

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

Twenty-Sixth Session
Geneva, October 24 to 28, 2011

INDUSTRIAL DESIGN LAW AND PRACTICE – DRAFT REGULATIONS

Document prepared by the Secretariat

INTRODUCTION

1. At its twenty-fifth session, held in Geneva from March 28 to April 1, 2011, the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (hereinafter referred as the “SCT”) requested the Secretariat to prepare a revised working document for consideration at the twenty-sixth session of the SCT, reflecting all comments made at the twenty-fifth session and highlighting the issues that needed more discussion.
2. During the discussions held at the twenty-fifth session of the SCT, a number of delegations suggested splitting the revised working document into two documents, for ease of reference, the first containing draft Articles and the second containing draft Regulations. Accordingly, the Secretariat has prepared two revised working documents. The first is document SCT/26/2, with an Annex containing draft Articles, i.e. provisions of a general nature. The second is the present document, with an Annex containing draft Regulations, which further elaborate upon a number of the draft Articles.
3. The Annex to this document contains the following new draft Rules, as requested by the SCT: Rule 1 (Abbreviated Expressions), Rule 14 (Details Concerning the Request for Recording of a Change in Name or Address) and Rule 15 (Details Concerning the Request for Correction of a Mistake).

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

(i) comment upon the draft Regulations;

(ii) review the draft Regulations, amend them, add further draft Rules, or omit any of them; and

(iii) indicate how it wishes to pursue its work on design law and practice.

[Annex follows]

CONTENTS

page

REGULATIONS UNDER THE ARTICLES

Rule 1	Abbreviated Expressions	1
Rule 2	Details Concerning the Application	1
Rule 3	Details Concerning Representation of the Industrial Design	3
Rule 4	Details Concerning Representatives, Address for Service or Address for Correspondence	5
Rule 5	Details Concerning Filing Date	7
Rule 6	Details Concerning Publication	7
Rule 7	Details Concerning Communications	8
Rule 8	Identification of an Application Without Its Application Number	11
Rule 9	Details Concerning Renewal	11
Rule 10	Details Concerning Relief in Respect of Time Limits	12
Rule 11	Details Concerning Reinstatement of Rights After a Finding by the Office of Due Care or Unintentionality Under Article 13	13
Rule 12	Details Concerning the Requirements Concerning the Request for Recording of a License or a Security Interest or for Amendment or Cancellation of the Recording of a License or a Security Interest	14
Rule 13	Details Concerning the Request for Recording of a Change in Ownership	17
Rule 14	Details Concerning the Request for Recording of a Change in Name or Address ...	18
Rule 15	Details Concerning the Request for Correction of a Mistake	19

REGULATIONS UNDER THE ARTICLES

Rule 1
Abbreviated Expressions

- (1) *[Abbreviated Expressions Defined in the Regulations] For the purposes of these Regulations, unless expressly stated otherwise:*
- (i) *“Article” refers to the specified Article of the Articles;*
 - (ii) *“exclusive license” means a license which is only granted to one licensee and which excludes the holder from using the industrial design and from granting licenses to any other person;*
 - (iii) *“sole license” means a license which is only granted to one licensee and which excludes the holder from granting licenses to any other person but does not exclude the holder from using the industrial design;*
 - (iv) *“non-exclusive license” means a license which does not exclude the holder from using the industrial design or from granting licenses to any other person.*
- (2) *[Abbreviated Expressions Defined in the Articles] The abbreviated expressions defined in Article 1 for the purposes of the Articles shall have the same meaning for the purposes of these Regulations.*

Note on Rule 1

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

Rule 2
Details Concerning the Application

- (1) *[Further Requirements under Article 3] In addition to the requirements provided for in Article 3, a Party may require that an application contain some, or all, of the following indications or elements:*
- (i) *an indication of the product or products which incorporate the industrial design, or in relation to which the industrial design is to be used;*
 - (ii) *an indication of the class of the Locarno Classification to which belongs the product which constitutes the industrial design, or in relation to which the industrial design is to be used;*
 - (iii) *a claim;*

