

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

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INDUSTRIAL DESIGN LAW AND PRACTICE-DRAFT PROVISIONS

Document prepared by the Secretariat

INTRODUCTION

1. The Summary by the Chair of the twenty-third session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) concluded that “all delegations attached great importance to the work of the SCT on possible convergences in industrial design law and practice of Member States and that the SCT supported the advancement of that work. To that effect, the Secretariat was requested to prepare a revised working document, for consideration and future work in this area by the SCT at its twenty-fourth session, taking into account the conclusions presented in document SCT/23/5, as well as the comments made by delegations at the twenty-third session of the SCT.”
2. In accordance with the above-mentioned conclusion by the Chair of the twenty-third session of the SCT, the Secretariat has prepared the present working document. The Annex to the document contains draft provisions for industrial design law and practice in the following areas: (a) application, (b) representation of the industrial design, (c) requirement to file the application in the name of the creator, (d) division of application, (e) filing date, (f) grace period for filing in case of disclosure, (g) deferment of publication of the industrial design, (h) communications, (i) initial term of protection and renewal, (j) relief in respect of time limits, (k) reinstatement of rights after a finding by the office of due care or unintentionality, (l) request for recording of a license or a security interest, and (m) request for recording of a change in ownership.

3. The draft provisions on the last two issues, namely “request for recording of a license or a security interest” and “request for recording of a change in ownership,” mirror the corresponding provisions in the Singapore Treaty on the Law of Trademarks (“the Singapore Treaty”) and in the Patent Law Treaty (“PLT”). The inclusion of those draft provisions is intended to initiate the discussion on topics which have not, thus far, been dealt with in detail by the SCT.
4. So far, documents presented to the SCT have centered on a comparison and analysis of industrial design laws and practices in SCT members, as well as on categorizing such laws and practices as areas of convergence or common trends. By proposing draft provisions, the present document attempts to respond to the objective of advancing work on industrial design law and practice, as expressed by the SCT at its twenty-third session.
5. To a large extent, the draft provisions take into consideration the existing areas of convergence and common trends which were identified in document SCT/23/5. It is understood, however, that certain of the draft provisions may not reflect entirely the law and practice of some members. In this regard, it is recalled that it is not the aim of this document to further set out areas of convergence or common trends. Rather, the document intends to propose draft provisions which respond adequately to the goal of simplification of industrial design procedures, for the benefit of users and offices. In this endeavor, due consideration has been given to the positions put forward by all delegations in past sessions of the SCT, as well as the need to strike a balance between the interests of designers and their representatives, offices and third parties.

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

(i) comment upon the draft provisions;

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

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

[Annex follows]

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DRAFT PROVISIONS

Application

- (1) *[Contents of Application; Fee]*
- (a) *It may be required that an application for registration, or for grant of protection, of an industrial design contain some, or all, of the following details:*
- (i) *a request for the registration or grant of protection of the industrial design;*
 - (ii) *the name and address of the applicant;*
 - (iii) *where the applicant has a representative, the name and address of that representative;*
 - (iv) *a representation of the industrial design, as prescribed;*
 - (v) *an indication of the product or products which incorporate the industrial design, or in relation to which the industrial design is to be used;*
 - (vi) *a claim;*
 - (vii) *a statement of novelty;*
 - (viii) *a description;*
 - (ix) *an indication of the identity of the creator of the design;*
 - (x) *the name of a State of which the applicant is a national, the name of a State in which the applicant has his/her domicile, if any, and/or the name of a State in which the applicant has a real and effective industrial or commercial establishment, if any;*
 - (xi) *where the applicant is not the creator of the industrial design and the applicable law requires that the application be filed in the name of the creator, a statement of assignment;*
 - (xii) *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 of priority that may be required pursuant to Article 4 of the Paris Convention;*
 - (xiii) *where the applicant wishes to take advantage of Article 11 of the Paris Convention, a declaration 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, together with indications in support of that declaration;

- (xiv) *where the application includes more than one industrial design, an indication of the number of industrial designs included;*
- (xv) *where the applicant wishes that publication of the industrial design be deferred, a request for deferment or, where applicable, for secret design.*

(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) may be required in respect of the application.*

(3) *[Several industrial designs in the same application] Subject to such conditions as may be prescribed, an application may include two or more industrial designs.*

