



American Intellectual Property Law Association

June 25, 2024

The Honorable Kathi Vidal
Under Secretary of Commerce for Intellectual Property and
Director of U.S. Patent and Trademark Office
U.S. Patent and Trademark Office
600 Dulany Street
Alexandria, VA 22314
Via Online Submission: Regulations.gov

Re: Comments of AIPLA in response to the Notice on the WIPO Diplomatic Conference on the Design Law Treaty 89 Fed. Reg. 60 (March 27, 2024), Docket No. PTO-C-2024-0008

Dear Director Vidal:

The American Intellectual Property Law Association (“AIPLA”) appreciates the opportunity to offer the following response to the March 27, 2024, Notice on WIPO Diplomatic Conference on the Design Law Treaty (“March 27 Notice”).

Founded in 1897, the American Intellectual Property Law Association is a national bar association of approximately 7,000 members including professionals engaged in private or corporate practice, in government service, and in the academic community. AIPLA members represent a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, trade secret, and unfair competition law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property. Our mission includes helping establish and maintain fair and effective laws and policies that stimulate and reward invention while balancing the public’s interest in healthy competition, reasonable costs, and basic fairness.

Since 2006, the World Intellectual Property Organization (WIPO) has worked on a Design Law Treaty focused on aligning examination and procedural guidelines associated with what have historically been referred to as “industrial designs.” The Treaty’s stated goal is to make the process easier and more streamlined for applicants, particularly small and medium-sized enterprises. The most recent meeting related to the Design Law Treaty took place in Geneva, Switzerland in October 2023. There, the member states agreed to convene a Diplomatic Conference to Conclude and Adopt a Design Law Treaty in Riyadh, Saudi Arabia on November 11-22, 2024. The USPTO subsequently published the March 27 Notice in view of the upcoming Diplomatic Conference.

AIPLA supports strong, efficient, transparent, and quality patent systems to incentivize innovation. AIPLA surveyed all members of its Industrial Design Committee, and each member received an opportunity to respond. The survey was anonymous and could only be taken once

per device. The survey consisted of 19 questions summarizing the questions in the Federal Register.

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.

AIPLA members have extensive experience filing for industrial design protection in numerous jurisdictions worldwide, including the five largest receiving offices for designs (i.e., the ID5 – China, European Union, Japan, South Korea, and U.S.), and other national offices, including Australia, Argentina, Canada, Chile, Colombia, Egypt, India, Indonesia, Kenya, Kuwait, Mexico, New Zealand, Pakistan, Russia, Saudi Arabia, Taiwan, Thailand, UAE, and Vietnam. Members described varied experiences in satisfying specific formalities requirements, such as grace periods, drawing requirements, and documentation needs. For example, members highlighted challenges in adjusting to different grace period lengths, understanding specific drawing requirements, and complying with varied documentation standards across jurisdictions.

2. Please identify any particular challenges encountered in relation to requirements across jurisdictions when pursuing protection for an industrial design in multiple jurisdictions.

Members identified several challenges in pursuing industrial design protection across multiple jurisdictions. Key challenges included the lack of a uniform grace period, leading to difficulties in protecting designs in countries like China where early product leaks can compromise protection. Differences in drawing requirements, such as the prohibition on broken lines and surface shading and inability to claim partial designs, also posed significant hurdles. Additionally, members noted the complexity in keeping track of the various local filing requirements and grace periods, which often necessitates relying on local counsel, increasing the cost, and complexity of filing.

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.

Members reported that specific formalities were unworkable or too difficult, and in certain jurisdictions led to the loss of design rights or additional costs. For instance, with differences in grace periods, sometimes protection can be obtained in one jurisdiction but not another because a filing made outside a grace period leads to a loss of rights. The current lack of harmonization is confusing and costly to navigate. For example, some jurisdictions have 1-year grace periods, others have 6-month grace periods, and still others have no grace period at all (i.e., absolute novelty). There are also differences in how the grace periods are calculated. Some are calculated in years (e.g., 1 year), others in months (e.g., 6 months), and others in days (e.g., 180 days). One AIPLA member reported the loss of design rights in Brazil because an application was filed within 6 months but outside of the 180-day grace period applicable in Brazil. Additionally, the stringent grace period requirements in Japan were noted as a cause for loss of rights or requiring extensive efforts to retain rights due to prior art issues. These formalities often increased costs, both in terms of direct fees and the need for extensive pre-filing consultations with local counsel. AIPLA members also pointed out that UK law prevents amendments to

drawings in Hague applications designating the UK, whereas for application filed directly (non-Hague) such amendments are permitted.

