

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

### **Twenty-Ninth Session**

**Geneva, May 27 to 31, 2013**

### **INDUSTRIAL DESIGN LAW AND PRACTICE – DRAFT REGULATIONS**

*Document prepared by the Secretariat*

#### **INTRODUCTION**

1. At the twenty-eighth session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (hereinafter referred as “the Standing Committee” or “the SCT”), held in Geneva from December 10 to 14, 2012, the Chair of the SCT concluded that the Secretariat was requested to prepare revised working documents for consideration of the SCT at its twenty-ninth session, which should reflect all comments made at that session and highlight the different proposals put forward by delegations by using square brackets, strikethrough, underlining or footnotes, as appropriate (see paragraph 6 of document SCT/28/7).
2. As in the three previous sessions of the SCT, the documents prepared for the twenty-ninth session follow a two-level approach. Document SCT/29/2 contains an Annex with draft Articles, *i.e.* provisions of a general nature. The present document includes an Annex containing draft Regulations, which further elaborate upon a number of the draft Articles.
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 presented for consideration.

[Annex follows]

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## **Rule 1** **Abbreviated Expressions**

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

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

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

### Note on Rule 1

Note 1.01 This Rule was included following the comments made at the twenty-fifth session of the SCT.

## **Rule 2** **Details Concerning the Application**

(1) *[Further Requirements Under Article 3]* In addition to the requirements provided for in Article 3, a Contracting Party may require that an application contain some, or all, of the following indications or elements<sup>1</sup>:

- ~~(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;~~
- (i) an indication of the class of the Locarno Classification to which belongs the product which incorporates the industrial design, or in relation to which the industrial design is to be used;

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<sup>1</sup> [At the twenty-eighth session of the SCT, the Delegation of the Republic of Korea proposed to add two new items to this paragraph, namely :](#)

[\(xvi\) an indication of partial design;](#)

[\(xvii\) a request for earlier publication.](#)

- (ii) a claim;
  - (iii) a statement of novelty;
  - (iv) a description;
  - (v) indications concerning the identity of the creator of the industrial design;
  - (vi) a statement that the creator believes himself/ herself to be the creator of the industrial design;
  - (vii) where the applicant is not the creator of the industrial design, a statement of assignment or, at the option of the applicant, other evidence of the transfer of the design to the applicant admitted by the Office;
  - (viii) where the applicant is a legal entity, the legal nature of that legal entity and the State, and, where applicable, the territorial unit within that State, under the law of which the said legal entity has been organized;
  - (ix) the name of a State of which the applicant is a national if he/she is the national of any State, the name of a State in which the applicant has his/her domicile, if any, and the name of a State in which the applicant has a real and effective industrial or commercial establishment, if any;
  - (x) an indication of any prior application or registration, or other information, of which the applicant is aware, that could have an effect on the eligibility for registration of the industrial design;
  - (xi) where the applicant wishes to maintain the industrial design unpublished for a period of time, a request to that effect;
  - (xii) where the application includes more than one industrial design, an indication of the number of industrial designs included;
  - (xiii) an indication of the term of protection for which the application is filed;
  - (xiv) where a Contracting Party requires payment of a fee in respect of an application, evidence that the payment was made.
- (2) [Requirements in Case of Divisional Applications] A Contracting Party may require that, where an application is to be treated as a divisional application, the application contain the following:
- (i) an indication to that effect;
  - (ii) the number and filing date of the initial application.

#### Notes on Rule 2

Note 2.01 Paragraph (1). Item (i). No Contracting Party will be obliged to require an indication of the class of the Locarno Classification.