Notes

- Note 1.01 Paragraph (1) of this provision sets out the contents of an application. It prescribes that, while the applicable law may require some of the elements listed, it may not require further elements. Item (iv) of this paragraph should be read in conjunction with the provision on *Representation of the industrial design*.
- Note 1.02 Paragraph (3) of this provision allows for the possibility of filing what is commonly known as “multiple applications”. This facility is offered in a large number of jurisdictions (76% of the returns to the Questionnaires on Industrial Design Law and Practice, hereinafter “the Questionnaires”, indicate that multiple applications are allowed), as well as under the Geneva Act. It is understood that, in certain jurisdictions, the facility is not offered at present.
- Note 1.03 From the point of view of users, the possibility of filing several industrial designs in the same application provides a clear benefit in terms of simplification.
- Note 1.04 From the point of view of examining offices, there is a need to limit the complexity which may ensue from the examination of several industrial designs in the same application. Such complexity is usually restrained by the prerequisite that all the designs in an application should conform to certain requirements, such as that the industrial designs apply to, or are constituted by, products which belong to the same class of the Locarno International Classification, or that they conform to a condition of unity of design or unity of invention.
- Note 1.05 Paragraph (3) of this provision leaves it to the applicable law to determine the conditions under which more than one industrial design may be included in an application.

Representation of the Industrial Design

- (1) *[Form of representation]* The representation of the industrial design shall, at the option of the applicant, be in the form of graphic or photographic reproductions, either in color or in black and white.
- (2) *[Possible elements of graphic reproductions]* Where the representation of the industrial design is in the form of graphic reproductions, such reproductions may include:
 - (a) dotted or stippled lines, to indicate matter for which protection is not claimed;
 - (b) shading, to show the contours or volume of a three-dimensional design.
- (3) *[Number of copies of reproductions]* No more than one copy of any reproduction of the industrial design may be required where the application is filed electronically, and no more than three copies where the application is filed on paper.
- (4) *[Views]*
 - (a) The industrial design may, at the option of the applicant, be represented by one view that fully discloses the appearance of the industrial design or by several different views that fully disclose the appearance of the industrial design.
 - (b) Notwithstanding subparagraph (a), additional, specific views may be required by the Office, where such views are necessary to fully disclose the industrial design. However, additional views disclosing new matter shall not be admitted.

Notes

- Note 2.01 This provision addresses one of the major concerns for applicants who file in several countries: the difficulty of having to file different sets of reproductions of the industrial design.
- Note 2.02 Paragraphs (1) and (2) contain provisions that would result in greater simplification for applicants, who would have the choice as to the form of reproductions, graphic or photographic, in color or in black and white, and would be guaranteed the acceptability of their choice in other jurisdictions.
- Note 2.03 The position concerning the choice between graphic and photographic reproductions is largely justified by developments in reproduction technology in the past years. Presently, high-quality photographic reproductions, in color or in black and white, may be obtained easily and are capable of representing clearly the industrial design.
- Note 2.04 Paragraph (3). Arguably, applications that are filed electronically do not require more than one copy of the reproduction, or reproductions, as the case may be. With regard to applications filed on paper, discussions in the SCT have revealed that, while receiving more than one copy could sometimes facilitate the

processes for offices, there was rarely any practical need for offices to receive nowadays more than three copies. As for applicants, limiting the number of copies of each reproduction in an application filed on paper would result in an advantage in terms of simplification at the time of preparing the application.

- Note 2.05 Paragraph (4). It is generally agreed that the reproductions of the industrial design should completely disclose the appearance of the claimed design, and that several views of the design may be needed to that end, particularly where the industrial design is three-dimensional.
- Note 2.06 Paragraph (4) of this provision leaves it to the applicant to determine, on a case by case basis, the number and types of views which are needed to fully disclose the industrial design. Thus, applicants would no longer need to vary the number of views to satisfy the requirements of the different jurisdictions in which they file.
- Note 2.07 At the same time, this provision enables offices to call for further views where they consider that such views are needed to adequately disclose the industrial design. This would present an advantage for offices, as they would not have to automatically examine views which, in some cases, may be considered to be superfluous.

