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**POSSIBLE AREAS OF CONVERGENCE IN INDUSTRIAL DESIGN LAW
AND PRACTICE**

Document prepared by the Secretariat

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ANNEX I

[Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs]

ARTICLE 9: FILING DATE OF THE INTERNATIONAL APPLICATION

RULE 14: EXAMINATION BY THE INTERNATIONAL BUREAU

ANNEX II

[Patent Law Treaty]

ARTICLE 5: FILING DATE

RULE 2: DETAILS CONCERNING FILING DATE UNDER ARTICLE 5

I. INTRODUCTION

1. At the twentieth session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT), held in Geneva from December 1 to 5, 2008, the SCT requested the Secretariat to prepare a working document for consideration by the SCT at its twenty-first session that would be based on documents SCT/19/6 and WIPO/STrad/INF/2 Rev.1 as well as on the report of the twentieth session of the SCT, and which would identify possible areas of convergence on industrial design law and practice in SCT Members, highlighting particular issues to be addressed in that context and taking into account existing international instruments (see document SCT/20/4 Prov., paragraph 6).

2. Pursuant to that request, the Secretariat has prepared the present document, which is divided into nine chapters identifying possible areas of convergence on industrial design law and practice. In each chapter, the matter under discussion has been addressed from three points of view, namely the approaches followed by the national and regional systems in SCT Members, the ensuing practical issues, and the existing international legal framework, where applicable.

3. Regarding the international legal framework, the document presents the features of the Geneva Act (1999 Act) of the Hague Agreement Concerning the International Registration of Industrial Designs (“the Geneva Act”) whenever this is considered to be relevant to the discussion, as per the request of the SCT to take into account existing international instruments. Other international instruments that are taken into account in the present document, where applicable, are the Paris Convention for the Protection of Industrial Property (“the Paris Convention”), the Patent Law Treaty (“the PLT”), the Singapore Treaty on the Law of Trademarks (“the Singapore Treaty”) and the Agreement on Trade-Related Aspects of Intellectual Property Rights (“the TRIPS Agreement”).

4. Finally, during the discussions at the above-mentioned twentieth session of the SCT, the Chair considered that it would be useful if the Secretariat were to enquire about the state of advancement of the project establishing a digital access service for priority documents in the field of patents, with a view to assessing whether it would be worth proposing a similar project in the field of designs (see document SCT/20/5 Prov., paragraph 143). Accordingly, the present document contains a chapter which provides background information on the aforementioned project and summarizes its state of advancement.

II. THE APPLICATION

(a) Contents of Application

(i) *The Reproduction*

5. The reproduction of the industrial design is at the heart of an application, as it determines, alone or along with other elements of the application, the scope of the protection conferred by the industrial design¹. It is therefore of the utmost importance that the reproduction fully disclose the industrial design. In addition, in the interest of third parties, it is also essential that the reproduction be capable of fully disclosing the design *when published*.

Form of Reproduction

6. Most SCT Members now consider drawings and photographs to be adequate forms of reproduction of an industrial design². However, a distinction can be made between two slightly different positions among those Members. Some Members accept either drawings or photographs, at the option of the applicant. That is also the position under the Geneva Act³. In contrast, the practice of other Members is to require drawings as a general rule, and to accept photographs only when the design cannot be clearly illustrated by an ink drawing.

7. Traditionally, drawings have been the generally accepted form of reproduction of industrial designs, mainly because of the difficulty, in certain cases, of adequately reproducing the design shown on photographs, for the purpose of publication. However, it has been noted that digital reproduction has to a large extent eliminated that problem. This will most likely contribute to a more widespread use of photographs. According to the Quantitative Summary of Replies to the Questionnaires on Industrial Design Law and Practice (document SCT/19/6, Annex I), the vast majority of SCT Members accepts, not only black and white photographs (95%), but also color photographs (92%).

8. The use of drawings as a form of reproduction of the industrial design usually enables the applicant to show, with broken or dotted lines, the environment in which the industrial design will be used, the article to which it will be applied, or the entire product of which the industrial design may be just a part. In other words, broken or dotted lines may be used in many jurisdictions to represent matter which is not part of the claimed design, but which may illustrate the way the design will look when in use. Out of the 67 SCT Members which responded to Part I of the Questionnaire on Industrial Design Law and Practice (“the Questionnaire”), 46 (72%) indicated that they accept the use of broken or dotted lines for the purpose of representing matter that is not part of the claimed design. The Geneva Act also accepts such use of broken or dotted lines⁴.

9. Shading is another practice that is used, in certain cases, when reproducing the industrial design by means of a drawing. In some jurisdictions, shading should be used to show more clearly the contour or volume of a three-dimensional design⁵.

10. In contrast to the effects of shading mentioned in the foregoing paragraph, there is at least one jurisdiction in which shading serves the purpose of showing matter which is not part of the design, for which broken or dotted lines are more generally used⁶.

Possible Area of Convergence on the Form of Reproduction of Industrial Designs

With regard to the form of reproduction of industrial designs, consideration might be given to the possibility of converging towards the position that offices would be required to accept graphic or photographic reproductions, and that the choice of the form of the reproduction would be left to the applicant. Since the use of color as a distinctive feature of the design becomes more and more frequent, applicants should be allowed to represent industrial designs by way of color photographs. Where applicants present graphic reproductions of industrial designs, the use of dotted lines should be permitted to indicate matter for which protection is not claimed. Moreover, where the applicant chooses to submit drawings, the use of shading should be permitted to show more clearly the contours or volume of a three-dimensional design.

Views and Number of Copies

11. It is generally agreed that the reproductions, whether in the form of drawings or photographs, should completely disclose the appearance of the claimed design, and that several views of the design may be needed to that end, particularly where the industrial design is three-dimensional. The requirements concerning the number and types of views to be submitted vary, however, from one jurisdiction to another.

12. There are three major approaches to the question of views. According to the first one, followed by nearly one quarter of the respondents to the Questionnaire, it is considered that certain views, as a minimum, are necessary to fully disclose a three-dimensional industrial design. Hence, the legislation requires that at least those views are submitted in the application. In general, the minimum number of views required is six, encompassing a front, rear, right, left, top and bottom view of the design. In certain jurisdictions, a seventh view showing the perspective is also required.

13. According to the second approach, followed by 18% of the respondents to the Questionnaire, it is left to the applicant to determine the number and types of views which are needed to fully disclose the industrial design, but the legislation prescribes a *maximum* number of views that may be submitted. Admittedly, the main aim of the prescription is to avoid an excessively lengthy publication of the industrial design. At the same time, a balance must be found between the constraints of publication and the need to allow for a sufficient number of views to enable applicants to completely disclose all types of industrial designs, including complex ones. In this regard, it has been noted that the legislation of one SCT Member has been recently amended to raise the maximum number of admitted views from seven to 10⁷.

14. The third approach would consist in not prescribing a minimum number of required views or a maximum number of admitted views. The applicant is entirely free to determine, on a case by case basis, the number and types of views which are needed to fully disclose the industrial design concerned.

15. Nearly 60% of the respondents to the Questionnaire follow this latter approach. This is also the general rule under the Geneva Act, although it is possible for a Contracting Party which requires certain views to make a declaration to that effect. In any event, not more than one view may be required by a Contracting Party in respect of a two-dimensional design, or more than six views in respect of a three-dimensional one.

16. The third approach raises the question as to whether or not all the views submitted are actually published by an office, a particularly relevant question where a large number of views is filed. More generally, the question of views raises at least two other issues. The first one concerns the possibility for an office to request more views where it considers that the views submitted do not adequately disclose the industrial design. The ensuing question is whether in those cases or in the case where several views are required by legislation but only some are submitted, the filing of one or some views, but not all, is sufficient to accord a filing date.

17. It is also worth clarifying the issue as to the number of copies of each reproduction that is generally required. In this regard, it may be noted that the majority of SCT Members require between one and three copies⁸. The number of copies appears to be of importance in particular with regard to applications filed on paper. Arguably, applications that are filed electronically will never require more than one copy of the reproduction, or reproductions, as the case may be.

