



June 25, 2024

The Honorable Katherine K. Vidal
Under Secretary of Commerce for Intellectual Property
and Director of the United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Submitted via: eRulemaking Portal at https://www.regulations.gov

Re: Request for Comments on Negotiations at the World Intellectual Property Organization (WIPO) regarding a proposed Design Law Treaty (DLT); Docket No. PTO-C-2024-0008

Dear Director Vidal:

Intellectual Property Owners Association (IPO) appreciates the opportunity to respond to the USPTO's March 27, 2024 request for public comments regarding the World Intellectual Property Organization (WIPO) Diplomatic Conference on the Design Law Treaty (DLT), 89 Fed. Reg. 21,242 (Mar. 27, 2024).

IPO is an international trade association representing a "big tent" of diverse companies, law firms, service providers and individuals in all industries and fields of technology that own, or are interested in, intellectual property rights. IPO membership includes over 125 companies and spans over 30 countries. IPO advocates for effective and affordable IP ownership rights and offers a wide array of services, including supporting member interests relating to legislative and international issues; analyzing current IP issues; providing information and educational services; supporting and advocating for diversity, equity, and inclusion in IP and innovation; and disseminating information to the public on the importance of IP rights.

IPO's vision is the global acceleration of innovation, creativity, and investment necessary to improve lives. The Board of Directors has adopted a strategic objective to foster diverse engagement in the innovation ecosystem and to integrate diversity, equity, and inclusion in all its work to complement IPO's mission of promoting high quality and enforceable IP rights and predictable legal systems for all industries and technologies.

IPO applauds efforts to negotiate proposed language for a DLT in a manner that fosters harmonization of formalities relating to industrial design applications and registrations. It offers the following comments for consideration.

I. General Observations and Experiences

IPO members regularly file design applications via the Paris Convention and the Hague System, which allow an applicant to claim priority in subsequent filings with other Contracting Parties based on the priority application's filing date, so long as subsequent applications are filed within six months of the priority date. When preparing priority applications, it is important to

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consider differences between jurisdictions in specific formality requirements to ensure later filings based on the priority application have a sufficient basis in the priority application. Greater harmonization of formalities between Contracting Parties would help alleviate the challenges and costs associated with having to predict in which international jurisdictions a U.S. priority application will be used as a basis.

More specifically, across jurisdictions, IPO members encounter differences in accommodation of line shading, restrictions as to the minimum or maximum number of views of a design, time to publication, and application of unity of invention or restriction standards. Some of these differences may involve substantive, as distinct from formalistic or procedural requirements, though the DLT is understood to be directed to providing a procedural common ground as opposed to substantive uniformity.

Applicants would also benefit greatly from having a minimum length of time during which an industrial design application remains unpublished. IPO supports a period of six months from the date of filing in each Contracting Party—and not, as some WIPO delegations proposed, from the priority date—with an option to provide applicants a procedure to request early publication.

IPO members have also encountered difficulties with respect to variations in approaches to handling multiple embodiments or designs in a single application. For instance, if a U.S. priority design patent application or a Hague design application includes more than one design or embodiment, some jurisdictions require distinct applications be filed upon entry into that jurisdiction, while others permit the designs to be included in a single application, subject to later objections or restriction requirements and with the option to file divisional applications. The DLT is an opportunity to provide a uniform approach, such as one that permits multiple designs to be included in a single application and accorded a single application number upon filing in the office of each Contracting Party, subject to later objection on the basis of unity of invention or restriction requirements and with the right to file divisional applications directed to non-elected designs or embodiments. Article 8 of the Basic Proposal for the DLT appears to adequately address this issue.

## **II. Observations and Experiences – Disclosure Requirement Related to Genetic Resources, Traditional Knowledge, and Traditional Cultural Expressions**

IPO believes it would be premature and unnecessary to include in the DLT a disclosure requirement for traditional cultural expressions, traditional knowledge, or biological/genetic resources utilized or incorporated in industrial designs.

IPO is mindful of the recent WIPO Treaty on Intellectual Property, Genetic Resources and Associated Traditional Knowledge (IP GR/ATK Treaty) that establishes a disclosure requirement for *patent* applicants whose inventions are based on genetic resources and/or associated traditional knowledge. Contracting Parties would benefit from seeing how the IP GR/ATK Treaty's disclosure requirement is implemented with respect to patent applications before new disclosure requirements are adopted for industrial design applications. Furthermore, it would be premature to include a disclosure requirement on traditional knowledge or traditional cultural expressions and folklore, as negotiations on these topics are still ongoing in the Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional

Knowledge and Folklore — and universal definitions for disclosure requirements have yet to be agreed upon.

There are particular challenges to implementing similar disclosure requirements in the design context. As a threshold matter, U.S. design patent applications focus on protecting ornamental aspects of designs for articles of manufacture. Because the same ornamentality can result from many types of compositions, design composition is almost always unspecified in applications. Accordingly, determining and disclosing whether a particular design includes, for example, biological/genetic resources, would be difficult, if not impossible.

Industrial designs are evaluated based on their overall visual appearance. To parse a design into individual components, as would likely be necessary to assess whether traditional cultural expressions, traditional knowledge, or biological/genetic resources are utilized or incorporated in an industrial design to such an extent as to give rise to a disclosure obligation would complicate determinations of infringement, novelty, and non-obviousness under the recent approaches indicated in *LKQ Corp. v. GM Global Technology Operations LLC*, No. 2021-2348 (Fed. Cir. May 21, 2024) and the May 22, 2024 guidance provided to examiners by the USPTO.

IPO agrees with comments presented during the October 2023 Special Session of the WIPO Standing Committee on the Law of Trademarks, Industrial Designs, and Geographical Indications (SCT) that novelty and (in those Contracting Parties whose substantive law for industrial design protection requires it) non-obviousness should be adequate to address concerns over private attempts to exclude others from the use of traditional cultural expressions, traditional knowledge, or biological/genetic resources in a given industrial design.

IPO thanks the USPTO for its attention to IPO's comments submitted herein. Further dialogue and/or opportunities to comment would be welcome.

Sincerely,



Krish Gupta  
President