

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

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INDUSTRIAL DESIGN LAW AND PRACTICE – DRAFT ARTICLES

Document prepared by the Secretariat

INTRODUCTION

1. At its forty-seventh (22rd ordinary) session, held in Geneva from October 5 to 14, 2015, the World Intellectual Property Organization (WIPO) General Assembly agreed the following (see document WO/GA/47/19, paragraph 123):

“That the text of the basic proposal for the Design Law Treaty should be finalized by the SCT at its thirty-fourth and thirty-fifth sessions;

(i) to convene a diplomatic conference for the adoption of a Design Law Treaty at the end of the first half of 2017, only if the discussions on technical assistance and disclosure have been completed during the thirty-fourth and thirty-fifth sessions of the SCT;

(ii) that the text of the basic proposal for the Design Law Treaty should be finalized by the SCT at its thirty-fourth and thirty-fifth sessions;

(iii) that, if a diplomatic conference is convened at the end of the first half of 2017, the date and venue of the diplomatic conference would be decided in a preparatory committee, to be held back-to-back with the thirty-fifth session of the SCT.”

2. Following that session of the WIPO General Assembly, the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT), at its thirty-fourth session, held in Geneva from November 16 to 18, 2015, continued discussions on technical

assistance and capacity building, as well as on a disclosure requirement in design applications for subject matter using, or directly based on, traditional knowledge, traditional cultural expressions or genetic resources.

3. The Delegation of Nigeria, on behalf of the African Group, presented a new proposal for Article 3(1)(a)(ix), and the Chair presented text for a new Article 1 *bis* on General Principles. The Chair concluded that both proposals would be included between square brackets in a revised version of document SCT/33/2, for consideration of the thirty-fifth session of the SCT (see document SCT/34/7, paragraphs 5 to 8).

4. The Secretariat has prepared document SCT/35/2, taking into account the conclusions of the Chair of SCT/34. The Annex to the document contains draft Articles on Industrial Design Law and Practice, including, between square brackets, the new proposal of the African Group for item (ix) of Article 3(1)(a) of the draft DLT, as well as a footnote expressing the different views on that proposal. The Annex to document SCT/35/2 also includes, between square brackets, the text presented by the Chair for a new Article 1 *bis* on General Principles, as well as two footnotes. The first indicates that the text of Article 1 *bis* was based on the proposal made by the Chair at the thirty-fourth session of the SCT, as contained in Chair Non-paper No.1, and the second reflects the different views of delegations on proposed Article 1 *bis* and/or on proposed item (ix) of Article 3(1)(a) of the draft DLT.

5. As in previous versions of the documents, new text appears in underlining and deleted text in strikethrough. Provisions for which alternative options exist are shown in square brackets. Individual proposals for which there was support by other delegations at previous sessions of the SCT are also shown in square brackets, with an indication of the delegations that supported the proposal. In both cases, the square brackets appear in bold to differentiate them from square brackets used in the title of a paragraph. Individual proposals for which there was no support at previous sessions of the SCT, as well as reservations to provisions, have been kept in footnotes.

6. The following provisions are the subject of alternative options or proposals supported by several delegations:

- (i) Article 1 *bis* concerning general principles;
- (ii) Article 3(1)(a)(ix), concerning the option to require a disclosure in design applications of the origin or source of traditional cultural expressions, traditional knowledge or biological/genetic resources utilized or incorporated in the industrial design;
- (iii) Article 5, concerning filing-date requirements;
- (iv) Article 15(4)(b), concerning the prohibition of other requirements in requests for recording of a license or a security interest;
- (v) Article 17, concerning the effects of the non-recording of a license;
- (vi) Article 22/Resolution, concerning technical assistance and capacity building. This Article or Resolution is based on revised non-paper No. 2 by the Chair, of March 20, 2014;
- (vii) Article 23(1)(b), concerning Model International Forms in the Regulations;

- (viii) Article 24(c), concerning the participation in sessions of the Assembly of delegations of Contracting Parties that are regarded as developing countries, LDCs or countries in transition to a market economy;
 - (ix) Article 28(2), concerning the number of instruments of ratification or accession needed for the entry into force of the Treaty.
7. The following provisions are the subject of individual proposals:
- (i) Article 2(1), concerning a specific reference to “divisional applications” at the end of paragraph (1);
 - (ii) Article 5(1), concerning permitted requirements for the granting of a filing date;
 - (iii) Article 13, concerning the nature of the provision on reinstatement of rights;
 - (iv) Article 14(2), concerning the nature of paragraph (2), related to restoration of the right of priority;
 - (v) Article 17(1), concerning the nature of paragraph (1), related to the effects of the non-recording of a license;
 - (vi) Article 24(2)(v), concerning the wording of this item, related to the tasks of the Assembly.
8. The following provisions are the subject of individual reservations:
- (i) Article 4(2)(b), concerning mandatory representation;
 - (ii) Article 6, concerning the duration of the grace period for layout designs of integrated circuits and the acts of disclosure that would give rise to a grace period;
 - (iii) Article 12(2), concerning relief in respect of time limits;
 - (iv) Article 14(2), concerning restoration of the right of priority;
 - (v) Article 20, concerning changes in names or addresses.

9. The SCT is invited to consider the draft provisions contained in the Annexes to documents SCT/35/2 and 3, with a view to finalizing the basic proposal for the Design Law Treaty.

[Annex follows]

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Article 1
Abbreviated Expressions

For the purposes of this Treaty, unless expressly stated otherwise:

- (i) “Contracting Party” means any State or intergovernmental organization party to this Treaty;*
- (ii) “Office” means the agency of a Contracting Party entrusted with the registration of industrial designs;*
- (iii) “registration” means the registration of an industrial design, or the grant of a patent for an industrial design, by an Office;*
- (iv) “application” means an application for registration;*
- (v) “applicable law” means, where the Contracting Party is a State, the law of that State and, where the Contracting Party is an intergovernmental organization, the legal enactments under which that intergovernmental organization operates;*
- (vi) references to “industrial design” shall be construed as references to “industrial designs”, where the application or the registration includes more than one industrial design;*
- (vii) references to a “person” shall be construed as references to both a natural person and a legal entity;*
- (viii) “procedure before the Office” means any procedure in proceedings before the Office with respect to an application or registration;*
- (ix) “communication” means any application, or any request, declaration, document, correspondence or other information, relating to an application or a registration, which is filed with the Office;*
- (x) “records of the Office” means the collection of information maintained by the Office, relating to, and including the contents of, applications and registrations, irrespective of the medium in which such information is stored;*
- (xi) “applicant” means the person whom the records of the Office show, pursuant to the applicable law, as the person who is applying for registration, or as another person who is filing or prosecuting the application;*
- (xii) “holder” means the person shown in the records of the Office as the holder of the registration;*
- (xiii) “Paris Convention” means the Paris Convention for the Protection of Industrial Property, signed on March 20, 1883, as revised and amended;*
- (xiv) “license” means a license for the use of an industrial design under the law of a Contracting Party;*
- (xv) “licensee” means the person to whom a license has been granted;*
- (xvi) “Regulations” means the Regulations referred to in Article 23;*

(xvii) “Diplomatic Conference” means the convocation of Contracting Parties for the purpose of revising the Treaty;

(xviii) “Assembly” means the Assembly referred to in Article 24;

(xix) references to an “instrument of ratification” shall be construed as including references to instruments of acceptance and approval;

(xx) “Organization” means the World Intellectual Property Organization;

(xxi) “International Bureau” means the International Bureau of the Organization;

(xxii) “Director General” means the Director General of the Organization;

(xxiii) references to an “Article” or to a “paragraph”, “subparagraph” or “item” of an Article shall be construed as including references to the corresponding rule(s) under the Regulations.

Notes on Article 1

- Note 1.01 *Items (iii) and (iv).* The term “application” comprises applications both for registration of an industrial design and for the grant of a patent for an industrial design under those systems in which industrial designs are protected under patent law. Similarly, the term “registration” comprises both registrations of industrial design and grants of a patent for an industrial design under those systems which protect industrial designs under patent law.
- Note 1.02 The term “application” in item (iv) should be understood in a broad sense, including an application that contains one industrial design and an application that contains more than one industrial design.
- Note 1.03 *Item (ix).* The term “communication” is used to refer only to matter which is filed with the Office. Accordingly, a notification or other correspondence sent by the Office to an applicant, holder or other interested person does not constitute a “communication” as defined in this item. The term “communication” as defined in this item covers, *inter alia*, any document which is filed with the Office, relating to an application or a registration, including powers of attorney.
- Note 1.04 *Item (x).* The draft provision uses the term “records of the Office” rather than “register of industrial designs” in order to acknowledge the situation of member States that grant design patents and do not maintain industrial design registers. It should be noted that this term is supposed to be used for the application of the provision only. It is sufficiently broad so as to encompass the notion of national or regional registers of industrial designs, when they exist, and would not prevent the use of the term “register of industrial designs” by individual Contracting Parties.

[\[Article 1bis^{1,2}](#)
[General Principles](#)

[\(1\) \[No Regulation of Substantive Industrial Design Law\] Nothing in this Treaty or the Regulations is intended to be construed as prescribing anything that would limit the freedom of a Contracting Party to prescribe such requirements of the applicable substantive law relating to industrial designs as it desires.](#)

[\(2\) \[Relation to Other Treaties\] Nothing in this Treaty shall derogate from any obligations that Contracting Parties have to each other under any other treaties.\]](#)

Article 2
Applications and Industrial Designs to Which This Treaty Applies

(1) *[Applications] This Treaty shall apply to national and regional applications which are filed with, or for, the Office of a Contracting Party³.*

(2) *[Industrial Designs] This Treaty shall apply to industrial designs that can be registered as industrial designs, or for which patents can be granted, under the applicable law.*

Notes on Article 2

Note 2.01 *Paragraph (1).* The Treaty would apply to national applications which are filed with the Office of a State, as well as to applications which are filed with, or for, the Office of a regional intergovernmental organization. The latter are referred to in this paragraph as “regional applications”. Examples of Offices of intergovernmental organizations are the African Intellectual Property Organization (OAPI)⁴, the African Regional Intellectual Property Organization (ARIPO)⁵, the Benelux Office for Intellectual Property (BOIP)⁶ and the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)⁷.

Note 2.02 The expression “applications which are filed ... for the Office of a Contracting Party” covers, in particular, applications for regional registration that are filed with the Office or other competent authority of a member State of a regional intergovernmental organization for onward transmission to the Office of that organization.

Note 2.03 The Treaty is intended to apply to applications as defined in Article 1(iv), including divisional applications of national or regional applications. Divisional applications are defined in Article 8(1).

¹ [The text of this Article is based on the proposal made by the Chair at the thirty-fourth session of the SCT, contained in Chair Non-paper No. 1.](#)

² [Some delegations indicated that they were not supportive of either this proposed article or the proposed item \(ix\) of Article 3\(1\)\(a\). Some delegations supported the proposal contained in item \(ix\) of Article 3\(1\)\(a\).](#)

³ At the thirtieth session of the SCT, the Delegation of the United States of America proposed to add “and to divisional applications thereof” at the end of paragraph (1).

⁴ OAPI registers designs with effect in the 16 States party to the Bangui Agreement.

⁵ ARIPO registers designs with effect in up to 16 States party to the Lusaka Agreement.