Possible Area of Convergence on the Views of the Industrial Design

With regard to the views of the industrial design, consideration might be given to the possibility of converging towards the position that the applicant should be free to decide the number and types of views which are needed to fully disclose the industrial design, without prejudice to the fact that offices should be free to require additional views at a later stage of the examination process if they deem that such additional views are necessary to adequately disclose the industrial design.

Possible Area of Convergence on the Number of Copies of Each Reproduction

With regard to the number of copies of each reproduction, consideration might be given to the possibility of converging towards the position that an office should not require more than three copies of each reproduction of the industrial design where the application is filed on paper, and not more than one copy where the application is filed electronically. In any case, one copy of a sufficiently clear reproduction should be enough for the purpose of granting a filing date.

(ii) *Specimens*

18. Certain jurisdictions admit that the industrial design be represented by means of specimens. Usually, the policy to accept specimens rests on the consideration that for certain industries the submission of reproductions is too costly or cumbersome. That is the case for those industries producing short-lived-cycle designs or collections with hundreds of designs to protect, for example the textile industry.

19. On the other hand, the acceptance of specimens poses certain issues of a logistical and administrative nature for offices, concerning, for example, the stocking of the specimens or their reproduction for publication purposes.

20. It follows from the returns to the Questionnaire that the question of specimens can be addressed in four different ways. Firstly, there are a number of offices that do not permit the submission of specimens, although some may request them in addition to reproductions at the time of examination. That is the position of 26 out of the 67 Members States of the SCT that responded to the Questionnaire.

21. Secondly, there are offices that accept specimens in the case of deferment of publication only, with a requirement for the applicant to submit a reproduction at the time of publication. In general, the acceptance of specimens in this case is also limited to two-dimensional designs. This is the position of 7 out of the 67 SCT Members that responded to the Questionnaire. It is also the position under the Geneva Act⁹.

22. Thirdly, there are offices that admit specimens for two-dimensional designs only, irrespective of any deferment of publication. In general, the specimens should conform to certain characteristics, such as not to exceed a given dimension, be presented on a sheet of paper, or be able to be reproduced. Out of the 67 replies to the Questionnaire, 19 indicate that this approach is followed.

23. Finally, there are offices that admit specimens for both two and three-dimensional designs, usually subject to certain limits on size and weight. Out of the 67 replies to the Questionnaire, 23 indicate that this approach is followed. In some of those offices, specimens are admitted *instead* of reproductions, and the office then undertakes the reproduction for the purposes of publication. In other offices, specimens are admitted for all types of designs, but only *as a complement* to the reproductions.

24. In addition to the issues already raised, there are two other questions which are worth posing. The first one refers to the format of representation of the industrial design which prevails, in case of divergence between the specimen and the reproduction, in order to determine the scope of the protection. Most jurisdictions seem to adopt the position that the specimen prevails.

25. Another question relates to the priority documents which are to be submitted where a specimen only has been included in the first filing. This question remains largely unanswered.

26. In conclusion, while the possibility of submitting specimens responds to the needs of specific industries, it would appear that, in practice, it is not commonly used by applicants in most jurisdictions¹⁰. Against this statement, it is worth noting that there is more than insignificant use of the possibility in at least two jurisdictions, Sweden (almost 10% of all applications) and Germany (15.5% of applications).

Possible Area of Convergence on Specimens

With regard to the presentation of specimens of industrial designs as part of applications, consideration might be given – with particular reference to digital reproduction techniques – to the possibility of converging towards the position that the filing of specimens in lieu of reproductions should constitute an optional element in industrial design applications. The answer to this question should be without prejudice to the possibility for applicants to file specimens, or for offices to require specimens, as the case may be, where this is necessary in order to determine the scope of protection of the industrial design in question.

(iii) Other Contents of the Application Generally Required

27. It is widely agreed that, in addition to a representation of the industrial design, an application should usually contain the following elements: a request for the registration of the industrial design in question, indications allowing the identity of the applicant to be established, the contact details of the applicant or his representative, and an indication of the product or products which incorporate the industrial design or in relation to which the industrial design is to be used. Moreover, a fee should be paid to the office¹¹.

28. In addition, an indication of the class or sub-class of the International Classification for Industrial Designs under the Locarno Agreement is required in 30 out of the 67 SCT Members (45%) which replied to the Questionnaire.

Possible Area of Convergence on Other Contents of the Application Generally Required

With regard to other contents of the application that are generally required, consideration might be given to the possibility of converging towards the position that the following elements should be mandatory in any application for an industrial design: (i) a request for the registration of the industrial design in question, (ii) indications allowing the identity of the applicant to be established, the contact details of the applicant or his representative, and (iii) an indication of the product or products which incorporate the industrial design or in relation to which the industrial design is to be used. Moreover, consideration might be given as to whether the indication of the class or sub-class of the International Classification for Industrial Designs under the Locarno Agreement should be part of the application.

(iv) Other Contents of the Application Required in Certain Jurisdictions

Claim/Statement of Novelty

29. In certain jurisdictions, the application should contain a claim that defines the design for which protection is requested¹². In other jurisdictions, the application should contain a statement of novelty indicating the features of the design that are considered to be novel. It has been noted that, while not identified as such, a statement of novelty can be assimilated to a form of claim.

30. Usually, where a claim or a statement of novelty is required or, while not required, is voluntarily submitted by the applicant, it serves to define the scope of the rights. In this regard, given its essential nature in those jurisdictions in which it is compulsory, the claim or the statement of novelty usually constitutes a filing date requirement in those jurisdictions. However, under Article 5(1) of the PLT, a claim does not constitute a filing date requirement.

Description

31. A description is another element which may be required in certain jurisdictions¹³. In practice, there are at least two different types of description. The first is a description of the views or features of the reproduction, which generally does not have an effect on the scope of protection. The second is a description of the characteristic features of the industrial design. Where this type of description is required or, while not required, is voluntarily submitted by the applicant, it usually serves to define the scope of the protection conferred on the industrial design¹⁴. In other jurisdictions, it merely assists the examiner in understanding the design, without any effect on the scope of protection.

32. Whether or not descriptions are published is of practical relevance. The length of a description has obviously an impact on publication. In order to limit that impact, some jurisdictions require that a description not exceed a given number of words¹⁵.

Indication of the Identity of the Creator

33. Finally, an indication of the identity of the creator is another element that may be required in certain jurisdictions¹⁶. In this regard, it has been indicated that the creator has a moral right to be named in the application.

Possible Area of Convergence on Other Contents of the Application Required in Certain Jurisdictions

With regard to other contents of the application required in certain jurisdictions, consideration might be given to the possibility of converging towards the position that a claim and a statement of novelty, a description, and the indication of the identity of the creator of the design, where they are mandatory elements of the application, should not constitute a filing date requirement.

With respect to filing date requirements, see Possible Area of Convergence on Filing Date Requirements.

(b) Certain Requirements Concerning the Application

34. There are certain requirements which are not elements of the application as such, but relate to an underlying principle of the application. Two such requirements have been identified. The first one is that the application should be filed in the name of the creator. The second is that the application should follow the principle of unity of design or unity of invention.

(i) *Requirement to File in the Name of the Creator*

35. Out of the 67 SCT Members which replied to the Questionnaire, 15 (that is 25%) indicated that the application must be filed in the name of the creator. If the applicant is not the creator, a statement of assignment or other evidence of the transfer of the design to the applicant must be provided.

36. By way of example, under the Common Regulations under the 1999 Act, the 1960 Act and the 1934 Act of the Hague Agreement (hereinafter, “the Common Regulations of the Hague Agreement”), a Contracting Party bound by the Geneva Act may declare that its legislation requires that the application be filed in the name of the creator. Two Contracting Parties to the Geneva Act have made so far that declaration, namely Ghana and Iceland. When designating those Contracting Parties, the applicant has to indicate the name of the creator. A statement of assignment, pre-printed on the international application form, is made by the applicant, in the signing of the form.

