

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

**Twenty-Fifth Session**  
**Geneva, March 28 to April 1, 2011**

### **INDUSTRIAL DESIGN LAW AND PRACTICE-DRAFT PROVISIONS**

*Document prepared by the Secretariat*

#### **INTRODUCTION**

1. From its twenty-first session through to its twenty-third session, the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) considered possible areas of convergence in industrial design law and practice in Member States, on the basis of a number of working documents (documents SCT/21/4, SCT/22/6 and SCT/23/5). Those documents were based on the results of a broad survey conducted among Members of the SCT, with the help of two questionnaires (documents SCT/18/7 and SCT/18/8 Rev.). The replies to the questionnaires were compiled in document WIPO/STrad/INF/2 Rev.1, and an analysis of those replies was provided in document SCT/19/6.
2. At its twenty-fourth session, held in Geneva from November 1 to 4, 2010, the SCT examined draft provisions concerning industrial design law and practice (document SCT/24/3). The Chair of the session concluded that “all delegations supported the advancement of the work of the SCT on industrial design law and practice and that the twenty-fourth session made significant progress in that regard. He noted that the Secretariat was requested to prepare a revised text for consideration at the next session of the SCT, which would take into consideration all comments made at the current session and which should present provisions on two levels, namely one general level setting out provisions of a broader and general nature, and a second subordinate level of provisions addressing in detail specific aspects of the general provisions. Moreover, the revised text should address certain horizontal issues that were not dealt with in the

present text, such as definitions, representation before the Office, communications in general and electronic communications. As to the continuation of the work, he noted that a number of delegations called for the convening of a diplomatic conference for the adoption of a treaty on industrial design registration formalities in the next biennium 2012-2013, while other delegations were of the view that further discussions were needed on the revised text before considering the convening of a diplomatic conference. The Chair concluded that, on the basis of the revised text, the next session of the SCT should be in a position to decide its future work concerning that aspect.”

3. Pursuant to the request of the SCT, the Secretariat has prepared the present document, with an Annex structured in draft Articles, containing provisions of a general nature, and draft Regulations, which further elaborate upon a number of the draft Articles.
4. The two-level structure followed in the document is intended to facilitate the analysis of the issues under consideration and to establish a dynamic and flexible framework for the subsequent development of design law, so as to keep pace with future technological, socio-economic and cultural changes.
5. The Annex to the document contains the following horizontal provisions, as requested by the SCT: (a) abbreviated expressions, (b) applications and industrial designs to which the draft provisions apply, (c) representation, address for service or address for correspondence, and (d) communications.
6. In order to facilitate the work on these draft provisions, the term “Party” is used throughout the document to indicate any State or intergovernmental organization that may apply the draft provisions. The use of this term, however, should not be seen as prejudging the potential format of any future outcome of the work of the SCT on design law and practice.
7. This document takes into account the comments that were made, and the suggestions that were put forward, by delegations at the twenty-fourth session of the SCT. However, the draft provisions inevitably cannot reflect the law and practice of all SCT Members. The document endeavors to propose draft provisions which respond to the goal of simplification and unification of industrial design procedures. Without losing sight of that goal, the document further endeavors to take into account the different needs and interests of countries, by including flexibilities such as those provided for in draft Articles 3(3) (conditions for so-called “multiple applications”), 6 (requirement to file the application in the name of the creator), 8(1) (maximum period for maintaining an industrial design unpublished), 9(1)(a) (requirements for representation before the office), and (3) (requirement of address for service or address for correspondence), and 10(1) (means of transmittal and form of communications). Finally, due consideration is given to the need to strike a balance between the rights and interests of designers and their representatives, on the one hand, and the interests of the general public, on the other.

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

*(i) comment upon the draft Articles and draft Regulations;*

*(ii) review the draft Articles and draft Regulations, amend them, add further draft Articles or draft Rules, 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 ARTICLES

**Article 1**  
**Abbreviated Expressions**

*For the purposes of these draft Articles, unless expressly stated otherwise:*

- (i) *“application” means an application for the registration of an industrial design or an application for the grant of a patent for an industrial design;*
- (ii) *“registration” means the registration of an industrial design, or the grant of a patent for an industrial design, by an Office;*
- (iii) *“Office” means the agency of a Party entrusted with the registration of industrial designs;*
- (iv) *“Party” means any State or intergovernmental organization that applies these Draft Provisions;*
- (v) *“applicable law” means, where the Party is a State, the law of that State and, where the Party is an intergovernmental organization, the legal enactments under which that intergovernmental organization operates;*
- (vi) *references to a “person” shall be construed as references to both natural person and a legal entity;*
- (vii) *references to “industrial design” shall be construed as references to “industrial designs”, where the application includes two or more industrial designs;*
- (viii) *“holder” means the person shown by the register of industrial designs as the holder of the registration;*
- (ix) *“register of industrial designs” means the collection of data maintained by an Office, which includes the contents of all registrations and all data recorded in respect of all registrations, irrespective of the medium in which such data are stored;*
- (x) *“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;*
- (xi) *“procedure before the Office” means any procedure in proceedings before the Office with respect to an application or registration;*
- (xii) *“Regulations” means the second level of provisions subordinate to the Draft Articles, as referred to in Article 19;*
- (xiii) *“Paris Convention” means the Paris Convention for the Protection of Industrial Property, signed on March 20, 1883, as revised and amended;*
- (xiv) *“Locarno Classification” means the classification established by the Locarno Agreement Establishing an International Classification for Industrial Designs, signed at Locarno on October 8, 1968, as revised and amended.*

### Notes on Article 1

- Note 1.01 *Items (i) and (ii).* 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 *Item (x).* The term “communication” covers, *inter alia*, any document which is filed with the Office, relating to an application or a registration, including powers of attorney.