- (iv) *a statement of novelty;*
 - (v) *a description;*
 - (vi) *indications concerning the identity of the creator of the industrial design ;*
 - (vii) *a statement that the creator believes himself/ herself to be the creator of the industrial design;*
 - (viii) *where the applicant is not the creator of the industrial design, a statement of assignment or other evidence of the transfer of the design to the applicant;*
 - (ix) *the name of a State of which the applicant is a national, the name of a State in which the applicant is domiciled, if any, and the name of a State in which the applicant has a real and effective industrial or commercial establishment, if any;*
 - (x) *an indication of any prior application or registration, or other information, of which the applicant is aware, that could have an effect on the eligibility for registration of the industrial design;*
 - (xi) *where the applicant wishes to maintain the industrial design unpublished for a period of time, a request to that effect;*
 - (xii) *where the application includes more than one industrial design, an indication of the number of industrial designs included;*
 - (xiii) *an indication of the term of protection for which the application is filed;*
 - (xiv) *where a party requires payment of a fee in respect of an application, evidence that the payment was made.*
- (2) *[Requirements in Case of Divisional Applications] Where the applicant wishes that an application be treated as a divisional application:*
- (a) *an indication that he/she wishes the application to be so treated;*
 - (b) *the number and filing date of the initial application.*

Notes on Rule 2

Note 2.01 *Paragraph (1). Item (i).* Each Party will be free to determine how the indication of the product or products should be provided. A Party can require, for example, that the indication of the product be in the form of a title to the application or in any other specific form.

- Note 2.02 *Item (ii)*. This item was included in the list of possible contents of an application at the request of several delegations at the twenty-fourth session of the SCT. No Party will be *obliged* to require an indication of the class of the Locarno Classification.
- Note 2.03 *Item (iii)* refers to claims, in the sense of patent law. A claim under this item could be required by a Party in which industrial designs are protected under patent law. No Party will be *obliged* to require a claim.
- Note 2.04 *Item (vii)* was introduced following the twenty-fifth session of the SCT.
- Note 2.05 *Item (viii)* was amended following the twenty-fifth session of the SCT, in order to broaden the options given to the applicant to provide evidence of the transfer of the industrial design from the creator to the applicant.
- Note 2.06 *Item (x)* was included following the twenty-fourth session of the SCT, in order to enable an Office to obtain information that could affect the registrability of the industrial design, or to ascertain whether filing took place within the applicable grace period. The term “novelty”, used in the previous version of the document, has been replaced by “eligibility for registration”, so as to not unnecessarily narrow down the scope of this provision.
- Note 2.07 *Item (xi)* has been maintained as proposed in document SCT/25/3, as the discussion on Article 9, concerning the possibility of maintaining the industrial design unpublished for a period of time, is still ongoing.
- Note 2.08 *Item (xiii)* was included following the twenty-fifth session of the SCT. No Party will be obliged to provide for separate terms of protection. However, where a Party does enable the applicant to choose among different initial terms of protection, an indication of the term for which the application is filed will be needed.
- Note 2.09 *Item (xiv)* was included following the twenty-fifth session of the SCT. The term “evidence” is meant to include a copy of receipt, but may be interpreted wider so as to cover all form of payment.

Rule 3

Details Concerning Representation of the Industrial Design

- (1) *[Form of Representation of the Industrial Design]* (a) *The representation of the industrial design shall, at the option of the applicant, be in the form of:*
- (i) *photographs;*
 - (ii) *graphic reproductions;*
 - (iii) *any other visual representation admitted by the Office;*
 - (iv) *a combination of any of the above.*
- (b) *The representation of the industrial design may, at the option of the applicant, be in color or in black and white.*