⁶ BOIP registers designs with effect in the three Benelux countries.

⁷ OHIM registers designs with effect in the 28 member states of the European Union.

- Note 2.04 While it would not have to do so, a Contracting Party could apply some, or all, of the provisions of the Treaty to any specific type of application provided for in its law and not covered by paragraph (1), such as “converted”, “amended”, or “continuation” applications.
- Note 2.05 *Paragraph (2).* The draft Treaty does not contain a definition of industrial design. The Treaty would apply to any industrial design that can be registered as an industrial design, or for which a design patent can be granted, under the applicable law. Accordingly, the question as to what matter can be protected as an industrial design remains an issue to be determined by the law of each Contracting Party.
- Note 2.06 Given the specific nature of the procedures established under the Hague Agreement Concerning the International Registration of Industrial Designs, this Treaty does not apply to such procedures.

Article 3 Application

(1) *[Contents of Application; Fee] (a) A Contracting Party may require that an application contain some, or all, of the following indications or elements:*

- (i) a request for registration;*
- (ii) the name and address of the applicant;*
- (iii) where the applicant has a representative, the name and address of that representative;*
- (iv) where an address for service or an address for correspondence is required under Article 4(3), such address;*
- (v) a representation of the industrial design, as prescribed in the Regulations;*
- (vi) an indication of the product or products which incorporate the industrial design, or in relation to which the industrial design is to be used;*
- (vii) where the applicant wishes to take advantage of the priority of an earlier application, a declaration claiming the priority of that earlier application, together with indications and evidence in support of the declaration that may be required pursuant to Article 4 of the Paris Convention;*
- (viii) where the applicant wishes to take advantage of Article 11 of the Paris Convention, evidence that the product or products which incorporate the industrial design or in relation to which the industrial design is to be used have been shown at an official, or officially recognized, international exhibition;*
- [\[\(ix\) a disclosure of the origin or source of traditional cultural expressions, traditional knowledge or biological/genetic resources utilized or incorporated in the industrial design.\]](#)⁸*
- [\(x\) any further indication or element prescribed in the Regulations.](#)*

⁸ [Some delegations supported proposed item \(ix\) of Article 3\(1\)\(a\). Some delegations were not supportive of this proposal.](#)

(b) *In respect of the application, the payment of a fee may be required.*

(2) *[Prohibition of Other Requirements] No indication or element, other than those referred to in paragraph (1) and in Article 10, may be required in respect of the application.*

(3) *[Several Industrial Designs in the Same Application] Subject to such conditions as may be prescribed under the applicable law, an application may include more than one industrial design.*

(4) *[Evidence] A Contracting Party may require that evidence be furnished to the Office where, in the course of the examination of the application, the Office may reasonably doubt the veracity of any indication or element contained in the application.*

Notes on Article 3

Note 3.01 This Article and the corresponding Rules of the Regulations propose a closed list of indications or elements that may be required in an application. While *paragraph (1)* sets out the maximum contents of an application that may be required by a Contracting Party, *paragraph (2)* makes it clear that no further element may be required by a Contracting Party in an application, except those elements that may be required under Article 10 (“Communications”). Establishing a closed list of elements contributes to create a predictable framework of industrial design formalities, and is therefore of the outmost importance, with a view to simplifying and streamlining industrial design procedures.

Note 3.02 This provision does not aim at creating an uniform content of applications, but at establishing a maximum content, so that anyone wishing to file an application knows exactly what are the elements that may be required. However, a Contracting Party may require some only, rather than all, of the elements listed. For instance, no Contracting Party would be obliged to require a claim (see Rule 2(1)(ii)). A claim would presumably not be required by a Contracting Party that protects industrial designs under a registration system, as opposed to a system of protection under patent law.

Note 3.03 This Article sets out the elements of general nature in an application, those required by virtually all Contracting Parties. Elements of more detailed nature have been transferred to the Regulations. The proposed scheme is intended to establish a dynamic and flexible framework for the subsequent development of design law.

Note 3.04 *Paragraph (1)(a). Item (i).* A Contracting Party will be free to require that the request for registration be made on an official form, established by the Office of the Contracting Party.

Note 3.05 *Item (ii).* Each Contracting Party would be free to determine the details concerning the name and address. For example, a Contracting Party could permit that, for privacy considerations, the applicant provides only an address for correspondence, and not necessarily a home address.

- Note 3.06 *Item (v)*. Details concerning the representation of industrial designs are prescribed in Rule 3. The Regulations provide a more flexible framework to amend and adopt further requirements concerning this matter, which may be justified in the future by the development of new reproduction techniques.
- Note 3.07 *Item (vi)*. Each Contracting Party will be free to determine how the indication of the product or products should be provided. A Contracting Party may require, for example, that the indication of the product or products be in the form of a title to the application or in any other specific form.
- Note 3.08 *Paragraph (3)*. This paragraph sets out the principle that applications including more than one industrial design, so-called “multiple applications”, may be filed by an applicant. 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 applicants in those jurisdictions which offer the facility. From the point of view of examining offices, however, 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 costs⁹.
- Note 3.09 In order to balance the interests of users and offices, acceptance of “multiple applications” by a Contracting Party is subject to compliance, by the applicant, with the conditions prescribed in the Contracting Party’s applicable law. This provision does not prescribe the conditions under which multiple applications are to be admitted. Each Contracting Party would be free to determine under what conditions it admits multiple applications. For example, a Contracting Party may prescribe that it accepts multiple applications only where all the designs in the application apply to, or are constituted by, products which belong to the same class of the Locarno Classification, or only where all the designs in the application conform to the requirement of unity of design or unity of invention or when the products to which the design is applied belong to a set or are intended for the same purpose.
- Note 3.10 With respect to a given application, a Contracting Party will be able to process it as a multiple application if the application conforms to the conditions prescribed in the Contracting Party’s law or, if that is not the case, to request the applicant to either amend the application to comply with those conditions or divide the application into two or more applications (see Article 8(1)).

Article 4

Representatives; Address for Service or Address for Correspondence

(1) *[Representatives Admitted to Practice]* (a) A Contracting Party may require that a representative appointed for the purposes of any procedure before the Office

(i) *have the right, under the applicable law, to practice before the Office in respect of applications and registrations;*

(ii) *provide, as its address, an address in a territory prescribed by the Contracting Party.*

⁹ See document SCT/21/4.

(b) An act, with respect to any procedure before the Office, by or in relation to a representative who complies with the requirements established by the Contracting Party under subparagraph (a), shall have the effect of an act by or in relation to the applicant, holder or other interested person who appointed that representative.

(2) [Mandatory Representation] (a) Subject to subparagraph (b), a Contracting Party may require that for the purposes of any procedure before the Office, an applicant, holder, or other interested person who has neither a domicile nor a real and effective industrial or commercial establishment in its territory appoint a representative.

(b) An applicant, holder, or other interested person who has neither a domicile nor a real and effective industrial or commercial establishment in the territory of the Contracting Party may act himself/herself before the Office for the filing of an application, for the purposes of the filing date, and for the mere payment of a fee¹⁰.

(3) [Address for Service or Address for Correspondence] A Contracting Party may, to the extent that it does not require representation in accordance with paragraph (2), require that, for the purposes of any procedure before the Office, an applicant, holder, or other interested person who has neither a domicile nor a real and effective industrial or commercial establishment in its territory, shall have an address for service, or an address for correspondence, in a territory prescribed by the Contracting Party.

(4) [Appointment of a Representative] A Contracting Party shall accept that the appointment of a representative be filed with the Office in a manner prescribed in the Regulations.

(5) [Prohibition of Other Requirements] Subject to the requirements of Article 10, no Contracting Party may demand that requirements, other than those referred to in paragraphs (1) to (4), be complied with in respect of the matters dealt with in those paragraphs.

(6) [Notification] Where one or more of the requirements applied by the Contracting Party under paragraphs (1) to (4) is or are not complied with, the Office shall notify the applicant, holder or other interested person, giving the opportunity to comply with any such requirement within the time limit prescribed in the Regulations.

(7) [Non-Compliance with Requirements] Where one or more of the requirements applied by the Contracting Party under paragraphs (1) to (4) is or are not complied with within the time limit prescribed in the Regulations, the Contracting Party may apply such sanction as is provided for in its law.

Notes on Article 4

Note 4.01 This Article is modeled, to a large extent, on Article 7 of the Patent Law Treaty (PLT) and Article 4 of the Singapore Treaty.

Note 4.02 This Article does not apply to representatives who are employees or officials of a legal entity (whether applicant or holder), for example, executive officers or in-house counsels of a corporation. It typically applies to agents and attorneys in private practice. This Article relates only to the appointment itself and to the possible limitation of the appointment, but does not deal with the termination of the appointment. In the latter respect, and in respect of any other matter relating to representation which is not covered by the Treaty, a Contracting Party will apply its own law. For example, a Contracting Party may provide that

¹⁰ At the thirtieth session of the SCT, the Delegation of China reserved its position with respect to Article 4(2)(b).

the appointment of a new representative terminates the appointment of all previous representatives. Or a Contracting Party may allow sub-representation and in that case, require that, where the power of a representative extends to the appointment of one or more sub-representatives, the power of attorney expressly authorize a representative to appoint such sub-representatives.

- Note 4.03 *Paragraph (1)(a). Item (i)* of this paragraph permits a Contracting Party to require that the appointed representative be a person who is admitted to practice before the Office in respect of applications and registrations, such as, for example, a registered patent attorney. It also permits a Contracting Party to have a less strict requirement.
- Note 4.04 A Contracting Party may apply the requirement under *item (ii)* of paragraph 1(a) instead of, or in addition to, the requirement that the appointed representative have the right to practice before the Office, under *item (i)*. A Contracting Party may, in particular, require that the address be in its own territory.
- Note 4.05 *Paragraph (1)(b)*. As regards the expression “interested person” used in this and other provisions, it could be, for example, in the case of a transfer of an application or registration, the new owner of the application or registration.
- Note 4.06 *Paragraph (2)*. This paragraph is divided into two subparagraphs. *Subparagraph (a)* permits, but does not oblige, a Contracting Party to require representation for any procedure before the Office, except for filing an application as far as the purpose of obtaining a filing date is concerned and for the mere payment of a fee. The ability for a Contracting Party to require representation is, in any event, limited to the cases where the applicant, holder or other interested person has neither a domicile nor a real and effective industrial or commercial establishment in the territory of the Contracting Party. This limitation is modeled on Article 4(2)(a) of the Singapore Treaty.
- Note 4.07 *Subparagraph (b)* is modeled on Article 7(2) of the PLT and aims at reducing the barriers for users to seek industrial design protection abroad. This subparagraph provides for two exceptions to the principle established in subparagraph (a). The first permits an applicant who has neither a domicile nor a real and effective industrial or commercial establishment in the territory of a Contracting Party to file an application for the purposes of the filing date without appointing a representative. In other words, if an application contains the elements which are required under Article 5(1), it will be accorded a filing date even if it was filed by an applicant who has neither a domicile nor a real and effective industrial or commercial establishment on the territory of the Contracting Party and even if the Contracting Party concerned requires that such applicant appoint a representative to file an application. After the filing date, the Contracting Party may require that a representative be appointed, within a given time limit, to continue the procedure. If no representative is appointed within the time limit, the Contracting Party may apply a sanction provided for in its law, including, for example, considering the application to be abandoned.
- Note 4.08 The second exception to the principle established under subparagraph (a) permits an applicant, holder or other interested person who has neither a domicile nor a real and effective industrial or commercial establishment in the territory of a Contracting Party to act himself/herself before the Office for the mere payment of a fee.