### **Article 2**

#### ***Applications and Industrial Designs to Which these Draft Articles and the Draft Regulations Apply***

- (1) *[Applications]* These draft Articles and the draft Regulations shall apply to national and regional applications for industrial design, which are filed with, or for, the Office of a Party, and to divisional applications thereof.
- (2) *[Industrial Designs]* These draft Articles and the draft Regulations shall apply to industrial designs that can be registered as industrial designs under the applicable law.

### Notes on Article 2

- Note 2.01 *Paragraph (1).* These draft provisions would apply to national applications for industrial design which are filed with the Office of a State, as well as to applications for industrial design, 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 Office for Harmonization in the Internal Market (OHIM), which registers designs that are valid in all 27 countries of the European Union, the African Intellectual Property Organization (OAPI), which registers designs with effect in the 16 States members of the Bangui Agreement, and the Benelux Office for Intellectual Property (BOIP), which registers designs in the Benelux.
- Note 2.02 *Paragraph (2).* These draft provisions do not contain a definition of industrial design. They would apply to any industrial design that can be registered as an industrial design under the applicable law.

### **Article 3** ***Application***

- (1) *[Contents of Application; Fee]* (a) A Party may require that an application contain some, or all, of the following indications or elements:
- (i) a request for the registration 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) where an address for service or an address for correspondence is required, such address;

- (v) *a representation of the industrial design, as prescribed in the Regulations;*
  - (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 is domiciled, 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 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 applicant wishes to maintain the industrial design unpublished for a period of time, a request to that effect;*
  - (xv) *any further requirement prescribed in the Regulations.*
- (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 two or more industrial designs.*
  - (4) *[Evidence] Any 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 *Paragraph (1)* sets out the maximum contents of an application that may be required by a Party. It also prescribes that a Party may require some only, rather than all, of the elements listed. For instance, no claim would be required by a Party that protects industrial designs under a registration system, as opposed to a system of protection under patent law.
- Note 3.02 *Paragraph (1)(a)(v)*. Details concerning the representation of industrial designs are prescribed in Rule 2. 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 3.03 *Paragraph (1)(a)(vi)*. This item refers to claims, in the sense of patent law. A claim under this item could be required by a Party in which industrial designs are protected under patent law.
- Note 3.04 *Paragraph (2)*. Paragraph (1) contains an exhaustive list of elements or indications that may be required in an application. Paragraph (2) makes it clear that no further element may be required by a Party in an application, except those elements that may be required under Article 10 (“Communications”). Under that article, for instance, a Party may require that the application be signed by the applicant, where it is a paper application.
- Note 3.05 *Paragraph (3)*. This paragraph sets out the principle that applications including more than one industrial design, so-called “multiple application”, may be filed by an applicant. However, acceptance of such applications by a Party may be subject to certain conditions prescribed in its law. For example, a Party may accept 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. Where an applicant files a multiple application, but the application does not conform to the conditions concerning multiple applications, prescribed in the Party’s law, the Party will be able to request the applicant to divide the application under Article 7.

### **Article 4** **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 the applicant’s 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) *[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 (1), the Office shall notify the applicant and give the opportunity to comply with such requirements within the time limit prescribed in the Regulations.
- (4) *[Filing date in case of Subsequent Compliance with Requirements]* If, within the time limit referred to in paragraph (3), the applicant complies with the applicable requirements, the filing date shall be the date on which all the requirements applied by the Party under paragraph (1) are received by the Office. Otherwise, the application shall be treated as if it had not been filed.

#### Notes on Article 4

- Note 4.01 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 know “who” filed “what.”
- Note 4.02 *Paragraph (1)(a)* sets out the requirements that may be established by a Party for the purpose of assigning a filing date. It is made clear in the provision that a Party may require that the application be filed in a language admitted by the Office, in order to be given 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 4.03 Consistent with the underlying rationale of this article, as explained in Note 4.01, the payment of fees has not been included in the list of filing-date requirements. When an Office receives an application for which the fees have not been paid on the date of receipt of the application, it may decide not to further examine the application until the fees have been paid. If the fees are paid within the applicable time limit, nothing would however appear to prevent the Office from according the application an earlier filing date. In other words, an Office could dissociate the payment of the fees from the grant of a filing date.
- Note 4.04 *Paragraph (1)(b)* gives the possibility to a Party to accord a filing date where some only of the requirements listed in subparagraph (a) are complied with.
- Note 4.05 *Paragraph (2)* makes it clear that the list provided for in paragraph (1)(a) 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 having been affected.
- Note 4.06 *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. The time limit is prescribed in the Regulations, so as to facilitate any change that may be justified in the future.

**Article 5**  
**Grace Period for Filing in Case of Disclosure**

*[Disclosure giving rise to a Grace Period for Filing] A disclosure of the industrial design during the period of 12 months immediately 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:*

- (a) by the creator or his/her successor in title;*
- (b) by a person informed of the industrial design, and authorized to disclose it, by the creator or his/her successor in title;*
- (c) as a result of an abuse in relation to the creator or his/her successor in title.*

Notes on Article 5

Note 5.01 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.