- (c) *The industrial design shall be represented alone, to the exclusion of any other matter.*
- (2) *[Particulars Concerning Reproduction] The reproduction of the industrial design may include:*
- (a) *dotted or stippled lines, to indicate matter for which protection is not claimed;*
- (b) *shading, to show the contours or volume of a three-dimensional design.*
- (3) *[Views] (a) The industrial design may, at the option of the applicant, be represented by one view that fully discloses the appearance of the industrial design, or by several different views that fully disclose the appearance of the industrial design.*
- (b) *Notwithstanding subparagraph (a), additional, specific views may be required by the Office where such views are necessary to fully disclose the industrial design. However, additional views disclosing new matter do not have to be admitted.*
- (4) *[Number of Copies of Representation] No more than one copy of any representation of the industrial design may be required where the application is filed electronically, and no more than three copies where the application is filed on paper.*

Notes on Rule 3

- Note 3.01 *Paragraph (1).* Under this provision, applicants would have the choice as to the form of representation of the industrial design for which protection is sought. Applicants would thus have the possibility of representing the industrial design by means, for example, of photographs, graphic reproductions, such as drawings, or a combination thereof.
- Note 3.02 The words “any other visual representation” are intended to cover other forms of representation, such as computer-animated representations, or forms which are not currently known, but which may develop in the future. It is understood that, whatever the form which the representation of the industrial design may take, it should always be visual.
- Note 3.03 It is generally agreed that the industrial design should be represented in such a way as to completely disclose its appearance. While several views of the design may be needed to fully disclose certain designs, it cannot be excluded that even a three-dimensional design could be fully disclosed by means of a single view, such as, for example, a perspective view.

- Note 3.04 *Paragraph (2)(a)*. An applicant may include dotted or stippled lines in the reproduction of the industrial design, to indicate matter, for example environmental matter, for which protection is not claimed. Such matter, while not part of the industrial design itself, can help to better understand the nature of the design.
- Note 3.05 *Paragraph (3)* of this provision leaves it to the applicant to determine, on a case by case basis, the number and types of views which are needed to fully disclose the industrial design. Thus, applicants would no longer need to vary the number of views to satisfy the requirements of the different jurisdictions in which they file.
- Note 3.06 At the same time, this provision enables Offices to call for further views where they consider that such views are necessary to fully disclose the industrial design. However, in order for this provision to fulfill its underlying purpose, namely the streamlining of procedures, it would be presumed that Offices would implement it in a considered manner. It is not the spirit of this provision to enable Offices to systematically call for further views whenever an industrial design is three-dimensional.
- Note 3.07 This provision does not establish any maximum number of views which may be filed by the applicant, or published by an Office. Opting for a given number would present an inconvenience, as it is not unlikely that such number could rapidly become obsolete. An Office that is not presently in a position to publish more than a given number of views without additional cost could soon be able to increase that number, taking into account the pace at which new reproduction methods develop. Moreover, it is not unlikely that new reproduction techniques will make it easier for applicants to fully represent complex designs by means of fewer views.
- Note 3.08 The wording of subparagraph (b) was modified so as to clarify that the Office will determine whether or not an additional view results in the presentation of new matter.
- Note 3.09 In the absence of a provision regarding a maximum number of views, each Party remains free to introduce a limitation in its law in this respect, and to determine the maximum number.

Rule 4

Details Concerning Representatives, Address for Service or Address for Correspondence

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

- (b) *The power of attorney may relate to one or more applications and/or registrations identified in the power of attorney or, subject to any exception indicated by the appointing person, to all existing and future applications and/or registrations of that person.*
 - (c) *The power of attorney may limit the powers of the representative to certain acts. Any Party may require that any power of attorney under which the representative has the right to withdraw an application or to surrender a registration contain an express indication to that effect.*
 - (d) *Where a communication is submitted to the Office by a person referred to in the communication as a representative, but where the Office is, at the time of the receipt of the communication, not in possession of the required power of attorney, the Party may require that the power of attorney be submitted to the Office within the time limit fixed by the Party, which shall be not less than one month from the date of the invitation to such person to submit the power of attorney. Any Party may provide that, where the power of attorney has not been submitted to the Office within the time limit fixed by the Party, the communication by the said person shall have no effect.*
- (2) *[Reference to Power of Attorney] A Party may require that any communication made to the Office by a representative for the purposes of a procedure before the Office contain a reference to the power of attorney on the basis of which the representative acts.*
 - (3) *[Time Limit Under Article 4(6)] The time limit referred to in Article 4(6) shall be not less than one month from the date of the notification referred to in that Article.*
 - (4) *[Evidence] A Party may require that evidence be filed with the Office where the Office may reasonably doubt the veracity of any indication contained in any communication referred to in paragraph (1).*

