



DEPARTMENT OF COMMERCE

Patent and Trademark Office

[Docket No.: PTO-C-2024-0008]

WIPO Diplomatic Conference on the Design Law Treaty

AGENCY: United States Patent and Trademark Office, Department of Commerce.

ACTION: Notice and request for comments.

SUMMARY: The United States Patent and Trademark Office (USPTO), Department of Commerce, requests public comments on negotiations at the World Intellectual Property Organization (WIPO) regarding a proposed Design Law Treaty (DLT). A diplomatic conference to finalize the DLT will be conducted in Riyadh, Saudi Arabia on November 11-22, 2024. Public comments are requested regarding the DLT.

The negotiations at the Diplomatic Conference will be the culmination of years of discussions at the WIPO Standing Committee on the Law of Trademarks, Industrial Designs, and Geographical Indications (SCT). The provisions of the DLT will pertain to formalities associated with applications for the protection of industrial designs, and its adoption may result in changes to requirements associated with filing these applications in the United States.

DATES: Written comments must be received by [INSERT DATE 90 DAYS AFTER PUBLICATION IN THE *FEDERAL REGISTER*] to ensure consideration.

ADDRESSES: For reasons of government efficiency, comments should be submitted through the Federal eRulemaking Portal at <https://www.regulations.gov>. To submit

comments via the portal, enter docket number PTO-C-2024-0008 on the homepage and select “Search.” The site will provide a search results page listing all documents associated with this docket. Find a reference to this request for information and select the “Comment” icon, complete the required fields, and enter or attach your comments.

Attachments to electronic comments will be accepted in ADOBE® portable document format or MICROSOFT WORD® format. Because comments will be made available for public inspection, information that the submitter does not desire to make public, such as an address or phone number, should not be included.

Visit the Federal eRulemaking Portal (<https://www.regulations.gov>) for additional instructions on providing comments via the portal. If electronic submission of comments is not feasible due to a lack of access to a computer and/or the internet, please submit comments by First-Class Mail or Priority Mail to: Keith M. Mullervy, Patent Attorney, Mail Stop OPIA, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450.

FOR FURTHER INFORMATION CONTACT: Keith M. Mullervy, Patent Attorney, Office of Policy and International Affairs (OPIA), at 571-270-7079.

SUPPLEMENTARY INFORMATION:

WIPO is a specialized United Nations agency based in Geneva, Switzerland. The WIPO SCT is a forum at which WIPO Member States¹ and accredited observers facilitate coordination and provide guidance on the development of international law on

¹ WIPO currently has 193 Member States. www.wipo.int/members/en/.

trademarks, industrial designs, and geographical indications, including the harmonization of national laws and procedures.

The draft DLT aims to help designers obtain easier, faster and cheaper protection for their industrial designs -- both in domestic and foreign markets. The DLT would streamline the global system for protecting industrial designs, which are an integral part of many brands, by simplifying and aligning requirements associated with industrial design filings. If approved, these changes would benefit the community of designers, particularly for small-scale designers who may have limited access to legal support for registering their industrial designs. In particular, the DLT would make it significantly easier for small and medium-sized enterprises to obtain industrial design protection overseas as a result of simplified, streamlined and aligned procedures and requirements.

Work on the simplification of procedures for the protection of industrial designs was initially started in the WIPO SCT in 2006 and gradually matured into an initial set of draft Articles (WIPO/SCT/35/2,² the “Industrial Design Law and Practice – Draft Articles”) and draft Regulations (WIPO/SCT/35/3,³ the “Industrial Design Law and Practice – Draft Regulations”) for a treaty. Similar treaties already exist in the area of patents (Patent Law Treaty of 2000) and trademarks (Trademark Law Treaty of 1994 and Singapore Treaty on the Law of Trademarks of 2006).

In 2006 and 2007, the SCT requested the WIPO Secretariat to develop a set of questionnaires relating to the formalities of industrial design registration and to the differences between all types of marks and industrial designs, with a view to promoting a

² https://www.wipo.int/edocs/mdocs/sct/en/sct_35/sct_35_2.pdf.

³ https://www.wipo.int/edocs/mdocs/sct/en/sct_35/sct_35_3.pdf.

better understanding of the different design systems. In response, the Secretariat developed a set of questionnaires on industrial design law and practice and circulated them among SCT members. After receiving replies from the SCT members, the Secretariat compiled a summary of replies to the set of questionnaires (WIPO/Strad/INF/2 Rev.2).⁴ In addition, in 2011 and 2012, the SCT requested that the Secretariat prepare a study on the impact of the Draft Articles and Draft Regulations. In response, the Secretariat, with the involvement of the WIPO Chief Economist prepared the study (WIPO/SCT/27/4⁵ and WIPO/SCT/27/4 ADD).⁶