Note 5.02 This provision establishes a grace period to file in case of disclosure made by the creator or his/her successor in title, or by another person who has had access to the industrial design as a result of information provided by the creator or his/her successor in title, and who has been authorized to disclose the design. Furthermore, the provision established a grace period to file in case of a disclosure made as a result of an abuse in relation to the creator or his/her successor in title. An example of abusive disclosure could be a disclosure made without the authorization of the creator, or his successor in title, by a person who had been informed of the industrial design under conditions of confidentiality.

**Article 6**  
**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 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 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, on the application form, and:
  - (a) that name corresponds to the name of the applicant, or*
  - (b) 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 6

- Note.6.01 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 6.02 *Paragraph (2)*. This provision aims at simplifying the procedure 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 on the application form. In order to safeguard the rights of creators, the statement of assignment must, in any event, be signed by the creator.

### **Article 7** **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] (a) The division of an application may be subject to the payment of fees.*
- (b) The sum of the fees due for the initial and divisional applications shall not exceed the sum of the fees due for an equivalent number of separate applications.*

### Notes on Article 7

- Note 7.01 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 7.02 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.
- Note 7.03 *Paragraph (3)(b)*. This provision was included following the twenty-fourth session of the SCT.

**Article 8**  
**Publication of the Industrial Design**

- (1) *[Request to maintain the Industrial Design unpublished] Upon request by the applicant, a Party shall maintain the industrial design unpublished for a maximum period fixed by its applicable law, subject to the minimum period prescribed in the Regulations.*
- (2) *[Fee] In respect of a request for maintaining the industrial design unpublished, the Office may require the payment of a fee.*

Notes on Article 8

- Note 8.01 This provision has been re-drafted following the twenty-fourth session of the SCT. Instead of addressing the issue of deferment of publication *per se*, the provision now deals with publication of the industrial design in general, including the possibility for an applicant to maintain the industrial design unpublished.
- Note 8.02 Under this article, applicable to all Parties, irrespective of their system of examination, a Party would have to maintain an industrial design unpublished during a certain period, upon request by the applicant. However, the article does not provide for a specific system under which the design would have to be maintained unpublished. Thus, a Party may comply with this article by implementing, for example, a system of deferment of publication, a secret design system, or a system based on request for delayed registration.
- Note 8.03 The provision leaves it to each Party to determine the maximum period during which an industrial design may be maintained unpublished. However, a minimum period is prescribed in the Regulations.

**Article 9**  
**Representation; Address for Service or Address for Correspondence**

- (1) *[Representatives Admitted to Practice] (a) A 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 Party.*

(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 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 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 be represented by a representative.*
- (3) *[Address for Service or Address for Correspondence] A 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, have an address for service, or an address for correspondence, in that territory.*

- (4) *[Appointment of a Representative] A 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 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 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 Party under paragraphs (1) to (4) is or are not complied with within the time limit prescribed in the Regulations, the Party may apply such sanction as is provided for in its law.*

#### Notes on Article 9

- Note 9.01 This Article is modeled, to a large extent, on Article 7 of the Patent Law Treaty (hereinafter “the PLT”) and Article 4 of the Singapore Treaty on the Law of Trademarks (hereinafter “the Singapore Treaty”).
- Note 9.02 *Paragraph (1)(a).* Item (i) of this paragraph permits a 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 Party to have a less strict requirement.
- Note 9.03 *Paragraph (1)(a).* A Party may apply the requirement under item (ii) of this subparagraph instead of, or in addition to, the requirement that the appointed representative have the right to practice before the Office, under item (i). A Party may, in particular, require that the address be in its own territory.
- Note 9.04 *Paragraph (2).* This provision permits, but does not oblige, a Party to require representation for the purposes of any procedure before the Office. The ability for a Party to require representation is 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 Party.
- Note 9.05 *Paragraph (3).* A Party may, instead of requiring 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 Party concerned. This requirement is viewed as less stringent than the appointment of a representative.

**Article 10**  
**Communications**

- (1) *[Means of Transmittal and Form of Communications]* A 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 Party may require that any communication be in a language admitted by the Office.  
  
(b) No attestation, notarization, authentication, legalization or other certification of any translation of a communication may be required, except in those cases prescribed in these Draft Provisions.
- (3) *[Address for Correspondence, Address for Service and Contact Details]* A 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 Party may require that a communication on paper be signed by the applicant, holder or other interested person. Where a Party requires a communication on paper to be signed, that Party shall accept any signature that complies with the requirements prescribed in the Regulations  
  
(b) No Party may require the attestation, notarization, authentication, legalization or other certification of any signature, except in those cases prescribed in the Regulations.  
  
(c) Notwithstanding subparagraph (b), any 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 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 Party may demand that, in respect of paragraphs (1) to (5), requirements other than those referred to in this Article be complied with.
- (7) *[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. An Office may require that any communication be in a language admitted by it. It follows that communications or parts of communications, in particular documents, which are not in a language admitted by the Office, must be filed in translated form. In that case, however, no attestation, notarization, authentication, legalization or other certification of the translation may be required, except as prescribed in the draft provisions.
- Note 10.03 *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 Party in any communication. In particular, indication of an address for correspondence or an address for service may be required where a 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 10.04 Under this provision a 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 6(1)(b), are a telephone number, a facsimile number or an email address.
- Note 10.05 *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 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 evidence of the authenticity of a signature.