- Note 2.02 *Item (ii)* refers to claims, in the sense of patent law. A claim under this item could be required by a Contracting Party in which industrial designs are protected under patent law. No Contracting Party will be obliged to require a claim.
- Note 2.03 *Item (iv)*. A Contracting Party will be free to determine the form and contents of the description. The description includes a brief description, as provided by national legislation.
- Note 2.04 *Item (vi)* may be required in an application both where the applicant is the creator of the industrial design and where the applicant is not the creator of the industrial design.
- Note 2.05 *Item (vii)*. Where the applicant is not the creator of the industrial design, a Contracting Party may require evidence of the transfer of the industrial design from the creator to the applicant. It is for each Contracting Party to decide whether or not to require such evidence. Where a Contracting Party does require such evidence, the applicant would, in principle, have the option between two forms of evidence, i.e. a statement of assignment or other evidence of the transfer admitted by the office, for example the complete deed of assignment. *Item (vii)* makes it clear that, if the applicant wants to provide another form of evidence apart from a statement of assignment, such evidence must be admitted by the office. Thus, if an office does not admit other form of evidence but a statement of assignment, the applicant will have to provide a statement of assignment.
- Note 2.06 *Item (x)* enables an Office to obtain information that could affect the registrability of the industrial design, or to ascertain whether filing took place within the applicable grace period. The term “novelty”, used in a previous version of the document, was replaced by “eligibility for registration”, so as to not unnecessarily narrow down the scope of this provision.
- Note 2.07 *Item (xiii)*. No Contracting Party will be obliged to provide for separate terms of protection. However, where a Contracting Party does enable the applicant to choose among different initial terms of protection, an indication of the term for which the application is filed will be needed.
- Note 2.08 *Item (xiv)*. The term “evidence” is meant to include a copy of receipt, but may be interpreted wider so as to cover all form of payment.

**Rule 3**  
**Details Concerning Representation of the Industrial Design**

(1) [Form of Representation of the Industrial Design] (a) *The representation of the industrial design shall, at the option of the applicant, be in the form of:*

- (i) *photographs;*
- (ii) *graphic reproductions;*
- (iii) *any other visual representation admitted by the Office;*
- (iv) *a combination of any of the above.*

(b) *The representation of the industrial design may, at the option of the applicant, be in color or in black and white.*

(c) *The industrial design shall be represented alone, to the exclusion of any other matter.*

(2) [Particulars Concerning ~~Reproduction~~ Representation] Notwithstanding paragraph (1)(c), the ~~reproduction~~ representation of the industrial design may include:

(i) matter that does not form part of the claimed design if it is identified as such in the description and/or it is shown by means of dotted or ~~stippled~~ broken lines, ~~to indicate matter that does not form part of the claimed design;~~

(ii) *shading, to show the contours or volume of a three-dimensional design<sup>2</sup>.*

(3) [Views]<sup>3</sup> (a) *The industrial design may, at the option of the applicant, be represented by one view that fully discloses the industrial design, or by several different views that fully disclose the industrial design.*

(b) *Notwithstanding subparagraph (a), additional, specific views may be required by the Office where such views are necessary to fully show the product or products that incorporate the industrial design or in relation to which the industrial design is to be used. However, additional views disclosing new matter affecting the industrial design, which are not derivable from the original view or views, do not have to be admitted.*

(4) [Number of Copies of Representation] *No more than one copy of any representation of the industrial design may be required where the application is filed electronically, and no more than three copies<sup>4</sup> where the application is filed on paper.*

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<sup>2</sup> At the twenty-seventh session of the SCT, the Delegation of Peru proposed that items (i) and (ii) of Rule 3(2) read as follows:

“(i) *dotted or stippled lines;*  
(ii) *shading.*”

<sup>3</sup> At the twenty-eighth session of the SCT, the Delegation of China proposed to add a subparagraph (c) to Rule 3(3), which would read as follows: “Notwithstanding subparagraph (a), the part in solid lines that indicates the matter of industrial design protection should satisfy the requirements of the Office”.

<sup>4</sup> At the twenty-eighth session of the SCT, the Delegation of India proposed to replace “three copies” by “four copies”.