Possible Area of Convergence on the Filing of the Application in the Name of the Creator

With regard to the presentation of an application in the name of the creator, consideration might be given to the possibility of converging towards the position that, where it is required that the application be filed in the name of the creator, such requirement would be satisfied if the applicant declares that she/he files in the name of the creator.

(ii) *Unity of Design or Unity of Invention*

37. In certain jurisdictions, an application must conform to a requirement of unity of design or unity of invention¹⁷. That usually means that designs that are independent and distinct must be the subject of separate applications.

Possible Area of Convergence on Unity of Design or Unity of Invention

With regard to the requirement of unity of design or unity of invention, consideration might be given to the possibility of converging towards the position that, in cases in which a requirement of unity of design or unity of invention is applicable, the possibility of dividing the application, without prejudice to the granting of the original filing date, should be made available.

(c) Multiple Applications

38. As indicated in document SCT/19/6, the notion of a multiple application refers to the possibility of requesting protection for several industrial designs in one application for registration. This facility is offered in a vast number of jurisdictions (76% of the returns to the Questionnaire indicate that multiple applications are allowed), as well as under the Geneva Act.

39. From the point of view of users, multiple applications provide a clear benefit in terms of simplification of filing, which is evidenced by the fact that the facility is largely availed of by applicants¹⁸. From the point of view of examining offices, multiple applications entail the need to undertake searches for each industrial design included in the application. In this regard, a major concern for offices, particularly those which carry out a novelty examination, lies in the ability to adequately recover search and examination costs¹⁹.

40. In response to that concern, one jurisdiction admits multiple applications only in respect of the designs of products with short life cycles, which are not examined as to substance²⁰.

41. However, in most jurisdictions admitting multiple applications, the ensuing complexity of searches and examination is restrained by the prerequisite that the designs conform to certain requirements, such as the following:

- that they apply to, or are constituted by, products which belong to the same class of the Locarno International Classification²¹;
- that they apply to, or are constituted by, products which belong to the same set or composition of items²²;
- unity of design or unity of invention²³;
- unity of production or unity of use²⁴.

42. In addition, in most jurisdictions which admit multiple applications, the number of industrial designs that may be included in an application is limited, generally to either 100 or 50 designs²⁵.

43. Having said that, it should be noted that in some jurisdictions, the provision that just a given number of designs be included in a multiple application or that the designs conform to certain requirements does not apply to mere ornamentation²⁶.

44. Finally, where the industrial designs in a multiple application do not conform to the applicable requirements, the applicant may generally divide the application²⁷.

Possible Area of Convergence on Multiple Applications

With regard to multiple applications, consideration might be given to the possibility of converging towards the position that offices would be required to allow such applications, subject to the designs contained in those applications conforming to certain requirements determined by the office. Moreover, where the designs in a multiple application do not meet the applicable requirement, the possibility of dividing the application, without prejudice to the granting of the original filing date, should be made available.

III. FILING DATE

(a) Filing Date Requirements

45. In most jurisdictions, the following elements or indications are required in an industrial design application for the granting of a filing date²⁸:

- a request that the registration of an industrial design is sought;
- indications allowing the identity of the applicant to be established;
- a sufficiently clear reproduction of the industrial design;
- indications allowing the applicant or its representative, if any, to be contacted.

46. Other elements which are commonly required by offices for according a filing date are:

- an indication of the product(s) which constitute the industrial design or in relation to which the industrial design is to be used;
- the payment of a fee²⁹.

47. In addition, certain countries require a description, a claim, or indications concerning the identity of the creator³⁰.

(b) Time Limits to Comply With Requirements

48. Where an application does not contain all the elements or indications which are required to obtain a filing date, the majority of offices afford a time limit to the applicant to complete the application³¹.

49. While the most widespread time limit is two months, many offices afford a one-month time limit to complete the application³². This may give rise to some concern about the ability of an applicant who is not in the territory of the office to comply with the time limit.

50. Usually, where a filing date requirement is missing in an application, but is provided within the applicable time limit, the filing date of the application is that on which the missing element is received by the office. It should be noted, however, that in certain jurisdictions the “earlier” filing date is maintained, provided that the applicant furnishes any missing requirement within the applicable time limit³³.

(c) Filing Date Under the Geneva Act

51. The following paragraphs summarize the provisions concerning filing date in the Geneva Act which are most relevant to the present discussion. The text of the applicable provisions is contained in Annex I.

52. Under the Geneva Act, the filing date of an international application is the date on which the International Bureau of WIPO receives the application, where the application was filed directly with that Bureau, or the date on which the application was received by the Office of the Contracting Party of the applicant, where it was filed indirectly. However, it follows from Article 9(3) of the Geneva Act and Rule 14(2) of the Common Regulations of the Hague Agreement that the filing date is postponed where the international application does not contain the following, *inter alia*:

- an express or implicit indication that international registration is sought;
- indications allowing the identity of the applicant to be established;
- indications sufficient to enable the applicant or its representative, if any, to be contacted;
- a reproduction, or, in accordance with Article 5(1)(iii) of the 1999 Act (Geneva Act), a specimen, of each industrial design that is the subject of the international application.

53. Moreover, any Contracting Party whose office is an examining office and whose law, at the time it becomes party to the Geneva Act, requires that an application for the grant of protection to an industrial design contain certain elements may, in a declaration, notify the Director General of WIPO of those elements. The elements are the following:

- indications concerning the identity of the creator;
- a brief description of the reproduction or of the characteristic features of the industrial design, and
- a claim.

54. The effect of the aforementioned declaration is that, where the Contracting Party concerned is designated, the international application should contain those elements in order that it be accorded a filing date under the law of that Contracting Party.

55. Where any of the filing date requirements is missing, the Common Regulations under the Hague Agreement provide for a time limit of three months to correct the irregularity, calculated from the date of the invitation sent by the International Bureau. If the irregularity is corrected within that time limit, the filing date of the international application is the date on which the correction is received by the International Bureau.

(d) Filing Date Under the PLT

56. The following paragraphs summarize the provisions concerning filing date in the PLT which are most relevant to the present discussion. The text of the applicable provisions is contained in Annex II.

57. Under Article 5(1)(a) of the PLT, the filing date of an application should be the date on which an office has received all of the following indications and elements:

- an express or implicit indication to the effect that the elements 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 office³⁴;
- a part which on the face of it appears to be a description. A Contracting Party may accept a drawing instead, for the purposes of the filing date.

58. Where the application does not comply with one or more of the filing date requirements, Rule 2(1) of the Regulations under the PLT provides that the applicant should be given the opportunity to furnish the missing requirements within a time limit of not less than two months from the date of a notification sent by the office.

59. Where one or more of the filing date requirements are not complied with in the application as initially filed, the filing date is generally that on which all of the requirements are subsequently complied with. A Contracting Party may, however, provide that, where a missing requirement is not complied with within the time limit referred to in the foregoing paragraph, the application will be deemed not to have been filed.

Possible Area of Convergence on the Definition of Filing Date Requirements

With regard to the requirements for the granting of a filing date, consideration might be given to the possibility of converging towards the position that a filing date for an industrial design application should be granted if at least the following indications and elements are presented: a request that the registration of an industrial design is sought; indications allowing the identity of the applicant to be established; a sufficiently clear reproduction of the industrial design; indications allowing the applicant or its representative, if any, to be contacted. Moreover, consideration might be given as to whether the payment of a fee should constitute a filing date requirement.

IV. SECRET FOR A WHILE: DEFERMENT OF PUBLICATION AND SECRET DESIGN

(a) General Remarks

60. An underlying principle of any system of registration of industrial designs rests on the publication of the claimed design for the purpose of disclosure to the public. Without prejudice to that principle, a number of jurisdictions offer the possibility of requesting deferment of publication or registration of a secret design. This policy acknowledges a situation in which applicants may need to maintain the secrecy of their designs over a period of time, until the launching of the product, for example, while securing legal protection for those designs as soon as possible.