Note 4.09 The expression “mere payment of a fee” permits a Contracting Party to require representation for any other act that is associated with the payment of the fee concerned, for example, a request for search or examination. Any Contracting Party may decide whether the payment of the fee is mere or not.

Note 4.10 *Paragraph (3).* A Contracting Party may, instead of requiring the appointment of a representative where the applicant is not domiciled or established in its territory, require that the applicant have an address for service or an address for correspondence in its territory. What constitutes an address for correspondence or an address for service is a matter for the applicable law of the Contracting Party concerned. This requirement is viewed as less stringent than the appointment of a representative.

Article 5 **Filing Date**

(1) *[Permitted Requirements]*¹¹ (a) *Subject to subparagraph (b) and paragraph (2), a Contracting Party shall accord as the filing date of an application the date on which the Office receives the following indications and elements, in a language admitted by the Office:*

(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;*

(iii) *a sufficiently clear representation of the industrial design;*

(iv) *indications allowing the applicant or the applicant’s representative, if any, to be contacted.*

(b) *A Contracting Party may accord as the filing date of an application the date on which the Office receives, together with a sufficiently clear representation of the industrial design, some only, rather than all, of the other indications and elements referred to in subparagraph (a), or receives them in a language other than a language admitted by the Office.*

[(2) [Permitted Additional Requirements] (a) A Contracting Party whose law, at the time it becomes party to this Treaty, requires that an application comply with any of the requirements specified in subparagraph (b) in order for that application to be accorded a filing date may, in a declaration, notify the Director General of those requirements.

(b) *The requirements that may be notified pursuant to subparagraph (a) are the following:*

(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*¹²;

¹¹ At the twenty-sixth session of the SCT, the Delegation of the United States of America proposed to add “a claim” to the list of filing-date requirements in paragraph (1).

At the twenty-seventh session of the SCT, the Delegation of China proposed to add “a brief description” and “where the appointment of a representative is mandatory, such appointment” to the list of filing-date requirements in paragraph (1).

At the twenty-eighth session of the SCT, the Delegation of India proposed to add “any further indication or element as prescribed under the applicable law” to the list of filing-date requirements in paragraph (1).

(ii) *a brief description of the reproduction or of the characteristic features of the industrial design;*

(iii) *a claim;*

(iv) *the payment of the required fees.*

(c) *Any declaration notified under subparagraph (a) may be withdrawn at any time.]*

(3) *[Prohibition of Other Requirements] No indication or element other than those referred to in paragraph[s] (1)(a) [and (2)(b)] may be required for the purpose of according a filing date to an application.*

(4) *[Notification and Time Limits] Where the application does not, at the time of its receipt by the Office, comply with one or more of the applicable requirements under paragraph[s] (1) [and (2)(b)], the Office shall notify the applicant and give the opportunity to comply with such requirements within the time limit prescribed in the Regulations.*

(5) *[Filing Date in Case of Subsequent Compliance with Requirements] If, within the time limit referred to in paragraph (4), the applicant complies with the applicable requirements, the filing date shall be no later than the date on which all the indications and elements required by the Contracting Party under paragraph[s] (1) [and (2)(b)] are received by the Office. Otherwise, the application shall be treated as if it had not been filed.*

Notes on Article 5

- Note 5.01 *Paragraph (1)(a) sets out a list of requirements that may be established by a Contracting Party for the purpose of according a filing date. The importance of keeping the list of filing-date requirements to the minimum has been reiterated several times, as in the field of industrial designs, postponement of the filing date may result in a definitive loss of rights. Filing-date requirements should be of such significance that, without them, it would not be possible for an Office to know “who” filed “what”.*
- Note 5.02 *Item (i). Contracting Parties will be free to decide whether, in a specific case, an indication can be considered as an “express or implicit indication to the effect that the elements are intended to be an application”.*
- Note 5.03 *It is made clear in paragraph (1)(a), read in conjunction with subparagraph (b), that a Contracting Party may require that the filing-date requirements be filed in a language admitted by the Office, in order to give the application a filing date. Inclusion of this requirement in this paragraph is justified by the fact that an Office may not be in a position to ascertain “who” filed “what” if the information is not provided in a language admitted by the Office.*
- Note 5.04 *The drafting of paragraph (1)(b) makes it clear that, while a Contracting Party may accord a filing date when some only, rather than all, of the indications and elements listed in subparagraph (a) are filed, it may not accord a filing date if a*

[Footnote continued from previous page]

¹² At the thirtieth session of the SCT, the Delegation of Japan proposed to maintain “an indication of the product or products which incorporate the industrial design, or in relation to which the industrial design is to be used” as item (v) of paragraph (1)(a).

sufficiently clear representation of the industrial design is missing. In other words, a representation of the industrial design should always be a filing date requirement.

- Note 5.05 *Paragraph (2)* permits a Contracting Party to require additional filing-date requirements, provided that they are present in the Contracting Party's law at the time it becomes party to the Treaty and are notified to the Director General in a declaration. Under *subparagraph (c)*, the declaration may be withdrawn at any time. The effect of withdrawing the declaration would be that, after the withdrawal, the Contracting Party concerned would be in a position to require only the indications or elements listed under paragraph (1)(a) for the purpose of the filing date.
- Note 5.06 *Paragraph (3)* makes it clear that the list provided for in paragraphs (1)(a) and (2)(b) is the maximum list of filing-date requirements. Other elements or indications may be required in an application, but they may be filed subsequently without the filing date being affected.
- Note 5.07 *Paragraph (4)* provides that, where an application does not contain all the elements or indications which are required to obtain a filing date, a time limit shall be afforded to the applicant to complete the application. The time limit is prescribed in the Regulations, so as to facilitate any change that may be justified in the future.
- Note 5.08 *Paragraph (5)* addresses the issue of the filing date when all the filing-date requirements are complied with after the date of filing the application. Usually, the filing date is the date on which all the indications and elements required by the Contracting Party are received by the Office. In other words, the filing date is postponed until all the filing-date requirements are complied with. However, two delegations indicated at the twenty-sixth session of the SCT that, in their legislation, the date of filing of the "irregular" application is maintained as the filing date, provided that the missing filing-date requirements are complied with within a given time limit. In order to accommodate this approach, one delegation, supported by a number of other delegations, proposed that the filing date shall be "no later" than the date on which all the indications and elements required by the Contracting Party under paragraphs (1) and (2) are received by the Office.

Article 6 **Grace Period for Filing in Case of Disclosure**

*A disclosure of the industrial design during a period of six or 12 months^{*13} preceding the date of filing of the application or, if priority is claimed, the date of priority, shall be without prejudice to the novelty and/or originality, as the case may be, of the industrial design, where it was made:*

- (i) by the creator or his/her successor in title; or*
- (ii) by a person who obtained information about the industrial design directly or indirectly, including as a result of an abuse, from the creator or his/her successor in title¹⁴.*

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

¹³ At the thirtieth session of the SCT, the Delegation of South Africa made a reservation concerning layout designs of integrated circuits, in respect of which a grace period of two years would apply.

Notes on Article 6

- Note 6.01 It is understood that, while most jurisdictions provide for a grace period to file, further to a disclosure made by the creator, his/her successor in title or another person, some jurisdictions do not. In those jurisdictions which do provide for a grace period, the duration of such grace period varies between six and 12 months. It is also understood, however, that the existence of different grace periods, and more generally the fact that some jurisdictions do not provide for a grace period, may cause an applicant to lose the possibility of obtaining protection for the industrial design abroad. A harmonized grace period, coupled with agreement on which disclosure gives rise to the grace period, would avoid this risk for applicants.
- Note 6.02 At the twenty-seventh session of the SCT, delegations agreed to a grace period of six or 12 months. A period of six or 12 months gives flexibility to Contracting Parties to choose between two periods. At the same time, a period of six or 12 months addresses, to a certain extent, the concern of certain delegations and representatives of users regarding the uncertainty created by a period of “at least six months”.
- Note 6.03 This provision establishes a grace period to file in case of disclosure made by the creator or his/her successor in title, or by a person who obtained information about the industrial design directly or indirectly from the creator or his/her successor in title. The notion of information obtained “directly or indirectly” from the creator or his/her successor in title is broad and expressly encompasses information obtained as a result of an abuse. An example of abusive disclosure could be a disclosure made without the authorization of the creator, or his/her successor in title, by a person who had been informed of the industrial design under conditions of confidentiality.
- Note 6.04 The question as to whether disclosure of an industrial design made in a bulletin published by a domestic or a foreign Office would give rise to a grace period remains a matter for the applicable law of each Contracting Party. A Contracting Party could consider that disclosure made in a bulletin by an Office does not fall within any of the situations referred to in items (i) and (ii) of Article 6 and, consequently, does not give rise to a grace period.
- Note 6.05 A statement that time limits expressed in “months” can be calculated by Contracting Parties in accordance with their national law has been added as a footnote in this Article. This is the first time in the draft Treaty that reference is made to a period expressed in months. The statement has been added to address the concerns by one delegation at the twenty-sixth session of the SCT, as to the way to calculate time limits expressed in months. The footnote could be transformed into an Agreed Statement by the Diplomatic Conference.

[Footnote continued from previous page]

¹⁴ At the thirtieth session of the SCT, the Delegation of China made a reservation with respect to the acts of disclosure that gave rise to the grace period, proposing that they should be limited to “disclosure at an exhibition, disclosure at a prescribed academic or technological meeting or disclosure by any person without the consent of the applicant”.

Article 7
Requirement to File the Application in the Name of the Creator

(1) *[Requirement That the Application Be Filed in the Name of the Creator]* A Contracting Party may require that the application be filed in the name of the creator of the industrial design.

(2) *[Formality Where There Is a Requirement to File the Application in the Name of the Creator]* Where a Contracting Party requires that the application be filed in the name of the creator of the industrial design, such requirement shall be satisfied if the name of the creator of the industrial design is indicated, as such, in the application, and:

(i) that name corresponds to the name of the applicant, or

(ii) the application is accompanied by, or contains, a statement of assignment from the creator to the applicant, signed by the creator of the industrial design.

Notes on Article 7

Note 7.01 In some jurisdictions, there is a requirement that the application be filed in the name of the creator. That means that, 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.

Note 7.02 This provision does not generalize the requirement that the application be filed in the name of the creator. The provision applies only to those Contracting Parties that do have that requirement in their applicable law. The provision aims at simplifying the procedure, where the requirement exists under the applicable law, by allowing the applicant to file a simple statement of assignment as evidence of the transfer. The statement may be in a separate document, accompanying the application, or pre-printed in the application. In order to safeguard the rights of creators, the statement of assignment must, in any event, be signed by the creator.

Article 8
Amendment or Division of Application
Including More Than One Industrial Design

(1) *[Amendment or Division of Application]* If an application that includes more than one industrial design (hereinafter “initial application”) does not comply with the conditions prescribed by the Contracting Party concerned in accordance with Article 3(3), the Office may require the applicant, at the option of the applicant, to either:

(i) amend the initial application to comply with those conditions; or

(ii) divide the initial application into two or more applications (hereinafter “divisional applications”) that comply with those conditions by distributing among the latter the industrial designs for which protection was claimed in the initial application.