Requirement to File the Application in the Name of the Creator

[Formality where there is a requirement to file the application in the name of the creator] Where there is a requirement to file the application in the name of the creator, such requirement shall be satisfied if:

- (i) the name of the creator is indicated on the application form and, where applicable;*
- (ii) a statement of assignment from the creator to the applicant, pre-printed on the application form, is made by the applicant, in the signing of the form.*

Notes

- Note 3.01 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 3.02 This provision aims at avoiding the need to supplement the application with transfer documents, where the applicant is not the creator. Instead, it would be sufficient for the applicant to declare, in the application, that the design has been assigned by the creator, as identified in the application form. The signing of the application form by the applicant, containing a pre-printed statement of assignment, will effect such a declaration.

- Note 3.03 In case the applicable law provides for the filing of applications in electronic form (“e-filing”) the signature requirement under item (ii) would have to conform to the generally applicable requirements for communications (see in general the draft provision on communications).
- Note 3.04 From the point of view of offices, this would have the positive effect of a reduction of the number of documents accompanying the application.

Division of Application

- (1) *[Division of application] Any application which includes two or more industrial designs (hereinafter referred to as “initial application”) may be divided by the applicant into two or more applications (hereinafter referred to as “divisional applications”) 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 any.*
- (3) *[Fees] The division of an application may be subject to the payment of fees.*

Notes

- Note 4.01 The aim of this provision is to enable an applicant who seeks protection for several industrial designs in a single application, to request the division of the application, and maintain the date of the original filing in the applications resulting from the division.
- Note 4.02 A division would be typically requested by the applicant where the Office raises the objection that some of the designs included in the application do not comply with the prescribed conditions, for example the same Locarno class or the unity of design requirement, for inclusion in a single application.

Filing Date

- (1) *[Filing-date requirements]*
 - (a) *Subject to subparagraph (b), the filing date of an application shall be the date on which the Office receives all of 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 its representative, if any, to be contacted.*

- (b) *The filing date of an application may be the date on which the Office receives some only, rather than all, of the indications and elements referred to in subparagraph (a), or receives them in a language other than a language admitted by the Office.*
- (2) *[Prohibition of other requirements] No indication or element other than those referred to in paragraph (1)(a) may be required for the purpose of according a filing date to an application.*
- (3) *[Correction and time limits] If the application does not, at the time of its receipt by the Office, comply with any of the applicable requirements of paragraph (1), the Office shall invite the applicant to comply with such requirements within a time limit indicated in the invitation. Such time limit shall be:*
- (a) *at least one month from the date of the invitation, where the applicant's address is in the territory of the jurisdiction in which the application was filed;*
- (b) *at least two months from the date of the invitation, where the applicant's address is outside the territory of the jurisdiction in which the application was filed.*
- (4) *[Filing date in case of correction] If, within the time limit indicated in the invitation referred to in paragraph (3), the applicant complies with such invitation, the filing date shall be the date on which all the required indications and elements referred to in paragraph (1)(a) are received by the Office. Otherwise, the application shall be treated as if it had not been filed.*

Notes

- Note 5.01 In the field of industrial designs, postponement of the filing date may result in a definitive loss of rights. It is therefore important that the list of filing-date requirements be kept to the minimum. Those requirements should be of such significance that, without them, it would not be possible for an Office to consider that there is an application for registration or for grant of protection of an industrial design.
- Note 5.02 Paragraph (1) sets out the list of requirements for the purpose of assigning a filing date. Paragraph (2) makes it clear that the list provided for in paragraph (1) 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 affecting the filing date.
- Note 5.03 Paragraph (3) 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. It would appear that the vast majority of jurisdictions (over 75% of those which replied to the Questionnaires) afford a time limit to the applicant to comply with a missing filing-date requirement.

- Note 5.04 Paragraph (3)(a) provides for a minimum time limit of one month to complete the application, where the applicant's address is in the territory of the jurisdiction in which the application was filed. This time limit, which may seem short at first glance, takes into account the importance of the missing element, along with recent developments in communications, which allow for a rapid response to irregularities.
- Note 5.05 Paragraph (3)(b) provides for a minimum time limit of two months to complete the application, where the applicant's address is not in the territory of the jurisdiction in which the application was filed. This longer time limit is justified by the fact that applicants filing from abroad must usually do so through a local representative. Communication through a representative may add to the time required to an applicant to correct an irregularity.

