



FÉDÉRATION INTERNATIONALE DES CONSEILS  
EN PROPRIÉTÉ INTELLECTUELLE

INTERNATIONAL FEDERATION OF  
INTELLECTUAL PROPERTY ATTORNEYS

INTERNATIONALE FEDERATION  
VON PATENTANWÄLTEN

## Resolution of the Executive Committee, Rome, 6-9 November 2011

### “Reinstatement of Rights in Industrial Designs”

**FICPI**, the International Federation of Intellectual Property Attorneys, broadly representative of the free profession throughout the world, assembled at its Executive Committee held in Rome, Italy, from 6 to 9 November 2011, passed the following Resolution:

**EMPHASISING** the necessity to maintain a standard of excellence of practice for IP attorneys in order to minimize the circumstances in which a loss of rights might occur,

**RECOGNISING** however that despite the use of normally-satisfactory monitoring systems, some isolated mistakes can occur which result in failure to comply with a time limit vis-a-vis an IP Office,

**FURTHER RECOGNISING** the increasing importance of design protection in promoting innovation and in combatting counterfeiting,

**WELCOMING** the fact that draft Provisions on Industrial Design Law and Practice under consideration by the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (“SCT”) in document SCT/26/2 include Article 13 *Reinstatement of Rights After a Finding by the Office of Due Care or Unintentionality* based on Article 13 of the Patent Law Treaty,

**OBSERVING** however that some delegations at the 26th Session of the SCT called for Article 13 to be made optional for States that apply the proposed Articles, possibly on a basis similar to the Singapore Treaty on the Law of Trademarks,

**NOTING** that a loss of rights in an application or registration will generally be fatal to industrial design protection because of the requirement of novelty for a design, in contrast to a trademark which may be capable of re-filing,

**WHILE RECOGNISING** that any provisions on reinstatement of rights should be subject to certain exclusions that safeguard the legitimate interests of third parties,

**URGES** the WIPO Member States at the SCT to retain *Reinstatement of Rights After a Finding by the Office of Due Care or Unintentionality* as a remedy available in all participating States.



### **Article 13**

#### ***Reinstatement of Rights After a Finding by the Office of Due Care or Unintentionality***

(1) *[Reinstatement of Rights After a Finding by the Office of Due Care or Unintentionality]* A Party shall provide that, where an applicant or holder has failed to comply with a time limit for an action in a procedure before the Office, and that failure has the direct consequence of causing a loss of rights with respect to an application or a registration, the Office shall reinstate the rights of the applicant or holder with respect to that application or registration, if:

- (i) a request to that effect is made to the Office in accordance with the requirements prescribed in the Regulations;
- (ii) the request is filed, and all of the requirements for the said action, in respect of which the time limit applied, are complied with, within the time limit prescribed in the Regulations;
- (iii) the request states the reasons for the failure to comply with the time limit; and
- (iv) the Office finds that the failure to comply with the time limit occurred in spite of due care required by the circumstances having been taken or, at the option of the Party, that any delay was unintentional.

(2) *[Exceptions]* There shall be no requirement to provide for the reinstatement of rights under paragraph (1) with respect to the exceptions prescribed in the Regulations.

(3) *[Fees]* A Party may require that a fee be paid in respect of a request under paragraph (1).

(4) *[Evidence]* A Party may require that a declaration or other evidence in support of the reasons referred to in paragraph (1)(iii) be filed with the Office within a time limit fixed by the Office.

(5) *[Opportunity to Make Observations in Case of Intended Refusal]* A request under paragraph (1) may not be refused, totally or in part, without the requesting party being given the opportunity to make observations on the intended refusal, within a reasonable time limit.

#### **Rule 11 (Extract)**

(2) *[Time Limit Under Article 13(1)(ii)]* The time limit for making a request, and for complying with the requirements, under Article 13(1)(ii), shall be the earlier to expire of the following:

- (i) not less than one month from the date of the removal of the cause of failure to comply with the time limit for the action in question;
- (ii) not less than 12 months from the date of expiration of the time limit for the action in question, or, where a request relates to non-payment of a renewal fee, not less than 12 months from the date of expiration of the period of grace provided under Article 5bis of the Paris Convention.