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

**Twenty-Second Session**  
**Geneva, November 23 to 26, 2009**

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

*Document prepared by the Secretariat*

#### I. INTRODUCTION

1. At the twenty-first session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT), held in Geneva from June 22 to 26, 2009, the SCT requested the Secretariat to prepare a revised working document on possible areas of convergence on industrial design law and practice in SCT Members, for consideration by the SCT at its twenty-second session. Such revised document should reflect the changes to the possible areas of convergence that were suggested during the twenty-first session of the SCT and contain a summary of the comments made by delegations at that session (document SCT/21/7, paragraph 8).

2. Pursuant to the request of the SCT, the Secretariat has prepared the present document.

3. With a view to facilitating the work of the Committee, each chapter in this document begins by setting out, in italics, the text of a possible area of convergence. Changes between the text of the possible area of convergence as presented in document SCT/21/4 and in the present document are indicated in “track changes” mode, i.e., with the text that is proposed to be deleted, struck through, and the text that is proposed to be added, appearing underlined.

This text is followed by a summary of the comments made by delegations at the twenty-first session.

4. The possible areas of convergence attempt to reflect a common ground for the various positions among SCT Members, and are without prejudice to a specific position that a delegation may have with regard to the subject concerned.

5. Where a possible area of convergence could not be identified for a given topic, an indication to that effect has been included. Again, such indication is without prejudice to possible future work by the SCT on that subject.

## II. THE APPLICATION

### Form of Reproduction

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

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

6. Delegations at the twenty-first session of the SCT expressed support for the text of this possible area of convergence. Thus, the text has not been changed in substance. However, from a formal point of view, the terms ‘color photographs’ have been replaced by “color graphic or photographic reproductions”.

### Views

#### *Possible Area of Convergence on the Views of the Industrial Design*

*With regard to the views of the industrial design, consideration might be given to the possibility of converging towards the position that the applicant should be free to decide the number and types of views which are needed to fully disclose the industrial design, without prejudice to the fact that offices should be free to require additional views at a later stage of the examination process if they deem that such additional views are necessary to adequately disclose the industrial design. Such additional views should not, however, disclose new matter. Moreover, offices should be free to impose a maximum number of views, which should be sufficiently high so as to enable full disclosure of all types of industrial designs.*

7. Delegations at the twenty-first session of the SCT expressed support for the text of this possible area of convergence. In addition, delegations concurred in that additional views required by offices at a later stage of the examination process should not add new matter. The revised text of this possible area of convergence takes that consideration into account.

8. With respect to the prescription of a maximum number of views, it was said that, in some jurisdictions, the maximum number of permitted views has been raised so as to enable applicants to completely disclose all types of designs. In other jurisdictions, there is no restriction as to the number of permitted views, but offices may limit the number of published representations.

9. The discussions revealed that users would have reservations with respect to the possibility of offices limiting the number of published representations. However, users would not be against a *proviso* limiting the maximum number of permitted views, on the condition that such number was sufficiently high.

10. The revised text of this possible area of convergence includes a possible solution to the question of the maximum number of views, leaving open the determination of what might be a “sufficiently high number of views”.

#### Number of Copies of Reproduction

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

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

11. Delegations at the twenty-first session of the SCT expressed support for the text of this possible area of convergence. In this regard, it is worth noting that certain delegations which presently require more than three copies of each reproduction have indicated that they would not exclude bringing the number of required copies down to three, or less, in the future. The text of this possible area of convergence has therefore not been changed.

#### Specimens

12. Text for a possible area of convergence was put forward to the SCT at its twenty-first session\*. However, the discussions during that session revealed that the approaches to the question of specimens remain largely divergent.

13. Firstly, there are a number of legislations that do not permit the submission of specimens. In this regard, certain delegations pointed out that digital reproduction has rendered specimens largely obsolete.

14. Secondly, in some of the jurisdictions in which the submission of specimens is not permitted, specimens may nonetheless be requested by offices at the time of examination. In this regard, a number of users expressed the view that offices should not request specimens for the purposes of examination.

15. Thirdly, there are offices that accept specimens in the case of deferment of publication only, together with a requirement for the applicant to submit a reproduction at the time of publication.
16. Fourthly, there are offices that admit specimens for two-dimensional designs only, irrespective of any possible deferment of publication.
17. Finally, there are offices that admit specimens for both two and three-dimensional designs, usually subject to certain limits on size and weight.
18. Taking into account the divergence of approaches, this document does not contain a revised text for a possible area of convergence on this matter.

#### Other Contents of the Application Generally Required

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

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

19. Delegations at the twenty-first session of the SCT expressed support for the text of this possible area of convergence. However, some delegations pointed out that indication, by the applicant, of the class or sub-class of the International Classification for Industrial Designs under the Locarno Agreement often gives rise to errors, and should not therefore be a mandatory requirement in an application. Consequently, the text for this possible area of convergence has been modified so as to delete the reference to the indication of the class or sub-class as a required element of an application.
20. The discussions during the twenty-first session of the SCT showed that the positions as to whether or not a claim or a statement of novelty, a description, or the indication of the identity of the creator constitute a filing date requirement, remain somehow divergent. In particular, two delegations indicated that a claim, a description and the indication of the identity of the creator are mandatory elements for according a filing date. For that reason, those elements were added to the area of convergence concerning other contents of the application generally required. Whether or not those elements should constitute a filing date requirement will be addressed in the chapter concerning filing date.