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.

AIPLA surveyed those of its members who file extensive numbers of design applications. Not a single member reported any experience with, or even awareness of, a jurisdiction requiring an applicant filing for industrial design protection to disclose the source of genetic resources, traditional knowledge, or traditional cultural expressions in an industrial design application.

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.

As noted, the surveyed AIPLA members were unaware of any jurisdiction requiring applicants to disclose this information. AIPLA therefore has no first-hand experience to report. That being said, because the terms are new and undefined in the context of design patents (e.g., origin, source, traditional cultural expression), AIPLA can foresee challenges with compliance.

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.

N/A

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.

A disclosure requirement is in place in the United States, where applicants must disclose known prior art material to the examination of the design. Many jurisdictions do not have such a requirement. For example, applicants in the European Union and China need not disclose known material prior art.

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.

Unless a jurisdiction with additional costly hurdles was particularly important, AIPLA members indicated they might forego protection in that country. Some members reported the decision reminded them of jurisdictions requiring verbalization of a design claim. Sometimes for strategic reasons, applicants will skip those jurisdictions. AIPLA members expressed consternation as to how biological/genetic resources can have any impact on appearance of aesthetic design.

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.

The consensus among AIPLA members is that adding disclosure requirements related to genetic resources, traditional knowledge, and/or traditional cultural expressions would not simplify the design application process. Instead, it would increase complexity and costs, particularly for small and medium-sized enterprises. Members expressed concerns that such requirements would create additional burdens without clear benefits, making it more difficult and expensive to obtain and enforce design protections. This added complexity could deter some applicants from seeking design protection, especially in jurisdictions with stringent disclosure requirements.

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.

Members largely agreed that the Design Law Treaty should not include a disclosure requirement related to genetic resources, traditional knowledge, and/or traditional cultural expressions. They indicated that such a requirement would complicate the application process and increase costs without providing significant benefits. It would also place an undue burden on applicants to determine whether their designs incorporate elements requiring disclosure, potentially leading to inadvertent non-compliance and associated legal risks. Instead, the Treaty should focus on streamlining and simplifying the application process to make it more accessible and efficient for all applicants.

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.

Please see Exhibit 1 outlining our comments on the articles and rules. We appreciate the opportunity to comment and thank you in advance for consideration of these comments. Please do not hesitate to contact us at any time.

Sincerely,



Ann M. Mueting
President
American Intellectual Property Law Association

AIPLA Comments on

Industrial Design Law and Practice – Draft Articles (SCT/S3/4)

Industrial Design Law and Practice – Draft Regulations (SCT/S3/5)

Industrial Design Law and Practice – Draft Articles (SCT/S3/4)

Article 2 Applications and Industrial Designs to Which This Treaty Applies

(1) [Applications] This Treaty shall apply to national and regional applications which are filed with, or for, the Office of a Contracting Party [and to divisional applications thereof].

(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.

AIPLA Comment:

AIPLA generally favors this provision. However, AIPLA suggests defining the scope of design subject matter more expansively than just “industrial designs.” The term “industrial design” is traditionally used for the design of *physical* products, such as furniture, appliances, and vehicles. Design rights now commonly protect appearances of products beyond physical products, including protection for GUIs, icons, and virtual designs. Indeed, the DLT contemplates designs other than traditional industrial designs, as expressed in Rule 3(1)(iii), which mentions “any other visual representations.” AIPLA notes that Note R3.02 specifically mentions that “any other visual representations’ are intended to cover forms of representations, such as computer-animated representations, or forms not currently known, but which may develop in the future.” With this understanding, instead of “industrial design,” AIPLA recommends using an umbrella term like “design” or “design right” or defining “industrial design” more expansively. A definition of the design, or even industrial design, can be “a right that protects the outward appearance or ornamentation of an object or article of manufacture, whether physical or virtual.” Furthermore, broadening the Treaty’s stated scope beyond “industrial design” better aligns with the Treaty’s name, namely, “Design Law Treaty.”

