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## **STANDING COMMITTEE ON THE LAW OF TRADEMARKS, INDUSTRIAL DESIGNS AND GEOGRAPHICAL INDICATIONS**

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FORMALITIES CONCERNING THE PROCEDURES FOR DESIGN REGISTRATION

*Document prepared by the Secretariat*

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## I. INTRODUCTION

1. At the fifteenth session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT), held in Geneva from November 28 to December 2, 2005, the SCT requested the Secretariat to prepare an information document on the formalities concerning the procedures for design registration (see document SCT/15/4, paragraph 24).
2. The present document provides a summary description of design registration systems, presents the Hague System for the International Registration of Industrial Designs, illustrates a number of features in design registration procedures and highlights some issues closely related of those procedures.

## II. DESIGN REGISTRATION SYSTEMS

3. Industrial design registration systems can be grouped under two broad categories, namely “deposit” systems and “examination” systems. Deposit systems are characterized by a relatively simple administrative deposit procedure, under which an industrial design is deposited or registered without being examined as to compliance with substantive requirements for protection, such as novelty or originality.
4. In examination systems, the registration of an industrial design is subject to an *ex officio* examination, which determines whether an industrial design for which registration is sought meets all conditions for protection, including substantive requirements. A particular form of an examination system would be a design patent system, which, from a procedural point of view, can be similar to a system for the granting of patents of invention.
5. Depending on the applicable system, a considerable variety of procedural aspects can be found, touching on features such as the reproduction of the industrial design, the possibility of multiple design applications, the deposit of design specimens, unity of design, or design claims, to name just a few. Those aspects will be dealt with in some detail in chapter IV of this document.

## III. THE HAGUE SYSTEM (GENEVA ACT)

6. At the international level, the Hague System for the International Registration of Industrial Designs provides for a central industrial design register, through which design registration can be obtained in all countries member of the Hague Union by means of a single registration procedure administered by the World Intellectual Property Organization (WIPO). The Hague System goes back to the Hague Agreement Concerning the International Deposit of Industrial Designs of 1925, which was amended and supplemented various times and, most recently, by the 1999 Geneva Act of the Hague Agreement. Notably, the Geneva Act also introduced a change in name of the Hague Agreement, namely from “International Deposit of Industrial Designs” to “International Registration of Industrial Designs”.

7. As indicated by the change in the name of the Hague Agreement, in its early form, the Agreement was geared towards design systems by which protection was granted without examination as to absolute grounds for refusal. Those systems appeared to exist mostly in European jurisdictions or in countries following the civil law approach. Hence, the membership of the Hague Union remained relatively limited.

8. In order to widen the circle of countries participating in the Hague Union and to enable countries with examination or design patent systems to join the Hague Agreement, the Geneva Act of the Hague Agreement introduced a number of procedural features to the Hague Agreement which take into account the procedures of examining systems.

9. For example, the mandatory contents of international applications were widened so as to allow Contracting Parties to require indications concerning the identity of the creator of the industrial design, a brief description of the reproduction or of the characteristic features of the industrial design, and a claim<sup>1</sup>. Consequently, the Geneva Act anticipates, to a certain extent, a convergence of design registration procedures – it being recalled that, with the exception of the term of protection, the Hague System does not harmonize aspects of substantive design law.

10. Bearing in mind that the preparatory work for the adoption of the Geneva Act of the Hague Agreement took eight years and covered extensively various aspects of design registration formalities, the experience gained during this exercise guided to work on this document<sup>2</sup>.

#### IV. CONTENTS OF APPLICATION

##### (a) Application data

11. An application for the registration of an industrial design must contain the name of the applicant and indicate whether it is a natural person or a legal entity. Furthermore, the country of domicile, nationality or in which the applicant has a real and effective industrial or commercial establishment, may be required. Some offices give applicants specific client numbers, which may be indicated in an application.

12. The law of a country may allow an application to be filed by several applicants. In some countries, it has to be indicated which one of them is entitled, on behalf of all the applicants, to receive notifications or correspondence concerning the application.

13. The address of the applicant is usually required to be given in such a way as to satisfy the customary requirements for prompt postal delivery at the indicated address. Where an application is in the name of several applicants, it may be required that a single address as the address for correspondence is indicated.

