Article 3 of the WIPO Design Law Treaty

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WIPO Diplomatic Conference Side Event
Riyadh, Saudi Arabia
November 18, 2024

Article 3 of the basic proposal, DLT/DC/3

[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;

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

(viii) 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;

(Article 3), Alternative 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;]

(Article 3) Alternative B, (x) and (b)

[(ix) an indication of any prior application or registration, or of other information[3], of which the applicant is aware, that is relevant to the eligibility for registration of the industrial design;]

(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.

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3. Other information could include, among other things, information relating to traditional knowledge and traditional cultural expressions.

DLT/DC/5, Secretariat Notes: Article 3: Application

3.01 This Article and the corresponding Rules of the Regulations propose a closed list of indications or elements that may be required in an application. While paragraph (1) sets out the maximum contents of an application that may be required by a Contracting Party (including indications and elements prescribed in the Regulations), paragraph (2) makes it clear that no further element may be required by a Contracting Party in an application, except those elements that may be required under Article 10 (“Communications”). Establishing a closed list of elements contributes to create a predictable framework for industrial design procedures, and is therefore of the outmost importance, with a view to simplifying and streamlining such procedures.

3.02 This provision does not aim at creating a uniform content of applications, but at establishing a maximum content, so that anyone wishing to file an application knows exactly what are the elements that may be required. However, a Contracting Party may require some only, rather than all, of the elements listed. For instance, no Contracting Party would be obliged to require a claim (see Rule 2(1)(ii)). A claim would presumably not be required by a Contracting Party that protects industrial designs under a registration system, as opposed to a system of protection under patent law.

DLT/DC/5, Article 3: Application, con't

3.08. Item (ix). The text of item (ix) under Alternative A was proposed by the African Group at the thirty-fourth session of the SCT. The text of item (ix) under Alternative B, along with the corresponding footnote, was proposed by Ambassador Socorro Flores Liera (Mexico) to the fifty-first (24th ordinary) session of the WIPO General Assembly, held in Geneva from September 30 to October 9, 2019.

Government funding of designs

United States
37 CFR § 1.154 Arrangement of application elements in a design application.

(b) The specification should include the following sections in order:

(1) Preamble, stating the name of the applicant, title of the design, and a brief description of the nature and intended use of the article in which the design is embodied.

(2) Cross-reference to related applications (unless included in the application data sheet).

(3) Statement regarding federally sponsored research or development.

(4) Description of the figure or figures of the drawing.

(5) Feature description.

(6) A single claim.

https://www.ecfr.gov/current/title-37/chapter-I/subchapter-A/part-1/subpart-B/subject-group-ECFR5ba9219fb1b6d20/section-1.154

A October 25, 2024 KEI letter to USPTO regarding obligation to disclose public funding included an annex of 100 US design patents with federal government funding and rights disclosed.

https://www.keionline.org/wp-content/uploads/KEI-USPTO-Letter-WIPO-DLT-Article3-25Oct2024.pdf

Using search terms in patents.google.com, such as:

type:DESIGN "government has certain rights"

The disclosures in patent applications when inventions were made with government support are important.

A possible sanction for failing to disclose federal funding can result in the U.S. government taking ownership of the patent.

The disclosure of federal funding signals that the federal government has a “nonexclusive, nontransferrable, irrevocable, paid-up license to practice or have practiced for or on behalf of the United States any subject invention throughout the world,” and

a march-in right that can be used whenever a patent holder does not make the benefits of patent “available to the public on reasonable terms,” or when action is necessary to alleviate health or safety, or necessary to meet requirements for public use specified by Federal regulations, or to ensure that a product is manufactured substantially in the United States.

Artificial Intelligence

USPTO:

If the use of an AI tool is material to patentability, the use of the AI tool must be disclosed to the USPTO

US Copyright Office notice:

“Based on these developments, the Office concludes that public guidance is needed on the registration of works containing AI-generated content. This statement of policy describes how the Office applies copyright law's human authorship requirement to applications to register such works and provides guidance to applicants.” Copyright Registration Guidance: Works Containing Material Generated by Artificial Intelligence, A Rule by the Copyright Office, Library of Congress on 03/16/2023

USPTO is issuing multiple notices regard AI and patents (including design patents)

2024 Guidance Update on Patent Subject Matter Eligibility, Including on Artificial Intelligence by the Patent and Trademark Office on 09/17/2024.

2024 Guidance Update on Patent Subject Matter Eligibility, Including on Artificial Intelligence by the Patent and Trademark Office on 07/17/2024.

Impact of the Proliferation of AI on Prior Art and PHOSITA: Notice of Public Listening Session by the Patent and Trademark Office on 07/05/2024.

Inventorship Guidance for AI-Assisted Inventions by the Patent and Trademark Office on 06/06/2024.

Request for Comments Regarding the Impact of the Proliferation of Artificial Intelligence on Prior Art, the Knowledge of a Person Having Ordinary Skill in the Art, and Determinations of Patentability Made in View of the Foregoing by the Patent and Trademark Office on 04/30/2024.

Guidance on Use of Artificial Intelligence-Based Tools in Practice Before the United States Patent and Trademark Office by the Patent and Trademark Office on 04/11/2024.