Article 3 Application

(1) [Contents of Application; Fee] (a) A Contracting Party may require that an application contain some, or all, of the following indications or elements:

(i) a request for registration;

(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 under Article 4(3), such address;

(v) a representation of the industrial design, as prescribed in the Regulations;

Exhibit 1 - AIPLA Comments on the DLT Draft Articles and Rules

(vi) an indication of the product or products which incorporate the industrial design, or in relation to which the industrial design is to be used;

(vii) 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;

(viii) where the applicant wishes to take advantage of Article 11 of the Paris Convention, evidence 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;

~~Option A~~

~~*[(ix) 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~~

~~*[(ix) 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] [Footnote: Other information could include, among other things, information relating to traditional knowledge and traditional cultural expressions.]*~~

(x) any further indication or element 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 more than one industrial design.

(4) [Evidence] A Contracting 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.

AIPLA Comment:

AIPLA generally favors establishing a maximum closed list of elements required for a design application to provide simplicity and efficiency. AIPLA supports Article 3, but without paragraph (ix), Option A or B. Paragraph (ix) is inconsistent with the DLT's stated goal of simplifying and streamlining design right procedures. Including paragraph (ix) would complicate and obfuscate matters. The language of (ix) introduces vague, undefined abstract concepts (e.g. "origin," "source," "expression," "knowledge"), with marginal if any relation to design protection (e.g., biological/genetic resources has little to no relevance to an aesthetic design right), and not the type of core information that should

be included in the closed list of Article 3. It is also noted that Option A does not limit the contemplated disclosure by the applicant to information of which the applicant *is aware*. Given the ambiguity of the provision's language, and the marginal relevance of the requested information to *design* applicants, these significant additional burdens seem unwarranted and run counter to the DLT's stated purpose, which is to simplify and streamline the design filing process.

Further, whether in its Articles, Rules or Notes, the text, does not mention the purported relevance of the information draft provision (ix) seeks to collect or what a Contracting Party is to do with the information once collected. A design right only protects the novel overall appearance of a product. A design right does not independently protect any constituent visual portions of that overall appearance. Thus, whether a *constituent element* is found in the prior art, and thus not novel, is irrelevant to whether the *overall appearance* of the design is novel. Stated differently, the only operative question is whether the overall appearance of the design is novel, not the novelty of any individual elements.

Article 5 Filing Date

(1) [Permitted Requirements] (a) Subject to subparagraph (b) and paragraph (2), a Contracting Party shall accord as the filing date of an application the date on which the Office receives 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) 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.

[(2) [Permitted Additional Requirements] (a) A Contracting Party whose law, at the time it becomes party to this Treaty, requires that an application comply with any of the requirements specified in subparagraph (b) in order for that application to be accorded a filing date may, in a declaration, notify the Director General of those requirements.

(b) The requirements that may be notified pursuant to subparagraph (a) are the following:

- (i) an indication of the product or products which incorporate the industrial design, or in relation to which the industrial design is to be used;*

~~(ii) a brief description of the reproduction or of the characteristic features of the industrial design;~~

(iii) a claim;

(iv) the payment of the required fees.

(c) Any declaration notified under subparagraph (a) may be withdrawn at any time.]

(3) [Prohibition of Other Requirements] No indication or element other than those referred to in paragraph[s] (1)(a) [and (2)(b)] may be required for the purpose of according a filing date to an application.

(4) [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[s] (1) [and (2)(b)], the Office shall notify the applicant and give the opportunity to comply with such requirements within the time limit prescribed in the Regulations.

(5) [Filing Date in Case of Subsequent Compliance with Requirements] If, within the time limit referred to in paragraph (4), the applicant complies with the applicable requirements, the filing date shall be no later than the date on which all the indications and elements required by the Contracting Party under paragraph[s] (1) [and (2)(b)] are received by the Office. Otherwise, the application shall be treated as if it had not been filed.

AIPLA Comment:

AIPLA generally supports Section 5's language, including the provisions of paragraph (2), except it recommends deleting (2)(b)(ii) because a design's scope is best communicated *visually*. Verbal descriptions risk being too broad or too narrow. This may also confuse the public as to the design's scope.

Further, AIPLA suggests striking the language "sufficiently clear" that precedes "representation of the industrial design." To receive a filing date, the applicant should need only to represent the industrial design for which it seeks protection. If the representations are ultimately determined insufficient, the applicant may not be entitled to a design right or the scope thereof may be encumbered. But none of that should affect receipt of a filing date in the first instance. Holding a design applicant's filing date in abeyance while a determination on sufficiency of drawings (which could go on for months), or amendments to the drawings, could jeopardize the applicant's rights, even if ultimately resolved the applicant's favor.