61. Out of the 67 SCT Members which replied to the Questionnaire, 32 indicated that deferment of publication is available under their legislation (that amounts to 49% of the respondents, as opposed to 42% which indicated that deferment is not provided for). A secret design system is available in Japan and the Republic of Korea.

62. In most systems of deferment of publication and of secret design, the industrial design is examined upon receipt of the application and recorded in the Register where it is successful at the stage of examination. Publication is however postponed for a prescribed period, although the possibility of requesting publication before the expiry of the applicable period is usually available.

63. The maximum deferment periods can vary substantially from one jurisdiction to another. This means that applicants wishing to obtain protection in several jurisdictions with different periods are in reality required to abide by the shortest period, since once publication has taken place in one jurisdiction, deferment in other jurisdictions ceases to make sense. Of course, the issue might be even more relevant where protection is sought at the same time in jurisdictions which do not provide for deferment of publication, yet a *de facto* deferment takes place in those jurisdictions which carry out a substantive examination.

64. The most widespread periods of deferment are 12 and 30 months from the date of filing or the priority date³⁵. It is worth noting that in a secret design system, the period for which the design can be kept secret commences at the date of registration, not at the date of filing or the priority date³⁶. That results in an effective longer period of secrecy.

65. As to the use which applicants make of the possibility of requesting deferment of publication, out of the 32 SCT Members which recognize that possibility in their legislation, only 5 (16%) declared in the Questionnaire that deferment is widely requested. It is interesting to note that the possibility is often availed of in the Scandinavian countries (85% of designs are subject to deferment in Finland, 70% in Norway, and 50% in Sweden). Regarding the large use of deferment in Norway, however, it has been pointed out that the reason for it may stem from the structure of the application form. In that form, the applicant has to indicate expressly that he does not wish to benefit from deferred publication, failing which deferment for six months is automatically applicable.

(b) Deferment of Publication Under the Geneva Act

66. Under the Geneva Act, publication of an international registration takes place six months after the date of the international registration, unless the applicant requests that it take place immediately after registration or that it be deferred. Deferment of publication may be requested for a maximum period of 30 months from the filing date or the priority date. However, a Contracting Party may, in a declaration, notify the Director General that its legislation does not provide for deferment, or provides for a shorter deferment period than 30 months.

67. It follows that, where an international application contains a request for deferment of publication, the publication takes place at the expiry of 30 months, where none of the designated Contracting Parties has made one of the declarations referred to in the foregoing paragraph. However, where one or several designated Contracting Parties have made a declaration for a shorter deferment period, the publication takes place at the expiry of the shortest period. Moreover, where a designated Contracting Party has made a declaration whereby deferment is not provided for under its legislation, the request for deferment is disregarded, unless the applicant withdraws the designation of that Contracting Party.

68. Earlier publication may be requested by the holder of the international registration at any time during the deferment period.

Possible Area of Convergence on Deferment of Publication and Secret Design

With regard to deferment of publication and secret design, consideration might be given to the possibility of converging towards the position that applicants should be given the possibility of maintaining an industrial design unpublished for a period of at least six months from the filing date.

V. A WHILE TO THINK: PERIOD OF GRACE IN CASE OF DISCLOSURE;
UNREGISTERED DESIGN

69. While it is important for creators to ensure protection of their designs as early as possible, filing an application for protection of an industrial design entails costs. Creators may not always be ready to incur those costs, before testing the degree of success on the market for the products embodying the design. That entails divulging the design to the public, which is in serious contradiction with the requirement of novelty.

70. In some jurisdictions, the existence of a grace period for filing an application after disclosure of the design may help creators in addressing a problem with two, conflicting variants, namely the requirement of novelty of the industrial design and the need to take account of certain considerations of a practical and economic nature. In addition, an unregistered design right in a number of jurisdictions provides an alternative type of protection to those creators who, on reflection, do not deem it necessary to register their designs.

(a) Grace Period in the Event of Disclosure

71. Article 25(1) of the TRIPS Agreement stipulates that “Members shall provide for the protection of independently created industrial designs that are new or original”. In most

jurisdictions, novelty is a condition for the validity of an industrial design³⁷. Usually, a design ceases to be novel when it is disclosed. However, in many jurisdictions, a disclosure under certain conditions does not destroy the novelty of the industrial design, provided that an application for registration of the design is filed within a given period of time³⁸.

72. The period of time, the “grace period,” varies from one jurisdiction to another. The most commonly accepted grace periods are 12 and 6 months from disclosure³⁹.

73. The existence of different grace periods to file following a disclosure, and more generally the fact that not all jurisdictions provide for such grace period, may have far-reaching implications for an applicant who wants to protect an industrial design internationally. For instance, an applicant whose country of origin provides for a grace period of 12 months, and who files in that country eight months after having disclosed the industrial design, files, at the same time, in country A, which provides for a grace period of six months, and in country B, which does not provide for a grace period. While the industrial design will be valid in the country of origin in spite of its disclosure prior to filing, it will be subject to a refusal or invalidation for lack of novelty in countries A and B.

74. Another relevant issue concerns the authorship of the disclosure eligible to give rise to the grace period. In the vast majority of jurisdictions, an eligible disclosure is one made by the creator or an authorized person⁴⁰. Moreover, a disclosure made by an unauthorized person, in bad faith or unintentionally, also gives rise to a grace period to file in a large number of jurisdictions⁴¹.

Possible Area of Convergence on Grace Period in the Event of Disclosure

With regard to a grace period for filing in the event of disclosure of an industrial design, consideration might be given to the possibility of converging towards the position that any disclosure made by the creator or her/his successor in title within 12 months prior to the date of filing should be without prejudice to the novelty/originality of the industrial design.

(b) Unregistered Design

75. Under a system of unregistered design, protection is provided to a design as soon as it is disclosed, without it being necessary for the creator to comply with any registration formality. The protection conferred is usually narrower than the one conferred by a registered design, as it is generally limited to copying by an identical design. Moreover, the term of protection, usually limited to three years, is shorter than the one provided by a registered design, and is not subject to renewal.

76. In combination with a grace period for filing after disclosure, a system of unregistered design enables creators to ensure some protection for their designs from the time of disclosure, while they take some time to consider the merit of incurring the costs of registration in respect of those designs.

77. The term “unregistered design” employed in this document is not recognized internationally, even though the general features of the system described under this term in paragraph 75, above, are shared by a number of jurisdictions.

78. The term is mainly used in Council Regulation (EC) N° 6/2002 of December 12, 2001 on Community Designs. In other jurisdictions, a system similar to the European Community unregistered design may be described differently, for instance “design right” in the United Kingdom. Yet other jurisdictions provide for a system similar to “unregistered design”, without describing such system by a specific term⁴². It is also worth mentioning that, while an “unregistered design” system is not provided for in the United States of America, the Vessel Hull Design Protection Act addresses some of the concerns which are referred to in this chapter.

VI. TERM OF PROTECTION AND RENEWAL

(a) Duration of Protection

79. Article 26(3) of the TRIPS Agreement provides for a minimum duration of protection of 10 years for industrial designs. Out of the 67 SCT Members which replied to the Questionnaire, 12 (nearly 18%) indicated that they provide for a total duration of protection corresponding to the 10-year minimum required by the TRIPS Agreement. In addition, 23 SCT Members (34%) indicated that they provide for a total duration of protection of 15 years, while 27 (40%) indicated that they provide for 25 years.

80. It has been mentioned that the needs of designers regarding the duration of protection of their designs depend on the type of product embodying the design. While designs associated with certain short-lived products may not require very long protection, those embodied in products with longer life cycles may need to be protected for a longer period. It has been further mentioned that the duration of the protection should take account of this diversity.

81. Moreover, it has been said that a careful balance between the needs of designers and the needs of third parties should be borne in mind by legislators when deciding on the duration of the protection. It is important that designs for which protection is no longer required by owners might fall into the public domain within a reasonable period of time.