(2) *[Filing Date and Right of Priority of Divisional Applications]* Divisional applications shall preserve the filing date of the initial application and the benefit of the claim of priority, if applicable.

(3) *[Fees]* The division of an application may be subject to the payment of fees.

Notes on Article 8

- Note 8.01 This provision should be read in conjunction with Article 3(3). That Article provides that, subject to such conditions as may be prescribed under the applicable law, an application may include more than one industrial design. If an application containing more than one industrial design does not fulfill the applicable conditions, then the Office would be in a position to require the applicant to, at his/her option, amend the application, for example by suppressing the industrial designs that do not meet the applicable conditions, or to divide it into two or more applications that fulfill the conditions. It follows from the term “division of application” that division should be possible only as long as the initial application is pending.
- Note 8.02 The aim of this provision is to enable an applicant to rectify a mistake in filing an application for more than one industrial design (“initial application”), where some of the industrial designs do not comply with the conditions prescribed by the Contracting Party for an application to include more than one industrial design. The option is given to the applicant to correct the mistake by either amending the application or dividing it. Division of an application does not exempt an applicant from fulfilling the formalities, or from paying the fees, with respect to the divisional applications. The interest of division is, however, that divisional applications maintain the filing date and, if applicable, the priority date, of the initial application. Therefore, division may be perceived as a mechanism that softens the effects of a mistake made by the applicant in an initial application, while not entailing any negative impact on offices.
- Note 8.03 *Paragraph (1)*. Following the discussion at the twenty-eighth session of the SCT, the possibility of amendment of the initial application to comply with the conditions of a Contracting Party has been added to this paragraph. Prior versions of draft Article 8(1) provided only for a single mechanism to soften the effects of a mistake in an initial application, namely division of the initial application.
- Note 8.04 The words “the Office may require the applicant” make it clear that the type of amendment or division envisaged in this provision is one required by the Office, as explained in Note 8.01, above. This provision does not cover the situation in which an applicant amends or divides the application on his/her own initiative. Contracting Parties can provide for such type of amendment or division in their legislation, if they so wish, but are not required to do so under this provision.
- Note 8.05 The words “at the option of the applicant” make it clear that, while the Office may require action to “correct” an initial application, it is for the applicant to choose between amendment and division.
- Note 8.06 Following the discussion at the twenty-eighth session of the SCT, the definitions of “initial application” and “divisional applications” are now contained in Article 8(1) instead of in Article 1. This approach follows that of the Singapore Treaty, and is justified by the fact that the terms “initial application” and “divisional applications” are used in the context of this Article.
- Note 8.07 *Item (ii)*. In order to explain the words “by distributing among the latter the industrial designs for which protection was claimed in the initial application”, the following example may be useful. Let us imagine that an initial application covering three industrial designs was filed in a Contracting Party. Two

industrial designs belong in class 7 of the International Classification for Industrial Designs under the Locarno Agreement, while one belongs in class 9. Let us further imagine that, under the applicable law of the Contracting Party, multiple applications are admitted, subject to all the industrial designs in the application belonging in the same class of the International Classification. In the example, therefore, the Office would request the applicant to divide the initial application into two divisional applications, one covering the two industrial designs that belong in class 7 and a second covering the industrial design that belongs in class 9.

Note 8.08 The words “those conditions” in item (ii) refer to the conditions prescribed by the Contracting Party concerned in accordance with Article 3(3). In other words, they refer to the conditions prescribed under the applicable law of the Contracting Party concerned.

Article 9 **Publication of the Industrial Design**

(1) [Maintaining the Industrial Design Unpublished] A Contracting Party shall allow the industrial design to be maintained unpublished for a period fixed by its applicable law, subject to the minimum period prescribed in the Regulations.

(2) [Request to Maintain the Industrial Design Unpublished; Fee] (a) A Contracting Party may require that, for the purposes of maintaining the industrial design unpublished under paragraph (1), the applicant make a request to the Office.

(b) In respect of a request for maintaining the industrial design unpublished under subparagraph (a), the Office may require the payment of a fee.

(3) [Request to Publish Further to a Request to Maintain Unpublished] Where a request to maintain the industrial design unpublished has been made under paragraph (2)(a), the applicant or holder, as the case may be, may, at any time during the period applicable under paragraph (1), request the publication of the industrial design.

Notes on Article 9

Note 9.01 Under *paragraph (1)*, a Contracting Party would be required to allow the industrial design to be maintained unpublished for a period fixed by its applicable law, subject to the minimum period prescribed in the Regulations. This provision would be justified by the fact that there is an interest for users in maintaining the industrial design unpublished for some time, as this enables them to control the first release of the product embodying the industrial design. However, maintaining an industrial design unpublished in one jurisdiction serves no purpose if the design is published in another jurisdiction. It is a fact that, nowadays, any matter that is made accessible in one part of the world can easily become accessible everywhere.

Note 9.02 The article does not provide for a uniform period of time during which the industrial design can be maintained unpublished. It provides for a minimum period, prescribed in the Regulations, and leaves it to each Contracting Party to determine the period above the prescribed minimum period during which an industrial design may be maintained unpublished.

- Note 9.03 With regard to the different existing systems for maintaining an industrial design unpublished, the article does not provide for a specific system. Thus, a Contracting Party may comply with this Article by implementing, for example, a system of deferment of publication, a secret design system, or a system giving the possibility to effectively postpone publication, where publication takes place after registration or grant of protection, by delaying the payment of the registration fees or delaying the grant of protection.
- Note 9.04 The language of paragraph (1) and the general structure of Article 9 aim to accommodate the different existing systems for maintaining an industrial design unpublished. Thus, paragraph (1) has been drafted in a general manner. It requires a Contracting Party to allow an industrial design to be maintained unpublished for some time, but does not require a request by the applicant for that purpose. This approach accommodates those systems where the applicant is in a position to postpone the publication of the industrial design by delaying the payment of the registration fees or delaying the grant of protection, without having to file any request as such.
- Note 9.05 Under the proposed structure of this Article, *paragraph (2)* gives the possibility to a Contracting Party to require a request by the applicant for maintaining the industrial design unpublished. Such request would be required, for example, in a secret-design or in a deferment-of-publication system.
- Note 9.06 *Paragraph (3)*. This paragraph makes it clear that, where a request for maintaining the industrial design unpublished has been made, the applicant or holder may subsequently request that the industrial design be published before the expiry of the applicable period. The words “the period applicable under paragraph (1)” refer to the period established by the applicable legislation, which cannot be less than a minimum period fixed in the Regulations.
- Note 9.07 It is understood that no Office will be required to publish an industrial design where, under the law of the Contracting Party concerned, publication of such industrial design would be considered to be prejudicial to the national security of the Contracting Party.

Article 10 **Communications**

(1) *[Means of Transmittal and Form of Communications]* A Contracting Party may choose the means of transmittal of communications and elect whether to accept communications on paper, communications in electronic form, or any other form of communication.

(2) *[Language of Communications]* (a) A Contracting Party may require that any communication be in a language admitted by the Office.

(b) A Contracting Party may require that, where a communication is not in a language admitted by its Office, a translation of that communication by an official translator or a representative, into a language admitted by the Office, be supplied within a reasonable time limit.

(c) No Contracting Party may require the attestation, notarization, authentication, legalization or any other certification of any translation of a communication, except in those cases prescribed in this Treaty.

(d) *Notwithstanding subparagraph (c), a Contracting Party may require that any translation of a communication be accompanied by a statement that the translation is true and accurate.*

(3) *[Address for Correspondence, Address for Service and Contact Details] A Contracting Party may, subject to any provisions prescribed in the Regulations, require that an applicant, holder, or other interested person, indicate in any communication:*

- (i) *an address for correspondence;*
- (ii) *an address for service;*
- (iii) *any other address or contact details provided for in the Regulations.*

(4) *[Signature of Communications on Paper] (a) A Contracting Party may require that a communication on paper be signed by the applicant, holder or other interested person. Where a Contracting Party requires a communication on paper to be signed, that Contracting Party shall accept any signature that complies with the requirements prescribed in the Regulations.*

(b) *No Contracting Party may require the attestation, notarization, authentication, legalization or other certification of any signature, except in respect of any quasi-judicial proceedings or in those cases prescribed in the Regulations.*

(c) *Notwithstanding subparagraph (b), a Contracting Party may require that evidence be filed with the Office where the Office may reasonably doubt the authenticity of any signature of a communication on paper.*

(5) *[Communications Filed in Electronic Form or by Electronic Means of Transmittal] Where a Contracting Party permits the filing of communications in electronic form or by electronic means of transmittal, it may require that any such communications comply with the requirements prescribed in the Regulations.*

(6) *[Prohibition of Other Requirements] No Contracting Party may demand that, in respect of paragraphs (1) to (5), requirements other than those referred to in this Article be complied with.*

(7) *[Indications in Communications] A Contracting Party may require that any communication contain one or more indications prescribed in the Regulations.*

(8) *[Means of Communication with Representative] Nothing in this Article regulates the means of communication between an applicant, holder or other interested person and the representative of any such person.*

Notes on Article 10

Note 10.01 Under *paragraph (1)*, an Office may choose the means of transmittal of communications and the form of the communications that it accepts.

Note 10.02 *Paragraph (2)* deals with the language of communications. Under *subparagraph (a)*, an Office may require that any communication be in a language admitted by it. It follows that, where a communication or part of a communication, is not in a language admitted by the Office, a Contracting Party may require that the communication be filed in translated form. This is provided for in *subparagraph (b)*. In that case, for the sake of simplification, no attestation, notarization, authentication, legalization or other certification of the

translation, for instance by a notary public, may be required, except as prescribed in the Treaty. For instance, it is prescribed in Article 19(2) that documents in support of a request to record a change in ownership be certified as being in conformity with the original. This would entail certification of a translation of these documents, where the original documents are not in a language admitted by the Office.

- Note 10.03 *Subparagraph (b)*. The question as to who may be a “representative” admitted to make a translation for the purposes of this paragraph is a matter for the applicable law of the Contracting Party concerned. A Contracting Party may provide that only a representative who is a registered agent is allowed to translate a communication.
- Note 10.04 *Subparagraph (d)* provides that a Contracting Party may require a statement that the translation conforms to the original communication. It would be for each Contracting Party to determine who can validly make such statement. Such statement could be made, for example, by a representative admitted to practice before the Office or by an official translator.
- Note 10.05 *Paragraph (3)* is partly modeled on Article 8(6) of the PLT. An indication of an address for correspondence, an address for service, or any other prescribed address or contact details, may be required by any Contracting Party in any communication. In particular, indication of an address for correspondence or an address for service may be required where a Contracting Party does not require representation, but requires that the applicant have an address for service or an address for correspondence in the territory concerned.
- Note 10.06 Under this provision, a Contracting Party may also require the indication, in a communication, of contact details of the applicant, holder, or other interested person. The contact details that may be required, as prescribed in Rule 7(1)(b), are a telephone number, a telefacsimile number or an email address.
- Note 10.07 *Paragraph (4)* deals with the signature of communications on paper. Consistent with the aim of simplification, this paragraph provides that no attestation, notarization, authentication, legalization or other certification of any signature may be required, except in respect of quasi-judicial proceedings or in those cases prescribed in the Regulations. To balance the absence of certification of any signature, the paragraph further provides for the possibility for an Office to require, in cases of reasonable doubt, evidence of the authenticity of a signature.
- Note 10.08 *Paragraph (7)* allows a Contracting Party to require that a communication contain indications prescribed in the Regulations, such as the name and address of the applicant, holder or other interested person, or the number of the application or registration to which the communication relates. The paragraph is modeled on Article 8(5) of the PLT.

