligation should not entail the invalidation of the registration of the industrial design in whole or in part.

Article 18 **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 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 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 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 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 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 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 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 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 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.*

Notes on Article 18

Note 18.01 This provision is based, to a large extent, on the provisions on the recording of a change in ownership in the Singapore Treaty and the PLT.

Note 18.02 *Paragraphs (1) and (2)* provide for the general requirements concerning a request for change in ownership and the supporting documents. Details concerning such request and supporting documents are provided for in the Regulations.

Note 18.03 *Paragraph (3).* Under this paragraph, a Party may require the payment of a fee in respect of a request. Each Party is free to determine the amount of the fee, depending, *inter alia*, on the number of applications or registrations concerned by the change in ownership.

Note 18.04 *Paragraph (5)* makes it clear that a change in ownership may also be recorded in respect of an application. The manner of identifying the application where the application number has not yet issued or is not known to the applicant is provided for in the Regulations.

Article 19 **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 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 Party may require that the request contain some, or all, of the indications prescribed in the Regulations.

(c) A 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 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 required¹⁶.

(5) [Evidence] Any 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.

Notes on Article 19

Note 19.01 This Article was introduced following the twenty-fifth session of the SCT. It is modeled on Article 10 of the Singapore Treaty.

Note 19.02 Paragraph (1)(c). Under this paragraph, a Party may require the payment of a fee in respect of a request. Each Party is free to determine the amount of the fee, depending, *inter alia*, on the number of registrations concerned by the changes.

Article 20 **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.

¹⁶ At the twenty-sixth session of the SCT, the Delegation of China suggested deleting the last sentence of this paragraph.

- (b) *A 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 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 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 Party, that it was made without intentional delay, following the discovery of the mistake.*
- (2) *[Fees]*
- (a) *Subject to subparagraph (b), a 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 18(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 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 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 the Articles or prescribed in the Regulations.*
- (6) *[Exclusions] A Party may exclude the application of this Article in respect of any mistake which must be corrected in that Party under a procedure for reissue of the registration.*

Notes on Article 20

- Note 20.01 This Article was inserted following the twenty-fifth session of the SCT. It is modeled on Rule 18 of the PLT, rather than on Article 12 of the Singapore Treaty, taking into account that the issues arising from the correction of a mistake regarding an industrial design may be more akin to those concerning patents.
- Note 20.02 This Article regulates the formal requirements and procedures concerning the request for correction of a mistake. It does not regulate the substantive requirements which a Party may apply in determining the allowability of a correction. For example, a Party may require that the correction be obvious in the sense that it is unequivocally clear that nothing else could have been intended than what is offered as the correction. It also does not regulate corrections in the application which are not the subject of a request for correction, in particular, the amendment of the description or the representation of the industrial designs, either voluntarily following the receipt of a search report, or in the course of substantive examination.

- Note 20.03 *Paragraph (1)(a)*, introductory words. The expression “mistake in the records of the Office” is to be interpreted in light of the definition of the term “records of the Office” under Article 1(xii). Examples of mistakes which could be the subject of a request under paragraph (1) are mistakes in the bibliographic data or in details concerning a priority claim. It follows from the wording “which is correctable under the applicable law” that the question of which mistakes are correctable is not regulated by this Article. As regards the terms “applicant” and “holder,” reference is made to the explanations given under Article 1(xiii) and (xiv).
- Note 20.04 *Paragraph (1)(b)*. This provision allows a Party to require that a replacement part (for example, a replacement page in the case of an application filed on paper), or a part incorporating the correction (for example, an errata sheet), be filed. In the case where the request applies to more than one application and/or registration, an Office may require that a separate replacement part, or part incorporating the correction, be filed for each application and registration, to facilitate the work of the Office.
- Note 20.05 *Paragraph (1)(c)*. This provision permits a Party to refuse a request for correction of a mistake where the requesting party is unable to file a declaration that the said mistake was made in good faith, for example, where the mistake was made with deceptive intention. It is a matter for the Party concerned to decide what constitutes good faith.
- Note 20.06 *Paragraph (1)(d)*. This provision permits a Party to refuse a request for correction of a mistake where there was undue or intentional delay in making the request after the discovery of the mistake. It is a matter for the Party concerned to decide what constitutes undue or intentional delay; for example, it may consider that there is undue delay where the request is not diligently made.
- Note 20.07 *Paragraph (4)*. This paragraph permits a Party to require evidence in the case of any request for correction where, for example, notwithstanding the declaration referred to in paragraph (1)(c), there is reasonable doubt as to whether the mistake was made in good faith, or where there is reasonable doubt as to whether the request was made without undue or intentional delay following the discovery of the mistake in accordance with paragraph (1)(d).

Article 21 **Regulations**

- (1) [Content] *The Regulations under these Articles provide rules concerning:*
- (i) *matters which these Articles expressly provide to be prescribed in the Regulations;*
 - (ii) *any details useful in the implementation of the provisions of these Articles;*
 - (iii) *any administrative requirements, matters or procedures.*

(2) [Conflict Between the Articles and the Regulations] In the case of conflict between these Articles and the Regulations, the former shall prevail.

[End of Annex and of document]