(b) Structure of the Duration of Protection

82. Structuring the period of protection in separate terms enables jurisdictions to address the concern for a fair balance between the needs of design holders and the needs of third parties⁴³.

83. In most jurisdictions, an industrial design is protected for an initial term of five years, and may be renewed for additional five-year terms⁴⁴.

84. That structure is followed also by the Geneva Act. The minimum period of protection under the Geneva Act is 15 years, but an industrial design can be renewed in respect of a given Contracting Party beyond that period, by further terms of five years, up to the expiry of the total period of protection (beyond 15 years) in that Contracting Party.

85. In contrast to the approach described above, some jurisdictions provide protection in a single, non-renewable term. Out of the 67 SCT Members which replied to the Questionnaire, 15 (22%) indicated that protection is granted in one single term.

Possible Area of Convergence on Term of Protection

With regard to the term of protection, consideration might be given to the possibility of converging towards the position that the period of protection should be divided into an initial term of five years, renewable for additional five-year terms, up to a maximum period to be decided at the national or regional level.

VII. COMMUNICATIONS

(a) Means of Transmittal and Form of Communications

86. Communications on paper are accepted by all the SCT Members which replied to the Questionnaire. Moreover, most offices accept communications filed by electronic means of transmittal, such as facsimile⁴⁵. Communications filed in electronic form, for instance via the Internet, are accepted by many offices, although not all of them accept the electronic filing (e-filing) of applications⁴⁶.

87. In one half of the SCT Members which indicated that they accept the filing of communications in electronic form (40% of the SCT Members which replied to the Questionnaire), those communications may be authenticated through a system of electronic authentication.

(b) Signature Requirements

88. A communication on paper must be signed by the applicant, holder or other interested person in the vast majority of jurisdictions (94% of the SCT Members which replied to the Questionnaire), but it is seldom that the signature must be certified as a matter of course (13% of the SCT Members which replied to the Questionnaire). In a number of jurisdictions, certification of the signature is required only in certain special cases, for example in case of surrender of the registration⁴⁷.

(c) Communications Under the Singapore Treaty and the PLT

89. Under both the Singapore Treaty and the PLT, a Contracting Party may choose the means of transmittal of communications. Under the PLT, while a Contracting Party may choose a means of transmittal other than paper, it cannot exclude the filing of communications on paper for the purposes of establishing a filing date or complying with a time limit. Concerning the Singapore Treaty, Contracting Parties may prescribe the exclusive use of electronic means of communication. Nevertheless, Article 8(7) of the Singapore Treaty states explicitly that this provision is without prejudice to the means of communication between an applicant, holder or other interested person and its representative.

90. With respect to signatures, a Contracting Party under both treaties may require that a communication on paper be signed by the applicant, holder or other interested person, as the case may be. However, no Contracting Party may require the attestation, notarization, authentication, legalization or other certification of any signature, except, under the Singapore Treaty, in the case of surrender of a registration, or, under the PLT, in respect of any quasi-judicial proceedings. Moreover, under the PLT, a Contracting Party may require that evidence be filed with the Office where it reasonably doubts the authenticity of a signature, and that an electronic signature under Rule 9(5) be confirmed by a process for certifying signatures in electronic form specified by that Contracting Party.

Possible Area of Convergence on Communications

With regard to communications, consideration might be given to the possibility of converging towards the position that the means of transmittal of communications should be determined by offices. With regard to communications on paper, offices should have the possibility of requiring that such communications be signed. However, no attestation, notarization, authentication, legalization or other certification of any signature should be required by offices, except in individual specified cases.

VIII. RELIEF MEASURES

(a) Available Relief Measures

91. Most jurisdictions provide for one or more of the following relief measures in case of failure of the applicant or holder to comply with a time limit for an action in a proceeding before the office: extension of the time limit, continued processing and reinstatement of rights⁴⁸.

92. Most jurisdictions provide for an extension of the time limit, whether before or after the expiration of such time limit⁴⁹. Often, that measure exists together with another relief measure.

93. Continued processing is available as far as concerns 40% of the SCT Members which replied to the Questionnaire. The effect of continued processing is that the office will continue with the procedure concerned as if the time limit had been complied with. The omitted act must then be completed within the time period available for filing a request for continued processing, without it being necessary for the person making the request to state the reasons for the failure to comply with the time limit.

94. Reinstatement of rights is available in 49% of the SCT Members which replied to the Questionnaire. A request for reinstatement of rights should usually state the reasons for the failure to comply with a time limit, and is subject to a finding by the office that the failure occurred in spite of due care required by the circumstances or that the failure was unintentional.

(b) Relief Measures Under the Singapore Treaty⁵⁰

95. While a Contracting Party is free to provide for the extension of a time limit *prior* to the expiry of such time limit, it has an obligation to provide for one or more of the following relief measures *after* the expiry of a time limit: extension of the time limit, continued processing or reinstatement of rights.

96. Exceptions to the aforementioned obligation are provided for in the Regulations under the Singapore Treaty. Such exceptions include failure to comply with a time limit where a relief measure has already been granted, for filing a request for a relief measure, for payment of a renewal fee, for an action in *inter partes* proceedings, for filing certain declarations, or for the correction or addition of a priority claim.

(c) Relief Measures Under the PLT⁵¹

97. Prior to the expiry of a time limit fixed by the office, a Contracting Party is free to provide for the extension of such time limit. After the expiry of a time limit, a Contracting Party is obliged to provide for a relief measure in the form of either an extension of the time limit or continued processing.

98. Exceptions to such obligation are provided for in the Regulations under the PLT, and include the same cases as under the Singapore Treaty, except the cases of failure to comply with a time limit for the filing of certain declarations.

99. In addition to one of the relief measures mentioned above, a Contracting Party is obliged to provide for reinstatement of rights in case of failure of the applicant or owner to comply with a time limit entailing a loss of rights, where the office concerned finds that such failure occurred in spite of due care required by the circumstances having been taken or was unintentional. A number of exceptions to that obligation are also provided for in the Regulations under the PLT.

Possible Area of Convergence on Relief Measures

With regard to relief measures, consideration might be given to the possibility of converging towards the position that offices should provide for at least one of the following relief measures in case of failure of the applicant or holder to comply with a time limit for action in a procedure before the office, after the expiry of such time limit: extension of the time limit, continued processing or reinstatement of rights. Alternatively, it could be considered that offices should provide for either extension of the time limit or continued processing in case of failure to comply with an expired time limit, and additionally provide for reinstatement of rights.

IX. RELATIONSHIP BETWEEN INDUSTRIAL DESIGNS AND OTHER RIGHTS

100. It is widely agreed that certain subject matter can in theory be protected by different intellectual property protection systems. This chapter addresses the situation in SCT Members regarding the relationship between industrial designs and trademarks, copyright and unfair competition law, based on the returns to the Questionnaire on Industrial Design Law and Practice (Part II).

(a) Relationship With Trademarks

101. In the majority of jurisdictions, a given object can be protected at the same time by design law and by trademark law, subject to that object complying with the applicable requirements under each system. In other words, for an object to be protected as an industrial design and as a trademark, it must not only be novel or original, but also be capable of functioning as a mark, that is to say, allow consumers to distinguish goods on the market.

(i) *Elements Which May Enjoy Coexisting Protection in Many Jurisdictions*

102. In most jurisdictions, according to the applicable law, the following subject matter may be protected at the same time under industrial design law and trademark law:

- product packaging (in 98% of the SCT Members which replied to the Questionnaire);
- product shape (in 93% of the SCT Members which replied to the Questionnaire);
- ornamentation, such as figurative elements and patterns (in 89% of the SCT Members which replied to the Questionnaire);
- labels (in 87% of the SCT Members which replied to the Questionnaire);
- a cartoon character (in 81% of the SCT Members which replied to the Questionnaire);
- a graphic symbol, such as a drawing, picture, or logo (in 80% of the SCT Members which replied to the Questionnaire).

