

To: consultation@ipaaustralia.gov.au

Date: 21 September 2024

WIPO DESIGN LAW TREATY

We refer to IP Australia's request for comments on the WIPO Design Law Treaty dated 23 August 2024.

New Zealand Intellectual Property Attorney Incorporated ("NZIPA") is an incorporated body representing most trans-Tasman patent attorneys registered and practicing in New Zealand. The current membership of NZIPA comprises 172 Fellows, 3 Honorary, 10 Students, 10 Non-resident, 28 Associates and 2 Retired.

We have noted that in November 2024, the World Intellectual Property Organization (WIPO) will host a Diplomatic Conference to finalise a Design Law Treaty (DLT) and that the majority of the Treaty has already been agreed to, but the outstanding issues include:

- grace periods – namely the periods after public disclosure of the product when you can still seek design registration (Article 6)
- whether a procedural treaty should include substantive law (e.g. proposal for term of protection in Article 9bis)
- the option for an office to require disclosure when a designer has utilised any traditional knowledge, traditional cultural expressions or biological/genetic resources in the design (Article 3)
- whether IP offices should be required to provide an electronic system for design applications (Article 9ter and 9quater)
- the assistance WIPO should provide to developing countries (e.g. technical assistance and capacity building for the ratification of the treaty) (Article 22).
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We make the following comments on these items.

(a) grace periods – namely the periods after public disclosure of the product when you can still seek design registration (Article 6)

We have no further comments on this.

(b) whether a procedural treaty should include substantive law (e.g. proposal for term of protection in Article 9bis)

We note that Article 9bis states:

Article 9bis8: "A Contracting Party shall provide a term of protection for industrial designs of at least 15 years from either: (a) the filing date, or (b) the date of grant or registration."

We note that Australia is not consistent with this article and the term of a registered design will need to change. We agree that Australia should be consistent with Article 9bis and the proposal of a 15-year term.

However, the question posed by IP Australia states: whether a procedural treaty should include substantive law (for example the term of protection).

We submit that any other changes to substantive law should not be agreed upon in a Treaty but rather this treaty is restricted to procedural and administrative aspects only.

The second point from IP Australia should only be discussing the term and no other substantive law changes without further consultation.

(a) the option for an office to require disclosure when a designer has utilised any traditional knowledge, traditional cultural expressions or biological/genetic resources in the design (Article 3)

We are hesitant to have a traditional knowledge disclosure requirement for designs.

Designs, as with other aesthetic creations, are often heavily influenced by experiences, including exposure to different cultures. It would not be unusual for a design to include elements of artistic expression from many different cultures - possibly without the designer even realising.

We believe it would often be impracticable for a designer to correctly list all traditional cultural expressions from which they have taken design inspiration. For example, some argue that hooped earrings commonly worn by women across the globe for decades are the traditional cultural expression of certain indigenous groups in the Americas. Others think that hooped earrings are simply a common fashion choice for earrings.

Similarly, spirals may be considered to come from Scotland, sometimes from Scandinavia, and sometimes from Maori carvings for example, and sometimes the use of spirals may be a simple uninfluenced design choice because spirals, for example, are very well known.

We think it impractical to list traditional cultural expressions for design applications and such a requirement would place an undue burden on design applicants.

If such disclosure requirements are to be required, we submit that any incorrect or incomplete disclosures should not be met with a penalty and should not disadvantage the design owner as the very nature of correctly identifying traditional cultural expressions may be fraught for some designs.

(b) whether IP offices should be required to provide an electronic system for design applications (Article 9ter and 9quater)

No further comments on this.

(c) the assistance WIPO should provide to developing countries (e.g. technical assistance and capacity building for the ratification of the treaty) (Article 22).

No further comments on this.

Do not hesitate to contact us if you wish to discuss any matter in more detail.

Yours faithfully,
New Zealand Intellectual Property Attorneys Inc.