## Requirement to File in the Name of the Creator

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

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

*(i) the name of the creator is indicated on the application form, and*

*(ii) a statement of assignment, pre-printed on the application form, is made by the applicant, in the signing of the form.*

21. The text of this possible area of convergence has not been changed, except for some formal amendments for the purpose of clarification.

## Unity of Design or Unity of Invention

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

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

22. The text of this possible area of convergence has not been changed. However, as there seems to be some overlap between this possible area of convergence and the revised possible area of convergence for multiple applications, as set out in this document, the SCT may wish to consider whether this text could be merged with the text concerning the possible area of convergence for multiple applications.

## Multiple Applications

### *Possible Area of Convergence on Multiple Applications*

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

23. The discussions during the twenty-first session of the SCT showed that the positions regarding the acceptance of multiple applications remain divergent. However, they revealed that jurisdictions that accept multiple applications generally make available the possibility of dividing the application, where it does not conform to the prescribed requirements, while maintaining the original filing date.

24. The text of this possible area of convergence has therefore been limited to the possibility, in those jurisdictions that accept multiple applications, of dividing the application, without prejudice to the granting of the original filing date to the resulting applications.

### III. FILING DATE

#### *Possible Area of Convergence on the Definition of Filing Date Requirements*

*With regard to the requirements for the granting of a filing date, consideration might be given to the possibility of converging towards the position that ~~a filing date for an industrial design application should be granted if at least the following indications and elements are presented~~ no indication or element other than those listed hereafter should be required for the purposes of according a filing date to an industrial design application: a request that the registration of, or grant of protection for, an industrial design is sought; indications allowing the identity of the applicant to be established; a sufficiently clear reproduction of the industrial design; indications allowing the applicant or its representative, if any, to be contacted; an indication of the product(s) which constitute the industrial design or in relation to which the industrial design is to be used. ~~Moreover, consideration might be given as to whether the payment of a fee should constitute a filing date requirement.~~ In addition, in certain jurisdictions, a description, a claim and the payment of a fee may be requested for the purposes of according a filing date.*

25. During the discussions at the twenty-first session of the SCT, several delegations pointed out that the text of this possible area of convergence, as originally presented, does not reflect the situation in their respective jurisdictions. For instance, certain delegations indicated that a claim, a description, or an indication of the product, are filing-date requirements in their jurisdictions. The text of this possible area of convergence has therefore been amended to include the aforementioned elements as potential filing-date requirements.

26. Moreover, a number of delegations expressed the view that payment of a fee should not constitute a filing-date requirement. Other delegations indicated that such payment does constitute a filing-date requirement in their jurisdictions. With a view to reflecting the situation in the largest number of jurisdictions, payment of a fee has been included as a potential filing-date requirement.

27. One delegation further pointed out that, for the purposes of granting a filing date, the required indications have to be in a language accepted by the Office. However, as the question of languages has not been discussed in detail by the SCT, the text of the revised possible area of convergence does not touch upon it at this stage. The SCT may wish to revert to this issue in a more general context.

28. The question of the time limits for complying with filing date requirements is an issue that has not been included in the revised possible area of convergence, but which could benefit from more detailed discussion.

29. As stated in document SCT/21/4, where an application does not contain all the elements or indications which are required to obtain a filing date, the majority of offices afford a time limit to the applicant to complete the application. Usually, where a filing date requirement is missing in an application, but is provided within the applicable time limit, the filing date of the application is that on which the missing element is received by the office. While the most widespread time limit is two months, some offices grant a one-month time limit for filing the missing elements. This may arguably give rise to some concern about the ability of an applicant who is not established or domiciled in the territory of the office to comply with the time limit.

#### IV. DEFERMENT OF PUBLICATION AND SECRET DESIGN

##### *Possible Area of Convergence on Deferment of Publication and Secret Design*

*With regard to deferment of publication and secret design, consideration might be given to the possibility of converging towards the position that, in those jurisdictions in which registration or grant of protection of the industrial design occurs without prior examinations as to novelty and/or originality, as the case may be, applicants should be given the possibility of maintaining an industrial design unpublished for a period of at least six months from the filing or priority date.*

*In those jurisdictions in which registration or grant of protection of the industrial design occurs following examination as to novelty and/or originality, as the case may be, applicants should be given the possibility of maintaining an industrial design unpublished for a period of at least six months from the filing or priority date, provided that the application has not been yet examined and that the registration or grant of protection has not been awarded.*

30. Discussions during the twenty-first session of the SCT showed that deferring publication of the industrial design is of particular interest in those jurisdictions in which protection of the design is granted without a novelty, originality or other substantive examination. In those jurisdictions, registration or grant of protection, and by the same token, publication are likely to occur within a short period of time. Requesting deferment of publication thus enables the applicant to control the first release of the design.