Grace Period for Filing in Case of Disclosure

- (1) *[Disclosure made by the creator, his/her successor in title or an authorized third party] Any disclosure of the industrial design made by the creator, his/her successor in title or an authorized party within 12 months prior to 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.*
- (2) *[Disclosure made by unauthorized party] The applicable law may provide that a disclosure of the industrial design made by a party without the authorization of the creator or his/her successor in title within 12 months prior to 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.*

Notes

- Note 6.01 It is understood that, while most jurisdictions provide for a grace period to file further to a disclosure, some do not, and that, 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 his/her industrial design abroad.
- Note 6.02 Therefore, this provision establishes a grace period to file in case of disclosure within a period of 12 months prior to the date of filing of the application or the priority date, if any. This period has been opted for, as this is the period provided for by the majority of jurisdictions.
- Note 6.03 A distinction is made in paragraphs (1) and (2) from the point of view of the author of the disclosure. Paragraph (1) establishes the obligation to provide for a 12-month grace period in case of disclosure made by the creator, his/her successor in title or an authorized third party. Paragraph (2) provides for the possibility of a 12-month grace period in case of disclosure made by a third party without the authorization of the creator or his/her successor in title.

Deferment of Publication of the Industrial Design

Where the applicable law provides for registration or grant of protection of the industrial design without prior examination as to novelty or originality, as the case may be, the Office shall accept a request made by the applicant for maintaining the industrial design unpublished up to a maximum prescribed period, which shall be not less than six months.

Notes

- Note 7.01 The ability for the applicant to request the postponement of publication is of particular interest in those jurisdictions in which protection of the design is granted without a novelty and/or originality 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. By deferring publication, the applicant is able to maintain the design secret until the first release of the product, while securing legal protection, albeit limited protection, during the deferment period, as from an earlier date.
- Note 7.02 In contrast, the interest for an applicant to request the postponement of publication is less evident in those countries in which registration or grant of protection takes place after novelty and/or originality examination. In those countries, the pendency period for an application is likely to be longer, and publication is therefore generally deferred *de facto*.
- Note 7.03 In most jurisdictions in which the Office does not carry out a novelty and/or originality examination, applicants are given the possibility of maintaining an industrial design unpublished for a period of at least six months from the filing date. This provision effectively confers the same entitlement on the applicant.

Communications

- (1) *[Means of transmittal and form of communications] An Office 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) *An Office may require that any communication be in a language admitted by the Office.*
 - (b) *Where it is not required that a communication be in a language admitted by the Office, the Office may require that 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 attestation, notarization, authentication, legalization or other certification of any translation of a communication may be required, except in specific cases.*

- (3) *[Signature of Communications on Paper]*
- (a) *An Office may require that a communication on paper be signed by the applicant, holder or other interested person.*
 - (b) *Where it is required that a communication on paper be signed, the Office:*
 - (i) *shall accept a handwritten signature;*
 - (ii) *may permit, instead of a handwritten signature, the use of other forms of signature, such as a printed or stamped signature, or the use of a seal or of a bar-coded label;*
 - (iii) *may, where the natural person who signs the communication is a national of the country concerned and such person's address is in its territory, or where the legal entity on behalf of which the communication is signed is organized under its law and has either a domicile or a real and effective industrial or commercial establishment in its territory, require that a seal be used instead of a handwritten signature.*
 - (c) *No attestation, notarization, authentication, legalization or other certification of any signature may be required, except in individual, specified cases.*
 - (d) *Notwithstanding subparagraph (c), an Office may require that evidence be filed with it as to the authenticity of any signature of a communication on paper, where it may reasonably doubt such authenticity.*
- (4) *[Authentication of Communications in Electronic Form] Where the applicable law permits the filing of communications in electronic form, the Office may require that any such communication be authenticated through a prescribed system of electronic authentication.*

Notes

- Note 8.01 The aim of this provision is to simplify the procedures regarding communications, for the benefit of both users and offices. The provision is largely based on the corresponding provision of the Singapore Treaty, the responses to the Questionnaires and the discussions held in previous sessions of the SCT.
- Note 8.02 Under paragraph (1), an Office may choose the means of transmittal of communications and the form of the communications that it accepts.
- Note 8.03 Paragraph (2) deals with the language of communications. An Office may require either that a communication be in a language admitted by it, or that a translation into that language be provided. In the latter case, however, no attestation, notarization, authentication, legalization or other certification of the translation may be required, except in specific cases to be determined. For

example, under the Singapore Treaty, in the framework of the recording of a change in the ownership of a registration, certification of the translation of the contract or of an extract of the contract showing the change in ownership may be required.

Note 8.04 Paragraph (3) deals with the signature of communications on paper. It takes into account the requirement in certain jurisdictions whereby communications on paper must be signed by using a seal, instead of a handwritten signature.

