GRUR

Deutsche Vereinigung für gewerblichen Rechtsschutz und Urheberrecht e.V.

Der Generalsekretär

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Third Special Session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (the SCT Special Session), and to the Preparatory Committee of the Diplomatic Conference to Conclude and Adopt a Design Law Treaty (DLT) (the Preparatory Committee)
GRUR comments on the proposal for the Design Law Treaty - SCT/S3/4

Dear Sir or Madam,

We thank you for the invitation of 12 May 2023 (C. 9168) to the Third Special Session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (the SCT Special Session), and to the Preparatory Committee of the Diplomatic Conference to Conclude and Adopt a Design Law Treaty (DLT) (the Preparatory Committee).

The German Association for the Protection of Intellectual Property ("Deutsche Vereinigung für gewerblichen Rechtsschutz und Urheberrecht e.V.", in the following "GRUR") is a non-profit association with an academic focus. Its statutory purpose is the academic advancement and development of industrial property, copyright and competition law at the German, European and international level. For fulfilling these tasks, GRUR provides assistance to the legislative bodies and to authorities competent for issues of intellectual property law, organises conferences, workshops and continued education courses, provides financial aid to selected university chairs and research projects and also publishes four leading German professional IP law journals (GRUR, GRUR International, GRUR-RR and GRUR-Prax). With over 5,000 members coming from 60 countries, GRUR offers an umbrella for a wide range of IP professionals: lawyers, patent attorneys, judges, academics, representatives of the specific public authorities and of the international organisations as well as enterprises dealing with issues of intellectual property.

Members of the GRUR Standing Committee on Designs have reviewed and discussed the current draft for the DLT and embrace aspects of these discussions for the present comments.

1. Article 2 DLT

Article 2 governs the scope of application of the DLT. However, the wording of Article 2 expressis verbis only covers "applications which are filed" (para. 1) and " industrial designs that can be registered as industrial designs, or for which patents can be granted " (para. 2).

Designs that are already registered at the time of the conclusion of the DLT would not be covered under certain circumstances according to the wording. Nevertheless, the DLT contains numerous provisions that are aimed at designs that have already been registered.

It should therefore be clarified that the DLT also applies to designs that are already registered at the time the DLT enters into force or for which a design patent has already been granted at the time the DLT enters into force, as well as to applications that are pending at the time the DLT is concluded. This could be done, for example, as follows (amendments in red):

> *(1) [Applications] This Treaty shall apply to national and regional applications which are filed with, or for, the Office of a Contracting Party,* ***including pending applications filed before the entry into force of this Treaty****.*
>
> *(2) [Industrial Designs] This Treaty shall apply to industrial designs that can be registered as industrial designs, or for which patents can be granted, under the applicable law****, including designs that have been registered or for which patents have been granted when this Treaty entered into force.***

2. Article 5(1)(b) DLT

The current version allows Contracting States to provide that anonymous applications receive a filing date, even if the holder is not specified. The current draft reads as follows:

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

This contradicts the principle rightly stated in the Notes, according to which - quite rightly - "who filed what" must be known for the accordation of the filing date, and should not be intended in this way (see, for example, Note 5.01 of the draft: "...Filing-date requirements should be of such significance that, without them, it would not be possible for an Office to know "who" filed "what"). We propose the following modification:

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

3. Article 13 DLT

According to its wording, the provision shall only apply to failures to observe a deadline that have the **direct** consequence of causing a loss of rights ("... and that failure has the direct consequence of causing a loss of rights"). Thus, there shall be no possibility of reinstatement for failures to observe a time limit which only *indirectly* lead to a loss of rights.

Art. 12 (1) of the Patent Law Treaty contains the same criterion of directness. In contrast, the Singapore Treaty does not contain such a restrictive view. According to Art. 14(2)(iii) Singapore Treaty the Contracting Parties shall only provide for reinstatement if the Office finds that failure to comply with the time limit concerned occurred in spite of due care required by the circumstances having been taken or, at the option of the Contracting Party, that the failure was unintentional. Accordingly, direct consequence of causing a loss of rights is not required under the Singapore Treaty.

As far as we can see, the question of when the constituent element of "direct consequence" exists and whether such a restrictive view of the right for reinstatement is required at all is treated differently in national legislation and the application of the law.

Therefore, we question whether it is advisable to regulate such a restrictive handling of the right to reinstatement within the framework of the DLT. Rather, we consider it preferable to leave the concrete formulation of the right to reinstatement to the law of the Contracting Party and therefore suggest deleting the word "direct" in the DLT.

In case, the requirement of “direct consequence” is to be retained, we suggest that examples be included in Note 13.03 as to which deadlines are not to be reinstated because there is only an indirect consequence of causing a loss of rights if the relevant deadline is missed.

4. Article 3(1)(a)(ix) DLT

According to Art. 3(1)(a)(ix), there is an option for Contracting Parties to also require that the Traditional Knowledge / Traditional Cultural Expressions / Genetic Resources underlying the design must be disclosed. The proposal reads in Option A:

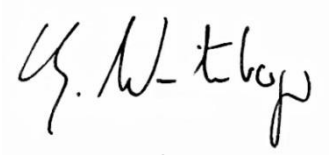
> *“a disclosure of the origin or source of traditional cultural expressions, traditional knowledge or biological/genetic resources utilized or incorporated in the industrial design”*

Option B goes beyond this provision and reads (under "other information, of which the applicant is aware" the cases mentioned expressis verbis in Option A should also be covered):

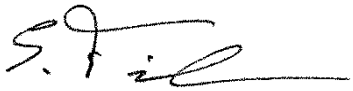
> *“an indication of any prior application or registration, or of other information, of which the applicant is aware, that is relevant to the eligibility for registration of the industrial design”*

The GRUR’s Standing Committee on Designs prefers the language in Option A which can be accepted as proposed.

Yours sincerely,



Dr. Gert Würtenberger
President



Stephan Freischem
Secretary General