Notes on Rule 4

Note 4.01 *Paragraph (1)(a).* Following the twenty-fifth session of the SCT, this provision was revised to follow the approach of Article 4(3)(a) of the Singapore Treaty instead of, as in the previous draft, the approach of Rule 7(2) of the Regulations under the PLT. In the previous draft, a Party would have had to accept the appointment of a representative made either in a separate power of attorney or in the application. Under the present draft, a Party may require that the appointment of a representative be made in a separate power of attorney. No reference is made to an appointment made in the application. The power of attorney should indicate the name of the applicant, holder, or other interested person, as well as the name and address of the representative. The elements required in the power of attorney are modeled, however, on Rule 7(2)(a)(i) of the PLT, rather than in Article 4(3)(a) of the Singapore Treaty. The elements required in the Singapore Treaty are limited to an indication of the name of the applicant, the holder or any other interested person.

- Note 4.02 *Paragraph (1)(b),(c) and (d)* is based on Article 4(3)(b), (c) and (d) of the Singapore Treaty. Regarding paragraph (1)(d) of this Rule, it provides for a minimum time limit of one month to submit a power of attorney in reply to the invitation by an Office. Following the twenty-fifth session of the SCT, a minimum time limit of one month has replaced a time limit of two months, to be more in line with Rule 4(3) of the Regulations under the Singapore Treaty. However, in contrast with this Rule, which distinguishes between two time limits, one or two months, depending on the address of the person on behalf of whom the communication is made, the proposed Rule establishes a single time limit, for the sake of consistency with Rule 5. The reason why a single time limit has been opted for under this Rule is that, as expressed during the 24th session of the SCT, providing for different time limits which depend on whether or not the address of the applicant is in the territory of the Party, is no longer justified in an era of electronic communication.
- Note 4.03 *Paragraph (3)*. For the sake of consistency with paragraph (1)(d), the time limit of two months which was proposed in the previous draft of this provision has been replaced by a one-month time limit.

Rule 5 **Details Concerning Filing Date**

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

Notes on Rule 5

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

Rule 6 **Details Concerning Publication**

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

Notes on Rule 6

- Note 6.01 This Rule provides for a minimum period of six months from the filing date or the priority date, during which an Office has to maintain an industrial design unpublished, if so requested by the applicant. A short period of six months has been opted for, in an attempt to strike a balance between the interest of applicants for secrecy and the interest of other parties. Other parties will most likely want to have the industrial design published as soon as possible, in order to have an idea of what is protected.
- Note 6.02 The Rule stipulates that the starting point of the six-month period is the filing date or, where priority is claimed, the priority date. It is true that, in many cases, where priority is claimed, the minimum period to maintain, upon request, the industrial design unpublished in the countries of second filing might be reduced or no longer available. However, as indicated by some delegations at the twenty-fifth session of the SCT, this approach would be consistent with the aim of the provision, namely to ensure that the applicant will be able to maintain the industrial design unpublished during a short period of time from the “beginning” of the registration procedures. Furthermore, this solution would better accommodate the different national approaches to postponement of publication.