Note 8.05 Consistent with the aim of simplification, paragraph (3) also provides that no attestation, notarization, authentication, legalization or other certification of any signature may be required, except in individual, specified cases to be determined. An example of such case could be the surrender of a registration. To balance the absence of certification of any signature, the paragraph further provides for the possibility for an Office to require evidence of the authenticity of a signature.

Initial Term of Protection and Renewal

- (1) *[Initial Term of Protection] The initial term of protection for an industrial design shall be five years.*
- (2) *[Renewal for additional terms] The initial term of protection may be renewed for additional terms of five years, up to the maximum period prescribed by the applicable law.*
- (3) *[Indications or elements contained in, or accompanying, a request for renewal; Fee]*
 - (a) *It may be required that the renewal of the term of protection 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 of the registration or, where applicable, the patent concerned;*
 - (iv) *where it is permitted that renewal be made for some only of the industrial designs contained in the registration or, where applicable, the patent, and such a renewal is requested, an indication of the industrial design number(s) for which the renewal is, or is not, requested;*
 - (v) *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) *In respect of the renewal, the Office may require the payment of a fee.*

- (4) *[Period for presentation of the request for renewal and payment of the fee]*
- (a) *It may be required that any request for renewal be presented, and any renewal fee be paid, to the Office within a period which shall be no less than the period prescribed in subparagraph (b).*
- (b) *The period during which any request for renewal may be presented, and any renewal fee may be paid, shall commence at least six months before the date on which the renewal is due and shall end, at the earliest, six months after that date. If the request for renewal is presented or the fees are paid after the date on which the renewal is due, the acceptance of the request for renewal and the payment of the fee may be subject to the payment of a surcharge.*

Notes

- Note 9.01 Users of design protection systems have indicated that more homogeneous structures of the period of protection for designs would result in greater simplification and benefit for them. The needs of designers regarding the duration of protection of their designs depend on the type of product embodying the design. While designs embodied in products with long-life cycles may need to be protected for a longer period, those associated with certain short-lived products may not require very long protection. As regards the latter types of design, and for the sake of striking a balance between the interests of design owners and the interests of third parties, it is desirable that protection should not extend beyond the period for which it is useful to owners.
- Note 9.02 This provision does not concern the duration of the protection of an industrial design, but the *structure* of renewable terms of protection. It provides for the division of the overall term of protection into separate five-year terms. This structure is followed by the majority of jurisdictions. Moreover, such structure enables holders to elect for shorter or longer terms of protection, depending on their actual needs.
- Note 9.03 Regarding the choice of five-year terms, as opposed to one or two-year terms, five years would appear to be a reasonable period, short enough to attain the objective referred to in the preceding notes, and long enough to avoid the administrative burden that would be put on both offices and holders if the terms of protection were shorter.
- Note 9.04 Paragraph (3) provides that renewal of the protection may be subject to the filing of a request for renewal and/or the payment of a fee.
- Note 9.05 Paragraph (4) concerns the period within which any renewal fee must be paid and any request for renewal that may be required must be submitted. It establishes, in particular, a period of grace of at least six months after the date on which the renewal is due, to pay the fee and to submit the request for renewal, which may be subject to the payment of a surcharge. A grace period for the payment of fees for the maintenance of rights is already provided for in Article 5*bis* of the Paris Convention for the Protection of Industrial Property. The interest of this provision is that it also provides for a grace period for submitting any request for renewal that may be required.

Relief in Respect of Time Limits

- (1) *[Extension of Time Limits] The applicable law may provide for the extension of a time limit fixed by the Office for an action in a procedure before the Office in respect of an application, a registration or, where applicable, a patent, if a request to that effect is filed with the Office in accordance with the prescribed requirements, and the request is filed:*
 - (a) *prior to the expiry of the time limit; or*
 - (b) *after the expiration of the time limit, and within a prescribed time limit.*

- (2) *[Continued Processing] Where an applicant or holder has failed to comply with a time limit fixed by the Office for an action in a procedure before the Office in respect of an application, a registration or, where applicable, a patent, and the applicable law does not provide for the extension of a time limit under paragraph (1)(b), the applicable law shall provide for continued processing with respect to the application, registration or patent and, if necessary, reinstatement of the rights of the applicant or holder with respect to that application, registration or patent, if:*
 - (a) *a request to that effect is made to the Office in accordance with the prescribed requirements;*
 - (b) *all of the requirements in respect of which the time limit for the said action had applied, are complied with, within the prescribed time limit.*

