

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

**Riyadh, November 11 to 22, 2024**

### **NOTES ON THE BASIC PROPOSAL FOR THE DESIGN LAW TREATY (DLT)**

*Document prepared by the Secretariat*

The present document contains Explanatory Notes on the Basic Proposal for the Design Law Treaty (DLT), contained in document DLT/DC/3 (the “Basic Proposal”). The Explanatory Notes are not part of the Basic Proposal and will not be adopted by the Diplomatic Conference. Where a conflict exists between the Explanatory Notes and the Basic Proposal, the latter shall prevail.

## NOTES ON THE BASIC PROPOSAL FOR THE DESIGN LAW TREATY (DLT)

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## NOTES ON ARTICLE 1: ABBREVIATED EXPRESSIONS

1.01 *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.

1.02 The term “application” in item (iv) should be understood in a broad sense, including an application that contains one industrial design and an application that contains more than one industrial design.

1.03 *Item (viii)*. The expression “procedure before the Office” covers any procedure in which an applicant, holder or other interested person communicates with the Office, either to initiate proceedings before the Office or in the course of such proceedings. It covers all procedures in proceedings before the Office and is therefore not restricted to those procedures which are referred to in express terms. Examples of such procedures are the filing of an application, the filing of a request for the recording of a license, the payment of a fee, the filing of a response to a notification issued by the Office, or the filing of a translation of an application. It also covers procedures in which the Office contacts an applicant, holder or other interested person in the course of proceedings relating to an application or a registration, for example, the issuance of a notification that an application does not comply with certain requirements, or the issuance of a receipt for a document or a fee.

1.04 *Item (ix)*. 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.

1.05 *Item (x)*. The term “records of the Office” is used, rather than “register of industrial designs”, to acknowledge the situation of Contracting Parties that grant design patents and do not maintain industrial design registers. It should be noted that this term is supposed to be used for the application of the provision only. It is sufficiently broad to encompass the notion of national or regional registers of industrial designs, when they exist, and would not prevent the use of the term “register of industrial designs” by individual Contracting Parties.

1.06 *[Item (xxiv)]*. At the Third Special Session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT), the Delegation of Brazil proposed to add this item in Article 1, stating that time limits expressed in “months” can be calculated by Contracting Parties in accordance with their national law.

## NOTES ON ARTICLE 2: APPLICATIONS AND INDUSTRIAL DESIGNS TO WHICH THIS TREATY APPLIES

2.01 *Paragraph (1)*. The Treaty would apply to national applications which are filed with the Office of a State, as well as to applications which are filed with, or for, the Office of a regional intergovernmental organization. The latter are referred to in this paragraph as “regional applications”. Examples of intergovernmental organizations that maintain an Office are the African Intellectual Property Organization (OAPI)<sup>1</sup>, the African Regional Intellectual Property

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<sup>1</sup> OAPI registers designs with effect in the States party to the Bangui Agreement (<https://www.oapi.int/index.php/fr/>).

Organization (ARIPO)<sup>2</sup>, the Benelux Organization for Intellectual Property (BOIP)<sup>3</sup>, the Eurasian Patent Organization (EAPO)<sup>4</sup> and the European Union<sup>5</sup>.

2.02 The expression “applications which are filed ... for the Office of a Contracting Party” covers, in particular, applications for regional registration that are filed with the Office or other competent authority of a member State of a regional intergovernmental organization for onward transmission to the Office of that organization.

2.03 The Treaty is intended to apply to applications for registration. At the Third Special Session of the SCT, the Delegation of the United States of America proposed to add the terms “and to divisional applications thereof” under Article 2(1). Divisional applications are provided for in Article 8(1).

2.04 While it would not have to do so, a Contracting Party could apply some, or all, of the provisions of the Treaty to any specific type of application provided for in its law and not covered by paragraph (1), such as “converted”, “amended”, or “continuation” applications.

2.05 *Paragraph (2)*. The Treaty does not contain a definition of industrial design. The Treaty 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 Contracting Party.

2.06 Given the specific nature of the procedures established under the Hague Agreement Concerning the International Registration of Industrial Designs, the Treaty would not apply to such procedures.