**Article 11**  
**Renewal**

- (1) *[Indications or Elements Contained in, or Accompanying, a Request for Renewal; Fee] (a) A Party may require 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;*
  - (iv) where the holder has a representative, the name and address of that representative;*
  - (v) where the holder has an address for service or an address for correspondence, such address;*

- (vi) *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;*
- (vii) *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 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 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 Party, subject to the minimum periods prescribed in the Regulations.*
- (3) *[Prohibition of Other Requirements] No 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 It will be recalled that document SCT/24/3 contained draft provisions concerning the structure of the duration of the protection of an industrial design, which established an initial term of protection of five years, renewable for additional five-year terms, up to the maximum period prescribed by the applicable law.
- Note 11.02 The present document does not include such provisions, as the discussion that took place at the twenty-fourth session confirmed that SCT Members have very different positions concerning the structure of the protection.
- Note 11.03 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. It will be applicable only in those Parties which provide for renewal in their law.

#### **Article 12** **Relief in Respect of Time Limits**

- (1) *[Extension of Time Limits] A 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 Party:*
  - (a) *prior to the expiry of the time limit; or*
  - (b) *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 for an action in a procedure before the Office, 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 or registration and, if necessary, reinstatement of the rights of the applicant or holder with respect to that application or registration, if:*



- (a) *a request to that effect is made to the Office in accordance with the requirements prescribed in the Regulations;*
- (b) *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 Party may require that a fee be paid in respect of a request under paragraph (1) or (2).*
- (5) *[Prohibition of Other Requirements] No 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 these Draft Provisions 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.*

### **Article 13**

#### **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] A 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:*
  - (a) *a request to that effect is made to the Office in accordance with the requirements prescribed in the Regulations;*
  - (b) *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;*
  - (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, at the option of the 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 Party may require that a fee be paid in respect of a request under paragraph (1).*
- (4) *[Evidence] A Party may require that a declaration or other evidence in support of the reasons referred to in paragraph (1)(c) 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.

Notes on Articles 12 and 13

- Note13.01 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 13.02 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 13.03 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 13.04 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 13.05 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 13.06 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 13.07 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.

**Article 14**  
**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 Party provides for the recording of a license, that Party may require that the request for recording:
  - (a) *be filed in accordance with the requirements prescribed in the Regulations, and*
  - (b) *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) *the furnishing of the license contract, or a translation of it;*
  - (iii) *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 Party concerning the disclosure of information for purposes other than the recording of the license in the register of industrial designs.*
- (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 Party provides for such recording.
- (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 application or registration.

Notes on Article 14

Note 14.01 This Article is based on the provisions on the recording of licenses of the Singapore Treaty. Following the twenty-fourth session of the SCT, details on the requirements concerning the request for recording of a license or a security interest, along with those concerning supporting documents, have been transferred to the draft Regulations.

- Note 14.02 It follows from the introductory words of *paragraphs (1) and (2)* that there is no obligation for a Party to provide for the recording of licenses. However, where the applicable law provides for such recording, no indication or element other than those prescribed in Rule 10(1), or in Article 10, concerning “communications,” may be required. Similarly, a Party may not require any other document than those listed in Rule 10(2). It must accept any documentation under items (i) or (ii) of Rule 10(2), at the option of the requesting Party. A Party is not permitted to prescribe which document shall accompany the request.
- Note 14.03 Under *paragraph (6)*, the applicable requirements apply also to the recording of licenses in respect of *applications*, but only where the law of a Party provides for such recording. This provision, which is also contained in the Singapore Treaty, was included following the twenty-fourth session of the SCT.
- Note 14.04 *Paragraph (7)*, concerning a request for the recording of a security interest, is based on Rule 17(9) of the Regulations under the PLT. As in the case of the recording of a license under paragraph (1), there is no obligation for a Party to provide for the recording of a security interest.

#### **Article 15**

#### **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 Party provides for the recording of a license, that Party may require that the request for amendment or cancellation of the recording of a license:*
- (a) *be filed in accordance with the requirements prescribed in the Regulations, and*
  - (b) *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 14(2) to (5) 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 15

- Note 15.01 Articles 15, 16 and 17 are modeled on Articles 18, 19 and 20 of the Singapore Treaty.

**Article 16**  
**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 the 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 design.*
- (2) *[Certain Rights of the Licensee] A Party may not require the recording of a license as a condition for any right that the licensee may have under the law of that 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.*

Notes on Article 16

- Note 16.01 *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 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 Party such as, for example, the tax authority or the authority responsible for the establishment of statistics.
- Note 16.02 *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, where a licensee has the right under the law of a 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.