(ii) *Distinctiveness Acquired During the Period of Industrial Design Protection*

103. Out of the 44 SCT Members which replied to the Questionnaire, 36 (76%) indicated that a protected industrial design may acquire distinctiveness in the sense of trademark law during the period of industrial design protection.

(b) Relationship With Copyright

104. Industrial designs as ornamental and aesthetic creations can in theory be protected, not only by design *sui generis* law, but also by copyright. Depending on whether both regimes of protection are applicable simultaneously or alternatively, there are at least three approaches to the protection under industrial design and copyright, namely cumulative protection, separation of protection, and partial overlap of protection.

(i) *Cumulative Protection*

105. Following this approach, a design may be simultaneously protected by *sui generis* industrial design law and by copyright law.

106. Cumulative protection is based in a number of countries on the theory of *unity of art*. This theory states that art may be expressed in many ways and fixed in any material support, and that an artistic expression should not be dismissed merely because it is fixed or embodied in a utilitarian article.

107. Out of the 44 SCT Members which replied to the Questionnaire, 23 follow this approach.

(ii) *Separate Protection*

108. Under this approach, an industrial design can only be protected under the special regime for industrial designs, and cannot, as a matter of principle, be assimilated to a work of art protected by copyright.

109. A regime of strict separation of protection is followed by 7% of the SCT Members which replied to the Questionnaire.

110. However, certain jurisdictions admit that a subject matter which could be protected under industrial design law may be alternatively protected under copyright law. This is the position of 15 out of the 44 SCT Members that responded to the Questionnaire.

(iii) *Partial Overlap: Cumulative Protection Subject to Conditions*

111. Under this approach, protection is provided for the shape or appearance of any utilitarian, industrial or consumer product, but overlapping copyright protection is allowed in the event that the design can also be considered as a work of art.

112. In reference to the Questionnaire, out of 44 SCT Members which replied to the Questionnaire, 18 require that a subject matter which is protected under industrial design law presents a *high* or *marked* artistic character to be protected under copyright law.

113. Partial overlap of protection regimes may also be made to depend on whether the subject matter can be identified *separately* from, and exist *independently* of, the functional aspect of the product. This approach is followed by 10 out of the 44 SCT Members which replied to the Questionnaire (28%).

(c) Relationship With Unfair Competition

114. In many countries, a design may be protected against acts of unfair competition, including slavish copying and acts that may lead to confusion, acts of imitation or use of a third party's reputation. However, protection under unfair competition is generally significantly weaker and infringement is more difficult to prove.

115. Three approaches to the relationship between industrial design protection and unfair competition have been identified: a cumulative protection, a cumulative protection under conditions and a separate protection approach.

(i) *Cumulative Protection*

116. Certain jurisdictions accept that a subject matter which is protected under industrial design law may be protected at the same time under unfair competition law. This is the position of 17 (41%) out of 44 Members States of the SCT that responded to the Questionnaire.

(ii) *Cumulative Protection Subject to Conditions*

117. In certain jurisdictions, cumulative protection is subjected to conditions. Out of the 44 SCT Members which replied to the Questionnaire, 22 (54%) request certain conditions for a cumulative protection. 16 of those SCT Members declared that a subject matter which is

protected under industrial design law may be protected under unfair competition if there is a *distinct* act of unfair competition, which can be identified *separately* from an act of infringement of the industrial design.

(iii) *Separate Protection*

118. Out of the 44 SCT Members which replied to the Questionnaire, two indicated that a subject matter which is protected under industrial design law cannot be protected under unfair competition law.

X. OTHER ISSUES: PRIORITY DOCUMENT ACCESS SERVICE

119. The project establishing a digital access service for priority documents in the field of patents was initiated three years ago. The service, called “Priority Document Access Service,” is administered by the International Bureau of WIPO. It offers a simple and safe digital alternative to filing paper copies of priority documents with multiple patent offices, as it enables a patent applicant claiming priority to request patent offices of second filing to retrieve a copy of the priority document themselves via the service.

(a) Background

120. In 2006, the Assembly of the Paris Union for the Protection of Industrial Property, the Patent Law Treaty Assembly and the International Patent Cooperation Union Assembly (PCT Union) approved a proposal to establish the Digital Access Service for Priority Documents⁵². The creation of the service responds to an Agreed Statement by the Diplomatic Conference for the Adoption of the Patent Law Treaty in which WIPO was urged to expedite the creation of a digital library system for priority documents.

121. In addition, the Assemblies approved the convening of an *ad hoc* Working Group to consider matters associated with the establishment of the service. In particular, the Working Group was required to make recommendations for framework provisions and appropriate procedures for administering the service.

122. The Working Group on the Digital Access Service for Priority Documents had its first session in February 2007, and during the second session, held in July 2007, agreed, in principle, on the text of framework provisions designed to implement the digital access service for priority documents.

(b) Practical Aspects

123. The service functions as follows:

124. After a first filing, a patent applicant will request the office of first filing to deposit the priority document in a participating digital library. Following the deposit by the office of first filing, the applicant will be sent an “access code” by either the office of first filing or the International Bureau.

125. When making subsequent filings, the applicant will claim priority in exactly the same way as normal, but instead of sending a priority document to the office of second filing, the applicant will ask the office to retrieve a copy via the service. To that end, the applicant will have to have first authorized the office to access the document, by using the access code to manage a list, held on WIPO's PATENTSCOPE® website, of offices permitted to access the document.

126. WIPO does not charge for this service. However, a fee may be charged by the offices of first or second filing for the storage or retrieval of documents. The use of the service is voluntary for both applicants and offices.

(c) State of Advancement of the Project

127. On April 1, 2009, the Priority Document Access Service went into service with the Japan Patent Office (JPO) and the PCT Receiving Office of the International Bureau. The United States Patent and Trademark Office (USPTO) joined on April 20, 2009, and it is expected that the European Patent Office (EPO) and the Korean Intellectual Property Office (KIPO) will join around the second half of 2009. There are several other offices at various stages of testing, some of which will probably join the system later this year.

XI. CONCLUSION

128. This document has examined nine areas of industrial design law and practice. It has touched upon the practical issues regarding each area, and attempted to describe the different approaches followed by the national and regional systems in the SCT Members, on the basis of the replies to the questionnaire (document WIPO Strad/INF/2 Rev. 1) and of the discussion reflected in the report of the twentieth session of the SCT (document SCT/20/5 Prov.). In addition, the document has presented the existing international legal framework which might be relevant to each area.

129. Based on all those elements, the document has identified a number of possible areas of convergence. Those are: the form of reproduction, the views and the number of copies of the reproduction, specimens, other contents of the application, multiple applications, filing date requirements, deferment of publication, period of grace for filing in the event of disclosure, term of protection, communications and relief measures.

130. Positions regarding the availability of an unregistered design and the relationship between industrial designs and other intellectual property systems remain divergent. It should be noted that the discussion in the SCT over those issues has been very limited, so that it has not been possible to identify any possible area of convergence.