### NOTES ON ARTICLE 3: APPLICATION

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 Contracting Party (including indications and elements prescribed in the Regulations), paragraph (2) makes it clear that no further element may be required by a Contracting Party in an application, except those elements that may be required under Article 10 (“Communications”). Establishing a closed list of elements contributes to create a predictable framework for industrial design procedures, and is therefore of the outmost importance, with a view to simplifying and streamlining such procedures.

3.02 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 Contracting Party may require some only, rather than all, of the elements listed. For instance, no Contracting Party would be obliged to require a claim (see Rule 2(1)(ii)). A claim would presumably not be required by a Contracting Party that protects industrial designs under a registration system, as opposed to a system of protection under patent law.

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<sup>2</sup> ARIPO registers designs with effect in any designated State party to the Harare Protocol of the Lusaka Agreement (<https://www.aripo.org/>).

<sup>3</sup> BOIP registers designs with effect in the three Benelux countries.

<sup>4</sup> EAPO registers designs with effect in the States party to the Eurasian Patent Convention (<https://www.eapo.org/en/>).

<sup>5</sup> The European Union Intellectual Property Office (EUIPO) registers designs with effect in the member states of the European Union.

3.03 This Article sets out the elements of a general nature in an application, those required by virtually all Contracting Parties. Elements of a 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.

3.04 *Paragraph (1)(a). Item (i).* A Contracting Party may require that the request for registration be made on an official form, established by the Office of the Contracting Party.

3.05 *Item (ii).* Each Contracting Party may determine the details concerning the name and address. For example, a Contracting Party could permit that, for privacy considerations, the applicant provides only an address for correspondence, and not necessarily a home address.

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.

3.07 *Item (vi).* Each Contracting Party may determine how the indication of the product or products should be provided. A Contracting Party may require, for example, that the indication of the product or products be in the form of a title to the application or in any other specific form.

3.08 *Item (ix).* The text of item (ix) under Alternative A was proposed by the African Group at the thirty-fourth session of the SCT. The text of item (ix) under Alternative B, along with the corresponding footnote, was proposed by Ambassador Socorro Flores Liera (Mexico) to the fifty-first (24<sup>th</sup> ordinary) session of the WIPO General Assembly, held in Geneva from September 30 to October 9, 2019.

3.09 *Paragraph (1)(b).* This paragraph addresses the payment of a fee in respect of applications. However, it does not regulate to whom the fee is paid, for example, whether it is paid to the Office, another agency of the government or a bank. It also does not regulate the method of payment, so that each Contracting Party is free to decide whether to allow payments made, for example, from a deposit account with the Office or by electronic transaction, or whether to require, for example, in the case of applications filed electronically, that fees be paid by using a deposit account. A Contracting Party is also permitted to require the amount of the fee and/or its method of payment to be indicated, for example, on a fee sheet.

3.10 *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 used 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 costs.

3.11 In order to balance the interests of users and offices, acceptance of “multiple applications” by a Contracting Party is subject to compliance, by the applicant, with the conditions prescribed in the Contracting Party’s applicable law. This provision does not prescribe the conditions under which multiple applications are to be admitted. Each Contracting Party would be free to determine under what conditions it admits multiple applications. For example, a Contracting 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.

3.12 With respect to a given application, a Contracting Party will be able to process it as a multiple application if the application conforms to the conditions prescribed in the Contracting Party's law or, if that is not the case, to request the applicant to either amend the application to comply with those conditions or divide the application into two or more applications (see Article 8(1)).

#### **NOTES ON ARTICLE 4: REPRESENTATIVES; ADDRESS FOR SERVICE OR ADDRESS FOR CORRESPONDENCE**

4.01 This Article is modeled, to a large extent, on Article 7 of the Patent Law Treaty (PLT) and Article 4 of the Singapore Treaty on the Law of Trademarks (Singapore Treaty).

4.02 This Article does not apply to representatives who are employees or officials of a legal entity (whether applicant or holder), for example, executive officers or in-house counsels of a corporation. It typically applies to agents and attorneys in private practice. This Article relates only to the appointment itself and to the possible limitation of the appointment, but does not deal with the termination of the appointment. In the latter respect, and in respect of any other matter relating to representation which is not covered by the Treaty, a Contracting Party will apply its own law. For example, a Contracting Party may provide that the appointment of a new representative terminates the appointment of all previous representatives. Or a Contracting Party may allow sub-representation and, in that case, require that, where the power of a representative extends to the appointment of one or more sub-representatives, the power of attorney expressly authorize a representative to appoint such sub-representatives.