- (3) *[Exceptions] There shall be no requirement to provide for the extension of time limits under paragraph (1) or continued processing under paragraph (2) in the following cases of failure of an applicant or holder to comply with a time limit fixed by the Office:*
 - (a) *filing a request for a relief measure under paragraphs (1) or (2);*
 - (b) *payment of a renewal fee;*
 - (c) *an action before a board of appeal or other review body constituted in the framework of the Office;*
 - (d) *an action in inter partes proceedings;*
 - (e) *the correction or addition of a priority claim;*
 - (f) *where a relief measure has already been granted under paragraphs (1) or (2);*

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

- (1) *[Reinstatement of Rights After a Finding by the Office of Due Care or Unintentionality]* The applicable law shall provide that, where an applicant or owner 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, a registration or, where applicable, a patent, the Office shall reinstate the rights of the applicant or owner with respect to that application, registration or patent, if:
- (a) a request to that effect is made to the Office in accordance with the prescribed requirements;
 - (b) the request is filed, and all of the requirements in respect of which the time limit for the said action had applied are complied with, within the prescribed time limit;
 - (c) the request states the reasons for the failure to comply with the time limit; and
 - (d) 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 that any delay was unintentional.
- (2) *[Exceptions]* There shall be no requirement to provide for the reinstatement of rights under paragraph (1) in the following cases of failure of an applicant or owner to comply with a time limit fixed by the Office:
- (a) the filing of a request for relief or a request for reinstatement;
 - (b) an action before a board of appeal or other review body constituted in the framework of the Office;
 - (c) an action in *inter partes* proceedings;
 - (d) the correction or addition of a priority claim.

Notes

- Note 10.01 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 10.02 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 is irretrievable.

- Note 10.03 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 10.04 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 10.05 In addition, a Contracting Party is obliged to provide for reinstatement of rights in case of failure of the applicant or owner to comply with a time limit entailing a loss of rights, where the office concerned finds that such failure occurred in spite of due care required by the circumstances having been taken or was unintentional.
- Note 10.06 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 10.07 Exceptions to the applicability of relief measures and reinstatement of rights are provided for in paragraph (3) of the provision on *Relief In Respect of Time Limits* and in paragraph (2) of the provision on *Reinstatement of Rights After a Finding by the Office of Due Care or Unintentionality*, respectively. 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.

Request for Recording of a License or a Security Interest

- (1) *[Requirements Concerning the Request for Recording of a License] Where the applicable law provides for the recording of a license, it may require that the request for recording contain some or all of the following indications or elements:*
- (i) the name and address of the holder;*
 - (ii) where the holder has a representative, the name and address of that representative;*
 - (iii) the name and address of the licensee;*
 - (iv) where the licensee has a representative, the name and address of that representative;*

- (v) *the name of a State of which the licensee is a national, the name of a State in which the licensee has his/her domicile, if any, and/or the name of a State in which the licensee has a real and effective industrial or commercial establishment, if any;*
 - (vi) *the number of the registration or where applicable, the patent which is the subject of the license;*
 - (vii) *where the license is not granted in respect of all the industrial designs contained in a registration or patent, the industrial design number(s) for which the license is granted;*
 - (viii) *an indication as to whether the license is an exclusive license, a non-exclusive license or a sole license;*
 - (ix) *where applicable, that the license concerns only a part of the territory covered by the registration or patent, together with an explicit indication of that part of the territory;*
 - (x) *the duration of the license.*
- (2) *[Requirements Concerning Supporting Documents for Recording of a License] Where the applicable law provides for the recording of a license, it may require that the request for recording be accompanied, at the option of the requesting party, by one of the following supporting documents:*
- (i) *an extract of the license contract indicating the parties and the rights being licensed, which extract may be required to be certified by a notary public or any other competent authority or, where permitted under the applicable law, by a representative having the right to practice before the Office, as being a true extract of the contract; or*
 - (ii) *an uncertified statement of license, signed by both the holder and the licensee.*
- (3) *[Fees] In respect of the recording of a license, the Office may require the payment of a fee.*
- (4) *[Single Request] A single request shall be sufficient even where the license relates to more than one registration or patent, provided that the registration or patent numbers of all registrations or patents concerned are indicated in the request, the holder and the licensee are the same for all registrations or patents, and the request indicates the scope of the license with respect to all registrations or patents.*
- (5) *[Prohibition of Other Requirements] No requirement other than those referred to in paragraphs (1) to (4) may be demanded in respect of the recording of a license. In particular, the following may not be required:*
- (a) *the furnishing of the registration or patent certificate of the industrial design which is the subject of the license;*

