

Hague — A New Consideration For US Design Applications

Law360, New York (May 12, 2015, 10:23 AM ET) --

Starting May 13, significant changes in the law of design patents come into effect. First, the U.S. and Japan both join the Hague Agreement for the Registration of Industrial Designs. Second, all U.S. design patents filed May 13 or later will have a 15-year term from issuance. This is an increase from the current 14-year term. Third, starting May 13, applicants are no longer required to file a petition and pay fees to include color drawings in U.S. design applications.

Of these changes, the U.S. joining the Hague Agreement is likely to have the greatest impact. The Hague Agreement is an international treaty that establishes a simple filing procedure for filing a design patent application that can be transmitted to many countries worldwide. The Hague Agreement does for design patents what the “Common Application” does for college applications. With the Common Application, a student can fill out one college application that is accepted at over 500 different colleges. The online application form helps ensure that the required information is provided before it can be submitted to the designated member colleges. It can also help coordinate the submission of supplemental information that may be required for a particular college. Once a college receives the application, it will be reviewed according to the institution’s particular standards for admission.

Similarly, the Hague Agreement harmonizes basic filing requirements for design patents and industrial design registrations across member countries. This helps avoid complexities related to, for example, foreign language translations, basic drawing requirements, fees, and deadlines for renewal.

The Hague Agreement establishes minimum mandatory content for all applications, to which individual countries may add additional requirements. The basic mandatory content includes: applicant name, figures, indication of product within a single Locarno Classification (which is also used for trademark applications), and number of designs or embodiments. Country requirements for applications that designate the U.S. include: a claim, inventors and an oath or declaration.

Applicants may file Hague applications in their home country via their national patent office or with the World Intellectual Property Organization, which administers the treaty. WIPO performs an initial formalities review to ensure that the required content has been provided. One benefit of this review is that after acceptance by WIPO, the application should not be rejected based on formalities in the



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designated countries. This includes drawing formalities such as drawing quality and drawing conventions.

Once all of the basic requirements for filing have been met, WIPO publishes the application and transmits it to the countries previously designated by the applicant. The application is then registered or examined according to each particular country's substantive design patent or industrial design laws. Thus, just like the Common Application, whether the applicant gets an acceptance letter or not will depend on whether the design meets the substantive requirements of a particular country.

Hague applications have access to over 75 countries, either directly or through a member intergovernmental organization such as the European Union. Member countries include, for example, South Korea, Japan, Switzerland and Singapore. Notable nonmember countries include Australia, Canada, China and Russia. These countries are at different stages in the process of conforming, or debating whether to conform, their laws to be able to join the Hague Agreement.

Benefits and Drawbacks of the Hague Agreement

There are many benefits of using the Hague Agreement, though certain of the benefits are only realized when multiple embodiments are included and/or when filing in a number of different countries.

One of the main benefits and objectives of the Hague Agreement is reducing the complexity of filing an application in multiple countries. A single application can be filed for all member countries, rather than the current process of filing applications in every desired country. Because of this change, there may be less need to involve foreign attorneys, with a resulting cost savings. A local attorney would be required only in the event that an office action is issued in connection with an application. As many countries simply register designs without a thorough examination, similar to the way copyright applications are examined in the U.S., these cost savings can be significant. Further, formalities such as address change, ownership transfer, and payment of annuities can be handled directly through WIPO.

On the flip side, filing an application using the Hague Agreement may increase the risk that an application does not meet the specific requirements of a particular country. A foreign applicant, for example, may designate the U.S. without understanding U.S. standards for examination. Figures acceptable in a foreign country may not be proper in the U.S. and may be rejected for not enabling a person skilled in the art to make and use the product. To overcome the rejection, certain features may need to be disclaimed and in the worst case, the application may have to be abandoned. This is true now as well, but foreign applicants typically hire a licensed local practitioner to file the application for them. This allows the local practitioner to provide input and potentially correct defects in the application prior to filing. Applications that designate the U.S. under the Hague Agreement may not get the benefit of this prefiling review.

Other aspects of filing strategy can benefit from the input of a local practitioner. For example a Hague application can include up to 100 different embodiments within a single Locarno classification. Since the filing fees are based on the number of embodiments, the number of figures, and the number of words over 100 in the application, the cost (calculated in Swiss Francs) can quickly increase for large filings. A licensed practitioner can assist the applicant in devising a cost effective filing strategy.

It is also important to note that designating multiple countries may increase the complexity of the application. The Hague Agreement establishes mandatory content for the application, and certain countries have additional content required to enter that country. The basic mandatory content includes:

applicant name, figures, indication of product, and number of designs (i.e., embodiments). Country requirements for U.S. designated applications include: a claim, inventors and an oath or declaration. If the country specific requirements are not met, either at the time of filing or shortly thereafter, the application will lose its designation for the country in question. In addition, if the mandatory contents are not provided initially, this may prevent the application from obtaining a filing date.

Another feature of the Hague applications can be both a benefit and a drawback. Hague applications are published at six months from filing or from the filing of any earlier priority application. Applicants can request immediate publication or defer publication for up to 30 months. Deferral of publication is only available for certain countries and is not available if the U.S. is designated. For example, if the E.U. is designated the applicant can defer for the full 30 months. But, if the U.S. and the E.U. are designated, publication cannot be deferred.

For applications that enter the U.S., publication creates beneficial provisional rights. As U.S. design applications do not publish before grant, provisional rights have not been previously available. This will continue to be true of U.S. design applications which are not Hague applications. But published Hague applications will have provisional rights similar to published utility patent applications. This will allow applicants to put potential infringers on notice of the published application, and potentially obtain damages from the date of notification. As many design patents are not amended during prosecution, provisional rights may turn out to be a far more powerful tool for design patents than they have been for utility patents.

At the same time, publication of a Hague application also means that the disclosure is not held confidential by the U.S. Patent and Trademark office. This may be a significant drawback for some applicants. This may be especially true for industries with long lead times from product development to market. Where a utility application does not publish for 18 months, a client may be surprised to find that a Hague application publishes after only six months. Of course, if the U.S. and certain other countries are not designated, the publication can be delayed for up to 30 months.

The Hague Agreement offers applicants a useful option when filing international applications. In addition to providing a simplified filing process for foreign protection, applicants may further be able to reduce the expense of filing and maintaining the application across jurisdictions. One of the biggest benefits for applications that designate the U.S. is the availability of provisional rights arising after publication. This benefit alone is a reason for applicants to consider Hague applications when developing filing strategies for designs.

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