Article 11 **Renewal**

(1) *[Request for Renewal; Fee]* (a) Where a Contracting Party provides for renewal of the term of protection, it may require that the renewal be subject to the filing of a request and that such request contain some, or all, of the following indications:

- (i) *an indication that renewal is sought;*
- (ii) *the name and address of the holder;*
- (iii) *the number(s) of the registration(s) concerned by the renewal;*
- (iv) *an indication of the term of protection for which renewal is requested;*
- (v) *where the holder has a representative, the name and address of that representative;*
- (vi) *where the holder has an address for service or an address for correspondence, such address;*
- (vii) *where it is permitted that renewal be made for some only of the industrial designs contained in the registration, and such a renewal is requested, an indication of the industrial design number(s) for which the renewal is, or is not, requested;*
- (viii) *where it is permitted that a request for renewal may be filed by a person other than the holder or its representative, and the request is filed by such a person, the name and address of that person.*

(b) A Contracting Party may require that, in respect of the renewal, a fee be paid to the Office.

(2) *[Period for Presentation of the Request for Renewal and Payment of the Fee]* A Contracting Party may require that the request for renewal referred to in paragraph (1)(a) be presented, and the corresponding fee referred to in paragraph (1)(b) be paid, to the Office within a period fixed by the law of the Contracting Party, subject to the minimum periods prescribed in the Regulations.

(3) *[Prohibition of Other Requirements]* No Contracting Party may demand that requirements other than those referred to in paragraphs (1) and (2) and in Article 10 be complied with in respect of the request for renewal.

Notes on Article 11

Note 11.01 This Article deals exclusively with the contents of a request for renewal and the period for presenting such request or for paying the renewal fees. As explicitly indicated in *paragraph (1)*, the provision will only apply to those Contracting Parties which provide for renewal in their law.

Note 11.02 *Item (iii)*. Under this provision, Contracting Parties may allow that a single request for renewal relates to more than one registration, provided that the numbers of all registrations concerned are indicated in the request.

Note 11.03 *Item (iv) takes into account that, in some countries, renewal can be requested for one or several further terms of protection, at the option of the holder.*

Article 12

Relief in Respect of Time Limits

(1) *[Extension of Time Limits] A Contracting Party may provide for the extension, for the period prescribed in the Regulations, of a time limit fixed by the Office for an action in a procedure before the Office, if a request to that effect is filed with the Office in accordance with the requirements prescribed in the Regulations, and the request is filed, at the option of the Contracting Party:*

- (i) prior to the expiry of the time limit; or*
- (ii) after the expiry of the time limit, and within the time limit prescribed in the Regulations.*

(2) *[Continued Processing] Where an applicant or holder has failed to comply with a time limit fixed by the Office of a Contracting Party for an action in a procedure before the Office, and that Contracting Party does not provide for the extension of a time limit under paragraph (1)(ii), the Contracting Party shall¹⁵ provide for continued processing with respect to the application or registration and, if necessary, reinstatement of the rights of the applicant or holder with respect to that application or registration, if:*

- (i) a request to that effect is made to the Office in accordance with the requirements prescribed in the Regulations;*
- (ii) the request is filed, and all of the requirements for the said action, in respect of which the time limit applied, are complied with, within the time limit prescribed in the Regulations.*

(3) *[Exceptions] There shall be no requirement to provide for the extension of time limits under paragraph (1) or continued processing under paragraph (2) with respect to the exceptions prescribed in the Regulations.*

(4) *[Fees] A Contracting Party may require that a fee be paid in respect of a request under paragraph (1) or (2).*

(5) *[Prohibition of Other Requirements] No Contracting Party may demand that requirements other than those referred to in paragraphs (1) to (4) be complied with in respect of the relief provided for under paragraph (1) or (2), except where otherwise provided for by this Treaty or prescribed in the Regulations.*

(6) *[Opportunity to Make Observations in Case of Intended Refusal] A request under paragraph (1) or (2) may not be refused without the applicant or holder being given the opportunity to make observations on the intended refusal within a reasonable time limit.*

¹⁵ At the thirtieth session of the SCT, the Delegation of India reserved its position regarding the mandatory nature of paragraph (2).

Notes on Article 12

- Note 12.01 Both the Singapore Treaty and the PLT contain provisions on relief measures. Those provisions are intended to add some flexibility to the consequences that derive from the non-observance of a time limit. Without any relief measure, missing a time limit generally results in a loss of rights, which, in the case of patents and industrial designs, is irreparable.
- Note 12.02 Because of the irreparable nature of a patent loss, the approach to relief measures is different in the Singapore Treaty and in the PLT. A trademark may be filed again; a lost patent, as a lost industrial design, is irretrievable.
- Note 12.03 Under the Singapore Treaty, 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.
- Note 12.04 Under the PLT, 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 fixed by the Office, 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.
- Note 12.05 In addition, a Contracting Party is obliged to provide for reinstatement of rights in case of failure of the applicant or holder 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 having been taken or that the delay was unintentional.
- Note 12.06 The provisions presented in this document follow the approach of the PLT to relief measures, considering that loss of an industrial design is, as in the case of patents, irretrievable. This feature warrants an approach which makes available reinstatement of rights in case of failure of the applicant or holder to comply with a time limit entailing a loss of rights, under certain circumstances.
- Note 12.07 *Article 12* requires a Contracting Party to provide relief in respect of time limits. Such relief may be in the form of an extension of a time limit under paragraph (1) and/or continued processing under paragraph (2). The relief that a Contracting Party has to provide under paragraphs (1) and (2) is restricted to time limits “fixed by the Office for an action in a procedure before the Office.” The term “procedure before the Office” is defined in Article 1(viii). As regards the term “time limit fixed by the Office”, it is for each Contracting Party to decide which time limits, if any, are fixed by the Office. It follows that Article 12 does not apply to time limits that are not fixed by the Office, in particular, time limits established by national legislation or under a regional treaty. Neither does Article 12 apply to time limits for actions that are not before the Office, for example, actions before a court. Consequently, in respect of such other time limits, a Contracting Party would be free to apply the same requirements, apply other requirements, or make no provision for relief (other than reinstatement of rights under Article 13).
- Note 12.08 *Paragraph (2)*. This paragraph obliges a Contracting Party to provide for relief in the form of continued processing, after the applicant or holder has failed to comply with a time limit fixed by the Office, where that Contracting Party does

not provide for the extension of time limits under paragraph (1)(ii). The effect of such continued processing is that the Office continues with the procedure concerned as if that time limit had been complied with. Also, the Office must, if necessary, reinstate the rights of the applicant or holder with respect to the application or registration concerned.

Note 12.09 Exceptions to the applicability of relief measures and reinstatement of rights are provided for in *paragraph (3)*. Such exceptions are intended to prevent an applicant or holder from abusing a system of relief measures, for example by obtaining double relief in respect of a procedure.

Article 13

Reinstatement of Rights After a Finding by the Office of Due Care or Unintentionality¹⁶

(1) *[Reinstatement of Rights]* A Contracting Party shall provide that, where an applicant or holder has failed to comply with a time limit for an action in a procedure before the Office, and that failure has the direct consequence of causing a loss of rights with respect to an application or a registration, the Office shall reinstate the rights of the applicant or holder with respect to that application or registration, if:

(i) a request to that effect is made to the Office in accordance with the requirements prescribed in the Regulations;

(ii) the request is filed, and all of the requirements for the said action, in respect of which the time limit applied, are complied with, within the time limit prescribed in the Regulations;

(iii) the request states the reasons for the failure to comply with the time limit; and

(iv) the Office finds that the failure to comply with the time limit occurred in spite of due care required by the circumstances having been taken or, at the option of the Contracting Party, that any delay was unintentional.

(2) *[Exceptions]* There shall be no requirement to provide for the reinstatement of rights under paragraph (1) with respect to the exceptions prescribed in the Regulations.

(3) *[Fees]* A Contracting Party may require that a fee be paid in respect of a request under paragraph (1).

(4) *[Evidence]* A Contracting Party may require that a declaration or other evidence in support of the reasons referred to in paragraph (1)(iii) be filed with the Office within a time limit fixed by the Office.

(5) *[Opportunity to Make Observations in Case of Intended Refusal]* A request under paragraph (1) may not be refused, totally or in part, without the requesting party being given the opportunity to make observations on the intended refusal, within a reasonable time limit.

¹⁶ At the thirtieth session of the SCT, Option 2, as presented in document SCT/30/2, received support from the Delegation of India. Under that Option, reinstatement of rights would be optional.

Notes on Article 13

- Note 13.01 This Article obliges a Contracting Party to provide for the reinstatement of rights with respect to an application or registration following failure to comply with a time limit for an action in a procedure before the Office. In contrast to Article 12, such reinstatement is subject to a finding by the Office that the failure occurred in spite of all due care required by the circumstances or, at the option of the Contracting Party, was unintentional. Also in contrast to Article 12, Article 13 is not restricted to time limits fixed by the Office, although it is subject to certain exceptions under paragraph (2) and Rule 11(3).
- Note 13.02 This Article is modeled on Article 12 of the PLT. However, the jurisprudence and practice developed in the field of patents in respect of reinstatement of rights would not be necessarily applicable in the interpretation of this provision with respect to industrial designs.
- Note 13.03 *Paragraph (1)*. The phrase "that failure has the direct consequence of causing a loss of rights with respect to an application or a registration" is intended to cover the situations where a failure to comply with a time limit directly causes a loss of rights with respect to the application or registration. An example of this could be the case where the required filing fee is not paid when filing a design application. In that case, the Office of the Contracting Party will issue an invitation requesting the applicant to pay the filing fee. The invitation will set a specified period for response. If the filing fee is not paid within the specified period, the design application will be dismissed as the direct consequence of the expiration of the specified period. That failure would thus have the direct consequence of causing a loss of rights with respect to the application concerned. A Contracting Party would therefore have to provide for reinstatement of rights under Article 13. As regards the term "procedure before the Office", reference is made to the explanation under Article 1(viii)."

Article 14

Correction or Addition of Priority Claim; Restoration of Priority Right

(1) *[Correction or Addition of Priority Claim]* A Contracting Party shall provide for the correction or addition of a priority claim with respect to an application ("the subsequent application"), if:

- (i) *a request to that effect is made to the Office in accordance with the requirements prescribed in the Regulations;*
- (ii) *the request is filed within the time limit prescribed in the Regulations; and*
- (iii) *the filing date of the subsequent application is not later than the date of the expiration of the priority period calculated from the filing date of the earliest application whose priority is claimed.*

(2) *[Delayed Filing of the Subsequent Application]*¹⁷ A Contracting Party shall¹⁸ provide that, where an application (“the subsequent application”) which claims or could have claimed the priority of an earlier application has a filing date which is later than the date on which the priority period expired, but within the time limit prescribed in the Regulations, the Office shall restore the right of priority, if:

(i) a request to that effect is made to the Office in accordance with the requirements prescribed in the Regulations;

(ii) the request is filed within the time limit prescribed in the Regulations;

(iii) the request states the reasons for the failure to comply with the priority period;
and

(iv) the Office finds that the failure to file the subsequent application within the priority period occurred in spite of due care required by the circumstances having been taken or, at the option of the Contracting Party, was unintentional.