### Notes on Rule 3

- Note 3.01 *Paragraph (1)*. Under this provision, applicants would have the choice as to the form of representation of the industrial design for which protection is sought. Applicants would thus have the possibility of representing the industrial design by means, for example, of photographs, graphic reproductions, such as drawings, or a combination thereof.
- Note 3.02 The words “any other visual representation” are intended to cover other forms of representation, such as computer-animated representations, or forms which are not currently known, but which may develop in the future. It is also intended to cover specimens, if they are admitted by the Office. It is understood that, whatever the form which the representation of the industrial design may take, it should always be visual.
- Note 3.03 It is generally agreed that the industrial design should be represented in such a way as to completely disclose its appearance. While several views of the design may be needed to fully disclose certain designs, it cannot be excluded that even a three-dimensional design could be fully disclosed by means of a single view, such as, for example, a perspective view.
- Note 3.04 *Paragraph (2)*. An applicant may indicate matter in the representation of the industrial design for which protection is not claimed, for example environmental matter. Such matter, while not part of the industrial design itself, can help to better understand the nature of the design. The applicant can indicate the matter for which protection is not claimed by means of dotted or broken lines in the representation of the industrial design, or by means of a description.
- Note 3.05 *Paragraph (3)* of this provision leaves it to the applicant to determine, on a case by case basis, the number and types of views which are needed to fully disclose the industrial design. Thus, applicants would no longer need to vary the number of views to satisfy the requirements of the different jurisdictions in which they file.
- Note 3.06 At the same time, this provision enables Offices to call for further views where they consider that such views are necessary to fully show the product or products that incorporate the industrial design. The provision was re-drafted following the twenty-sixth session of the SCT in order to make it clear that additional views can be required in order to show all aspects of the product incorporating the industrial design. However, the industrial design itself must be disclosed by the views as originally filed.
- Note 3.07 The wording of subparagraph (b) was modified following the twenty-sixth session of the SCT so as to clarify that the Office will determine whether or not an additional view results in the presentation of new matter.
- Note 3.08 This provision does not establish any maximum number of views which may be filed by the applicant, or published by an Office. Opting for a given number would present an inconvenience, as it is not unlikely that such number could rapidly become obsolete. An Office that is not presently in a position to publish more than a given number of views without additional cost could soon be able to increase that number, taking into account the pace at which new reproduction methods develop. Moreover, it is not unlikely that new reproduction techniques will make it easier for applicants to fully represent complex designs by means of fewer views.

Note 3.09 In the absence of a provision regarding a maximum number of views, each Contracting Party remains free to introduce a limitation in its law in this respect, and to determine the maximum number. It is understood that such maximum number should not be too low, so that all types of designs, including very complex ones, can be fully disclosed under existing reproduction techniques.

Note 3.10 *Paragraph (4)*. Arguably, applications that are filed electronically do not require more than one copy of the reproduction, or reproductions, as the case may be. With regard to applications filed on paper, the returns to the WIPO Questionnaires on Industrial Design Law and Practice show that the vast majority of SCT Members that replied to the Questionnaires (72 per cent) require between one and three copies (see document SCT/19/6). Moreover, discussions in the SCT have revealed that, while receiving more than one copy could sometimes facilitate the processes for offices, there was rarely any practical need for offices to receive nowadays more than three copies. In previous sessions of the SCT (see, in particular, the twenty-first session), delegations that declared that more than three copies were required under their current legislation pointed out that the number of reproductions could be brought down to three or less in future amendments. As for applicants, limiting the number of copies of each reproduction in an application filed on paper would result in an advantage in terms of simplification at the time of preparing the application.

#### **Rule 4**

#### **Details Concerning Representatives, Address for Service or Address for Correspondence**

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

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

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

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

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

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



#### Notes on Rule 4

- Note 4.01 *Paragraph (1)(a)*. Following the twenty-fifth session of the SCT, this provision was revised to follow the approach of Article 4(3)(a) of the Singapore Treaty on the Law of Trademarks (Singapore Treaty) instead of, as in the previous draft, the approach of Rule 7(2) of the Regulations under the Patent Law Treaty (PLT). In the draft submitted to the twenty-fifth session of the SCT, a Contracting Party would have had to accept the appointment of a representative made either in a separate power of attorney or in the application. Under the present draft, a Contracting Party may require that the appointment of a representative be made in a separate power of attorney. No reference is made to an appointment made in the application. The power of attorney should indicate the name of the applicant, holder, or other interested person, as well as the name and address of the representative. The elements required in the power of attorney are modeled, however, on Rule 7(2)(a)(i) of the PLT, rather than on Article 4(3)(a) of the Singapore Treaty. The elements required in the Singapore Treaty are limited to an indication of the name of the applicant, the holder or any other interested person.
- Note 4.02 *Paragraph (1)(b) and (c)* is based on Article 4(3)(b) and (c) of the Singapore Treaty. It contains permissive provisions regarding the mode of appointing a representative and the contents of a power of attorney. Given its permissive nature, paragraph (1)(c) would not be applicable to any Contracting Party that does not contemplate in its law the possibility of withdrawal of the application or surrender of the registration.
- Note 4.03 In document SCT/27/3, *paragraph (2)* presented two options regarding the minimum time limit to comply with the requirements that a Contracting Party may have concerning representatives, including the requirement to submit a power of attorney to appoint a representative. At the twenty-seventh session of the SCT, delegations expressed their preference for Option 2, which is the one that has been retained in the present document. The proposal put forward in the present document distinguishes between two time limits, one or two months, depending on whether or not the address of the person appointing the representative is in the territory of the Contracting Party concerned. The reason for this distinction is that a minimum time limit of one month is considered to be too short when the address is not in the territory of the Contracting Party in which the representative is appointed, particularly for the purpose of obtaining a power of attorney. This distinction is also made in Rule 4(3) of the Regulations under the Singapore Treaty.
- Note 4.04 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 Rule. This is the first time in the draft Rules 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.