AIPLA further notes that the language of paragraph (2)(i) directed at the indication of the product or products incorporating the industrial design, or in relation to which the industrial design is to be used, is particularly important in some jurisdictions, as the design right's scope is directly tied to the product or products identified.

Article 6 Grace Period for Filing in Case of Disclosure

[OPTION A]

A disclosure of the industrial design during a period of ~~six or~~ 12 months preceding the date of filing of the application or, if priority is claimed, the date of priority, ~~shall not be prior art to be without prejudice to the novelty and/or originality, as the case may be, of the industrial design, where it the disclosure was made:~~

(i) by the creator or his/her successor in title; or

(ii) by a person who obtained the disclosed information ~~about the industrial design~~ directly or indirectly, including as a result of an abuse, from the creator or his/her successor in title.

[OPTION B]

A disclosure of the industrial design during a period of ~~six or~~ 12 months preceding the date of filing of the application or, if priority is claimed, the date of priority, shall be without prejudice to the eligibility for the registration novelty and/or originality, as the case may be, of the industrial design, where ~~it the disclosure~~ was made:

(i) by the creator or his/her successor in title; or

(ii) by a person who obtained the disclosed information ~~about the industrial design~~ directly or indirectly, including as a result of an abuse, from the creator or his/her successor in title.

AIPLA Comment:

As an initial matter, AIPLA supports a 12-month grace period. Leaving the Contracting Parties to choose between 6 or 12 months runs counter to the DLT's stated goal. The DLT should specify a single term, and that term should be 12 months.

AIPLA notes that the current draft of Article 6 appears unduly limited to excepting the applicant's disclosure from consideration for only "novelty and/or originality." The current language does not effectively address the full goal of a grace period, which is that an applicant's own disclosures during a grace period should not serve as prior art to prejudice a design's registration. The current language shields the grace period disclosure only against "novelty" and/or "originality." These are two particular legal concepts, but they do not cover all instances where applicant only prior art can prejudice a design's registration. Beyond "novelty" and "originality," countries have many different names for registrability requirements (even if just facially) that are affected by an applicant's grace period disclosures. (See, e.g., EU ("individual character"), United States ("non-obviousness" and "originality"), Nigeria ("individual character" and "originality"), "Australia ("distinctiveness"), China ("distinctly different"), Japan ("creativity"), Peru ("particular appearance"), and Korea ("creativity"), etc.) One way to ensure the expansiveness of the grace period is to express the provision as an exception to what public disclosures can be considered "prior art" or, alternatively, "without prejudice to the eligibility of the registration of the industrial design."

Exhibit 1 - AIPLA Comments on the DLT Draft Articles and Rules

Given the various ways in which prior art is considered, this phraseology is too narrow.

Lastly, AIPLA notes that the trigger language, “who obtained information about the industrial design” is too broad, in that the “information about the industrial design” may not be related to the appearance of the design. (E.g., “information” can relate to many things, including dates, names, places, etc.). AIPLA suggests amendments to better tailor the language to what was “disclosed” and what was “obtained.”

Industrial Design Law and Practice – Draft Regulations (SCT/S3/5)

Rule 2 Details Concerning the Application

(1) [Further Requirements Under Article 3] In addition to the requirements provided for in Article 3, a Contracting Party may require that an application contain some, or all, of the following indications or elements:

(i) an indication of the class of the Locarno Classification to which belongs the product which incorporates the industrial design, or in relation to which the industrial design is to be used;

(ii) a claim;

~~*(iii) a statement of novelty;*~~

~~*(iv) a description;*~~

(v) indications concerning the identity of the creator of the industrial design;

(vi) a statement that the creator believes himself/ herself to be the creator of the industrial design;

(vii) where the applicant is not the creator of the industrial design, a statement of assignment or, at the option of the applicant, other evidence of the transfer of the design to the applicant admitted by the Office;

(viii) where the applicant is a legal entity, the legal nature of that legal entity and the State, and, where applicable, the territorial unit within that State, under the law of which the said legal entity has been organized;