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

(i) comment the possible areas of convergence and the Priority Document Access Service presented in the document;

(ii) *amend the possible areas of convergence presented in the document, add further possible areas of convergence or omit any of them;*

(iii) *consider the areas mentioned in paragraph 130, above;*

(iv) *consider any further course of action in respect of points (i) to (iii), above.*

[Annexes follow]

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- 1 See “Quantitative Summary of Replies to the Questionnaires on Industrial Design Law and
Practice” (SCT/19/6, Annex I), page 17.
- 2 *Idem*, page 2.
- 3 See Rule 9(1) of the Common Regulations under the 1999 Act, the 1960 Act and the 1934 Act
of the Hague Agreement.
- 4 See Section 403 of the Administrative Instructions for the Application of the Hague Agreement.
5 See document SCT/20/5 Prov., paragraphs 70 and 72, concerning the interventions of the
Delegations of the United States of America and of Uzbekistan. See also Section 404(b) of the
Administrative Instructions for the Application of the Hague Agreement.
- 6 See document SCT/20/5 Prov., paragraph 69, concerning the intervention of the Delegation of
Sweden.
- 7 See document SCT/20/5 Prov., paragraph 18, concerning the intervention of the Delegation of
Germany.
- 8 26% of the returns to the Questionnaire indicate that one copy is required; 24% require two, and
22% require three copies. Under the Geneva Act, a single copy is required.
- 9 See Article 5(1)(iii) of the Geneva Act.
- 10 See document SCT/20/5 Prov., paragraphs 114 to 117 and paragraph 122.
- 11 See document SCT/19/6, Annex I, pages 10 and 11.
- 12 Out of the 67 SCT Members which replied to the Questionnaire, 21 indicated that they require a
claim.
- 13 A description is mandatory in nearly 40% of the SCT Members which replied to the
Questionnaire.
- 14 Out of the 40 SCT Members which replied to the question concerned in the Questionnaire,
12 indicated that the scope of the protection is determined on the basis of the reproduction *and* a
description of the characteristic features.
- 15 For instance, a description may not exceed 100 words under the Registered Community Design
system. Under the Common Regulations under the 1999 Act, the 1960 Act and the 1934 Act of
the Hague Agreement, any description exceeding 100 words is subject to the payment of an
additional fee.
- 16 Out of the 67 SCT Members which replied to the question concerned in the Questionnaire,
52 indicated that the application must contain indications allowing the identity of the creator to
be established.
- 17 45% of the SCT Members which replied to the Questionnaire indicated that there was a
requirement of unity of design or unity of invention in their legislation.

[Endnote continued from previous page]

18 69% of the SCT Members which allow multiple applications declared that the facility is often
used by applicants. See also document SCT/20/5 Prov., paragraph 163, reporting that “a small
majority of the applications received by OHIM are multiple”. As regards the Hague Agreement,
19 in 2008, 64% of international applications were multiple.
See the Report of the Third Session of the Committee of Experts on the Development of the
Hague Agreement Concerning the International Deposit of Industrial Designs
20 (document H/CE/III/3).
See document SCT/20/5 Prov., paragraph 157, concerning the intervention of the Delegation of
the Republic of Korea.
21 This is followed by 63% of the SCT Members which replied to the Questionnaire and indicated
that they accept multiple applications. This is also the criteria followed by the Geneva Act.
22 This is followed by 51% of the SCT Members which replied to the Questionnaire and indicated
that they accept multiple applications.
23 This is followed by 45% of the SCT Members which replied to the Questionnaire and indicated
that they accept multiple applications.
24 This is followed by 14% and 18%, respectively, of the SCT Members which replied to the
Questionnaire and indicated that they accept multiple applications.
25 Out of the 37 SCT Members which indicated that the number of industrial designs in a multiple
application is limited, 9 indicated that it is limited to 100 designs, and 8 indicated that it is
limited to 50 designs.
26 See document SCT/20/5 Prov., paragraph 163.
27 That is the case in 37 out of the 46 SCT Member States which replied to the question concerned
in the Questionnaire.
28 It is the case in over 80% of the SCT Members which replied to the Questionnaire.
29 These two elements are required by just over half of the SCT Members which replied to the
Questionnaire.
30 These elements are required by a number of SCT Members ranging between 26% and 33% of
those which replied to the Questionnaire.
31 Nearly 80% of the SCT Members which replied to the Questionnaire afford a time limit.
32 Out of the 50 SCT Members which indicated that they afford a time limit, 24 afford two months
and 11, one month.
33 See document SCT/20/5 Prov., paragraphs 152, 146 and 148, concerning the interventions of
the Delegations of Algeria, Brazil and Egypt.
34 Under Article 5(1)(c) of the PLT, a Contracting Party may require both information allowing
the identity of the applicant to be established and information allowing the applicant to be
contacted by the office.
35 Out of the 32 SCT Members which indicated that they provide for deferment of publication,
12 indicated that the maximum deferment period is 12 months, while a further 12 indicated that
it is 30 months.
36 In Japan, a design can be kept secret for a maximum period of three years from the date of
registration of the design.
37 That is the case in 95% of the SCT Members that replied to the Questionnaire.
38 That is the case in 86% of the SCT Members that replied to the Questionnaire.
39 In 60% of the SCT Members that provide for a grace period, that period is 12 months, whereas
it is 6 months in 33% of those Members, according to the replies to the Questionnaire.
40 That is the case in all of the SCT Members that indicated in their reply to the Questionnaire that
they provide for a grace period in the event of disclosure.
41 That is the case in 24 out of the 37 SCT Members that indicated in their reply to the
Questionnaire that they provide for a grace period in the event of disclosure.
42 See, for instance, the laws on patents, utility models and industrial designs of Guatemala and
Nicaragua.

[Endnote continued on next page]

[Endnote continued from previous page]

- 43 Out of the 67 SCT Members which replied to the Questionnaire, 53 (nearly 80%) indicated that
the period of protection is structured in several terms.
- 44 This structure is followed by 69% of the SCT Members which replied to the Questionnaire.
- 45 In 68% of the SCT Members which replied to the Questionnaire.
- 46 While 40% of the SCT Members which replied to the Questionnaire indicated that they accept
communications filed in electronic form, only one third indicated that they provide for e-filing
of applications.
- 47 One third of the SCT Members which replied to the Questionnaire indicated that certification of
the signature is required only in case of surrender of the registration or in other special cases.
- 48 84% of the SCT Members which replied to the Questionnaire indicated that one or several relief
measures are available in their jurisdictions.
- 49 81% of the SCT Members which replied to the Questionnaire provide for an extension of the
time limit.
- 50 See Article 14 of the Singapore Treaty and Rule 9 of the Regulations under the Singapore
Treaty.
- 51 See Articles 11 and 12 of the PLT and Rules 12 and 13 of the Regulations under the PLT.
- 52 See document A/42/5 and document A/42/14, paragraph 220.

ANNEX I

[Geneva Act of the Hague Agreement Concerning the International Registration
of Industrial Designs]

“Article 9

Filing Date of the International Application

- (1) [*International Application Filed Directly*] Where the international application is filed directly with the International Bureau, the filing date shall, subject to paragraph (3), be the date on which the International Bureau receives the international application.
- (2) [*International Application Filed Indirectly*] Where the international application is filed through the Office of the applicant's Contracting Party, the filing date shall be determined as prescribed.
- (3) [*International Application with Certain Irregularities*] Where the international application has, on the date on which it is received by the International Bureau, an irregularity which is prescribed as an irregularity entailing a postponement of the filing date of the international application, the filing date shall be the date on which the correction of such irregularity is received by the International Bureau.”

“Rule 14

Examination by the International Bureau”

- (1) [*Time Limit for Correcting Irregularities*] If the International Bureau finds that the international application does not, at the time of its receipt by the International Bureau, fulfill the applicable requirements, it shall invite the applicant to make the required corrections within three months from the date of the invitation sent by the International Bureau.
- (2) [*Irregularities Entailing a Postponement of the Filing Date of the International Application*] Where the international application has, on the date on which it is received by the International Bureau, an irregularity which is prescribed as an irregularity entailing a postponement of the filing date of the international application, the filing date shall be the date on which the correction of such irregularity is received by the International Bureau. The irregularities which are prescribed as entailing a postponement of the filing date of the international application are the following:
- (a) the international application is not in the prescribed language or one of the prescribed languages;

(b) any of the following elements is missing from the international application:

(i) an express or implicit indication that international registration under the 1999 Act, the 1960 Act or the 1934 Act is sought;

(ii) indications allowing the identity of the applicant to be established;

(iii) indications sufficient to enable the applicant or its representative, if any, to be contacted;

(iv) a reproduction, or, in accordance with Article 5(1)(iii) of the 1999 Act, a specimen, of each industrial design that is the subject of the international application;

(v) the designation of at least one Contracting Party.

(3) [*International Application Considered Abandoned; Reimbursement of Fees*]
Where an irregularity, other than an irregularity referred to in Article 8(2)(b) of the 1999 Act, is not remedied within the time limit referred to in paragraph (1), the international application shall be considered abandoned and the International Bureau shall refund any fees paid in respect of that application, after deduction of an amount corresponding to the basic fee.”

