

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

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TEMPORARY PROTECTION PROVIDED TO INDUSTRIAL DESIGNS AT CERTAIN
INTERNATIONAL EXHIBITIONS UNDER ARTICLE 11 OF THE PARIS CONVENTION FOR
THE PROTECTION OF INDUSTRIAL PROPERTY: DRAFT QUESTIONNAIRE

Document prepared by the Secretariat

INTRODUCTION

1. At the fortieth session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT), which was held in Geneva from November 12 to 16, 2018, the Delegation of Spain presented a “Proposal for a Study on the Protection of Industrial Designs at Trade Shows in Member States” (document SCT/40/8). The proposal aimed at preparing and conducting a survey among Member States to determine how the protection provided for by Article 11 of the Paris Convention for the Protection of Industrial Property¹ (hereinafter “the Paris Convention”) is implemented and how the term “official or officially recognized international exhibitions” is interpreted.
2. The Chair of the fortieth session of the SCT concluded that “the Secretariat would prepare a draft questionnaire concerning the proposal contained in document SCT/40/8 for consideration by the Committee at its next session” (document SCT/40/9, paragraph 15).

¹ Article 11 of the Paris Convention reads as follows: “(1) The countries of the Union shall, in conformity with their domestic legislation, grant temporary protection to patentable inventions, utility models, industrial designs, and trademarks, in respect of goods exhibited at official or officially recognized international exhibitions held in the territory of any of them. (2) Such temporary protection shall not extend the periods provided by Article 4. If, later, the right of priority is invoked, the authorities of any country may provide that the period shall start from the date of introduction of the goods into the exhibition. (3) Each country may require, as proof of the identity of the article exhibited and of the date of its introduction, such documentary evidence as it considers necessary”.

3. Accordingly, the present document contains a *Draft Questionnaire on the Temporary Protection Provided to Industrial Designs at Certain International Exhibitions Under Article 11 of the Paris Convention for the Protection of Industrial Property*. It also provides background on the origin of Article 11 of the Paris Convention and its subsequent amendments.

BACKGROUND

4. The lack, uncertainty or inadequacy of the protection of inventions at universal exhibitions was one of the reasons leading to the conclusion of the Paris Convention². The problem came to the fore at the 1873 International Exhibition in Vienna, where it proved difficult to invite foreign inventors and creators to exhibit their inventions and creations because no adequate protection was guaranteed³. On the occasion of that exhibition, a congress was convened to deliberate on the reform of patent law. Subsequently, two international conferences on industrial property, held in Paris in 1878 and 1880, considered a draft Convention for the Protection of Industrial Property, which was approved at the International Conference of 1883 in Paris.

5. The original text of Article 11 of the Paris Convention (1883) read as follows: “*The High Contracting Parties undertake to grant temporary protection to patentable inventions, industrial designs and trade marks in respect of goods exhibited at official or officially recognized international exhibitions*”⁴. Contracting parties remained however free to determine the means of achieving the temporary protection⁵.

6. Several proposals aiming at amending or removing Article 11 were made at subsequent Revision Conferences.

7. At the Revision Conference in Brussels (1900), a proposal for a more detailed provision was put forward. However, Article 11 was amended only to clarify two points: (i) that the Contracting Parties had an obligation to legislate on the subject according to their domestic law and (ii) that the temporary protection was to be granted, whether the exhibition was held on a Contracting Party’s own territory or on the territory of any country of the Union⁶.

8. At the Revision Conference in Washington (1911), a proposal to complement Article 11, notably as to the starting date and the duration of the protection, was put forward. Another proposal was made to delete the provision because it was viewed as unnecessary and barely used by exhibitors⁷. However, unable to reach consensus on the matter, the Conference decided to maintain Article 11 in the text of the Convention, with the addition of the words “utility models”⁸.

² G.H.C. Bodenhausen, *Guide to the Application of the Paris Convention for the Protection of Industrial Property*, BIRPI, 1969, p. 149.

³ Stephen P. Ladas, *Patents, Trademarks, and Related Rights – National and International Protection*, Harvard University Press, Cambridge, Massachusetts, 1975, p. 59 and p. 544; Thomas Webster, *Vienna Universal Exhibition 1873 : Report on the International Patent Congress (translated into French)*, Libraires de la Cour de Cassation, Paris, 1877, p. 21.

⁴ See the original text of the Paris Convention (1883), in *Paris Convention Centenary, The Paris Convention for the Protection of Industrial Property from 1883 to 1983*, WIPO Publication 875(E), p. 216.

⁵ *Acts of the Paris Conference, 1880*, first edition, p. 106-108.

⁶ *Acts of the Brussels Conference, 1897 and 1900*, p. 47-48 and p. 185-186 ; Michel Pelletier & Edmond Vidal-Naquet, *La Convention d’Union pour la Protection de la Propriété Industrielle du 20 mars 1883 et les Conférences de Révision Postérieures*, Librairie de la Société du Recueil Général des Lois et des Arrêts, Paris, 1902, p. 171-178 and p. 431-432.

⁷ *Acts of the Washington Conference, 1911*, p. 53-54, p. 105 and p. 107-108.

⁸ *Acts of the Washington Conference, 1911*, p. 279-280.

9. At the Revision Conference in The Hague (1925), some countries expressed a lack of satisfaction in respect of the application of Article 11. They held that exhibitors had difficulties to determine in which countries and under which conditions the protection was granted. Besides, the applicable laws diverged on the starting point and duration of the protection and on the conditions and formalities to fulfill⁹. The relationship between Article 11 and the right of priority under Article 4 of the Paris Convention was also examined. Although several proposals were made to modify Article 11, the Conference agreed only upon an amendment to regulate the relationship with the right of priority under Article 4¹⁰. To that effect, paragraphs 2 and 3 were added to the provision.