(ix) the name of a State of which the applicant is a national if he/she is the national of any State, the name of a State in which the applicant has his/her domicile, if any, and the name of a State in which the applicant has a real and effective industrial or commercial establishment, if any;

(x) an indication of any prior application or registration, or other information, of which the applicant is aware, that could have an effect on the eligibility for registration of the industrial design;

(xi) where the applicant wishes to maintain the industrial design unpublished for a period of time, a request to that effect;

(xii) where the application includes more than one industrial design, an indication of the number of industrial designs included;

(xiii) an indication of the term of protection for which the application is filed;

(xiv) where a Contracting Party requires payment of a fee in respect of an application, evidence that the payment was made;

(xv) where applicable, an indication of partial design;

(xvi) where applicable, a request for earlier publication.

Exhibit 1 - AIPLA Comments on the DLT Draft Articles and Rules

(2) *[Requirements in Case of Divisional Applications]* A Contracting Party may require that, where an application is to be treated as a divisional application, the application contain the following: (i) an indication to that effect;

(ii) the number and filing date of the initial application.

AIPLA Comment:

AIPLA generally supports Regulation 2, except for the addition of (iii) “a statement of novelty” and (iv) “a description.”

As for Rule 2 (1)(iii)’s statement of novelty, such a requirement incorrectly shifts the focus of the design right to individual sub-portions of the design rather than the design’s *overall appearance*, which is what design protection affords. Design protection should be available, by way of registration, to protect the overall visual appearance (including ornamentation) of an object or article of manufacture as a whole. The concept of a “statement of novelty” is misguided, as it envisions something less than the novelty of the design’s *overall appearance*. Thus, AIPLA does not favor adding a “statement of novelty” to the closed list of permissible requirements.

AIPLA also does not favor adding a “description” to the closed list of permissible requirements. This could confuse or mislead by focusing on semantics, and would add more burden. Design rights are best defined by using *visual representations*, such as those set forth in Rule 3 *infra*. If an applicant must provide a verbal description of the design in one jurisdiction, that description can be misinterpreted and unfairly restrict the right’s scope in other jurisdictions. There are also differences in languages to consider. The right approach is to let the visual representations speak for themselves. As the adage goes, a picture is worth a thousand words.

Rule 3 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 Representation] Notwithstanding paragraph (1)(c), the representation of the industrial design may include:

- (i) matter that does not form part of the claimed design if it is identified as such in the description and/or it is shown by means of dotted or broken lines;*
- (ii) 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 industrial design, or by several different views that fully disclose the industrial design.

(b) Notwithstanding subparagraph (a), additional, specific views may be required by the Office where such views are necessary to fully show the product or products that incorporate the industrial design or in relation to which the industrial design is to be used. However, additional views disclosing new matter affecting the industrial design, which are not derivable from the original view or views, do not have to 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 copies¹ where the application is filed on paper.

AIPLA Comment:

AIPLA generally supports the language of Rule 3, with one exception. AIPLA does not support the inclusion of paragraph (1)(iv), as it seems to permit use of a combination of (i) photographs, (ii) graphic reproductions, and (iii) any other visual representations to depict a single design. Such a combination of visual representation formats risks detracting from the clarity of the design for which protection is sought. See Article 5(1)(a)(iii) calling for “a sufficiently clear representation of the industrial design.” It is very difficult to ensure consistency of disclosure across all views when using different formats, including a design’s relative scale, shape, perspective and visual disclaimers. The better approach, and to promote consistency and clarity, is to limit an applicant to choosing one

Exhibit 1 - AIPLA Comments on the DLT Draft Articles and Rules

of the enumerated formats for any given design. Accordingly, paragraph (iv) should be removed.

AIPLA supports the provision in paragraph (2)(i), which permits use of dotted or broken lines to depict matter forming no part of the claimed design.

AIPLA supports the provision in paragraph (2)(ii) permitting use of surface shading to depict the surfaces of a design. For many designs, particularly those with irregular surfaces or indentations, surface shading can help better describe the contour of the design claimed.

AIPLA supports the provisions of paragraph (3)(a) and (3)(b) discussing the number of views permitted to disclose a given design. The language as drafted appreciates and accommodates the wide breadth of potential design subject matter. Some designs can be sufficiently claimed with a single view, while other may be more complicated, with many facets, and thus require many more views. There is no need to set a maximum number of views for a given design. It is up to the applicant to sufficiently disclose and describe its design, whether with a single view or many.