Rule 7 **Details Concerning Communications**

- (1) *[Details Concerning Article 10(3)] (a) A Party may require that the address for correspondence referred to in Article 10(3)(i) and the address for service referred to in Article 10(3)(ii) be in a territory prescribed by that Party.*
- (b) *A Party may require that the applicant, holder, or other interested person, include some, or all, of the following contact details in any communication:*
- (i) *a telephone number;*
- (ii) *a telefacsimile number;*
- (iii) *an email address.*
- (2) *[Indications Accompanying Signature of Communication on Paper] A Party may require that the signature of the natural person who signs be accompanied by:*
- (a) *an indication, in letters, of the family or principal name and the given or secondary name or names, of that person or, at the option of that person, of the name, or names, customarily used by the said person;*
- (b) *an indication of the capacity in which that person signed, where such capacity is not obvious from reading the communication.*

- (3) *[Date of Signing]* A Party may require that a signature be accompanied by an indication of the date on which the signing was effected. Where that indication is required, but is not supplied, the date of signing shall be deemed to be the date on which the communication bearing the signature was received by the Office or, if the Party so allows, a date earlier than the latter date.
- (4) *[Signature of Communications on Paper]* Where a communication to the Office is on paper and a signature is required, that Party:
- (i) shall, subject to item (iii), accept a handwritten signature;
 - (ii) may permit, instead of a handwritten signature, the use of other forms of signature, such as a printed or stamped signature, or the use of a seal or of a bar-coded label;
 - (iii) may, where the natural person who signs the communication is a national of the country concerned and such person's address is in its territory, or where the legal entity on behalf of which the communication is signed is organized under its law and has either a domicile or a real and effective industrial or commercial establishment in its territory, require that a seal be used instead of a handwritten signature.
- (5) *[Attestation, Notarization, Authentication, Legalization or other Certification of a Signature of Communications on Paper]* A Party may require the attestation, notarization, authentication, legalization or other certification of any signature of a communication on paper, under Article 10(4)(b), if the communication concerns the surrender of a registration, where the law of the Party so provides.
- (6) *[Signature of Communications on Paper Filed by Electronic Means of Transmittal]* A Party that provides for communications on paper to be filed by electronic means of transmittal shall consider any such communication signed if a graphic or other representation of a signature accepted by that Party under paragraph (4) appears on the communication as received.
- (7) *[Original of a Communication on Paper Filed by Electronic Means of Transmittal]* A Party that provides for communications on paper to be filed by electronic means of transmittal may require that the original of any such communication be filed with the Office:
- (i) accompanied by a letter identifying that earlier transmission;
and
 - (ii) within a time limit which shall be at least one month from the date on which the Office received the communication by electronic means of transmittal.
- (8) *[Authentication of Communications in Electronic Form]* A Party that permits the filing of communications in electronic form may require that any such communication be authenticated through a system of electronic authentication, as prescribed by that Party.

- (9) *[Date of Receipt] A Party shall be free to determine the circumstances in which the receipt of a document or the payment of a fee shall be deemed to constitute receipt by or payment to the Office in cases in which the document was actually received by, or payment was actually made to*
- (i) *a branch or sub-office of the Office;*
 - (ii) *a national Office on behalf of the Office of the Party, where the Party is an intergovernmental organization;*
 - (iii) *an official postal service;*
 - (iv) *a delivery service, or an agency, specified by the Party;*
 - (v) *an address other than the nominated address(es) of the Office.*
- (10) *[Electronic Filing] (a) Subject to paragraph (8) and subparagraph (b), where a Party provides for the filing of a communication in electronic form or by electronic means of transmittal and the communication is so filed, the date on which the Office of that Party receives the communication in such form, or by such means, shall constitute the date of receipt of the communication.*
- (b) *Where the Office of a Party referred to in subparagraph (a) does not have evidence of the receipt of a communication filed in electronic form or by electronic means of transmittal, the date of transmittal of the communication shall be deemed to constitute the date of receipt of the communication, provided that evidence of the transmittal is supplied to the Office.*

Notes on Rule 7

- Note 7.01 *Paragraphs (2) to (10) are modeled on Rule 6 of the Regulations under the Singapore Treaty.*
- Note 7.02 *Paragraph (5) provides that a Party may require certification of any signature of a communication on paper, where the communication concerns the surrender of a registration and the law of the Party provides for such certification. Specifying in a Rule the case in which certification of signature may be required is justified by the fact that the Regulations constitute a more flexible framework to provide for other cases of certification of signature in the future, or remove any.*
- Note 7.03 *Subparagraph (b) of paragraph (10) has been added following the twenty-fifth session of the SCT, in order to address the situation where an Office has no record of having received a communication transmitted in electronic form or by electronic means, and the applicant, holder or other interested person claims that the communication has been transmitted. In order not to penalize the applicant, holder or other interested person, the person concerned is recognized as having filed as of the date on which the communication was transmitted, provided that evidence of the transmittal is submitted.*