[Annex II follows]

ANNEX II

[Patent Law Treaty]

“Article 5
Filing Date

(1) [*Elements of Application*] (a) Except as otherwise prescribed in the Regulations, and subject to paragraphs (2) to (8), a Contracting Party shall provide that the filing date of an application shall be the date on which its Office has received all of the following elements, filed, at the option of the applicant, on paper or as otherwise permitted by the Office for the purposes of the filing date:

(i) an express or implicit indication to the effect that the elements are intended to be an application;

(ii) indications allowing the identity of the applicant to be established or allowing the applicant to be contacted by the Office;

(iii) a part which on the face of it appears to be a description.

(b) A Contracting Party may, for the purposes of the filing date, accept a drawing as the element referred to in subparagraph (a)(iii).

(c) For the purposes of the filing date, a Contracting Party may require both information allowing the identity of the applicant to be established and information allowing the applicant to be contacted by the Office, or it may accept evidence allowing the identity of the applicant to be established or allowing the applicant to be contacted by the Office, as the element referred to in subparagraph (a)(ii).

(2) [*Language*] (a) A Contracting Party may require that the indications referred to in paragraph (1)(a)(i) and (ii) be in a language accepted by the Office.

(b) The part referred to in paragraph (1)(a)(iii) may, for the purposes of the filing date, be filed in any language.

(3) [*Notification*] Where the application does not comply with one or more of the requirements applied by the Contracting Party under paragraphs (1) and (2), the Office shall, as soon as practicable, notify the applicant, giving the opportunity to comply with any such requirement, and to make observations, within the time limit prescribed in the Regulations.

(4) [*Subsequent Compliance with Requirements*] (a) Where one or more of the requirements applied by the Contracting Party under paragraphs (1) and (2) are not complied with in the application as initially filed, the filing date shall, subject to subparagraph (b) and paragraph (6), be the date on which all of the requirements applied by the Contracting Party under paragraphs (1) and (2) are subsequently complied with.

(b) A Contracting Party may provide that, where one or more of the requirements referred to in subparagraph (a) are not complied with within the time limit prescribed in the Regulations, the application shall be deemed not to have been filed. Where the application is deemed not to have been filed, the Office shall notify the applicant accordingly, indicating the reasons therefore.

(5) [*Notification Concerning Missing Part of Description or Drawing*] Where, in establishing the filing date, the Office finds that a part of the description appears to be missing from the application, or that the application refers to a drawing which appears to be missing from the application, the Office shall promptly notify the applicant accordingly.

(6) [*Filing Date Where Missing Part of Description or Drawing Is Filed*]

(a) Where a missing part of the description or a missing drawing is filed with the Office within the time limit prescribed in the Regulations, that part of the description or drawing shall be included in the application, and, subject to subparagraphs (b) and (c), the filing date shall be the date on which the Office has received that part of the description or that drawing, or the date on which all of the requirements applied by the Contracting Party under paragraphs (1) and (2) are complied with, whichever is later.

(b) Where the missing part of the description or the missing drawing is filed under subparagraph (a) to rectify its omission from an application which, at the date on which one or more elements referred to in paragraph (1)(a) were first received by the Office, claims the priority of an earlier application, the filing date shall, upon the request of the applicant filed within a time limit prescribed in the Regulations, and subject to the requirements prescribed in the Regulations, be the date on which all the requirements applied by the Contracting Party under paragraphs (1) and (2) are complied with.

(c) Where the missing part of the description or the missing drawing filed under subparagraph (a) is withdrawn within a time limit fixed by the Contracting Party, the filing date shall be the date on which the requirements applied by the Contracting Party under paragraphs (1) and (2) are complied with.

(7) [*Replacing Description and Drawings by Reference to a Previously Filed Application*]

(a) Subject to the requirements prescribed in the Regulations, a reference, made upon the filing of the application, in a language accepted by the Office, to a previously filed application shall, for the purposes of the filing date of the application, replace the description and any drawings.

(b) Where the requirements referred to in subparagraph (a) are not complied with, the application may be deemed not to have been filed. Where the application is deemed not to have been filed, the Office shall notify the applicant accordingly, indicating the reasons therefore.

(8) [*Exceptions*] Nothing in this Article shall limit:

(i) the right of an applicant under Article 4G(1) or (2) of the Paris Convention to preserve, as the date of a divisional application referred to in that Article, the date of the initial application referred to in that Article and the benefit of the right of priority, if any;

(ii) the freedom of a Contracting Party to apply any requirements necessary to accord the benefit of the filing date of an earlier application to an application of any type prescribed in the Regulations.”

“Rule 2

Details Concerning Filing Date Under Article 5

(1) [*Time Limits Under Article 5(3) and (4)(b)*] Subject to paragraph (2), the time limits referred to in Article 5(3) and (4)(b) shall be not less than two months from the date of the notification referred to in Article 5(3).

(2) [*Exception to Time Limit Under Article 5(4)(b)*] Where a notification under Article 5(3) has not been made because indications allowing the applicant to be contacted by the Office have not been filed, the time limit referred to in Article 5(4)(b) shall be not less than two months from the date on which one or more elements referred to in Article 5(1)(a) were first received by the Office.

(3) [*Time Limits Under Article 5(6)(a) and (b)*] The time limits referred to in Article 5(6)(a) and (b) shall be:

(i) where a notification has been made under Article 5(5), not less than two months from the date of the notification;

(ii) where a notification has not been made, not less than two months from the date on which one or more elements referred to in Article 5(1)(a) were first received by the Office.

(4) [*Requirements Under Article 5(6)(b)*] Any Contracting Party may, subject to Rule 4(3), require that, for the filing date to be determined under Article 5(6)(b):

(i) a copy of the earlier application be filed within the time limit applicable under paragraph (3);

(ii) a copy of the earlier application, and the date of filing of the earlier application, certified as correct by the Office with which the earlier application was filed, be filed upon invitation by the Office, within a time limit which shall be not less than four months from the date of that invitation, or the time limit applicable under Rule 4(1), whichever expires earlier;

(iii) where the earlier application is not in a language accepted by the Office, a translation of the earlier application be filed within the time limit applicable under paragraph (3);

(iv) the missing part of the description or missing drawing be completely contained in the earlier application;

(v) the application, at the date on which one or more elements referred to in Article 5(1)(a) were first received by the Office, contained an indication that the contents of the earlier application were incorporated by reference in the application;

(vi) an indication be filed within the time limit applicable under paragraph (3) as to where, in the earlier application or in the translation referred to in item (iii), the missing part of the description or the missing drawing is contained.

(5) [*Requirements Under Article 5(7)(a)*]

(a) The reference to the previously filed application referred to in Article 5(7)(a) shall indicate that, for the purposes of the filing date, the description and any drawings are replaced by the reference to the previously filed application; the reference shall also indicate the number of that application, and the Office with which that application was filed. A Contracting Party may require that the reference also indicate the filing date of the previously filed application.

(b) A Contracting Party may, subject to Rule 4(3), require that:

(i) a copy of the previously filed application and, where the previously filed application is not in a language accepted by the Office, a translation of that previously filed application, be filed with the Office within a time limit which shall be not less than two months from the date on which the application containing the reference referred to in Article 5(7)(a) was received by the Office;

(ii) a certified copy of the previously filed application be filed with the Office within a time limit which shall be not less than four months from the date of the receipt of the application containing the reference referred to in Article 5(7)(a).

(c) A Contracting Party may require that the reference referred to in Article 5(7)(a) be to a previously filed application that had been filed by the applicant or his predecessor or successor in title.

(6) [*Exceptions Under Article 5(8)(ii)*] The types of applications referred to in Article 5(8)(ii) shall be:

- (i) divisional applications;
- (ii) applications for continuation or continuation-in-part;
- (iii) applications by new applicants determined to be entitled to an invention contained in an earlier application.”

[End of Annex II and of document]