- (b) *the furnishing of the license contract or a translation of it;*
- (c) *an indication of the financial terms of the license contract.*
- (6) *[Evidence] It may be required that evidence be furnished to the Office where the Office reasonably doubts the veracity of any indication contained in the request or in any supporting document.*
- (7) *[Request for Recording of a Security Interest] Paragraphs (1) to (6) shall apply mutatis mutandis to requests for the recording of a security interest in respect of an industrial design registration or patent.*

Notes

- Note 13.01 With respect to industrial designs, the recording of licenses is provided for in the majority of jurisdictions (88% of the returns to the Questionnaires indicate that the applicable law provides for the recording of licenses). Simplifying and harmonizing the formal requirements for the recording of industrial design licenses would therefore appear to be of merit. This is reinforced by the fact that neither The Hague nor the Geneva Acts of the Hague Agreement Concerning the International Registration of Industrial Designs provides for the recording of licenses in the International Register.
- Note 13.02 This provision is based on the provisions on the recording of licenses of the Singapore Treaty.
- Note 13.03 It follows from the introductory words of paragraphs (1) and (2) that there is no obligation to provide for the recording of licenses. However, where the applicable law provides for such recording, no indication or element other than those listed in paragraph (1) may be required. Similarly, it may not be required that any other document than those listed in paragraph (2) be submitted.
- Note 13.04 Paragraph (7), concerning a request for the recording of a security interest, is based on Rule 17(9) of the PLT. As in the case of recording of a license under paragraph (1), there is no obligation to provide for the recording of a security interest.

Request for Recording of a Change in Ownership

- (1) *[Requirements Concerning the Request for Recording]*
 - (a) *Where there is a change of the owner, the applicable law shall accept that a request for the recording of the change be made by the holder or by the new owner.*
 - (b) *The applicable law may require that the request contain some or all of the following indications:*
 - (i) *an indication to the effect that a recording of a change in ownership is requested;*
 - (ii) *the name and address of the holder;*

- (iii) *the name and address of the new owner;*
 - (iv) *the date of the change in the person of the owner;*
 - (v) *the name of a State of which the new owner is a national, the name of a State in which the new owner has his/her domicile, if any, and the name of a State in which the new owner has a real and effective industrial or commercial establishment, if any;*
 - (vi) *where the holder has a representative, the name and address of that representative;*
 - (vii) *where the new owner has a representative, the name and address of that representative;*
 - (viii) *where the new owner is required to have an address for service, such address.*
 - (ix) *the basis for the change requested.*
- (2) *[Requirements Concerning Supporting Documents for Recording of a Change in Ownership]*
- (a) *Where the change in ownership results from a contract, the applicable law may require that the request be accompanied, at the option of the requesting party, by one of the following:*
 - (i) *a copy of the contract, which may be required to be certified by a notary public or any other competent authority, as being in conformity with the original contract;*
 - (ii) *an extract of the contract showing the change in ownership, which may be required to be certified by a notary public or any other competent authority, as being a true extract of the contract;*
 - (iii) *an uncertified certificate of transfer signed by both the holder and the new owner;*
 - (iv) *an uncertified transfer document signed by both the holder and the new owner.*
 - (b) *Where the change in ownership results from a merger, the applicable law may require that the request be accompanied by a copy of a document, which originates from the 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 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, the applicable law 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, the applicable law 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 authority.*
- (3) *[Fee] The Office may require the payment of a fee in respect of the request.*
- (4) *[Single request] A single request shall be sufficient even where the change relates to more than one registration or patent, provided that the holder and the new owner are the same for each registration or patent, and that the numbers of all registrations or patents concerned are indicated in the request.*
- (5) *[Prohibition of Other Requirements] No requirement other than those referred to in paragraphs (1) to (4) may be demanded in respect of a request for the recording of a change in ownership.*
- (6) *[Evidence] It may be required 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 provision.*

Note

- Note 14.01 This provision is based on the provisions on the recording of a change in ownership in the Singapore Treaty and the PLT.

[End of Annex and of document]