10. At the Revision Conference in Lisbon (1958), discussions revolved around the definition of “official or officially recognized international exhibitions”, the nature of the temporary protection and the means for the inventors to prove the identity of the exhibited goods¹¹. While some delegations were of the view that the provision needed further developments to uniformly regulate those essential points, other delegations regarded Article 11 as obsolete and proposed to remove the provision. In view of the lack of consensus, Article 11 was kept unchanged.

11. The SCT is invited to consider the draft questionnaire contained in the present document.

[Annex follows]

⁹ Acts of The Hague Conference, 1925, p. 255-256.

¹⁰ Acts of The Hague Conference, 1925, p. 259-262, p. 272-273, p. 351-352 and p. 436-437.

¹¹ Acts of the Lisbon Conference, 1958, p. 447-459.

DRAFT QUESTIONNAIRE

Member State/Intergovernmental Organization:
Office:
Name:
Position:
Email address:

Please respond to the following questions based on the applicable law and practice in your jurisdiction.

QUESTIONS

(a) Preliminary question

1. Does the applicable law in your jurisdiction contain specific provisions concerning the temporary protection granted to industrial designs under Article 11 of the Paris Convention?
<input type="checkbox"/> YES <input type="checkbox"/> NO If YES, please indicate the reference

(b) Nature of the measure

2. What measure(s) give(s) effect to Article 11 of the Paris Convention:
<input type="checkbox"/> an “exhibition” right of priority ¹ <input type="checkbox"/> a “grace period” for filing ² <input type="checkbox"/> other - <i>Please specify</i>

(c) Starting date and duration of the temporary protection provided by Article 11 of the Paris Convention

3. What is the starting date of the temporary protection?
<input type="checkbox"/> the opening date of the exhibition <input type="checkbox"/> the date of the first disclosure of the goods on which the industrial design is incorporated or to which it is applied at the exhibition

¹ For the purpose of this questionnaire, an “exhibition” right of priority” is understood as the right of priority that may be claimed by an applicant with respect to an application for registration of an industrial design/the filing of a design patent, on the basis of the disclosure of the industrial design at an official or officially recognized international exhibition.

² For the purpose of this questionnaire, a “grace period” for filing is understood as a period of time, preceding the filing of an application for registration of an industrial design/the filing of a design patent, during which a disclosure of the industrial design will be without prejudice to its novelty and/or originality, provided that certain conditions are met. In certain jurisdictions, such a disclosure is referred to as a “non-prejudicial disclosure”; in other jurisdictions, such disclosure is regarded as an “exception to lack of novelty”.

other - *Please specify*

4. What is the duration of the temporary protection?

6 months 12 months

other - *Please specify*

5. Which date is taken into account to calculate the end of the temporary protection?

the date of filing of the application in your jurisdiction

the date of priority, if any

other – *Please specify*

(d) Official or officially recognized international exhibitions

6. Are criteria established to determine what is an “official or officially recognized international exhibition”?

YES NO

If NO, why?

the measure referred to in Question 2 is not limited to the disclosure at an official or officially recognized international exhibition

other – *Please specify*

If YES, what are those criteria?

the exhibition falls within the terms of the Convention Relating to International Exhibitions signed in Paris on 22 November 1928

other – *Please specify*

If YES, how are those criteria published or made available to the public?

the criteria are specified in the legislation

the criteria are published in an official Bulletin/Journal/Gazette

the criteria are published in the office’s guidelines or manuals

the criteria are published on the office’s website

other – *Please specify*

(e) Conditions and evidence

7. Must the applicant expressly claim the benefit of the measure referred to in Question 2?

YES NO

If YES, what conditions must be fulfilled?

- the applicant must claim an “exhibition” right of priority
- the applicant must make a declaration stating that the industrial design has been disclosed at an exhibition
- the applicant must make a declaration to claim the benefit of an exception to lack of novelty
- other - *Please specify*

If YES, when must the claim/declaration be filed?

- it must be filed with the application
- it may be filed at a later stage – *Please specify*

8. Must the applicant pay a fee to benefit from the measure referred to in Question 2?

YES NO

If YES, when must the fee be paid? *Please specify*

9. What documentary evidence is required to prove the disclosure of an industrial design at an exhibition?

- a certificate issued by the competent authority of the exhibition concerned or of the country where it was held
- a declaration by the applicant
- other – *Please specify*

10. What is the mandatory content of the documentary evidence referred to in Question 9

- name of the exhibition
- venue of the exhibition

- opening date of the exhibition
- closing date of the exhibition
- date of the first disclosure of the goods on which the industrial design is incorporated or to which it is applied at the exhibition
- name of the person(s) who disclosed the industrial design at the exhibition
- declaration that identifies the industrial design disclosed at the exhibition
- description of the industrial design disclosed at the exhibition
- photographs of the goods on which the industrial design is incorporated or to which it is applied, as exhibited at the exhibition
- other – *Please specify*

11. When is the documentary evidence referred to in Question 9 to be submitted?

- it must be submitted along with the application
- it may be submitted after the filing of the application, within a given time limit – *Please specify the time limit*
- it may be submitted during the application examination process in reply to an office's action
- other – *Please specify*

(f) Examination and recording

12. Where an applicant claims the benefit of the measure referred to in Question 2, does the office examine if the industrial design disclosed at the exhibition is the same as the industrial design subject to the application?

YES NO

13. Is the temporary protection granted to an industrial design recorded in the register?

YES NO

(g) Further remarks

14. Do you have any further remarks with respect to Article 11 of the Paris Convention?

YES NO

If YES, please specify

[End of Annex and of document]