(3) *[Fees]* A Contracting Party may require that a fee be paid in respect of a request under paragraph (1) and in respect of a request under paragraph (2).

(4) *[Evidence]* A Contracting Party may require that a declaration or other evidence in support of the reasons referred to in paragraph (2)(iii) be filed with the Office within a time limit fixed by the Office.

(5) *[Opportunity to Make Observations in Case of Intended Refusal]* A request under paragraph (1) or (2) may not be refused, totally or in part, without the requesting party being given the opportunity to make observations on the intended refusal within a reasonable time limit.

Notes on Article 14

Note 14.01 At the twenty-fifth session of the SCT, one delegation suggested to include a provision on correction or addition of a priority claim and restoration of priority right, modeled on Article 13 of PLT. At the twenty-eighth session of the SCT, two delegations, supported by a third, proposed to look into the question of a correction or addition of priority claim and restoration of a priority right. The delegations presented for discussion a draft Article 13*bis*, modeled on Article 13 of the PLT. Following the thirtieth session of the SCT, this Article has been renumbered as Article 14 to follow the natural numbering sequence.

Note 14.02 Article 14 would permit the applicant to correct or add a priority claim to an application which could have claimed the priority of an earlier application, but did not do so. It would apply both where the application filed contained no priority claim (addition of priority claim) and where the application already claimed priority of one or more earlier applications (correction of priority claim). The provision would also provide for the restoration of the priority right where a subsequent application is filed after the expiration of the priority period, but within a time limit prescribed in the Regulations. It would apply only where the

¹⁷ At the thirtieth session of the SCT, the Delegation of China reserved its position regarding the mandatory nature of paragraph (2).

¹⁸ At the twenty-ninth session of the SCT, the Delegation of India proposed to replace “shall” by “may”.

failure to file the application within the priority period occurred in spite of all due care required by the circumstances having been taken, or, at the option of the Contracting Party, was unintentional.

Article 15
Request for Recording of a License or a Security Interest

(1) *[Requirements Concerning the Request for Recording of a License]* Where the law of a Contracting Party provides for the recording of a license, that Contracting Party may require that the request for recording:

- (i) *be filed in accordance with the requirements prescribed in the Regulations, and*
- (ii) *be accompanied by the supporting documents prescribed in the Regulations.*

(2) *[Fees]* In respect of the recording of a license, the Office may require the payment of a fee.

(3) *[Single Request]* A single request shall be sufficient even where the license relates to more than one registration, provided that the registration numbers of all registrations concerned are indicated in the request, the holder and the licensee are the same for all registrations, and the request indicates the scope of the license with respect to all registrations.

(4) *[Prohibition of Other Requirements]* (a) No requirement other than those referred to in paragraphs (1) to (3) and in Article 10 may be demanded in respect of the recording of a license. In particular, the following may not be required:

(i) *the furnishing of the registration certificate of the industrial design which is the subject of the license;*

(ii) *an indication of the financial terms of the license contract.*

(b) *Subparagraph (a) is without prejudice to any obligations existing under the law of a Contracting Party concerning the disclosure of information for purposes other than the recording of the license[, including any requirements by tax authorities or monetary authorities]¹⁹.*

(5) *[Evidence]* It may be required that evidence be furnished to the Office where the Office may reasonably doubt the veracity of any indication contained in the request, or in any supporting document.

(6) *[Requests Relating to Applications]* Paragraphs (1) to (5) shall apply, mutatis mutandis, to requests for recording of a license in respect of an application, where the law of a Contracting Party provides for such recording.

(7) *[Request for Recording of a Security Interest]* With the exception of paragraph (4)(a)(ii), paragraphs (1) to (5) shall apply, mutatis mutandis, to requests for recording of a security interest in respect of an application or registration.

¹⁹ The text within brackets was supported at the thirtieth session of the SCT by the Delegations of Brazil and Indonesia.

Notes on Article 15

- Note 15.01 This Article is based on the provisions on the recording of licenses of the Singapore Treaty and the PLT.
- Note 15.02 It follows from the introductory words of *paragraphs (1) and (2)* that there is no obligation for a Contracting Party to provide for the recording of licenses. However, it follows from *paragraph (4)(a)* that, where the applicable law provides for such recording, no indication or element other than those prescribed in Rule 13(1), or in Article 10, concerning “communications”, may be required. Similarly, a Contracting Party may not require any other document than those listed in Rule 13(2).
- Note 15.03 *Paragraphs (2) and (3)*. Under paragraph (2), a Contracting Party may require the payment of a fee in respect of the recording of a license. Each Contracting Party would be free to determine the amount and structure of the fee. For instance, while under paragraph (3) a Contracting Party would be required to accept a single request for recording a license that relates to more than one registration, the Contracting Party would be free to establish a fee structure for such single request based on the number of applications or registrations concerned by the request. In other words, the Contracting Party could determine that the total amount of the fee to be paid in respect of a single request for the recording of a license relating to more than one registration is dependent on the number of applications or registrations.
- Note 15.04 *Paragraph (4)* does not exclude the furnishing of the license contract, or a translation of it. Under Rule 13(2)(a), a Contracting Party may require that the request for the recording of a license be accompanied, at the option of the requesting party, by an extract of the agreement or a copy of the license agreement.
- Note 15.05 This provision does not prevent any authorities of a Contracting Party, for example tax or monetary authorities or authorities establishing statistics, or anti-monopoly or authoritative competition bodies, from requiring the parties to a license to furnish information in accordance with the applicable law of that Contracting Party.
- Note 15.06 Under *paragraph (6)*, the applicable requirements apply also to the recording of licenses in respect of *applications*, but only where the law of a Contracting Party provides for such recording. This provision is also contained in the Singapore Treaty.
- Note 15.07 *Paragraph (7)*, concerning a request for the recording of a security interest, is based on Rule 17(9) of the Regulations under the PLT. It relates to the recording of a security interest in an application or registration, acquired by contract for the purpose of securing payment or performance of an obligation, such as a mortgage or a pledge, or for the purpose of indemnifying against loss or liability. As in the case of the recording of a license under paragraph (1), there is no obligation for a Contracting Party to provide for the recording of a security interest. Moreover, any Contracting Party which does allow for such recording is free to decide which security interests may be recorded.

Note 15.08 It follows from the introductory words of paragraph (7), “With the exception of paragraph (4)(a)(ii)”, that an indication of the financial terms of the security interest may be required by a Contracting Party for recording a security interest.

Article 16
Request for Amendment or Cancellation of the Recording of a License or a Security Interest

(1) *[Requirements Concerning the Request for Amendment or Cancellation of the Recording of a License] Where the law of a Contracting Party provides for the recording of a license, that Contracting Party may require that the request for amendment or cancellation of the recording of a license:*

- (i) be filed in accordance with the requirements prescribed in the Regulations, and*
- (ii) be accompanied by the supporting documents prescribed in the Regulations.*

(2) *[Requirements Concerning the Request for Cancellation of the Recording of a Security Interest] Paragraph (1) shall apply, mutatis mutandis, to requests for cancellation of the recording of a security interest.*

(3) *[Other Requirements] Article 15(2) to (7) shall apply, mutatis mutandis, to requests for amendment or cancellation of the recording of a license and to requests for cancellation of the recording of a security interest.*

Note on Article 16

Note 16.01 Articles 16, 17 and 18 are modeled on Articles 18, 19 and 20 of the Singapore Treaty.

Article 17
Effects of the Non-Recording of a License

(1) *[Validity of the Registration and Protection of the Industrial Design] The non-recording of a license with the Office or with any other authority of a Contracting Party shall not affect the validity of the registration of the industrial design which is the subject of the license, nor the protection of that industrial design²⁰.*

(2) *[Certain Rights of the Licensee] A Contracting Party may [not]²¹ require the recording of a license as a condition for any right that the licensee may have under the law of that Contracting Party to join infringement proceedings initiated by the holder or to obtain, by way of such proceedings, damages resulting from an infringement of the industrial design which is the subject of the license.*

²⁰ At the twenty-ninth session of the SCT, the Delegation of Iran (Islamic Republic of) proposed to turn Article 16(1), currently Article 17(1), into an optional provision.

²¹ At the thirty-first session of the SCT, the Delegations of Brazil, Chile and Pakistan supported the deletion of the word “not”.

Notes on Article 17

- Note 17.01 *Paragraph (1).* The purpose of this paragraph is to separate the question of the validity of the registration of an industrial design and the protection of the industrial design from the question as to whether a license concerning the said industrial design was recorded. If the law of a Contracting Party provides for the mandatory recording of licenses, non-compliance with that requirement may not result in the invalidation of the registration of the industrial design which is the subject of the license, and may not affect in any way the protection afforded to that industrial design. It is to be noted that this paragraph concerns the recording of a license with the Office or any other authority of a Contracting Party such as, for example, the tax or monetary authority or the authority responsible for the establishment of statistics.
- Note 17.02 *Paragraph (2).* This provision does not intend to harmonize the question whether a licensee should be allowed to join proceedings initiated by the licensor, or whether it would be entitled to damages resulting from an infringement of the licensed industrial design. This question is left to the applicable law. However, this provision deals with the question whether, where a licensee has the right under the law of a Contracting Party to join infringement proceedings initiated by the holder and to obtain damages resulting from an infringement of the licensed industrial design, the licensee should be able to exercise those rights independently of whether the license is recorded.
- Note 17.03 Following the thirtieth session of the SCT, paragraph (2) and the word “not” in paragraph (2) have been put within brackets. If it is subsequently decided to remove all the brackets and maintain paragraph (2), then the recording of a license will not be a condition for the licensee to join infringement proceedings initiated by the holder and to obtain damages, where those rights are provided for by the applicable law. This would follow the approach followed in the STLT (see Articles 19(2) and 29(4) of the STLT). If the word “not” in paragraph (2), or the entire paragraph (2), is deleted, a Contracting Party will be able to require that the license be recorded, as a condition for the licensee to join infringement proceedings initiated by the holder or to obtain damages.

Article 18 **Indication of the License**

Where the law of a Contracting Party requires an indication that the industrial design is used under a license, full or partial non-compliance with that requirement shall not affect the validity of the registration of the industrial design which is the subject of the license, nor the protection of that industrial design.

Note on Article 18

- Note 18.01 Article 18 leaves it to the law of a Contracting Party to prescribe whether or not products which are commercialized under a licensed industrial design must bear an indication of the fact that the industrial design is used under a license contract. However, where such indication is required by the applicable law, non-compliance with that obligation should not entail the invalidation of the registration of the industrial design in whole or in part.