In addition, at its Fifty-Fifth (30th Extraordinary) Session, held in Geneva on July 14-22, 2022, the WIPO General Assembly decided to convene a diplomatic conference (to be held no later than 2024) to conclude and adopt a Design Law Treaty, based on: document WIPO/SCT/35/2; document WIPO/SCT/35/3; the 2019 proposal considered by the WIPO General Assembly, on draft Articles and Regulations on Industrial Design Law and Practice; and any other contributions by Member States. The General Assembly further decided to convene a Preparatory Committee in the second half of 2023 to establish the necessary modalities of the diplomatic conference. The General Assembly also directed the SCT to meet in a special session for five days in the second half of 2023, preceding the Preparatory Committee, to further close any existing gaps to a sufficient level. Following that session of the WIPO General Assembly, the Secretariat prepared an updated set of draft Articles (WIPO/SCT/S3/4,⁷ the “Industrial Design Law and Practice – Draft Articles”) (“the Draft Articles”) and draft Regulations (WIPO/SCT/S3/5,⁸ the

⁴ https://www.wipo.int/export/sites/www/sct/en/meetings/pdf/wipo_strad_inf_2_rev_2.pdf.

⁵ https://www.wipo.int/edocs/mdocs/sct/en/sct_27/sct_27_4.pdf.

⁶ https://www.wipo.int/edocs/mdocs/sct/en/sct_29/sct_27_4_add.pdf.

⁷ https://www.wipo.int/edocs/mdocs/sct/en/sct_s3/sct_s3_4.pdf.

⁸ https://www.wipo.int/edocs/mdocs/sct/en/sct_s3/sct_s3_5.pdf.

“Industrial Design Law and Practice – Draft Regulations”) (“the Draft Regulations”) for a treaty.

A special session of the SCT, held in Geneva on October 2-6, 2023, worked to close existing gaps in the text based on document WIPO/SCT/S3/4; document WIPO/SCT/S3/5; and any other contributions by Member States. The special session is summarized in document WIPO/SCT/S3/9.⁹ In addition, a Preparatory Committee of the Diplomatic Conference, also held in Geneva on October 9, 2023, established the procedures for the diplomatic conference. The Preparatory Committee further determined that the diplomatic conference to conclude and adopt a design treaty will take place in Riyadh, Kingdom of Saudi Arabia, from November 11-22, 2024.¹⁰ The Preparatory Committee meeting is summarized in document WIPO/DLT/2/PM/6.¹¹

Request for Comments

This request for comments seeks public/stakeholder input to inform U.S. government participation in the diplomatic conference (scheduled from November 11-22, 2024) to conclude and adopt a Design Law Treaty. The proposed Design Law Treaty is a formalities treaty that would require contracting parties -- that is, the countries and intergovernmental organizations that accede to the treaty -- to adhere to certain requirements with respect to the protection of industrial designs. Examples of its provisions include:

- Limits on the requirements that contracting parties can impose as a condition for according design application filing dates to applicants;

⁹ https://www.wipo.int/edocs/mdocs/sct/en/sct_s3/sct_s3_9.pdf.

¹⁰ <https://www.wipo.int/diplomatic-conferences/en/design-law/index.html>.

¹¹ https://www.wipo.int/edocs/mdocs/sct/en/dlt_2_pm/dlt_2_pm_6.pdf.

- Requirements that contracting parties provide design applicants with certain flexibilities, including flexibilities for applicants who miss a time limit during the application process or who unintentionally allow the registration to lapse;
- Requirements that contracting parties must allow design applicants to correct or add a priority claim to an application in certain circumstances;
- Requirements that contracting parties provide for a grace period during which public disclosure would not affect eligibility requirements for obtaining the right; and
- Limits on the requirements that contracting parties may impose as to when applicants can be required to obtain local representation to take an action before the local office.

In addition, certain provisions are the subject of alternative options or proposals supported by several delegations, including:

- Requirements for an applicant disclosure in design applications of the origin or source of traditional cultural expressions, traditional knowledge or biological/genetic resources providing inspiration for, tangentially associated with, or utilized or incorporated in, some aspect of the industrial design;
- Limits on the requirements in requests for recording of a license or a security interest; and
- Effects of the non-recording of a license.

Request for Information

The USPTO welcomes any relevant comments on the topics described in this Request for Comments. However, the USPTO is particularly interested in comments responsive to the questions below. When responding to the questions, please identify yourself.

Commenters need not respond to every question and may provide relevant information even if it is not responsive to a particular question.

Questions for Comments

Section I – Observations and Experiences – Generally

1. Please discuss any experiences with filing for industrial design protection outside of the United States, and to the extent possible, please: (a) identify the jurisdiction(s); (b) describe the specific formalities requirements in these jurisdictions; and (c) describe any experiences associated with satisfying the specific formalities requirements in these jurisdictions.
2. Please identify any particular challenges encountered in relation to requirements across jurisdictions when pursuing protection for an industrial design in multiple jurisdictions.
3. Please describe instances, if any, in which particular formality requirements associated with the submission of design applications have resulted in any loss of design rights, additional costs, or other negative consequences.