4.03 *Paragraph (1)(a)*. Item (i) of this paragraph enables a Contracting 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 does not prevent a Contracting Party from having a less strict requirement.

4.04 A Contracting 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 Contracting Party may, in particular, require that the address be in its own territory.

4.05 *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.

4.06 *Paragraph (2)*. This paragraph is divided into two subparagraphs. Subparagraph (a) permits, but does not oblige, a Contracting 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 and for the mere payment of a fee. The ability for a Contracting 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 Contracting Party. This limitation is modeled on Article 4(2)(a) of the Singapore Treaty.

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 two exceptions to the principle established in subparagraph (a). The first permits an applicant who has neither a domicile nor a real and effective industrial or commercial establishment in the

territory of a Contracting 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 Contracting Party and even if the Contracting Party concerned requires that such applicant appoint a representative to file an application. After according the filing date, the Contracting 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 Contracting Party may apply a sanction provided for in its law, including, for example, considering the application to be abandoned.

4.08 The second exception to the principle established under subparagraph (a) permits an applicant, holder or other interested person who has neither a domicile nor a real and effective industrial or commercial establishment in the territory of a Contracting Party to act himself/herself before the Office for the mere payment of a fee.

4.09 The expression “mere payment of a fee” permits a Contracting Party to require representation for any other act that is associated with the payment of the fee concerned, for example, a request for search or examination. Any Contracting Party may decide what constitutes a “mere” payment of a fee.

4.10 *Paragraph (3)*. A Contracting 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 Contracting Party concerned. This requirement is viewed as less stringent than the appointment of a representative.

## **NOTES ON ARTICLE 5: FILING DATE**

5.01 *Paragraph (1)(a)* sets out a list of requirements that may be established by a Contracting Party for the purpose of according a filing date. The importance of keeping the list of filing-date requirements to the minimum has been reiterated several times, 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”.

5.02 *Item (i)*. Contracting Parties will be free to decide whether, in a specific case, an indication can be considered as an “express or implicit indication to the effect that the elements are intended to be an application”.

5.03 *Item(v)*. At the Third Special Session of the SCT, the Delegation of India proposed to add the terms “any further indication or element as prescribed under the applicable law” under Article 5(1).

5.04 It is made clear in paragraph (1)(a), read in conjunction with subparagraph (b), that a Contracting Party may require that the filing-date requirements be filed in a language admitted by the Office, to give the application 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.

5.05 *Paragraph (1)(b)*. The drafting of paragraph (1)(b) makes it clear that, while a Contracting 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.

5.06 At the Third Special Session of the SCT, the Delegation of the European Union presented a proposal whereby, in addition to a sufficiently clear representation, the indications allowing the identity of the applicant to be established should always be a filing-date requirement. The proposal is reflected in brackets in paragraph (1)(b).

5.07 *Paragraph (2)* was presented to the SCT by the Chair of the twenty-ninth session of the SCT in a non-paper. This paragraph permits a Contracting Party to require additional filing-date requirements, provided that they are present in the Contracting Party's law at the time it becomes party to the Treaty and are notified to the Director General in a declaration. Under subparagraph (c), the declaration may be withdrawn at any time. The effect of withdrawing the declaration would be that, after the withdrawal, the Contracting Party concerned would be in a position to require only the indications or elements listed under paragraph (1)(a) for the purpose of the filing date.

5.08 *Paragraph (3)* makes it clear that the list provided for in paragraphs (1)(a) and (2)(b) 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.

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.

5.10 *Paragraph (5)* addresses the issue of the filing date when all the filing-date requirements are complied with after the date of filing the application. Usually, the filing date is the date on which all the indications and elements required by the Contracting 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 Contracting Party under paragraphs (1) and (2) are received by the Office.

## **NOTES ON ARTICLE 6: GRACE PERIOD FOR FILING IN CASE OF DISCLOSURE**

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.