Article 19
Request for Recording of a Change in Ownership

(1) *[Requirements Concerning the Request for Recording]* (a) *Where there is a change in the person of the holder, a Contracting Party shall accept that a request for the recording of the change be made either by the holder or by the new owner.*

(b) *A Contracting Party may require that the request contain some, or all, of the indications prescribed in the Regulations.*

(2) *[Requirements Concerning Supporting Documents for Recording of a Change in Ownership]* (a) *Where the change in ownership results from a contract, a Contracting Party may require that the request be accompanied, at the option of the requesting party, by one of the elements prescribed in the Regulations.*

(b) *Where the change in ownership results from a merger, a Contracting Party may require that the request be accompanied by a copy of a document, which originates from a competent authority and evidences the merger, such as a copy of an extract from a register of commerce, and that that copy be certified by the authority which issued the document or by a notary public or any other competent public authority, as being in conformity with the original document.*

(c) *Where there is a change in one or more, but not all, of several co-holders, and such change in ownership results from a contract or a merger, a Contracting Party may require that any co-holder in respect of which there is no change in ownership give its express consent to the change in ownership, in a document signed by such co-holder.*

(d) *Where the change in ownership does not result from a contract or a merger but from another ground, for example, by operation of law or a court decision, a Contracting Party may require that the request be accompanied by a copy of a document evidencing the change and that that copy be certified as being in conformity with the original document by the authority which issued the document, or by a notary public or any other competent public authority.*

(3) *[Fees]* *A Contracting Party may require that, in respect of the request, a fee be paid to the Office.*

(4) *[Single Request]* *A single request shall be sufficient even where the change relates to more than one registration, provided that the holder and the new owner are the same for each registration, and that the numbers of all registrations concerned are indicated in the request.*

(5) *[Change in the Ownership of an Application]* *Paragraphs (1) to (4) shall apply, mutatis mutandis, where the change in ownership concerns an application, provided that, where the application number of the application concerned has not yet been issued or is not known to the applicant or its representative, the request identifies the application as prescribed in the Regulations.*

(6) *[Prohibition of Other Requirements]* *No Contracting Party may demand that requirements other than those referred to in paragraphs (1) to (5) and in Article 10 be complied with in respect of a request for the recording of a change in ownership.*

(7) *[Evidence]* *A Contracting Party may require that evidence, or further evidence where paragraph (2)(b) or (d) applies, be furnished to the Office where the Office reasonably doubts the veracity of any indication contained in the request or in any document referred to in the present Article.*

Notes on Article 19

- Note 19.01 This provision is based, to a large extent, on the provisions on the recording of a change in ownership in the Singapore Treaty and the PLT.
- Note 19.02 *Paragraphs (1) and (2) provide for the general requirements concerning a request for change in ownership and the supporting documents. Details concerning such request and supporting documents are provided for in the Regulations.*
- Note 19.03 *Paragraph (3). Under this paragraph, a Contracting Party may require the payment of a fee in respect of a request. Each Contracting Party is free to determine the amount of the fee, depending, *inter alia*, on the number of applications or registrations concerned by the change in ownership. For instance, while under paragraph (4) a Contracting Party would be required to accept a single request for recording a change that relates to more than one registration, the Contracting Party would be free to establish a fee structure for such single request based on the number of applications or registrations concerned by the request. In other words, the Contracting Party could determine that the total amount of the fee to be paid in respect of a single request is dependent on the number of applications or registrations concerned by the change.*
- Note 19.04 *Paragraph (5) makes it clear that a change in ownership may also be recorded in respect of an application. The manner of identifying the application where the application number has not yet issued or is not known to the applicant is provided for in the Regulations.*

Article 20²²
Changes in Names or Addresses

(1) *[Changes in the Name or Address of the Holder] (a) Where there is no change in the person of the holder but there is a change in its name and/or address, each Contracting Party shall accept that a request for the recording of the change by the Office be made by the holder in a communication indicating the registration number of the registration concerned and the change to be recorded.*

(b) A Contracting Party may require that the request contain some, or all, of the indications prescribed in the Regulations.

(c) A Contracting Party may require that, in respect of the request, a fee be paid to the Office.

(d) A single request shall be sufficient even where the change relates to more than one registration, provided that the registration numbers of all registrations concerned are indicated in the request.

²² At the thirtieth session of the SCT, the Delegation of India reserved its position regarding this Article.

(2) *[Change in the Name or Address of the Applicant]* Paragraph (1) shall apply, mutatis mutandis, where the change concerns an application or applications, or both an application or applications and a registration or registrations, provided that, where the application number of any application concerned has not yet been issued or is not known to the applicant or its representative, the request otherwise identifies that application as prescribed in the Regulations.

(3) *[Change in the Name or Address of the Representative or in the Address for Service]* Paragraph (1) shall apply, mutatis mutandis, to any change in the name or address of the representative, if any, and to any change relating to the address for service, if any.

(4) *[Prohibition of Other Requirements]* No Contracting Party may demand that requirements other than those referred to in paragraphs (1) and (2) and in Article 10 be complied with in respect of the request referred to in this Article. In particular, the furnishing of any certificate concerning the change may not be required.

(5) *[Evidence]* A Contracting Party may require that evidence be furnished to the Office where the Office may reasonably doubt the veracity of any indication contained in the request.

Notes on Article 20

Note 20.01 This Article is modeled on Article 10 of the Singapore Treaty.

Note 20.02 *Paragraph (1)(c).* Under this paragraph, a Contracting Party may require the payment of a fee in respect of a request. Each Contracting Party is free to determine the amount of the fee, depending, *inter alia*, on the number of registrations concerned by the changes. For instance, while under paragraph (1)(d) a Contracting Party would be required to accept a single request for recording a change that relates to more than one registration, the Contracting Party would be free to establish a fee structure for such single request, based on the number of applications or registrations concerned by the request. In other words, the Contracting Party could determine that the total amount of the fee to be paid in respect of a single request relating to more than one registration is dependent on the number of applications or registrations concerned by the change.

Article 21 **Correction of a Mistake**

(1) *[Request]* (a) *Where an application, a registration or any request communicated to the Office in respect of an application or a registration contains a mistake, not related to search or substantive examination, which is correctable by the Office under the applicable law, the Office shall accept that a request for correction of that mistake in the records and publications of the Office be made in a communication to the Office signed by the applicant or holder.*

(b) *A Contracting Party may require that the request be accompanied by a replacement part or part incorporating the correction or, where paragraph (3) applies, by such a replacement part or part incorporating the correction for each application and registration to which the request relates.*

(c) *A Contracting Party may require that the request be subject to a declaration by the requesting party stating that the mistake was made in good faith.*

(d) *A Contracting Party may require that the request be subject to a declaration by the requesting party stating that the said request was made without undue delay or, at the option of the Contracting Party, that it was made without intentional delay, following the discovery of the mistake.*

(2) *[Fees] (a) Subject to subparagraph (b), a Contracting Party may require that a fee be paid in respect of a request under paragraph (1).*

(b) *The Office shall correct its own mistakes, ex officio or upon request, for no fee.*

(3) *[Single Request] Article 19(4) shall apply, mutatis mutandis, to requests for correction of a mistake, provided that the mistake and the requested correction are the same for all applications and registrations concerned.*

(4) *[Evidence] A Contracting Party may only require that evidence in support of the request be filed with the Office where the Office may reasonably doubt that the alleged mistake is in fact a mistake, or where it may reasonably doubt the veracity of any matter contained in, or of any document filed in connection with, the request for correction of a mistake.*

(5) *[Prohibition of Other Requirements] No Contracting Party may require that formal requirements other than those referred to in paragraphs (1) to (4) be complied with in respect of the request referred to in paragraph (1), except where otherwise provided for by this Treaty or prescribed in the Regulations.*

(6) *[Exclusions] A Contracting Party may exclude the application of this Article in respect of any mistake which must be corrected in that Contracting Party under a procedure for reissue of the registration.*

Notes on Article 21

Note 21.01 This Article is modeled on Rule 18 of the PLT, rather than on Article 12 of the Singapore Treaty, taking into account that the issues arising from the correction of a mistake regarding an industrial design may be more akin to those concerning patents.

Note 21.02 This Article regulates the formal requirements and procedures concerning the request for correction of a mistake. It does not regulate the substantive requirements which a Contracting Party may apply in determining the allowability of a correction. For example, a Contracting Party may require that the correction be obvious in the sense that it is unequivocally clear that nothing else could have been intended than what is offered as the correction. It also does not regulate corrections in the application which are not the subject of a request for correction, in particular, the amendment of the description or the representation of the industrial designs, either voluntarily following the receipt of a search report, or in the course of substantive examination.

Note 21.03 *Paragraph (1)(a)*, introductory words. The expression “mistake in the records (...) of the Office” is to be interpreted in light of the definition of the term “records of the Office” under Article 1(x). Examples of mistakes which could be the subject of a request under paragraph (1) are mistakes in the bibliographic data or in details concerning a priority claim. It follows from the wording “which is correctable by the Office under the applicable law” that the question of which mistakes are correctable is not regulated by this Article.

- Note 21.04 *Paragraph (1)(b)*. This provision allows a Contracting Party to require that a replacement part (for example, a replacement page in the case of an application filed on paper), or a part incorporating the correction (for example, an errata sheet), be filed. In the case where the request applies to more than one application and/or registration, an Office may require that a separate replacement part, or part incorporating the correction, be filed for each application and registration, to facilitate the work of the Office.
- Note 21.05 *Paragraph (1)(c)*. This provision permits a Contracting Party to refuse a request for correction of a mistake where the requesting party is unable to file a declaration that the said mistake was made in good faith, for example, where the mistake was made with deceptive intention. It is a matter for the Contracting Party concerned to decide what constitutes good faith.
- Note 21.06 *Paragraph (1)(d)*. This provision permits a Contracting Party to refuse a request for correction of a mistake where there was undue or intentional delay in making the request after the discovery of the mistake. It is a matter for the Contracting Party concerned to decide what constitutes undue or intentional delay; for example, it may consider that there is undue delay where the request is not diligently made.
- Note 21.07 *Paragraph (4)*. This paragraph permits a Contracting Party to require evidence in the case of any request for correction where, for example, notwithstanding the declaration referred to in paragraph (1)(c), there is reasonable doubt as to whether the mistake was made in good faith, or where there is reasonable doubt as to whether the request was made without undue or intentional delay following the discovery of the mistake in accordance with paragraph (1)(d).

**[Article 22] [Resolution]
Technical Assistance and Capacity Building**

[(1)] [Principles] *The Organization shall, subject to availability of resources and with a view to facilitating the implementation of the Treaty, provide technical assistance, in particular to developing countries and Least Developed Countries. Such technical assistance shall*

(i) be development-oriented, demand-driven, transparent, targeted and adequate for the strengthening of the capacity of beneficiary countries to implement the Treaty;

(ii) take into account the priorities and the specific needs of receiving countries for enabling the users to take full advantage of the provisions of the Treaty.

(2) [Technical Assistance and Capacity Building] *(a) Technical assistance and capacity building activities provided under this Treaty shall be for the implementation of this Treaty and, where requested, include²³:*

(i) establishing the required legal framework and revising administrative practices and procedures of design registration authorities;

(ii) building up the necessary capacity of the Offices, including but not limited to providing training of human resources, [and providing appropriate equipment and technology as well as the required infrastructure].

²³ The Delegation of the United States of America proposed to insert the words "assistance with" after the word "include".