**Article 17**  
**Indication of the License**

*Where the law of a 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 17

- Note 17.01 Article 17 leaves it to the law of a 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 18**  
**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 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 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 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 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 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 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) *[Fee]* *A 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 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 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 provision.*

Notes on Article 18

- Note 18.01 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 18.02 *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 however provided for in the Regulations.*
- Note 18.03 *Paragraph (5) makes 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 19**  
**Regulations**

- (1) *[Content] The Draft Regulations under these Draft Articles provide rules concerning:*
- (i) *matters which these Draft Articles expressly provide to be prescribed in the Regulations;*
  - (ii) *any details useful in the implementation of the provisions of these Draft Articles;*
  - (iii) *any administrative requirements, matters or procedures.*
- (4) *[Conflict Between the Draft Articles and the Draft Regulations] In the case of conflict between these Draft Articles and the Draft Regulations, the former shall prevail.*

DRAFT REGULATIONS UNDER THE DRAFT PROVISIONS

**Rule 1**  
**Details Concerning the Application**

- (1) *[Further Requirements under Article 3] In addition to the requirements provided for in Article 3, a Party may further require that an application contain some, or all, of the following indications or elements:*
- (a) *an indication of the product or products which incorporate the industrial design, or in relation to which the industrial design is to be used;*
  - (b) *an indication of the class of the Locarno Classification to which belongs the product which constitutes the industrial design, or in relation to which the industrial design is to be used;*
  - (c) *an indication of any prior application or registration, or other information, of which the applicant is aware, that could have an effect on the novelty of the industrial design;*
  - (d) *where the application includes more than one industrial design, an indication of the number of industrial designs included.*
- (2) *[Requirements in Case of Divisional Applications] Where the applicant wishes that an application be treated as a divisional application:*
- (a) *an indication that he wishes the application to be so treated;*
  - (b) *the number and filing date of the initial application.*

Notes on Rule 1

- Note 1.01 *Paragraph (1)(b).* This element was included in the list of possible contents of an application at the request of several delegations at the twenty-fourth session of the SCT. No Party will be *obliged* to require an indication of the class of the Locarno Classification.
- Note 1.02 *Paragraph (1)(c).* This element was included following the twenty-fourth session of the SCT, in order to enable an Office to obtain information that could affect the novelty of the industrial design, or to ascertain whether filing took place within the applicable grace period.

**Rule 2**  
**Details Concerning Representation of the Industrial Design**

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



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

#### Notes on Rule 2

- Note 2.01 *Paragraph (1).* Under this provision, applicants would have the choice as to the form of representation of the industrial design for which protection is sought. Applicants would thus have the possibility of representing the industrial design by means, for example, of photographs, graphic reproductions, such as drawings, or a combination thereof.
- Note 2.02 The words “any other visual representation” are intended to cover other forms of representation, such as computer-animated representations, or forms which are not currently known, but which may develop in the future. It is understood that, whatever the form which the representation of the industrial design may take, it should always be visual.
- Note 2.03 It is generally agreed that the industrial design should be represented in such a way as to completely disclose its appearance. While several views of the design may be needed to fully disclose certain designs, it cannot be excluded that even a three-dimensional design could be fully disclosed by means of a single view, such as, for example, a perspective view.
- Note 2.04 *Paragraph (3)* of this provision leaves it to the applicant to determine, on a case by case basis, the number and types of views which are needed to fully disclose the industrial design. Thus, applicants would no longer need to vary the number of views to satisfy the requirements of the different jurisdictions in which they file.
- Note 2.05 At the same time, this provision enables Offices to call for further views where they consider that such views are necessary to fully disclose the industrial design. However, in order for this provision to fulfill its underlying purpose,

namely the streamlining of procedures, it would be presumed that Offices would implement it in a considered manner. It is not the spirit of this provision to enable Offices to systematically call for further views whenever an industrial design is three-dimensional.

- Note 2.06 This provision does not establish any maximum number of views which may be filed by the applicant, or published by an Office. Opting for a given number would present an inconvenience, as it is not unlikely that such number could rapidly become obsolete. An Office that is not presently in a position to publish more than a given number of views without additional cost could soon be able to increase that number, taking into account the pace at which new reproduction methods develop. Moreover, it is not unlikely that new reproduction techniques will make it easier for applicants to fully represent complex designs by means of fewer views.
- Note 2.07 In the absence of a provision regarding a maximum number of views, each Party remains free to introduce a limitation in its law in this respect, and to determine the maximum number.

### **Rule 3**

#### **Details Concerning Filing Date**

*[Time Limit Under Article 4(3)] The time limit referred to in Article 4(3) shall be not less than one month from the date of the notification referred to in that Article.*

#### Notes on Rule 3

- Note 3.01 The previous draft of this provision established two different time limits to comply with any missing filing-date requirement, depending on the address of the applicant. By contrast, this Rule provides for a single one-month time limit from the date of the notification by the Office.
- Note 3.02 As expressed during the twenty-fourth session of the SCT, providing for different time limits, depending on whether or not the address of the applicant is in the territory of the jurisdiction concerned, is no longer justified in an era of rapid means of communication. Consequently, this Rule provides for a single time limit. A one-month time limit, instead of two months, has been opted for, taking into account the ability for any applicant to respond quickly to a notification, along with the relevance of this irregularity, which has an effect on the filing date. Any Party may provide for a time limit of more than one month to comply with a missing filing-date requirement, although it will be in the interest of the applicant to comply with the requirement as soon as possible.

### **Rule 4**

#### **Details Concerning Publication**

*[Minimum Period Under Article 8(1)] The minimum period referred to in Article 8(1) shall be six months from the filing date or, where priority is claimed, from the priority date.*

#### Notes on Rule 4

- Note 4.01 This Rule provides for a minimum period of six months from the filing date or the priority date, during which an Office has to maintain an industrial design unpublished, if so requested by the applicant. A minimum period of six months has been opted for, in an attempt to strike a balance between the interest of applicants for secrecy and the interest of third parties for publication.