6.02 At the twenty-seventh session of the SCT, delegations agreed to a grace period of six or 12 months. A period of six or 12 months gives flexibility to Contracting Parties to choose between two periods. At the same time, a period of six or 12 months addresses, to a certain extent, the concern of certain delegations and representatives of users regarding the uncertainty created by a period of "at least six months".



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 a person who obtained information about the industrial design directly or indirectly from the creator or his/her successor in title. The notion of information obtained “directly or indirectly” from the creator or his/her successor in title is broad and expressly encompasses information obtained as a result of an abuse. 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.

6.04 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 Contracting Party. A Contracting 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) and (ii) of Article 6 and, consequently, does not give rise to a grace period.

6.05 *Paragraph (2).* At the Third Special Session of the SCT, the Delegation of China proposed to add a paragraph 2 under Article 6, reflected in brackets. Under that paragraph, a Contracting Party would be able to notify, in a declaration, that the grace period is triggered by acts other than those identified in paragraph (1). A Contracting Party would be able to make the declaration only if its law, at the time it becomes party to the Treaty, provides that a grace period is triggered by those acts.

6.06 At the Third Special Session of the SCT, the Delegations of Japan, India and the United States of America, respectively, also made proposals on Article 6, which are reflected in brackets.

#### **NOTES ON ARTICLE 7: REQUIREMENT TO FILE THE APPLICATION IN THE NAME OF THE CREATOR**

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.

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 Contracting 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.

#### **NOTES ON ARTICLE 8: AMENDMENT OR DIVISION OF APPLICATION INCLUDING MORE THAN ONE INDUSTRIAL DESIGN**

8.01 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 more than one industrial design. If an application containing more than one industrial design does not fulfill the applicable conditions, then the Office would be in a position to require the applicant to, at his/her option, amend the application, for example by suppressing the industrial designs that do not meet the applicable conditions, or to divide it 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.

8.02 The aim of this provision is to enable an applicant to rectify a mistake in filing an application for more than one industrial design (“initial application”), where some of the industrial designs do not comply with the conditions prescribed by the Contracting Party for an application to include more than one industrial design. The option is given to the applicant to correct the mistake by either amending the application or dividing it. 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.

8.03 *Paragraph (1)*. Following the discussion at the twenty-eighth session of the SCT, the possibility of amendment of the initial application to comply with the conditions of a Contracting Party was added to this paragraph. Prior versions of draft Article 8(1) provided only for a single mechanism to soften the effects of a mistake in an initial application, namely division of the initial application.

8.04 The words “the Office may require the applicant” make it clear that the type of amendment or division envisaged in this provision is one required by the Office, as explained in Note 8.01, above. This provision does not cover the situation in which an applicant amends or divides the application on his/her own initiative. Contracting Parties can provide for such type of amendment or division in their legislation, if they so wish, but are not required to do so under this provision.

8.05 The words “at the option of the applicant” make it clear that, while the Office may require action to “correct” an initial application, it is for the applicant to choose between amendment and division.

8.06 Following the discussion at the twenty-eighth session of the SCT, the definitions of “initial application” and “divisional applications” are now contained in Article 8(1) instead of in Article 1. This approach follows that of the Singapore Treaty, and is justified by the fact that the terms “initial application” and “divisional applications” are used in the context of this Article.

8.07 *Item (ii)*. 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 Contracting 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 Contracting 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.

8.08 The words “those conditions” in item (ii) refer to the conditions prescribed by the Contracting Party concerned in accordance with Article 3(3). In other words, they refer to the conditions prescribed under the applicable law of the Contracting Party concerned.

## **NOTES ON ARTICLE 9: PUBLICATION OF THE INDUSTRIAL DESIGN**

9.01 *Paragraph (1)*. Under this paragraph, a Contracting Party would be required to allow the industrial design to be maintained unpublished for a period fixed by its applicable law, subject to the minimum period prescribed in the Regulations. 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.

9.02 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 Contracting Party to determine the period above the prescribed minimum period during which an industrial design may be maintained unpublished.

9.03 With regard to the different existing systems for maintaining an industrial design unpublished, the article does not provide for a specific system. Thus, a Contracting 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, where publication takes place after registration or grant of protection, by delaying the payment of the registration fees or delaying the grant of protection.