14. If the applicant is not domiciled in the country in which registration is sought, she/he will regularly appoint a local representative. In this context, it is to be noted that national laws often contain restrictions as to who may be appointed as a representative. It may be required, for instance, that the representative be admitted to practice before the office. Where a representative is appointed, a power of attorney, may have to be submitted to the office.

15. The name and address of the representative must be indicated in the same manner as the name and address of the applicant. Some offices attribute specific numbers to attorneys, which may also have to be indicated.

(b) Reproduction of the industrial design

16. One or several reproductions of the industrial design or designs for which registration is sought are generally required to accompany the application. The reproductions may be either in the form of photographs, drawings or other graphic representations of the industrial design. A single application may well contain both photographs and graphic representations, which may be in black and white or in color.

17. A reproduction will usually represent the product which incorporates the industrial design. The reproductions will often be required to contain a sufficient number of views to completely disclose the appearance of the design, i.e. front, rear, right and left sides, top and bottom. In some cases, where all sides of the article are not visible during normal use, the law may permit that a sectional view is submitted, which more clearly brings out elements of the design. However, technical drawings showing articles in section or in plan, particularly with axes, dimensions, explanatory texts or legends, may not be acceptable.

18. Matter which is shown in a reproduction, but for which protection is not claimed, may be indicated by means of dotted or broken lines. When the claim is directed to just surface ornamentation for a product, the product in which it is embodied may have to be shown in dotted or broken lines. A dotted or broken line disclosure may be understood to be for illustrative purposes only and forms no part of the claimed design.

(c) Multiple design applications/registrations

19. The concept of “multiple design application” can be found in several national and regional design registration systems. The aim of such a system is to facilitate the filing of applications for those sectors of industry which develop large numbers of designs and where the cost and the administrative burden of filing one single application for each of them is considered too high.

20. Where there are several designs included in an application, each design must be specifically identified. The number of reproductions, which can be submitted for each design, may be limited, or a minimum number of different views may be required. Under the Geneva Act of the Hague Agreement, for example, the number of designs that can be included in an application is limited to 100. A condition for the acceptance of a multiple application may be, however, that the products which embody the multiple designs belong all to the same class (or sub-class) of the Locarno Agreement Establishing an International Classification for Industrial Designs (hereinafter called the Locarno Classification).

(d) Deposit of design specimen

21. It is possible in some jurisdictions to submit the design for which protection is sought in the form of a design specimen rather than as a reproduction. A specimen may either substitute a reproduction, or it may be an additional element clarifying some aspects of the reproduction. The filing of specimen, where possible, was traditionally possible for all types of products, with certain restrictions as to the size of those specimens<sup>3</sup>. However, the filing of

a specimen does usually not exempt the applicant from the requirement to furnish a reproduction of the design, for publication purposes, before the expiry of the deferment period. Moreover, for reasons of practicality, the filing of specimens may nowadays often be restricted to two-dimensional designs<sup>4</sup>.

22. The possibility of submitting a specimen of the industrial design instead of a reproduction is a procedural feature that is traditionally requested by industries which work with short product cycles and a high turnover of new designs, such as the textile or fashion industry. The deposit of multiple design specimens – in conjunction with a deferment of the publication – enables the applicant to postpone a decision concerning the design for which publication and protection is ultimately requested. This allows the owner of multiple designs to focus expenses for registration on those designs that are commercially successful.

(e) Indication of products in which the design is embodied

23. A product embodying an industrial design may be any industrial or handicraft article, capable of materializing the design, including parts to be assembled into a complex product. In particular, a product may consist of packaging, get-up, graphic symbols or typographical typefaces.

24. In case the industrial design consists of the shape of a product, the usual generic name of that product will be indicated in the application, for example “chair”. As regards decorative motifs in two dimensions intended to be used on the surface of a product, that product needs to be indicated, for example “drawing to be used on dishes” or “motif for textiles”. Product information must correspond to that shown in the reproduction of the design, and it should not describe the product’s appearance, such as “round table”. Furthermore, it may be required that the class and/or the sub-class of the Locarno Classification to which an industrial design belongs, is indicated.

(f) Unity of design

25. The requirement of unity of design can be found in the design laws of several countries. Generally speaking, the requirement of unity of design means that two or more designs included in the same application have to conform to the same creative concept. Typical examples of unity of design are the ornamentation applied to a set of different household articles (tableware, cutlery, wearing apparel).