**Rule 5**  
**Details Concerning Representation; Address for Service or Address for Correspondence**

- (1) *[Appointment of Representative Under Article 9(4)] A Party shall accept that the appointment of a representative be filed with the Office in:*
  - (a) *a separate communication (hereinafter referred to as “power of attorney”) signed by the applicant, holder, or other interested person, and indicating the name and address of the representative; or, at the option of the applicant,*
  - (b) *the application, signed by the applicant.*
- (2) *[Power of Attorney]* (a) *The power of attorney may relate to one or more applications and/or registrations identified in the power of attorney or, subject to any exception indicated by the appointing person, to all existing and future applications and/or registrations of that person.*
  - (b) *The power of attorney may limit the powers of the representative to certain acts. Any Party may require that any power of attorney under which the representative has the right to withdraw an application or to surrender a registration contain an express indication to that effect.*
  - (c) *Where a communication is submitted to the Office by a person referred to in the communication as a representative, but where the Office is, at the time of the receipt of the communication, not in possession of the required power of attorney, the Party may require that the power of attorney be submitted to the Office within the time limit fixed by the Party, which shall be not less than two months from the date of the invitation to such person to submit the power of attorney. Any Party may provide that, where the power of attorney has not been submitted to the Office within the time limit fixed by the Party, the communication by the said person shall have no effect.*
- (3) *[Reference to Power of Attorney]* *A Party may require that any communication made to the Office by a representative for the purposes of a procedure before the Office contain a reference to the power of attorney on the basis of which the representative acts.*
- (4) *[Time Limits Under Article 9(6)] The time limits referred to in Article 9(6) shall be not less than two months from the date of the notification referred to in that Article.*
- (5) *[Evidence]* *A Party may require that evidence be filed with the Office only where the Office may reasonably doubt the veracity of any indication contained in any communication referred to in paragraph (1).*

Notes on Rule 5

- Note 5.01 *Paragraph (1).* This provision is based on Rule 7(2) of the Regulations under the PLT. A Party would have to accept the appointment of a representative either in a separate power of attorney, signed by the applicant, holder or other interested person, or in the application, signed by the applicant.
- Note 5.02 *Paragraph (2)* is based on Article 4(3)(b), (c) and (d) of the Singapore Treaty. Regarding paragraph (2)(c) of this Rule, it provides for a minimum time limit of two months to submit a power of attorney in reply to the invitation by an Office. This contrasts with Rule 4(3) of the Regulations under the Singapore Treaty, which distinguishes between two time limits, one or two months, depending on

the address of the person on behalf of whom the communication is made. The reason why a single time limit has been opted for under this Rule is the same as in Note 3.02. However, a minimum time limit of two months has been opted for in this case, as the correction of this irregularity does not affect the filing date.

**Rule 6**  
**Details Concerning Communications**

- (1) *[Details Concerning Article 10(3)]* (a) A Party may require that the address for correspondence referred to in Article 10(3)(i) and the address for service referred to in Article 10(3)(ii) be in a territory prescribed by that Party.
  - (b) A Party may require that the applicant, holder, or other interested person, include some, or all, of the following contact details in any communication:
    - (i) a telephone number;
    - (ii) a telefacsimile number;
    - (iii) an email address.
- (2) *[Indications Accompanying Signature of Communication on Paper]* A Party may require that the signature of the natural person who signs be accompanied by:
  - (a) an indication, in letters, of the family or principal name and the given or secondary name or names, of that person or, at the option of that person, of the name, or names, customarily used by the said person;
  - (b) an indication of the capacity in which that person signed, where such capacity is not obvious from reading the communication.
- (3) *[Date of Signing]* A Party may require that a signature be accompanied by an indication of the date on which the signing was effected. Where that indication is required, but is not supplied, the date of signing shall be deemed to be the date on which the communication bearing the signature was received by the Office or, if the Party so allows, a date earlier than the latter date.
- (4) *[Signature of Communications on Paper]* Where a communication to the Office is on paper and a signature is required, that Party:
  - (i) shall, subject to item (iii), accept a handwritten signature;
  - (ii) may permit, instead of a handwritten signature, the use of other forms of signature, such as a printed or stamped signature, or the use of a seal or of a bar-coded label;
  - (iii) may, where the natural person who signs the communication is a national of the country concerned and such person's address is in its territory, or where the legal entity on behalf of which the communication is signed is organized under its law and has either a domicile or a real and effective industrial or commercial establishment in its territory, require that a seal be used instead of a handwritten signature.