9.04 The language of paragraph (1) and the general structure of Article 9 aim to accommodate the different existing systems for maintaining an industrial design unpublished. Thus, paragraph (1) has been drafted in a general manner. It requires a Contracting Party to allow an industrial design to be maintained 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 or delaying the grant of protection, without having to file any request as such.

9.05 *Paragraph (2)*. This paragraph gives the possibility to a Contracting 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.

9.06 *Paragraph (3)*. This paragraph 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.

9.07 It is understood that no Office will be required to publish an industrial design where, under the law of the Contracting Party concerned, publication of such industrial design would be considered to be prejudicial to the national security of the Contracting Party.

## **NOTE ON ARTICLE 9BIS: TERM OF PROTECTION**

9bis.01 At the Third Special Session of the SCT, two different proposals were made on the term of protection, one by the Delegation of the United States of America and another by the Delegation of Nigeria.

## **NOTES ON ARTICLE 9<sup>TER</sup> AND 9<sup>QUATER</sup>: ELECTRONIC INDUSTRIAL DESIGN SYSTEM**

9<sup>ter</sup>.01 At the Third Special Session of the SCT, the Delegation of the United States of America proposed a provision on an electronic industrial design system, contained in a proposed Article 9<sup>ter</sup>.

9<sup>quater</sup>.01 At the Third Special Session of the SCT, the Delegation of Nigeria proposed a provision on an electronic industrial design system, contained in a proposed Article 9<sup>quater</sup>.

## **NOTE ON ARTICLE 9<sup>QUINQUIES</sup>: EXCEPTIONS FOR PUBLICLY ACCESSIBLE DESIGN DATABASES**

9<sup>quinquies</sup>.01 At the Third Special Session of the SCT, the Delegation of Nigeria proposed a provision on exceptions for publicly accessible design databases, contained in a proposed Article 9<sup>quinquies</sup>.

## **NOTES ON ARTICLE 10: COMMUNICATIONS**

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

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 Contracting 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 Treaty. For instance, it is prescribed in Article 19(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.

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 Contracting Party concerned. A Contracting Party may provide that only a representative who is a registered agent is allowed to translate a communication.

10.04 *Subparagraph (d)* provides that a Contracting Party may require a statement that the translation conforms to the original communication. It would be for each Contracting Party to determine who can validly make such statement. Such statement could be made, for example, by a representative admitted to practice before the Office or by an official translator.

10.05 *Paragraph (3)* 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 Contracting Party in any communication. In particular, indication of an address for correspondence or an address for service may be required where a Contracting Party does not require representation, but requires that the applicant have an address for service or an address for correspondence in the territory concerned.

10.06 Under this provision, a Contracting 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(1)(b), are a telephone number, a telefacsimile number or an email address.

10.07 *Paragraph (4)* 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 respect of quasi-judicial proceedings or 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.

10.08 *Paragraph (7)* allows a Contracting Party to require that a communication contain indications prescribed in the Regulations, such as the name and address of the applicant, holder or 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.

## **NOTES ON ARTICLE 11: RENEWAL**

11.01 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 Contracting Parties which provide for renewal in their law.

11.02 *Paragraph (1)(a)(item (iii))*. Under this provision, Contracting Parties may allow that a single request for renewal relates to more than one registration, provided that the numbers of all registrations concerned are indicated in the request.

11.03 *Item (iv)* takes into account that, in some countries, renewal can be requested for one or several further terms of protection, at the option of the holder.

11.04 *Paragraph (1)(b)*. This paragraph enables a Contracting Party to charge fees in respect of renewals. However, it does not regulate to whom the fee is paid, for example, whether it is paid to the Office, another agency of the government or a bank. It also does not regulate the method of payment, so that each Contracting Party is free to decide whether to allow payments made, for example, from a deposit account with the Office or by electronic transaction, or whether to require, for example, in the case of renewals filed electronically, that fees be paid by using a deposit account. A Contracting Party is also permitted to require the amount of the fee and/or its method of payment to be indicated, for example, on a fee sheet.

## **NOTES ON ARTICLE 12: RELIEF IN RESPECT OF TIME LIMITS**

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.

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.

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.

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

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.

12.06 The provisions presented 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.

12.07 Article 12 requires a Contracting 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 Contracting 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(viii). As regards the term "time limit fixed by the Office", it is for each Contracting 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 Contracting 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).