(b) *The Organization shall provide, subject to [allocation and] availability of resources financing for [WIPO] activities and measures that are required to implement the Treaty in accordance with paragraph (2)(a), (3)(a) [and Article 24(1)(c)]. [Moreover, the Organization shall seek to enter into agreements with international financing organization, intergovernmental organizations and governments of receiving countries in order to provide financial support for technical assistance pursuant to this Treaty.]*

(3) *[Other Provisions]²⁴ [(a) The World Intellectual Property Organization is urged to expedite the creation of a digital library system for registered designs. Contracting Parties shall endeavor to communicate published registered design information through such system. The Organization shall support Contracting Parties in their efforts to exchange information through this system.]*

[(b) Contracting Parties to this Treaty [shall endeavor][are encouraged] to establish a fee reduction system to the benefit of design creators [(natural persons and small and medium enterprises (SMEs))]. [Such fee reduction system if implemented shall apply to those who are nationals of and reside in a developing country or an LDC.]]

Note on [Article 22] [Resolution]

Note [22] [Resolution] The Delegation of Spain said that the terms “the Organization shall” would appear to create an obligation on a third party, i.e., WIPO. Depending on the final format of this provision, this formulation could be further reflected on.

**Article 23
Regulations**

(1) *[Content] [(a)] The Regulations annexed to this Treaty provide rules concerning:*

- (i) matters which this Treaty expressly provides to be prescribed in the Regulations;*
- (ii) any details useful in the implementation of the provisions of this Treaty;*
- (iii) any administrative requirements, matters or procedures.*

[(b) The Regulations also provide for the publication of Model International Forms to be established by the Assembly.]²⁵

(2) *[Amending the Regulations] Subject to paragraph (3), any amendment of the Regulations shall require three-fourths of the votes cast.*

(3) *[Requirement of Unanimity] (a) The Regulations may specify provisions of the Regulations which may be amended only by unanimity.*

²⁴ Some delegations were of the opinion that the subject matter of this provision was better suited to a Resolution. Other delegations preferred to have this provision in a separate Article. Other delegations were of the view that this provision should not be in the Treaty.

²⁵ The text within brackets was supported at the thirtieth session of the SCT by the Delegations of Colombia, El Salvador, Morocco, Senegal and Spain.

(b) Any amendment of the Regulations resulting in the addition of provisions to, or the deletion of provisions from, the provisions specified in the Regulations pursuant to subparagraph (a) shall require unanimity.

(c) In determining whether unanimity is attained, only votes actually cast shall be taken into consideration. Abstentions shall not be considered as votes.

(4) [Conflict Between the Treaty and the Regulations] In the case of conflict between the provisions of this Treaty and those of the Regulations, the former shall prevail.

Article 24 Assembly

(1) [Composition] (a) The Contracting Parties shall have an Assembly.

(b) Each Contracting Party shall be represented in the Assembly by one delegate, who may be assisted by alternate delegates, advisors and experts. Each delegate may represent only one Contracting Party.

[(c) Option 1

[The expenses of each delegation shall be borne by the Contracting Party that has appointed the delegation. The Assembly may ask the Organization to grant financial assistance to facilitate the participation of delegations of Contracting Parties that are regarded as developing countries in conformity with the established practice of the General Assembly of the United Nations or LDCs or that are countries in transition to a market economy.]

Option 2

[Contracting Parties that are regarded as developing countries or LDCs or that are countries in transition to a market economy shall be granted adequate financial assistance by the Organization to facilitate the participation of at least one delegate of such Contracting Party in all ordinary and extraordinary sessions of the Assembly, and any inter-sessional meeting, working group, revision conference or diplomatic conference in relation to the Treaty and the Regulations.]]

(2) [Tasks] The Assembly shall

(i) deal with matters concerning the development of this Treaty;

[(ii) establish Model International Forms, referred to in Article 23(1)b);]

(iii) amend the Regulations;

(iv) determine the conditions for the date of application of each amendment referred to in item (iii);

(v) monitor, at every ordinary session, the technical assistance provided under this Treaty²⁶;

²⁶ The Delegation of the United States of America proposed the words "provided for implementation of this Treaty" in place of "provided under this Treaty".

(vi) *perform such other functions as are appropriate to implementing the provisions of this Treaty.*

(3) [Quorum] (a) *One-half of the members of the Assembly which are States shall constitute a quorum.*

(b) *Notwithstanding subparagraph (a), if, in any session, the number of the members of the Assembly which are States and are represented is less than one-half but equal to or more than one-third of the members of the Assembly which are States, the Assembly may make decisions but, with the exception of decisions concerning its own procedure, all such decisions shall take effect only if the conditions set forth hereinafter are fulfilled. The International Bureau shall communicate the said decisions to the members of the Assembly which are States and were not represented and shall invite them to express in writing their vote or abstention within a period of three months from the date of the communication. If, at the expiration of this period, the number of such members having thus expressed their vote or abstention attains the number of the members which was lacking for attaining the quorum in the session itself, such decisions shall take effect, provided that at the same time the required majority still obtains.*

(4) [Taking Decisions in the Assembly] (a) *The Assembly shall endeavor to take its decisions by consensus.*

(b) *Where a decision cannot be arrived at by consensus, the matter at issue shall be decided by voting. In such a case,*

(i) *each Contracting Party that is a State shall have one vote and shall vote only in its own name; and*

(ii) *any Contracting Party that is an intergovernmental organization may participate in the vote, in place of its Member States, with a number of votes equal to the number of its Member States which are party to this Treaty. No such intergovernmental organization shall participate in the vote if any one of its Member States exercises its right to vote and vice versa. In addition, no such intergovernmental organization shall participate in the vote if any one of its Member States party to this Treaty is a Member State of another such intergovernmental organization and that other intergovernmental organization participates in that vote.*

(5) [Majorities] (a) *Subject to Article 23(2) and (3), the decisions of the Assembly shall require two-thirds of the votes cast.*

(b) *In determining whether the required majority is attained, only votes actually cast shall be taken into consideration. Abstentions shall not be considered as votes.*

(6) [Sessions] *The Assembly shall meet upon convocation by the Director General and, in the absence of exceptional circumstances, during the same period and at the same place as the General Assembly of the Organization.*

(7) [Rules of Procedure] *The Assembly shall establish its own rules of procedure, including rules for the convocation of extraordinary sessions.*

Article 25
International Bureau

(1) *[Administrative Tasks]* (a) *The International Bureau shall perform the administrative tasks concerning this Treaty.*

(b) *In particular, the International Bureau shall prepare the meetings and provide the Secretariat of the Assembly and of such committees of experts and working groups as may be established by the Assembly.*

(2) *[Meetings Other than Sessions of the Assembly]* *The Director General shall convene any committee and working group established by the Assembly.*

(3) *[Role of the International Bureau in the Assembly and Other Meetings]* (a) *The Director General and persons designated by the Director General shall participate, without the right to vote, in all meetings of the Assembly, the committees and working groups established by the Assembly.*

(b) *The Director General or a staff member designated by the Director General shall be ex officio Secretary of the Assembly, and of the committees and working groups referred to in subparagraph (a).*

(4) *[Conferences]* (a) *The International Bureau shall, in accordance with the directions of the Assembly, make the preparations for any revision conferences.*

(b) *The International Bureau may consult with Member States of the Organization, intergovernmental organizations and international and national non-governmental organizations concerning the said preparations.*

(c) *The Director General and persons designated by the Director General shall take part, without the right to vote, in the discussions at revision conferences.*

(5) *[Other Tasks]* *The International Bureau shall carry out any other tasks assigned to it in relation to this Treaty.*

Article 26
Revision

This Treaty may only be revised by a diplomatic conference. The convocation of any diplomatic conference shall be decided by the Assembly.

Article 27
Becoming Party to the Treaty

(1) *[Eligibility]* *The following entities may sign and, subject to paragraphs (2) and (3) and Article 28(1) and (3), become party to this Treaty:*

(i) *any State member of the Organization in respect of which industrial designs may be registered or patented with its own Office;*

(ii) *any intergovernmental organization which maintains an Office in which industrial designs may be registered with effect in the territory in which the constituting treaty of the intergovernmental organization applies, in all its Member States or in those of its Member States which are designated for such purpose in the relevant application, provided that all the Member States of the intergovernmental organization are members of the Organization;*

(iii) *any State member of the Organization in respect of which industrial designs may be registered only through the Office of another specified State that is a member of the Organization;*

(iv) *any State member of the Organization in respect of which industrial designs may be registered only through the Office maintained by an intergovernmental organization of which that State is a member;*

(v) *any State member of the Organization in respect of which industrial designs may be registered only through an Office common to a group of States members of the Organization.*

(2) *[Ratification or Accession] Any entity referred to in paragraph (1) may deposit*

(i) *an instrument of ratification, if it has signed this Treaty,*

(ii) *an instrument of accession, if it has not signed this Treaty.*

(3) *[Effective Date of Deposit] The effective date of the deposit of an instrument of ratification or accession shall be,*

(i) *in the case of a State referred to in paragraph (1)(i), the date on which the instrument of that State is deposited;*

(ii) *in the case of an intergovernmental organization, the date on which the instrument of that intergovernmental organization is deposited;*

(iii) *in the case of a State referred to in paragraph (1)(iii), the date on which the following condition is fulfilled: the instrument of that State has been deposited and the instrument of the other specified State has been deposited;*

(iv) *in the case of a State referred to in paragraph (1)(iv), the date applicable under item (ii), above;*

(v) *in the case of a State member of a group of States referred to in paragraph (1)(v), the date on which the instruments of all the States members of the group have been deposited.*

Article 28
Entry into Force;
Effective Date of Ratifications and Accessions

(1) *[Instruments to Be Taken into Consideration] For the purposes of this Article, only instruments of ratification or accession that are deposited by entities referred to in Article 27(1) and that have an effective date according to Article 27(3) shall be taken into consideration.*

(2) *[Entry into Force of the Treaty]* This Treaty shall enter into force three months after ~~[10]~~ ~~[30]~~ States or intergovernmental organizations referred to in Article 27(1)(ii) have deposited their instruments of ratification or accession.

(3) *[Entry into Force of Ratifications and Accessions Subsequent to the Entry into Force of the Treaty]* Any entity not covered by paragraph (2) shall become bound by this Treaty three months after the date on which it has deposited its instrument of ratification or accession.

Article 29 **Reservations**

Article 30 **Denunciation of the Treaty**

(1) *[Notification]* Any Contracting Party may denounce this Treaty by notification addressed to the Director General.

(2) *[Effective Date]* Denunciation shall take effect one year from the date on which the Director General has received the notification. It shall not affect the application of this Treaty to any application pending or any industrial design registered in respect of the denouncing Contracting Party at the time of the expiration of the said one-year period, provided that the denouncing Contracting Party may, after the expiration of the said one-year period, discontinue applying this Treaty to any registration as from the date on which that registration is due for renewal.

Article 31 **Languages of the Treaty; Signature**

(1) *[Original Texts; Official Texts]* (a) This Treaty shall be signed in a single original in the English, Arabic, Chinese, French, Russian and Spanish languages, all texts being equally authentic.

(b) An official text in a language not referred to in subparagraph (a) that is an official language of a Contracting Party shall be established by the Director General after consultation with the said Contracting Party and any other interested Contracting Party.

(2) *[Time Limit for Signature]* This Treaty shall remain open for signature at the headquarters of the Organization for one year after its adoption.

Article 32 **Depositary**

The Director General shall be the depositary of this Treaty.

[End of Annex and of document]