26. Some industrial design laws require that all designs included in the same application conform to a requirement of unity of production or unity of use. Others state that designs that are independent and distinct from one another may not be included in a single application.

(g) Identity of the creator and signature of designer (creator of design)

27. Certain industrial design laws require that the name and address of the creator of a design be indicated in the application. It may be required that the creator be a natural person, or two or more natural persons.

28. Under some laws it might be required that the applicant be the creator of the design. Under other laws, however, the applicant need not be the creator of the design, but in such case, the application must be accompanied by a statement to the effect that the creator has assigned the design to the applicant.

(h) Statement of novelty

29. The novelty of a design is a basic requirement for protection in many countries, but the definition of novelty is not necessarily the same. While under some laws novelty is absolute (worldwide) and objective, under other laws the novelty test is limited to what is known to national trade circles.

30. It may be required that the creator of a design submit a statement of novelty. The statement may, for instance, be in the form of an oath or a declaration. Generally, the content of the statement is that the creator declares that she or he believes to be the original and first creator of the design that is claimed and for which protection is sought.

(i) Claims

31. Some laws require that applications for the registration (or patenting) of an industrial design contain a claim. The claim defines the design for which protection is sought. The description of the product that embodies the design or to which it is applied, may have to be consistent in terminology with the title of the design. The claim could read, for example, “the ornamental design for a toothbrush as shown and described”.

## V. FILING DATE

32. Article 4, Section A(3) of the Paris Convention defines the term “regular national filing” as any filing that is adequate to establish the date on which the application was filed in the country concerned, whatever may be the subsequent fate of the application. The records of the Revision Conference of Lisbon in 1958, at which this paragraph was introduced explain that a regular filing is deemed to exist when, according to the domestic legislation of the country concerned, the application is correct only as to the form and, even when it is incomplete or incorrect as to the form, if it is sufficient to establish the filing date<sup>5</sup>.

33. It is important that the filing date of an application for registration of an industrial design be accorded as soon as possible, since the filing date is the decisive point in time to assess the novelty of the design. The filing date is also the basis for a claim of priority for subsequent applications in respect of the same design, filed by the applicant, in a foreign country. For this reason, a harmonized approach to the definition of filing date requirements for industrial designs would appear to be desirable, in the same way as it is provided for trademark applications in the Singapore Treaty on the Law of Trademarks (Singapore Treaty) and for patent applications in the Patent Law Treaty (PLT).

34. For the purpose of granting a filing date to an application for a design registration, generally the following indications and elements may be required: an express or implicit indication that the registration of an industrial design is sought, indications allowing the identity of the applicant to be established or allowing the applicant or its representative, if any, to be contacted by the industrial property office, and a reproduction of the design. The law of a country may allow, if a deferment of publication is requested and the design is two dimensional, that a specimen of the design is enclosed with the application instead of a reproduction. It may also be required that the application be in a language admitted by the office.

35. In addition to the indications and elements mentioned above, further elements or indications may be required under some national systems in order to establish a filing date, such as indications concerning the identity of the creator of a design, a brief description of the reproduction or of the characteristic features of the industrial design and a claim. The payment of the applicable fee may constitute a further filing date requirement. In order to illustrate filing date requirements that exist currently in the international context, the relevant provisions under the Geneva Act of the Hague Agreement and the PLT are briefly described below.

#### *Geneva Act*

36. Article 6(2) of the Geneva Act provides that an international application is, as from its filing date and whatever may be its subsequent fate, equivalent to a regular filing within the meaning of Article 4 of the Paris Convention. An international application is usually filed directly with the International Bureau of WIPO, in which case, as stipulated in Article 9(1) of the Geneva Act, the filing date is the date on which the International Bureau receives the international application provided that the international application

- is in the prescribed language or one of the prescribed languages;
- contains an express or implicit indication that international registration is sought;
- contains indications allowing the identity of the applicant to be established;
- contains indications sufficient to enable the applicant or its representative, if any, to be contacted;
- contains a reproduction, or, in accordance with Article 5(1)(iii), a specimen, of each industrial design that is the subject of the international application; and
- contains the designation of at least one Contracting Party.