- (5) *[Attestation, Notarization, Authentication, Legalization or other Certification of a Signature of Communications on Paper] A Party may require the attestation, notarization, authentication, legalization or other certification of any signature of a communication on paper, under Article 10(4)(b), if the communication concerns the surrender of a registration, where the law of the Party so provides.*
- (6) *[Signature of Communications on Paper Filed by Electronic Means of Transmittal] A Party that provides for communications on paper to be filed by electronic means of transmittal shall consider any such communication signed if a graphic representation of a signature accepted by that Party under paragraph (4) appears on the communication as received.*
- (7) *[Original of a Communication on Paper Filed by Electronic Means of Transmittal] A Party that provides for communications on paper to be filed by electronic means of transmittal may require that the original of any such communication be filed with the Office:*
- (i) accompanied by a letter identifying that earlier transmission, and*
  - (ii) within a time limit which shall be at least one month from the date on which the Office received the communication by electronic means of transmittal.*
- (8) *[Authentication of Communications in Electronic Form] A Party that permits the filing of communications in electronic form may require that any such communication be authenticated through a system of electronic authentication, as prescribed by that Party.*
- (9) *[Date of Receipt] A Party shall be free to determine the circumstances in which the receipt of a document or the payment of a fee shall be deemed to constitute receipt by or payment to the Office in cases in which the document was actually received by, or payment was actually made to*
- (i) a branch or sub-office of the Office,*
  - (ii) a national Office on behalf of the Office of the Party, where the Party is an intergovernmental organization,*
  - (iii) an official postal service,*
  - (iv) a delivery service, or an agency, specified by the Party,*
  - (v) an address other than the nominated address(es) of the Office.*
- (10) *[Electronic Filing] Subject to paragraph (8), where a Party provides for the filing of a communication in electronic form or by electronic means of transmittal and the communication is so filed, the date on which the Office of that Party receives the communication in such form, or by such means, shall constitute the date of receipt of the communication.*

Notes on Rule 6

Note 6.01 Paragraphs (2) to (9) are modeled on Rule 6 of the Regulations under the Singapore Treaty.

Note 6.02 *Paragraph (5) provides that a Party may require certification of any signature of a communication on paper, where the communication concerns the surrender of a registration and the law of the Party provides for such certification. Specifying in a Rule the case in which certification of signature may be required is justified by the fact that the Regulations constitute a more flexible framework to provide for other cases of certification of signature in the future, or remove any.*

**Rule 7**  
**Details Concerning Renewal**

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

Note on Rule 7

Note 7.01 This Rule concerns the period within which any renewal fee must be paid and any request for renewal that may be required must be submitted. It establishes, in particular, a period of grace of at least six months after the date on which the renewal is due, to pay the fee and to submit the request for renewal, which may be subject to the payment of a surcharge. A grace period for the payment of fees for the maintenance of rights is already provided for in Article 5*bis* of the Paris Convention. The interest of this provision is that it also provides for a grace period for submitting any request for renewal that may be required.

**Rule 8**  
**Details Concerning Relief in Respect of Time Limits**

- (1) *[Requirements Under Article 12(1)] (a) A Party may require that a request referred to in Article 12 (1):*
  - (i) *be signed by the applicant or holder;*
  - (ii) *contain an indication to the effect that an extension of a time limit is requested, and an identification of the time limit in question.*

(b) *Where a request for an extension of a time limit is filed after the expiration of the time limit, a Party may require that all of the requirements for the action in respect of which the time limit applied, be complied with at the same time as the request is filed.*
- (2) *[Period and Time Limit Under Article 12(1)] (a) The period of extension of a time limit referred to in Article 12(1) shall be not less than two months from the date of the expiration of the un-extended time limit.*

(b) *The time limit referred to in Article 12(1)(b) shall expire not earlier than two months from the date of the expiration of the un-extended time limit.*
- (3) *[Requirements Under Article 12(2)(a)] A Party may require that a request referred to in Article 12(2)(a):*

- (i) *be signed by the applicant or holder;*
  - (ii) *contain an indication to the effect that relief in respect of non-compliance with a time limit is requested, and an identification of the time limit in question.*
- (4) *[Time Limit for Filing a Request Under Article 12(2)(b)] The time limit referred to in Article 12(2)(b) shall expire not earlier than two months after a notification by the Office that the applicant or holder did not comply with the time limit fixed by the Office.*
- (5) *[Exceptions Under Article 12(3)] No Party shall be required under Article 12(1) or (2) to grant:*
- (i) *a second, or any subsequent, relief in respect of a time limit for which relief has already been granted under Article 12(1) or (2);*
  - (ii) *relief for filing a request for a relief measure under Article 12(1) or (2) or a request for reinstatement under Article 13(1);*
  - (iii) *relief in respect of a time limit for the payment of a renewal fee;*
  - (iv) *relief in respect of a time limit for an action before a board of appeal, or other review body, constituted in the framework of the Office;*
  - (v) *relief in respect of a time limit for an action in inter partes proceedings;*
  - (vi) *relief in respect of a time limit for the correction or addition of a priority claim.*

#### Note on Rule 8

Note 8.01 This Rule is modeled on Rule 12 of Regulations under the PLT.

#### **Rule 9**

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

- (1) *[Requirements Under Article 13(1)(a)] A Party may require that a request referred to in Article 13(1)(a) be signed by the applicant or holder.*
- (2) *[Time Limit Under Article 13(1)(b)] The time limit for making a request, and for complying with the requirements, under Article 13(1)(b), shall be the earlier to expire of the following:*
- (i) *not less than two months from the date of the removal of the cause of failure to comply with the time limit for the action in question;*
  - (ii) *not less than 12 months from the date of expiration of the time limit for the action in question, or, where a request relates to non-payment of a renewal fee, not less than 12 months from the date of expiration of the period of grace provided under Article 5bis of the Paris Convention.*

- (3) *[Exceptions Under Article 13(2)] The exceptions referred to in Article 13(2) are failure to comply with a time limit:*
- (i) *for making a request for relief under Article 12 (1) or (2) or a request for reinstatement under Article 13(1);*
  - (ii) *for an action before a board of appeal, or other review body, constituted in the framework of the Office;*
  - (iii) *for an action in inter partes proceedings;*
  - (iv) *for the correction or addition of a priority claim.*

Note on Rule 9

Note 9.01 This Rule is modeled on Rule 13 of the Regulations under the PLT.