Rule 8
Identification of an Application Without its Application Number

- (1) *Where it is required that an application be identified by its application number, but such a number has not yet been issued or is not known to the applicant or its representative, the application shall be considered identified if the following is supplied:*
- (i) *the provisional application number, if any, given by the Office; or*
 - (ii) *a copy of the application; or*
 - (iii) *a representation of the industrial design, accompanied by an indication of the date on which, to the best knowledge of the applicant or the representative, the application was received by the Office, along with any identification number given to the application by the applicant or the representative.*
- (2) *[Prohibition of Other Requirements] No Party may demand that requirements other than those referred to in paragraph (1) be complied with in order for an application to be identified where its application number has not yet been issued or is not known to the applicant or its representative.*

Note on Rule 8

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

Rule 9
Details Concerning Renewal

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

Note on Rule 9

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

Rule 10
Details Concerning Relief in Respect of Time Limits

- (1) *[Requirements Under Article 12(1)]* (a) A Party may require that a request referred to in Article 12(1):
- (i) *be signed by the applicant or holder;*
 - (ii) *contain an indication to the effect that an extension of a time limit is requested, and an identification of the time limit in question.*
- (b) *Where a request for an extension of a time limit is filed after the expiration of the time limit, a Party may require that all of the requirements for the action in respect of which the time limit applied, be complied with at the same time as the request is filed.*
- (2) *[Period and Time Limit Under Article 12(1)]* (a) *The period of extension of a time limit referred to in Article 12(1) shall be not less than two months from the date of the expiration of the un-extended time limit.*
- (b) *The time limit referred to in Article 12(1)(ii) shall expire not earlier than two months from the date of the expiration of the un-extended time limit.*
- (3) *[Requirements Under Article 12(2)(i)]* A Party may require that a request referred to in Article 12(2)(i):
- (i) *be signed by the applicant or holder;*
 - (ii) *contain an indication to the effect that relief in respect of non-compliance with a time limit is requested, and an identification of the time limit in question.*
- (4) *[Time Limit for Filing a Request Under Article 12(2)(ii)]* *The time limit referred to in Article 12(2)(ii) shall expire not earlier than two months after a notification by the Office that the applicant or holder did not comply with the time limit fixed by the Office.*
- (5) *[Exceptions Under Article 12(3)]* *No Party shall be required under Article 12(1) or (2) to grant:*
- (i) *a second, or any subsequent, relief in respect of a time limit for which relief has already been granted under Article 12(1) or (2);*
 - (ii) *relief for filing a request for a relief measure under Article 12(1) or (2) or a request for reinstatement under Article 13(1);*
 - (iii) *relief in respect of a time limit for the payment of a renewal fee;*

- (iv) *relief in respect of a time limit for an action before a board of appeal, or other review body, constituted in the framework of the Office;*
- (v) *relief in respect of a time limit for an action in inter partes proceedings;*
- (vi) *relief in respect of a time limit for the correction or addition of a priority claim.*