12.08 *Paragraph (2)*. This paragraph presents two options, shown in brackets. Under the first option, a Contracting Party would be obliged to provide for relief in the form of continued processing, after the applicant or holder has failed to comply with a time limit fixed by the Office, where that Contracting Party does not provide for the extension of time limits under paragraph (1)(ii). This is the approach followed by the PLT. 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.

12.09 The second option presented in brackets is to make the provision under Article 12(2) optional. This option was proposed by the Delegation of India at the Third Special Session of the SCT. The proposal was supported by the Delegation of China.

12.10 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.

## **NOTES ON ARTICLE 13: REINSTATEMENT OF RIGHTS AFTER A FINDING BY THE OFFICE OF DUE CARE OR UNINTENTIONALITY**

13.01 *Paragraph (1)*. This paragraph presents two options, shown in brackets. Under the first, Contracting Parties would be obliged 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 Contracting 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).

13.02 At the Third Special Session of the SCT, the Delegation of India proposed to make the provision under Article 13(1) optional.

13.03 The phrase “that failure has the direct consequence of causing a loss of rights with respect to an application or a registration” is intended to cover the situations where a failure to comply with a time limit directly causes a loss of rights with respect to the application or registration. An example of this could be the case where the required filing fee is not paid when filing a design application. In that case, the Office of the Contracting Party will issue an invitation requesting the applicant to pay the filing fee. The invitation will set a specified period for response. If the filing fee is not paid within the specified period, the design application will be dismissed as the direct consequence of the expiration of the specified period. That failure would thus have the direct consequence of causing a loss of rights with respect to the application concerned. A Contracting Party would therefore have to provide for reinstatement of rights under Article 13. As regards the term “procedure before the Office”, reference is made to the explanation under Article 1(viii).”

13.04 This Article is modeled on Article 12 of the PLT. However, the jurisprudence and practice developed in the field of patents in respect of reinstatement of rights would not be necessarily applicable in the interpretation of this provision with respect to industrial designs.

## **NOTES ON ARTICLE 14: CORRECTION OR ADDITION OF PRIORITY CLAIM; RESTORATION OF PRIORITY RIGHT**

14.01 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. At the twenty-eighth session of the SCT, two delegations, supported by a third, proposed to look into the question of a correction or addition of priority claim and restoration of a priority right. The delegations presented for discussion a draft Article 13bis, modeled on Article 13 of the PLT. Following the thirtieth session of the SCT, this Article has been renumbered as Article 14 to follow the natural numbering sequence.

14.02 Article 14 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. It would apply both where the application filed contained no priority claim (addition of priority claim) and where the application already claimed priority of one or more earlier applications (correction of priority claim). 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 Contracting Party, was unintentional.

## NOTES ON ARTICLE 15: REQUEST FOR RECORDING OF A LICENSE OR A SECURITY INTEREST

15.01 This Article is based on the provisions on the recording of licenses of the Singapore Treaty and the PLT.

15.02 In accordance with the introductory words of paragraphs (1) and (2), there is no obligation for a Contracting 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 13(1), or in Article 10, concerning “communications”, may be required. Similarly, a Contracting Party may not require any other document than those listed in Rule 13(2).

15.03 *Paragraphs (2) and (3)*. Under paragraph (2), a Contracting Party may require the payment of a fee in respect of the recording of a license. Each Contracting Party would be free to determine the amount and structure of the fee. For instance, while under paragraph (3) a Contracting Party would be required to accept a single request for recording a license that relates to more than one registration, the Contracting Party would be free to establish a fee structure for such single request based on the number of applications or registrations concerned by the request. In other words, the Contracting Party could determine that the total amount of the fee to be paid in respect of a single request for the recording of a license relating to more than one registration is dependent on the number of applications or registrations.

15.04 *Paragraph (4)* does not exclude the furnishing of the license contract, or a translation of it. Under Rule 13(2)(a), a Contracting 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.

15.05 This provision does not prevent any authorities of a Contracting Party, for example tax or monetary authorities or authorities establishing statistics, or anti-monopoly or authoritative competition bodies, from requiring the parties to a license to furnish information in accordance with the applicable law of that Contracting Party.