**Rule 5**  
**Details Concerning Filing Date**

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

Note on Rule 5

Note 5.01 This Rule provides for a one-month time limit to comply with any missing filing-date requirement. A one-month time limit has been opted for, taking into account the ability for any applicant, in an era of electronic communication, to respond quickly to a notification, along with the relevance of the irregularities concerned, which have an effect on the filing date. Any Contracting Party may provide for a time limit of more than one month to comply with a missing filing-date requirement, although it will be in the interest of the applicant to comply with the requirement as soon as possible.

**Rule 6**  
**Details Concerning Publication**

*The minimum period referred to in Article 9(1) shall be six months from the filing date or, where priority is claimed, from the priority date.*

Notes on Rule 6

Note 6.01 This Rule provides for a minimum period of six months from the filing date or the priority date, during which an Office has to maintain an industrial design unpublished, if so wished by the applicant. A short period of six months has been opted for, in an attempt to strike a balance between the interest of applicants for secrecy and the interest of other parties. Other parties will most likely want to have the industrial design published as soon as possible, in order to have an idea of what is protected.

Note 6.02 The Rule stipulates that the starting point of the six-month period is the filing date or, where priority is claimed, the priority date. It is true that, in many cases, where priority is claimed, the minimum period to maintain, upon request, the industrial design unpublished in the countries of second filing might be reduced or no longer available. However, as indicated by some delegations at the twenty-fifth session of the SCT, this approach would be consistent with the aim of the provision, namely to ensure that the applicant will be able to maintain the industrial design unpublished during a short period of time from the “beginning” of the registration procedures. Furthermore, this solution would better accommodate the different national approaches to postponement of publication.

**Rule 7**  
**Details Concerning Communications**

(1) *[Indications Under Article 10(3)]* (a) A Contracting Party may require that any communication:

(i) *indicate the name and address of the applicant, holder or other interested person;*

(ii) *indicate the number of the application or registration to which it relates:*

(iii) *contain, where the applicant, holder or other interested person is registered with the Office, the number or other indication under which he/she is so registered.*

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

(i) *the name and address of the representative;*

(ii) *a reference to the power of attorney on the basis of which the representative acts;*

(iii) *where the representative is registered with the Office, the number or other indication under which he/she is registered.*

(2) *[Details Concerning Article 10(4)]* (a) A Contracting Party may require that the address for correspondence referred to in Article 10(4)(i) and the address for service referred to in Article 10(4)(ii) be in a territory prescribed by that Contracting Party.

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

(i) *a telephone number;*

(ii) *a telefacsimile number;*

(iii) *an email address.*

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

(i) *an indication, in letters, of the family or principal name and the given or secondary name or names, of that person or, at the option of that person, of the name, or names, customarily used by the said person;*

(ii) *an indication of the capacity in which that person signed, where such capacity is not obvious from reading the communication.*

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

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

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

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

(7) *[Signature of Communications on Paper Filed by Electronic Means of Transmittal] A Contracting Party that provides for communications on paper to be filed by electronic means of transmittal shall consider any such communication signed if a graphic or other representation of a signature accepted by that Contracting Party under paragraph (5) appears on the communication as received.*