Section II – Observations and Experiences – Disclosure Requirement Related to Genetic Resource, Traditional Knowledge and Traditional Cultural Expressions

4. Please discuss any experiences with filing for industrial design protection in a jurisdiction that requires disclosure of the source of genetic resources, traditional knowledge, or traditional cultural expressions in an industrial design application, and to the extent possible, please: (a) identify the jurisdiction(s) that required such disclosure; (b) describe the circumstances associated with satisfying the patent disclosure requirement in that jurisdiction; and (c) describe any experiences associated with the ease or difficulty in satisfying the patent disclosure requirement in that jurisdiction.

5. Please characterize the level of difficulty in complying with the aforementioned disclosure requirement. Please describe any anticipated or unanticipated problems that resulted or may result from the disclosure itself or the associated requirement for the disclosure.
6. Please describe how experiences with the disclosure requirement in the aforementioned jurisdiction or other jurisdictions affect the conduct of a design applicant or holder's business. Where possible, please identify the jurisdiction as well as any relevant details of the disclosure requirement.
7. Please identify any type of disclosure requirement associated with the filing of an application for industrial design protection, in particular, requirements pertaining to the disclosure of genetic resources, traditional knowledge, or traditional cultural expressions, that you believe is necessary, and any benefits or detriments stemming from such disclosure requirements.
8. Please share whether the existence of an industrial design disclosure requirement for the source of genetic resources, traditional knowledge, or traditional cultural expressions in an industrial design application was (or is or would be) a consideration in pursuing industrial design protection on a design in a given jurisdiction. Please provide details in relation to relevant sectors, industries or technologies where this may be a consideration, as well as alternative actions, if any, that the public has taken or would take in lieu of pursuing industrial design protection in that jurisdiction.
9. Would a disclosure requirement related to genetic resources, traditional knowledge, and/or traditional cultural expressions make the industrial design application process more simplified, consistent, straight-forward, and time and cost efficient for applicants, including for small and medium sized enterprises? Please explain why or why not.

10. Should a disclosure requirement related to genetic resources, traditional knowledge, and/or traditional cultural expressions be included in the Design Law Treaty? Please explain why or why not.

Section III – Current Text for Diplomatic Conference

11. Please describe your views on the current working text for an International Legal Instrument Relating to a Design Law Treaty, which has been approved for consideration by the Diplomatic Conference. Please describe recommendations, if any, for additions, deletions, or changes that you would recommend to Articles 1 through 32 of the Articles or to the Common Regulations, namely Rules 1 through 17. These texts can be found at the links below:

- a) Current working text “substantive articles” (Articles 1 through 23 from the WIPO Industrial Design Law and Practice – Draft Articles), as revised in the Third Special Session of the Standing Committee on the Law of Trademarks, Industrial Designs, and Geographic Indicators, held in Geneva on October 2-6, 2023, as included as pages 3-22 of Annex I to document WIPO/SCT/S3/9, which can be found on the WIPO website, https://www.wipo.int/edocs/mdocs/sct/en/sct_s3/sct_s3_9.pdf.
- b) Current working text “administrative provisions and final clauses” (Articles 24 through 32 from the WIPO Draft Administrative Provisions and Final Clauses for a Design Law Treaty), as revised in the Preparatory Committee of the Diplomatic Conference to Conclude and Adopt a Design Law Treaty, held in Geneva on October 9, 2023, as included as pages 2–6 of the Annex to document WIPO/DLT/2/PM6, which can be found on the WIPO website, https://www.wipo.int/edocs/mdocs/sct/en/dlt_2_pm/dlt_2_pm_6.pdf.
- c) Current working text “draft regulations” (Rules 1 through 17 from the WIPO Industrial Design Law and Practice – Draft Regulations), as revised in the

Third Special Session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographic Indicators, held in Geneva on October 2-6, 2023, as included as pages 2–14 of Annex II to document WIPO/ SCT/S3/9, which can be found on the WIPO website,

https://www.wipo.int/edocs/mdocs/sct/en/sct_s3/sct_s3_9.pdf.

- d) WIPO has established a website dedicated to the Diplomatic Conference to Conclude and Adopt a Design Law Treaty which can be found at <https://www.wipo.int/diplomatic-conferences/en/design-law/> which contains the aforementioned Articles and Regulations and other information regarding the Diplomatic Conference, the Design Law Treaty being considered, and other related information.
- e) Please identify any additional issues in relation to formalities for industrial designs that you believe should be considered for inclusion in the Design Law Treaty that are not already included or any amendments you recommend to existing provisions. Similarly, please identify any provisions (e.g., Article or Rules) presently included that should not be included. In any of these instances, please explain the rationale for this recommendation of an addition, amendment, or deletion of a provision.

Katherine K. Vidal,

Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.