**Rule 10**

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

- (1) *[Content of Request] (a) A Party may require that the request for the recording of a license under Article 14(1) or (6) contain some, or all, of the following indications or elements:*
- (i) *the name and address of the holder;*
  - (ii) *where the holder has a representative, the name and address of that representative;*
  - (iii) *where the holder has an address for service or an address for correspondence, such address;*
  - (iv) *the name and address of the licensee;*
  - (v) *where the licensee has a representative, the name and address of that representative;*
  - (vi) *where the licensee has an address for service or an address for correspondence, such address;*
  - (vii) *the name of a State of which the licensee is a national, the name of a State in which the licensee is domiciled, if any, and/or the name of a State in which the licensee has a real and effective industrial or commercial establishment, if any;*
  - (viii) *the registration number of the industrial design which is the subject of the license;*
  - (ix) *where the license is not granted in respect of all the industrial designs contained in a registration, the industrial design number(s) for which the license is granted;*
  - (x) *an indication as to whether the license is an exclusive license, a non-exclusive license or a sole license;*



- (xi) *where applicable, that the license concerns only a part of the territory covered by the registration, together with an explicit indication of that part of the territory;*
    - (xii) *the duration of the license.*
  - (b) *A Party may require that the request for amendment or cancellation of the recording of a license under Article 15(1) contain some or all of the following indications or elements:*
    - (i) *the indications specified in items (i) to (viii) of subparagraph (a);*
    - (ii) *the nature and scope of the amendment to be recorded or an indication that cancellation is to be recorded.*
- (2) *[Supporting Documents for Recording of a License] (a) A Party may require that the request for the recording of a license be accompanied, at the option of the requesting party, by one of the following:*
- (i) *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.*
- (b) *Any Party may require that any co-holder who is not a party to the license contract give its express consent to the license in a document signed by such co-holder.*
- (3) *[Supporting Documents for Amendment of Recording of a License] (a) A Party may require that the request for amendment of the recording of a license be accompanied, at the option of the requesting party, by one of the following:*
- (i) *documents substantiating the requested amendment of the recording of the license; or*
  - (ii) *an uncertified statement of amendment of license, signed by both the holder and the licensee.*
- (b) *Any Party may require that any co-holder who is not a party to the license contract give express consent to the amendment of the license in a document signed by such co-holder.*
- (4) *[Supporting Documents for Cancellation of Recording of a License] A Party may require that the request for cancellation of the recording of a license be accompanied, at the option of the requesting party, by one of the following:*
- (i) *documents substantiating the requested cancellation of the recording of the license; or*
  - (ii) *an uncertified statement of cancellation of license, signed by both the holder and the licensee.*

Note on Rule 10

Note 10.01 This Rule is modeled on Rule 10 of the Regulations under the Singapore Treaty.

**Rule 11**

**Details Concerning Request for Recording of a Change in Ownership**

- (1) *[Content of Request]* A Party may require that the request for the recording of a change in ownership under Article 18 contain some, or all, of the following indications:
- (i) *an indication to the effect that a recording of a change in ownership is requested;*
  - (ii) *the number of the registration concerned by the change;*
  - (iii) *the name and address of the holder;*
  - (iv) *the name and address of the new owner;*
  - (v) *the date of the change in ownership;*
  - (vi) *the name of a State of which the new owner is a national, the name of a State in which the new owner is domiciled, if any, and the name of a State in which the new owner has a real and effective industrial or commercial establishment, if any;*
  - (vii) *where the holder has a representative, the name and address of that representative;*
  - (viii) *where the new owner has a representative, the name and address of that representative;*
  - (ix) *where the new owner is required to have an address for service or an address for correspondence, such address.*
  - (x) *the basis for the change requested.*
- (2) *[Requirements Concerning Supporting Documents for Recording of a Change in Ownership]* A Party may require that the request for the recording of a change in ownership be accompanied, at the option of the requesting party, by one of the following:
- (i) *a copy of the contract, which may be required to be certified by a notary public or any other competent public authority, as being in conformity with the original contract;*
  - (ii) *an extract of the contract showing the change in ownership, which may be required to be certified by a notary public or any other competent public authority, as being a true extract of the contract;*
  - (iii) *an uncertified certificate of transfer signed by both the holder and the new owner;*
  - (iv) *an uncertified transfer document signed by both the holder and the new owner.*

- (3) *[Identification of an Application Without Its Application Number] Where it is required that an application be identified by its application number, but such a number has not yet been issued or is not known to the applicant or its representative, the application shall be considered identified if the following is supplied:*
- (i) the provisional application number, if any, given by the Office, or*
  - (ii) a copy of the application, or*
  - (iii) a representation of the industrial design, accompanied by an indication of the date on which, to the best knowledge of the applicant or the representative, the application was received by the Office, along with any identification number given to the application by the applicant or the representative.*

Note on Rule 11

Note 11.01 This Rule is modeled on Article 11(1)(b) and (f) of the Singapore Treaty and on Rule 7 of the Regulations under the Singapore Treaty.

[End of Annex and of document]