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

- (i) accompanied by a letter identifying that earlier transmission; and*
- (ii) within a time limit which shall be at least one month<sup>5</sup> from the date on which the Office received the communication by electronic means of transmittal.*

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

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

- (i) a branch or sub-office of the Office;*
- (ii) a national Office on behalf of the Office of the Contracting Party, where the Contracting Party is an intergovernmental organization;*
- (iii) an official postal service;*

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<sup>5</sup> [At the twenty-eighth session of the SCT, the Delegation of India proposed to replace the time limit of "at least one month" by a time limit of "at least 15 days".](#)

- (iv) a delivery service, or an agency, specified by the Contracting Party;
- (v) an address other than the nominated address(es) of the Office.

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

#### Notes on Rule 7

- Note 7.01 *Paragraph (1)*, as well as Article 10(3) to which this paragraph refers, have been added following the twenty-sixth session of the SCT. This paragraph is modeled on Rule 10(1) of the PLT.
- Note 7.02 *Item (i)* of paragraph (1). It will be for each Contracting Party to determine the specific manner in which names and addresses are to be indicated. For instance, in the case of natural persons, a Contracting Party may specify that the name to be indicated is the family or principal name and the given or secondary name(s) of the natural person. In the case of legal entities, a Contracting Party may specify that the name to be indicated is the full official designation of the legal entity.
- Note 7.03 *Paragraphs (3) to (11)* are modeled on Rule 6 of the Regulations under the Singapore Treaty.
- Note 7.04 *Paragraph (6)* provides that a Contracting Party may require certification of any signature of a communication on paper, where the communication concerns the withdrawal of an application or the surrender of a registration and the law of the Contracting Party provides for such certification. It is understood that, given its permissive nature, this provision will not be applicable where the law of a Contracting Party does not provide for such certification, or does not provide for withdrawal of an application or surrender of a registration.
- Note 7.05 Specifying in a Rule the case in which certification of signature may be required is justified by the fact that the Regulations constitute a more flexible framework to provide for other cases of certification of signature in the future, or remove any.

### **Rule 8** **Identification of an Application Without Its Application Number**

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

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

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

#### Note on Rule 8

Note 8.01 This Rule is modeled on Rule 7 of the Regulations of the Singapore Treaty.

### **Rule 9 Details Concerning Renewal**

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

#### Note on Rule 9

Note 9.01 This Rule concerns the period within which any renewal fee must be paid and any request for renewal that may be required must be submitted. It establishes, in particular, a period of grace of at least six months after the date on which the renewal is due, to pay the fee and to submit the request for renewal, which may be subject to the payment of a surcharge. A grace period for the payment of fees for the maintenance of rights is already provided for in Article 5bis of the Paris Convention. The interest of this provision is that it also provides for a grace period for submitting any request for renewal that may be required.

### **Rule 10 Details Concerning Relief in Respect of Time Limits**

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

(i) *be signed by the applicant or holder;*

(ii) *contain an indication to the effect that an extension of a time limit is requested, and an identification of the time limit in question.*

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

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

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

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

(i) *be signed by the applicant or holder;*

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

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

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

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

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

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

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

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

(vi) *relief in respect of a time limit for the correction or addition of a priority claim.*

#### Note on Rule 10

Note 10.01 This Rule is modeled on Rule 12 of the Regulations under the PLT.

#### **Rule 11**

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

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

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

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

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

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

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

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

(iii) *for an action in inter partes proceedings;*

(iv) *for filing a declaration which, under the law of the Contracting Party, may establish a new filing date for a pending application;*

(v) *for the correction or addition of a priority claim.*

#### Notes on Rule 11

Note 11.01 This Rule is vastly modeled on Rule 13 of the Regulations under the PLT.

Note 11.02 *Paragraph (2).* In *item (i)*, the minimum time limit of one month was replaced by two months, following the twenty-eighth session of the SCT. A minimum time limit of two months is also provided in Rule 13(2)(i) of the PLT.