37. In this context, it is to be noted that any Contracting Party whose office is an examining office and whose law, at the time it becomes party to the Geneva Act, requires, under Article 5(2) of the Geneva Act, that an application for the grant of protection for an industrial design contain (i) indications concerning the identity of the creator, (ii) a brief description of the reproduction or of the characteristic features of the industrial design and (iii) a claim, in order that an application be accorded a filing date under that law may, in a declaration, notify the Director General of WIPO, of those elements. Where such Contracting Party is designated, the international application should contain those elements.



*Patent Law Treaty*

38. Article 5(1)(a) of the PLT provides that a patent application which contains the following elements shall be accorded a filing date:

- an express or implicit indication to the effect that the elements [submitted to the office] are intended to be an application;
- indications allowing the identity of the applicant to be established or allowing the applicant to be contacted by the Office;
- a part which on the face of it appears to be a description.

39. The exact manner of presentation of those elements and a procedure for a subsequent compliance with those requirements is dealt with in further detail in Article 5 and Rule 2 of the PLT.

## VI. PUBLICATION

### (a) Deferment of publication

40. An application for the registration of a design may be published following an *ex officio* examination as to compliance with formal or substantive conditions of protection, as the case may be. Under some laws publication takes place before the substantive examination. Where opposition procedures are available and no opposition is lodged, the design for which registration is sought is registered. However, in some jurisdictions, publication takes place after registration of the design or, in a design patent system, after the grant of the design patent. The time of the publication may also depend on the time required by the industrial property office to carry out the relevant technical preparations for the publication.

41. Certain industrial design laws provide for the possibility of deferring of publication for a certain period of time. In general, the applicant may choose to request the publication of the design before the period of deferment has expired, or at the end of that period. The applicant must upon filing the application request that the publication of the design be deferred, or in the case of a multiple application, indicate those designs whose publication should be deferred.

42. During the period of deferment of publication, an action for enforcement will typically be subject to publication of the design in question.

43. If the application is withdrawn partially or totally during the period of deferment of publication, the design will not be published and the corresponding documents will not be made public. An application that is withdrawn before publication will not become part of the prior art.

(b) Furnishing of design reproductions in case of deposit of specimen

44. An application for design registration may contain a reproduction or, at the choice of the applicant, several different reproductions of the industrial design that is the subject of the application. However, some laws provide the filing of design specimens in lieu of design reproductions, if the design in question is two-dimensional.

45. In case an application is accompanied by a design specimen, reproductions of the design would still have to be submitted for the purpose of publication. The industrial property office may send an unofficial reminder notice to the applicant indicating the date by which the publication fee and the reproductions must be submitted.

46. The possibility of submitting specimens instead of reproductions may raise some issues, for example, if the reproduction filed before the expiry of the deferment period does not correspond to the specimen filed together with an application.

## VII. RENEWAL AND CHANGES

(a) Renewal

47. The registration of a design is generally effected for an initial period of time, and may be renewed for one or more additional periods, up to a total duration of protection provided by the applicable law. However, the applicable law may provide for only one initial period of protection with no possibility of renewal.

48. Some industrial property offices inform the holders of design registrations that a registration is due for renewal in the form of a notice of renewal.

49. It may be possible to effect renewals by a mere payment of the renewal fee, without submission of a formal request. However, an express indication that a renewal is sought may be required. In the latter case, contact details for the holder or representative (or other person who may file a request for renewal), the relevant application or registration number, the filing or registration date, and indication of the design or designs for which renewal is requested, and the date of expiry of the registration may be required.

50. In accordance with Article 5*bis* of the Paris Convention, a period of grace of not less than six months must be granted by contracting parties to the Paris Convention or to the Agreement Establishing the World Trade Organization (WTO), for the payment of renewal fees for industrial property rights. Where the renewal fee is paid after the date on which renewal is due and within the period of grace, a surcharge may be required.

51. The law may prescribe a time period, during which the request for renewal may be filed or the renewal fee be paid, before the expiry of the registration. This aims at ensuring that holders of designs will be able to file their requests for renewal in good time before the expiration of the registrations, thus ensuring a seamless continuation of their registered rights.

(b) Changes in ownership

52. A change in ownership of the registration may result from a contract, from a merger, from the operation of law or from a court decision (inheritance, bankruptcy, etc.). The change in ownership may relate to all or some of the designs that are the subject of the registration.