15.06 *Paragraph (6)*. Under this paragraph, the applicable requirements apply also to the recording of licenses in respect of applications, but only where the law of a Contracting Party provides for such recording. This provision is also contained in the Singapore Treaty.

15.07 *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 Contracting Party to provide for the recording of a security interest. Moreover, any Contracting Party which does allow for such recording is free to decide which security interests may be recorded.

15.08 It follows from the introductory words of paragraph (7), “With the exception of paragraph (4)(a)(ii)”, that an indication of the financial terms of the security interest may be required by a Contracting Party for recording a security interest.



## **NOTES ON ARTICLE 16: REQUEST FOR AMENDMENT OR CANCELLATION OF THE RECORDING OF A LICENSE OR A SECURITY INTEREST**

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

## **NOTES ON ARTICLE 17: EFFECTS OF THE NON-RECORDING OF A LICENSE**

17.01 *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 Contracting 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 Contracting Party such as, for example, the tax or monetary authority or the authority responsible for the establishment of statistics.

17.02 *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, this provision deals with the question whether, where a licensee has the right under the law of a Contracting 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.

17.03 The provision presents two alternative options, appearing in brackets. Under one of those options, the words “may not” would be maintained, so that the recording of a license will not be a condition for the licensee to join infringement proceedings initiated by the holder and to obtain damages, where those rights are provided for by the applicable law. This would follow the approach in the STLT (see Articles 19(2) and 29(4) of the STLT). Under the other option, the word “not” would be deleted, so that a Contracting Party will be able to require that the license be recorded, as a condition for the licensee to join infringement proceedings initiated by the holder or to obtain damages.

## **NOTES ON ARTICLE 18: INDICATION OF THE LICENSE**

18.01 Article 18 leaves it to the law of a Contracting 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.

## **NOTES ON ARTICLE 19: REQUEST FOR RECORDING OF A CHANGE IN OWNERSHIP**

19.01 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.

19.02 *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.

19.03 *Paragraph (3)*. Under this paragraph, a Contracting Party may require the payment of a fee in respect of a request. Each Contracting 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. For instance, while under paragraph (4) a Contracting Party would be required to accept a single request for recording a change that relates to more than one registration, the Contracting Party would be free to establish a fee structure for such single request based on the number of applications or registrations concerned by the request. In other words, the Contracting Party could determine that the total amount of the fee to be paid in respect of a single request is dependent on the number of applications or registrations concerned by the change.

19.04 *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.

## **NOTES ON ARTICLE 20: CHANGES IN NAMES OR ADDRESSES**

20.01 This Article is modeled on Article 10 of the Singapore Treaty.

20.02 *Paragraph (1)(c)*. Under this paragraph, a Contracting Party may require the payment of a fee in respect of a request. Each Contracting Party is free to determine the amount of the fee, depending, *inter alia*, on the number of registrations concerned by the changes. For instance, while under paragraph (1)(d) a Contracting Party would be required to accept a single request for recording a change that relates to more than one registration, the Contracting Party would be free to establish a fee structure for such single request, based on the number of applications or registrations concerned by the request. In other words, the Contracting Party could determine that the total amount of the fee to be paid in respect of a single request relating to more than one registration is dependent on the number of applications or registrations concerned by the change.

## **NOTES ON ARTICLE 21: CORRECTION OF A MISTAKE**

21.01 This Article 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.

21.02 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 Contracting Party may apply in determining the allowability of a correction. For example, a Contracting 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.

21.03 *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(x). 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 by the Office under the applicable law” that the question of which mistakes are correctable is not regulated by this Article.

21.04 *Paragraph (1)(b)*. This provision allows a Contracting 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.

21.05 *Paragraph (1)(c)*. This provision permits a Contracting 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 Contracting Party concerned to decide what constitutes good faith.

21.06 *Paragraph (1)(d)*. This provision permits a Contracting 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 Contracting 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.

21.07 *Paragraph (4)*. This paragraph permits a Contracting 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).

#### **NOTES ON [ARTICLE 22] [RESOLUTION]: TECHNICAL ASSISTANCE AND CAPACITY BUILDING**

22.01 At the Third Special Session of the SCT, the Delegation of the United States of America proposed to put the whole Article 22/Resolution in brackets.

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