Note 11.03 *Paragraph (3).* Following the suggestion of a delegation at the twenty-fifth session of the SCT, a further exception, provided for in *item (iv)*, was added. The same exception is contained in Rule 9(4)(vii) of the Singapore Treaty. Under *item (iv)*, a Contracting Party may exclude the application of relief measures in respect of the filing of a declaration which may have the effect of establishing a new filing date for a pending application. This may apply where the law of a Contracting Party provides for a system by which the date of an amendment of a pending application becomes the filing date of a new application based on that amendment. In such a case, the filing date should be fixed as early as possible to preserve the rights of third parties.

#### **[Rule 11bis Details Concerning Correction or Addition of Priority Claim and Restoration of Priority Right Under Article 13bis**

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

(2) [Time Limit Under Article 13bis(1)(ii)] The time limit referred to in Article 13bis(1)(ii) shall not be less than six months from the priority date or, where the correction or addition would cause a change in the priority date, six months from the priority date as so changed, whichever six-month period expires first, provided that the request may be submitted until the expiration of two months from the filing date.



(3) [Time Limits Under Article 13bis(2)] The time limits referred to in Article 13bis(2), introductory part, and Article 13bis(2)(ii) shall expire not less than one month from the date on which the priority period expired.

(4) [Requirements Under Article 13bis(2)(i)] A Contracting Party may require that a request referred to in Article 13bis(2)(i):

(i) be signed by the applicant; and

(ii) be accompanied, where the application did not claim the priority of the earlier application, by the priority claim.]

#### Note on Rules 11bis

Note 11bis.01 This Rule contains details concerning Article 13bis. Following the twenty-eighth session of the SCT, the Rule is presented for discussion at the request of two delegations, supported by a third. The present document reproduces it within brackets.

#### **Rule 12**

#### **Details Concerning the Requirements Concerning the Request for Recording of a License or a Security Interest or for Amendment or Cancellation of the Recording of a License or a Security Interest**

(1) [Content of Request] (a) A Contracting Party may require that the request for the recording of a license under Article 14(1) or (6) contain some, or all, of the following indications or elements:

(i) the name and address of the holder;

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

(iii) where the holder has an address for service or an address for correspondence, such address;

(iv) the name and address of the licensee;

(v) where the licensee has a representative, the name and address of that representative;

(vi) where the licensee has an address for service or an address for correspondence, such address;

(vii) where the licensee is a legal entity, the legal nature of that legal entity and the State, and, where applicable, the territorial unit within that State, under the law of which the said legal entity has been organized;

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

(ix) *the registration number of the industrial design which is the subject of the license;*

(x) *where the license is not granted in respect of all the industrial designs contained in a registration, the industrial design number(s) for which the license is granted;*

(xi) *whether the license is an exclusive license, a non-exclusive license or a sole license;*

(xii) *where applicable, that the license concerns only a part of the territory covered by the registration, together with an explicit indication of that part of the territory;*

(xiii) *the duration of the license.*

(b) *A Contracting Party may require that the request for amendment or cancellation of the recording of a license under Article 15(1) contain some or all of the following indications or elements:*

(i) *the indications specified in items (i) to (ix) of subparagraph (a);*

(ii) *the nature and scope of the amendment to be recorded or an indication that cancellation is to be recorded.*

(2) *[Supporting Documents for Recording of a License] (a) Where the license is a freely concluded agreement, a Contracting Party may require that the request for the recording of a license be accompanied, at the option of the requesting party<sup>6</sup>, by one of the following:*

(i) *a copy of the agreement, which copy may be required to be certified, at the option of the requesting party<sup>7</sup>, by a notary public or any other competent public authority or, where permitted under the applicable law, by a representative having the right to practice before the Office, as being in conformity with the original agreement;*

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

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

(c) *Where the license is not a freely concluded agreement, for example, it results from operation of law or a court decision, a Contracting Party may require that the request be accompanied by a copy of a document evidencing the license. A Contracting Party may also*

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<sup>6</sup> At the twenty-seventh session of the SCT, the Delegation of Brazil proposed to delete the words "at the option of the requesting party" in this subparagraph.

<sup>7</sup> At the twenty-seventh session of the SCT, the Delegation of Brazil proposed to delete the words "at the option of the requesting party" in this item.