Inventorship Guidance for AI-Assisted Inventions by the Patent and Trademark Office on 02/13/2024.

Inventorship Guidance for AI-Assisted Inventions

A Notice by the Patent and Trademark Office on 02/13/2024

Published Document: 2024-02623 (89 FR 10043)

V. Patent Practice

A. Applicability of This Guidance to Design and Plant Patent Applications and Patents

35 U.S.C. 171 provides that a patent for a design may be obtained by "[w]hoever invents any new, original, and ornamental design for an article of manufacture" and that the provisions related to utility patents are applicable to design patents, except as otherwise provided (*e.g.*, in 35 U.S.C. 172-173).[60] The Federal Circuit has interpreted 35 U.S.C. 171 such that the inventorship inquiry is the same for a design patent and a utility patent.[61]

35 U.S.C. 161 provides that a plant patent may be obtained by "[w]hoever invents or discovers and asexually reproduces" a distinct and new variety of plant.[62] 35 U.S.C. 161 limits patent protection to plants "that were created as a result of plant breeding or other agricultural and horticultural efforts *and* that were created by the inventor" (emphasis in original).[63] That is, to be entitled to patent protection, the inventor of a plant must have contributed to the creation of the plant in addition to having appreciated its uniqueness and asexually reproduced it.[64] This is true for new and distinct plant varieties invented with the assistance of AI. The use of an AI system by a natural person(s) does not preclude the natural person(s) from qualifying as an inventor (or joint inventors) of the claimed plant as long as the plant was created with significant contribution(s) from the natural person(s).

Therefore, this guidance regarding AI-assisted inventions applies not only to utility patents and patent applications but also to design and plant patents and patent applications.

Other transparency issues

License of right (LOR) regimes

“An LOR system is understood to mean a system whereby an applicant for, or holder of an intellectual property right (IPR) such as a patent, registered design, utility model or trade mark, can register a declaration with the relevant national intellectual property office (IPO) that they will not refuse to grant a licence of their IPR on application by a prospective licensee. Registering such a declaration in advance also often results in the reduction of registration and other fees at the relevant IPO.”[1]

European countries in the report below with LOR regimes include Albania, Bulgaria, Czech Republic, Germany, Greece, Ireland, Italy, Latvia, Lithuania, Luxembourg, Malta, San Marino, Slovakia, Spain, Turkey and the UK.

1. Report On Present Situation Of “Licence Of Right” System In Selected Epc Member States. https://www.jetro.go.jp/ext_images/world/europe/ip/pdf/Report_on_Present_Situation_of_Licence_of_Right_systems_in_selected_EPC_member_states.pdf

Standards essential designs

Governments are struggling to deal with policies on standards essential patents (SEPs). Standards can also involve designs. For example, charging technology for electric vehicles, a graphical user interface (GUI), parts for medical devices,

For example, a standard for patient monitoring systems in intensive care units (ICUs) that specifies a particular layout and visual design for displaying vital signs (heart rate, blood pressure, oxygen saturation), would ensure that information is presented clearly and consistently across different devices from various manufacturers, reducing the risk of misinterpretation by medical professionals in high-pressure situations.

A design patent protecting the specific arrangement of elements (graphs, numerical displays, color-coding) within this standardized GUI could be considered essential to the standard.

The standardized design minimizes cognitive load for healthcare providers, allowing them to quickly assess a patient's condition and make informed decisions.

Countries should be able to ask if the design is implicated to any relevant standard, and if so, are there any obligations on licensing.

More on Graphical User Interface designs

SCT/44/6 REV.4. Updated Proposal By the Delegations Of Canada, Israel, Japan, the Republic Of Korea, the United Kingdom, The United States of America And The European Union And Its Member States

SCT/46/5. Proposal by the African Group for a Study on the Impact of Design Protection for Graphical User Interface (GUI) Designs on Innovation

ISO 9241-210:2019, Ergonomics of human-system interaction Part 210: Human-centred design for interactive systems

W3C's Web Content Accessibility Guidelines (WCAG) outline how to make web content accessible to people with disabilities.

Information about the owners of designs

Countries may want to have more transparency of the beneficial owners of designs, and/or certain metrics about the owners, such as the nationality of the beneficial owners, the size of a company as measured by revenues or some other metric.

Many patent regimes currently give discounts on fees to small entities.

Litigation

It would be useful to require applicants to provide timely and updated information on global litigation over the design right.

TRIPS Article 29.9, Patent applications

> 2. Members may require an applicant for a patent to provide information concerning the applicant’s corresponding foreign applications and grants.

Some suggestions

Possible changes to Article 3

(1)(a)

(xii) other information that is considered essential for the protection of the public interest, the prevention of fraud, or to enhance transparency.

Or

(xii) other information that is considered essential for the protection of the public interest, the prevention of fraud, or to enhance transparency, provided that a notification to WIPO has been made, and the required disclosure do not unreasonably impair the opportunity to seek and obtain such protection. (Last part similar to the TRIPS 25.2)

Agreed Statement for Article 3. Nothing in his article will prevent contracting parties from requiring applicants to disclose the funding of design by a government, or a duty to disclose the extent to which artificial intelligence tools have been used to create the design, or the role of a design, if any, that is essential to implement a standard.

Contact info

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