53. The request to record a change in ownership will generally include the name and address of the holder and of the new owner, their representatives, if any, the application or registration number, and in the case the change relates only to some designs, of the indication of the designs concerned. Also the country of domicile or nationality of the new owner, or in which the new owner has a real and effective industrial or commercial establishment, may be indicated. In the case the new owner is a legal entity, information on the legal nature of the entity may be required.

54. It may be necessary that the request indicate the legal cause of the change in ownership, such as a contract or a merger, and that the request be accompanied by supporting documentation, for example a copy of the contract or a copy of an extract from a register of commerce.

(c) Corrections

55. A mistake in the information recorded on the register may be attributable to the applicant, to the holder, to a representative or to the industrial property office. In the case of mistakes attributable to an industrial property office, it may adopt a procedure for *ex officio* corrections. Where a mistake is noticed by the applicant or the holder, or by a representative, a correction may be effected following a request to that effect.

(d) Recording/Amendment/Cancellation of License

56. Many laws allow for the recording of a license granted in respect of a registered design. If the recording of a grant of license is allowed, the recording or non-recording of a license may have certain consequences.

57. The license may concern the whole or part of the territory of a country, and its duration may be restricted to a certain period of time. The license may be exclusive, non-exclusive or a sole license. An exclusive license means a license that is only granted to one licensee, and excludes the holder from exploiting the industrial design and from granting licenses to any other person. A sole license is a license granted to one licensee only and precludes the holder from granting licenses to any other person, but does not exclude the holder from exploiting the design himself. Non-exclusive license means a license which does not exclude the holder from exploiting the design or from granting licenses to any other person.

58. The request for recording of a grant of license will generally contain, the name and address of the holder and of the licensee, and, as the case may be, their representatives. The country of nationality or domicile of the licensee, or in which the licensee has a real and effective commercial or industrial establishment may be indicated. In the case that the licensee is a legal entity, information on its legal nature may be required. In addition, the application or registration number of the design and, in the case the license relates only to some designs, the numbers or other identification of the design(s) concerned, have to be provided.

59. The request may be required to indicate the legal cause of the grant of a license. The law may prescribe what supporting documentation, such as an extract of the license contract, must accompany a request for recording of a grant of a license.

60. The request for amendment or cancellation of the recording of a license will generally indicate the name and address of the holder and of the licensee, the application or registration number and the design or designs concerned. In accordance with the applicable law, it may be required that a request for amendment or cancellation of the recording of a license be accompanied by documents substantiating the requested amendment or cancellation.

#### VIII. GRACE PERIOD IN CASE OF DISCLOSURE OF DESIGN

61. The basic condition for the validity of an industrial design registration is the novelty of the design. Generally, a design is considered new if no identical design has been made available to the public before the date of filing of the application for registration or, if priority is claimed, the date of priority. A design may be considered to have been made available to the public, if it was published in the course of the registration procedure or otherwise, if it was exhibited, used in trade or has otherwise become known.

62. However, some forms of disclosure may not destroy the novelty of the design, in particular if done by the designer himself under conditions of confidentiality, or during a novelty grace period.

63. A grace period provision makes it possible to test a product on the market before taking a decision on its registration. However, it must be taken into account that not all countries provide for this type of grace period. If a design is made available to the public before an application for registration is filed, protection abroad may become impossible.

64. If a grace period for novelty is available under the law (which may not be necessarily the case in every jurisdiction), disclosure of the design by the creator or a third person as a result of information provided or action taken by the creator of the design will not be taken into consideration as an obstacle to the registration of the design. Another form of privileged disclosure not having necessarily an effect on the novelty of the design could be where it took place as a consequence of an abuse in relation to the creator of the design.

65. Where a grace period is provided, it will generally be of short duration, typically between six months and one year. The application to register the relevant design in the jurisdiction that provides for the grace period would have to be filed before the expiration of the grace period.

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<sup>1</sup> Article 5(2) of the Geneva Act.

<sup>2</sup> For detailed information on the preparatory work for the Geneva Act of the Hague Agreement, see WIPO documents of the H/CE series.

<sup>3</sup> See, for example, Article 5(3)(b) of the 1960 Hague Act.

<sup>4</sup> See, for example, Article 5(1)(iii) of the Geneva Act.

<sup>5</sup> See Lisbon Acts, pp. 311 to 326.