Note on Rule 10

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

Rule 11

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

- (1) *[Requirements Under Article 13(1)(i)] A Party may require that a request referred to in Article 13(1)(i) be signed by the applicant or holder.*
- (2) *[Time Limit Under Article 13(1)(ii)] The time limit for making a request, and for complying with the requirements, under Article 13(1)(ii), shall be the earlier to expire of the following:*
 - (i) *not less than one month from the date of the removal of the cause of failure to comply with the time limit for the action in question;*
 - (ii) *not less than 12 months from the date of expiration of the time limit for the action in question, or, where a request relates to non-payment of a renewal fee, not less than 12 months from the date of expiration of the period of grace provided under Article 5bis of the Paris Convention.*
- (3) *[Exceptions Under Article 13(2)] The exceptions referred to in Article 13(2) are failure to comply with a time limit:*
 - (i) *for making a request for relief under Article 12 (1) or (2) or a request for reinstatement under Article 13(1);*
 - (ii) *for an action before a board of appeal, or other review body, constituted in the framework of the Office;*
 - (iii) *for an action in inter partes proceedings;*
 - (iv) *for filing a declaration which, under the law of the Party, may establish a new filing date for a pending application;*
 - (v) *for the correction or addition of a priority claim.*

Notes on Rule 11

- Note 11.01 This Rule is vastly modeled on Rule 13 of the Regulations under the PLT.
- Note 11.02 *Paragraph (2)*. In item (i), the minimum time limit of two months has been replaced by one month, following the twenty-fifth session of the SCT.
- Note 11.03 *Paragraph (3)*. Following the suggestion of a delegation at the twenty-fifth session of the SCT, a further exception, provided for in item (iv), has been added. The same exception is contained in Rule 9(4)(vii) of the Singapore Treaty. Under item (iv), a Party may exclude the application of relief measures in respect of the filing of a declaration which may have the effect of establishing a new filing date for a pending application. This may apply where the law of a Party provides for a system by which the date of an amendment of a pending application becomes the filing date of a new application based on that amendment. In such a case, the filing date should be fixed as early as possible to preserve the rights of third parties.

Rule 12

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

- (1) *[Content of Request] (a) A Party may require that the request for the recording of a license under Article 14(1) or (6) contain some, or all, of the following indications or elements:*
- (i) *the name and address of the holder;*
 - (ii) *where the holder has a representative, the name and address of that representative;*
 - (iii) *where the holder has an address for service or an address for correspondence, such address;*
 - (iv) *the name and address of the licensee;*
 - (v) *where the licensee has a representative, the name and address of that representative;*
 - (vi) *where the licensee has an address for service or an address for correspondence, such address;*
 - (vii) *the name of a State of which the licensee is a national, the name of a State in which the licensee is domiciled, if any, and the name of a State in which the licensee has a real and effective industrial or commercial establishment, if any;*
 - (viii) *the registration number of the industrial design which is the subject of the license;*

- (ix) *where the license is not granted in respect of all the industrial designs contained in a registration, the industrial design number(s) for which the license is granted;*
 - (x) *whether the license is an exclusive license, a non-exclusive license or a sole license;*
 - (xi) *where applicable, that the license concerns only a part of the territory covered by the registration, together with an explicit indication of that part of the territory;*
 - (xii) *the duration of the license.*
- (b) *A Party may require that the request for amendment or cancellation of the recording of a license under Article 15(1) contain some or all of the following indications or elements:*
- (i) *the indications specified in items (i) to (viii) of subparagraph (a);*
 - (ii) *the nature and scope of the amendment to be recorded or an indication that cancellation is to be recorded.*
- (2) *[Supporting Documents for Recording of a License] (a) Where the license is a freely concluded agreement, a Party may require that the request for the recording of a license be accompanied, at the option of the requesting party, by one of the following:*
- (i) *a copy of the agreement, which copy may be required to be certified, at the option of the requesting party, by a notary public or any other competent public authority or, where permitted under the applicable law, by a representative having the right to practice before the Office, as being in conformity with the original agreement;*
 - (ii) *an extract of the agreement consisting of those portions of that agreement which indicate the parties, as well as the rights licensed and their extent, which extract may be required to be certified, at the option of the requesting party, by a notary public or any other competent authority or, where permitted under the applicable law, by a representative having the right to practice before the Office, as being a true extract of the agreement.*
- (b) *Any Party may require that any co-applicant or co-holder who is not a party to the license agreement give its express consent to the license in a document signed by such co-applicant or co-holder.*
- (c) *Where the license is not a freely concluded agreement, for example, it results from operation of law or a court decision, a Party may require that the request be accompanied by a copy of a document evidencing the license. A Party may also require that the copy be certified as being in conformity with the original document, at the option of the requesting party, by the authority*

which issued the document or by a notary public or any other competent public authority or, where permitted under the applicable law, by a representative having the right to practice before the Office.