31. In contrast, in those countries in which registration or grant of protection takes place after substantive examination, the pendency period is likely to be longer. In practice, therefore, a *de facto* deferment of publication generally takes place.

32. It has been noted, however, that in some of those countries, expedited examination can be requested, which can result in protection being granted, and in the design being published, in less than six months.

33. In order to properly address all situations, the possible area of convergence on this matter has thus been divided into two paragraphs. This first one is intended to cover the situation in those jurisdictions which provide for registration or grant of protection of the design without prior novelty, originality or other substantive examination. The second one aims at covering the situation in those jurisdictions which provide for registration or grant of protection of the design following a novelty, originality or other substantive examination.

## V. PERIOD OF GRACE IN CASE OF DISCLOSURE

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

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

34. The discussions during the twenty-first session of the SCT revealed that, while the positions regarding the duration of a grace period remain divergent, there is agreement on the principle that, in the event of disclosure, a “reasonable” grace period for filing is desirable.

35. The text of this possible area of convergence has therefore been amended to remove any reference to a grace period expressed in a time measure. The revised text refers instead to a “reasonable” period prior to the date of filing.

36. The text also states that any applicable disclosure should be “without prejudice to the novelty and/or originality of the industrial design, as the case may be.” This language aims at covering the different systems on which the validity of the design may be based.

## VI. STRUCTURE OF TERM OF PROTECTION AND RENEWAL

37. The discussions during the twenty-first session of the SCT showed that, while in many jurisdictions the period of protection is structured in separate terms, some jurisdictions provide protection in one single, non-renewable term.

38. During the discussions, some delegations put forward that structuring the protection in separate terms addresses the concern for a fair balance between the needs of design holders and the needs of third parties. Such approach would warrant a protection over a long period to designs embodied in products with long life cycles. At the same time, this approach would permit that designs for which protection is no longer required by right holders fall into the public domain within a reasonable period of time.

39. In jurisdictions which provide for a protection divided in separate terms, industrial designs are generally protected for an initial term of five years, and may be renewed for additional five-year terms.



40. There are jurisdictions in which the protection of an industrial design is subject to maintenance fees that have to be paid every year. Some delegations have put forward that this approach would be advantageous to right holders and third parties in many respects. However, other delegations do not view this approach favorably, because they see it as putting an administrative burden on offices.

41. In conclusion, it follows from the discussions that the positions as to the structure of the term of protection of industrial designs remain divergent. Consequently, this document does not contain text for a possible area of convergence on this matter.

## VII. COMMUNICATIONS

### *Possible Area of Convergence on Communications*

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

42. No comment was made at the twenty-first session of the SCT regarding this possible area of convergence. The text of this possible area of convergence has therefore not been changed.

## VIII. RELIEF MEASURES

### *Possible Area of Convergence on Relief Measures*

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

*Alternatively, it could be considered that offices should provide for either extension of the time limit or continued processing in case of failure to comply with an expired time limit. Moreover, when 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 design, reinstatement of rights after a finding of due care or unintentionality should be provided.*

43. The discussions during the twenty-first session of the SCT revealed that, although most jurisdictions provide for one or more relief measures in case of failure of the applicant or holder to comply with a time limit for an action in a proceeding before the office, some jurisdictions do not provide for any such relief measure. In this regard, some delegations expressed the view that providing for a relief measure would result in an unnecessary extension of the procedures before the office. The positions regarding relief measures remain

therefore divergent. It also followed from the discussions that, notwithstanding their divergent positions, delegations agree on pursuing the discussion over the matter.

44. For the purpose of future discussion, it has been indicated that, considering that industrial designs share with patents the requirement of novelty and the impossibility of re-filing an application, the approach followed by the PLT should be favored when considering relief measures in the area of industrial designs. Under the PLT, a Contracting Party is obliged under certain circumstances to provide for reinstatement of rights, along with one of the two other types of measure. In contrast, under the Singapore Treaty, reinstatement of rights is just one measure, among others, for which a Contracting Party can opt.

## IX. CONCLUSION

45. The discussions held during the twenty-first session of the SCT, reflected in the report of that session (document SCT/21/8 Prov.) have shed more light on the existing approaches followed by the national and regional systems in the SCT Members in a number of areas of industrial design law and practice. This document summarizes the comments made by SCT Members during that session, and presents revised possible areas of convergence, based on those comments.

46. Possible areas of convergence have been identified regarding the form of reproduction, the views and the number of copies of the reproduction, other contents of the application, division of multiple applications, filing-date requirements, deferment of publication, period of grace for filing in the event of disclosure, and communications.

47. However, the positions appear to remain divergent regarding specimens, certain contents of the application required in some jurisdictions (claim, description and indication of the identity of the creator), the structure of the term of protection, and relief measures.

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

*(i) comment upon the suggested possible areas of convergence;*

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

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

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[Endnote continued from previous page]

\* The text for a possible area of convergence on specimens that was put forward to the twenty-first session of the SCT read as follows:

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