*require that the copy be certified as being in conformity with the original document, at the option of the requesting party, by the authority which issued the document or by a notary public or any other competent public authority or, where permitted under the applicable law, by a representative having the right to practice before the Office.*

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

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

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

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

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

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

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

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

#### Notes on Rule 12

Note 12.01 *Rule 12(1)(a)(xi).* Definitions of “exclusive license”, “sole license” and “non-exclusive license” are provided in Rule 1. There is no requirement for a Contracting Party to recognize all three types of license. Where the law of a Contracting Party does not provide for all three types of license, the requirement under this item will be limited to an indication of the types of licenses which are provided for under that law. Similarly, if the law of a Contracting Party does not require any such indication, information under item (xi) will not have to be furnished.

Note 12.02 *Paragraph (2).* Following the twenty-fifth session of the SCT, this paragraph was modeled on Rule 17(2) of the PLT, rather than on Rule 10(2) of the Singapore Treaty. The main difference between the two approaches is that, in the PLT, provision is expressly made for the case where the license is not a freely concluded agreement. Moreover, where the license is a freely concluded agreement, a copy of the agreement, and not only an extract of the agreement, may accompany the request for recording of the license.

Note 12.03 Where the license is a freely concluded agreement, this provision permits a Contracting Party to require that the request for the recording of the license be accompanied by a copy of the agreement or an extract of the agreement, at the

option of the requesting party. In other words, while a Contracting Party may require documentation supporting the license, it should accept as such documentation either a copy of the agreement or an extract of the agreement. It is for the requesting party to decide which of the two it wishes to submit.

- Note 12.04 The words “portions of that agreement” in item (ii) include, in particular, information regarding the territory and duration of the licensing agreement, and whether there is a right to sub-license.
- Note 12.05 Pursuant to Article 10(2)(b), a Contracting Party may require that the documents referred to in paragraphs (2), (3) and (4) be accompanied by a translation into a language admitted by the Office.

### **Rule 13**

#### ***Details Concerning the Request for Recording of a Change in Ownership***

(1) *[Content of Request] A Contracting Party may require that the request for the recording of a change in ownership under Article 18 contain some, or all, of the following indications:*

- (i) an indication to the effect that a recording of a change in ownership is requested;*
- (ii) the number of the registration concerned by the change;*
- (iii) the name and address of the holder;*
- (iv) the name and address of the new owner;*
- (v) the date of the change in ownership;*
- (vi) where the new owner is a legal entity, the legal nature of that legal entity and the State, and, where applicable, the territorial unit within that State, under the law of which the said legal entity has been organized;*
- (vii) the name of a State of which the new owner is a national if he/she is the national of any State, the name of a State in which the new owner has his/her domicile, if any, and the name of a State in which the new owner has a real and effective industrial or commercial establishment, if any;*
- (viii) where the holder has a representative, the name and address of that representative;*
- (xix) where the new owner has a representative, the name and address of that representative;*
- (x) where the new owner is required to have an address for service or an address for correspondence, such address;*
- (xi) the basis for the change requested.*

(2) *[Requirements Concerning Supporting Documents for Recording of a Change in Ownership]*<sup>8</sup> A Contracting Party may require that the request for the recording of a change in ownership be accompanied, at the option of the requesting party, by one of the following:

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

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

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

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

### Note on Rule 13

Note 13.01 This Rule is modeled on Article 11(1)(b) and (f) of the Singapore Treaty.

### **Rule 14**

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

A Contracting Party may require that the request for the recording of a change in name and/or address under Article 19 contain some, or all, of the following indications:

(i) *the name and address of the holder;*

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

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

### **Rule 15**

#### **Details Concerning the Request for Correction of a Mistake**

A Contracting Party may require that the request for correction of a mistake under Article 20 contain some, or all, of the following indications:

(i) *an indication to the effect that a correction of mistake is requested;*

(ii) *the number of the application or registration concerned;*

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<sup>8</sup> [At the twenty-eighth session of the SCT, the Delegation of Canada proposed to amend Rule 13\(2\) to read as follows: "\[Requirements Concerning Documents for Recording of a Change in Ownership Resulting from a Contract\] A Contracting Party may require that the request for the recording of a change in ownership resulting from a contract be accompanied, at the option of the requesting party, by one of the following..."](#)

- (iii) *the mistake to be corrected;*
- (iv) *the correction to be made;*
- (v) *the name and address of the requesting party.*

[End of Annex and of document]