- (3) *[Supporting Documents for Amendment of Recording of a License]*
(a) *A Party may require that the request for amendment of the recording of a license be accompanied, at the option of the requesting party, by one of the following:*
- (i) *documents substantiating the requested amendment of the recording of the license; or*
 - (ii) *an uncertified statement of amendment of license, signed by both the holder and the licensee.*
- (b) *Any Party may require that any co-holder who is not a party to the license contract give express consent to the amendment of the license in a document signed by such co-holder.*
- (4) *[Supporting Documents for Cancellation of Recording of a License]*
A Party may require that the request for cancellation of the recording of a license be accompanied, at the option of the requesting party, by one of the following:
- (i) *documents substantiating the requested cancellation of the recording of the license; or*
 - (ii) *an uncertified statement of cancellation of license, signed by both the holder and the licensee.*
- (5) *[Security Interests] Paragraphs (1) to (4) shall apply, mutatis mutandis, to requests for the recording, amendment of the recording and cancellation of the recording, of a security interest.*

Notes on Rule 12

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

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

- Note 12.03 Where the license is a freely concluded agreement, this provision permits a Party to require that the request for the recording of the license be accompanied by a copy of the agreement or an extract of the agreement, at the option of the requesting party. In other words, while a Party may require documentation supporting the license, it should accept as such documentation either a copy of the agreement or an extract of the agreement. It is for the requesting party to decide which of the two it wishes to submit.
- Note 12.04 The words “portions of that agreement” in item (ii) include, in particular, information regarding the territory and duration of the licensing agreement, and whether there is a right to sub-license.
- Note 12.05 Pursuant to Article 10(2)(b), a Party may require that the documents referred to in paragraphs (2), (3) and (4) be accompanied by a translation into a language admitted by the Office.

Rule 13

Details Concerning the Request for Recording of a Change in Ownership

- (1) *[Content of Request] A Party may require that the request for the recording of a change in ownership under Article 18 contain some, or all, of the following indications:*
- (i) an indication to the effect that a recording of a change in ownership is requested;*
 - (ii) the number of the registration concerned by the change;*
 - (iii) the name and address of the holder;*
 - (iv) the name and address of the new owner;*
 - (v) the date of the change in ownership;*
 - (vi) the name of a State of which the new owner is a national, the name of a State in which the new owner is domiciled, if any, and the name of a State in which the new owner has a real and effective industrial or commercial establishment, if any;*
 - (vii) where the holder has a representative, the name and address of that representative;*
 - (viii) where the new owner has a representative, the name and address of that representative;*
 - (ix) where the new owner is required to have an address for service or an address for correspondence, such address.*
 - (x) the basis for the change requested.*

- (2) *[Requirements Concerning Supporting Documents for Recording of a Change in Ownership]* A Party may require that the request for the recording of a change in ownership be accompanied, at the option of the requesting party, by one of the following:
- (i) *a copy of the contract, which may be required to be certified by a notary public or any other competent public authority, as being in conformity with the original contract;*
 - (ii) *an extract of the contract showing the change in ownership, which may be required to be certified by a notary public or any other competent public authority, as being a true extract of the contract;*
 - (iii) *an uncertified certificate of transfer signed by both the holder and the new owner;*
 - (iv) *an uncertified transfer document signed by both the holder and the new owner.*

Note on Rule 13

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

Rule 14

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

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

- (i) *the name and address of the holder;*
- (ii) *where the holder has a representative, the name and address of that representative;*
- (iii) *where the holder has an address for service, such address.*

Rule 15

Details Concerning the Request for Correction of a Mistake

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

- (i) *an indication to the effect that a correction of mistake is requested;*
- (ii) *the number of the application or registration concerned;*
- (iii) *the mistake to be corrected;*

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

[End of Annex and of document]