Banner Witcoff Submits Comments on the World Intellectual Property Organization Riyadh Design Law Treaty

Banner Witcoff responded to the United States Patent and Trademark Office (USPTO) request for input on the World Intellectual Property Organization (WIPO) Riyadh Design Law Treaty (RDLT) adopted by WIPO Member States in Riyadh, Saudi Arabia on November 22, 2024. Specifically, the comment submitted addressed whether the United States should become a party to the RDLT and any impacts from doing so.

The firm's full comment, authored by Richard Stockton and Bradley Van Pelt, is below.

1. Should the United States become a party to the RDLT?

We believe that the U.S. should become a party to the Riyadh Design Law Treaty ("RDLT"). Moreover, when implementing the RDLT, the U.S. should not take any reservations.

The RDLT is a great step forward in simplifying and harmonizing design protection practices worldwide. The USPTO should be commended for working very hard to advocate for and negotiate the RDLT. The RDLT will reduce administrative divergence among national systems while preserving substantive domestic law in each jurisdiction adopting the RDLT. Accordingly, widespread implementation of the RDLT will improve international harmonization in design filings. This is critical because many U.S. companies frequently file for international protection for designs. Implementing similar or harmonized filing requirements, such as requirements for obtaining a filing date, mandatory grace periods, and relief mechanisms for missed deadlines or mistakes will decrease transaction costs for applicants. Moreover, the RDLT will strengthen design rights internationally, and therefore strengthen U.S. companies financially by protecting their investments in international markets.

While large multinational U.S. companies will benefit from the RDLT, individuals and small and medium enterprises will benefit too. In fact, individuals and small and medium enterprises who lack the resources to hire sophisticated design counsel may bear the brunt of the current landscape of diverging procedural formalities in design filings across the different jurisdictions. Sometimes, these "gotchas" result in total loss of design rights, and again individuals and small and medium enterprises might be most susceptible to those "gotchas." But by countering these "gotchas" with a framework for harmonizing design practices worldwide, the RDLT will really help individual inventors and small and medium enterprises too.

A few specific parts of the RDLT deserve special comment. First, the "closed list" approach of Article 4, will limit unnecessary documentation requirements and unnecessary costs internationally. And the RDLT in its final form did not include any mandatory disclosure requirement for genetic resources, traditional knowledge and traditional cultural expressions (as was periodically proposed during the 20-year period leading up to the RDLT). Instead, the compromise provision of Article 4(2) optionally allows no more than what 37 CFR 1.56 already requires, namely the disclosure of certain material information of which an applicant is aware—regardless of whether it relates to, e.g., traditional knowledge and traditional cultural expressions.

Second, the deferred publication of designs contemplated by Article 10 is advantageous to applicants of all variety in that it affords applicants the ability to avoid unveiling products through design filings, while also adequately protecting their designs and coordinating marketing efforts and public release without the product being disclosed through design registrations or filings. While existing USPTO practices technically meet the requirements for Article 10, we believe a formal means for deferment of publication would greatly further the interests and goals of U.S. design law and practice.

Third, although perhaps not required to join the RDLT, current USPTO drawing requirements should be clarified to put photographs on equal footing with line figures. Arguably, the MPEP and perhaps even the CFR suggests that photographs are only accepted in certain circumstances. But the RDLT, in Rule 3, states that the applicant has sole discretion to submit either line figures or photographs, provided of course that other requirements, e.g., those relating to sufficiency of disclosure, are met. Although not required for RDLT joinder, we believe the USPTO should also continue to investigate accepting alternative means for representing designs in the drawing (as contemplated by Rule 3), such as allowing submission of three-dimensional rendering files. Such files typically contain significantly more information and will make prosecution more efficient for applicants and the USPTO, i.e., by reducing the occurrence of sufficiency of disclosure-type rejections under 35 USC 112.

In joining the RDLT, the U.S. should not take any reservations. As stated above, the USPTO played a major role in preparing and negotiating the RDLT, and it largely, if not completely, accords with existing U.S. law and practice. Moreover, the U.S. should not take any reservations to send a clear message that the RDLT "as is" is an ideal framework for a global standard. In particular, Article 7 goes beyond the Paris Convention and other precedents in enshrining a one-year grace period as a global standard for excusing applicant prefiling disclosures from novelty assessments. The Article 7 grace period makes sense and is already widely recognized by many jurisdictions. But some major jurisdictions, including China, still do not have a one-year grace period for applicant disclosures (besides at certain trade shows). And those jurisdictions have the option to take a reservation as to Article 7. But as Article 7 is one of the most significant parts of the RDLT (whose worldwide adoption would completely change the practice of obtaining multijurisdictional design protection), it is hoped that reservations will not be taken. To the point, if the U.S. takes certain reservations, it might encourage other parties to take reservations too—including as to the grace period—and that will put holes in the RDLT that will require significant patchwork later. It is better to move forward with the entire RDLT now. In summary, the RDLT is a coup for design practice in the U.S. and worldwide. The USPTO has done an outstanding job over the past two decades of developing, advocating for and negotiating the RDLT, despite intransigence and other difficulties from some parties. It is now time for the U.S. to join the treaty it worked so hard to implement, and it should do so without any reservations. This will greatly help individuals and U.S. companies large and small reap the rewards of their endeavors.

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