U.S. Introduction to the Hague System

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Introduction:

For many years, non-U.S. parties have taken advantage of the Hague System to register their design patents, an important part of strengthening and differentiating your product and brand. On May 13, 2015, the Hague Agreement Implementation of the Patent Law Treaties Implementation Act of 2012 (PLT) went into effect in the U.S. As a result, the U.S. became a member of the Hague System, an international system of registration for design patents (also referred to as "industrial designs" internationally). Now, U.S. applicants wishing to register a design patent in the U.S. and abroad may submit a single application and pay a single fee to register such design patent in all or some of the 63 other Contracting Parties (both countries and intergovernmental organizations) that participate in the Hague Agreement. The Hague System will also allow national and international applicants to apply for a design patent in the U.S. through the World Intellectual Property Organization (WIPO).

There is clear demand for design patents by U.S. entities, whom will benefit from a simplified and less expensive system. According to WIPO statistics, 8.2% of design applications filed worldwide are from applicants in the U.S. Notable Contracting Parties to the Hague System include the European Union, African Intellectual Property Organization, Switzerland, South Korea, Japan and Turkey (some countries are notably absent, including China, Russia, Canada and Israel). To protect and strengthen your design across all markets coordinated national filings may be required.

The Hague Agreement & How it Works:

In order to qualify for the Hague Agreement applicants must (i) be a national of a Contracting Party to the agreement, (ii) maintain residence in the territory of the Contracting Party; and (iii) habitually reside within that state. Applicants who do not meet such criteria must file at a national or regional level at the appropriate office.

The international design application ("IDA") process starts when a designated national office, like the USPTO, receives an IDA and the transaction payment necessary to cover, among other things, the WIPO filing fee. When the application reaches WIPO, it is reviewed to determine compliance with prescribed formal requirements. Some of the formal requirements, among others, are the quality of the reproduction of the industrial design, the payment of required fees and completion of the application form. If there is a deficiency in the application, WIPO will inform the applicant and who may correct the defects. The International Bureau (IB) of WIPO will then record the design on the international register and publish the design in the International Design Bulletin and inform relevant Contracting Parties within the Hague System that there is an impending IDA in their jurisdiction. When the USPTO receives an IDA, it is then responsible for examining the application under the substantive criteria. A U.S. design patent can cover either a 2D or 3D artistic element that is an integral part of an article of manufacturing. Some well-known examples of design patents include the shape and small design of the Mini Cooper car, the shape of the classic Coca-Cola glass bottle, and the cylindrical shape of the Dyson vacuum. In order to be patentable in the U.S., the design must meet the minimum requirements of (i) ornamentality, (ii) novelty, (iii) non-obviousness, (iv) enablement and (v) definiteness (i.e. fixed and replicable.)

If the design is not refused by the USPTO or other designated office within the prescribed time

limit then the international registration automatically grants protection to that international design in the Contracting Party. International design registrations last for a period of 5 years, but may be renewed twice after the initial registration for a maximum of 15 years.

What's New:

Beyond streamlining international patent applications and associated fees through a single registration system, the PLT has provided several new features as well.

- The term of U.S. design patents has increased from 14 (fourteen) years from issuance to 15 (fifteen) years.
- The PLTA now allows U.S. domestic priority and foreign priority entitlements arising from the IDA.
- The U.S. patent system has gone from a "first-to- invent" system to a "first inventor-to-file" (FITF) system. A patent application with at least one claim having an effective filing date on or after March 16, 2013, will be examined under FITF provisions
- The PLT provides for the first time provisional rights resulting from publication of the international design application designating the U.S., entitling a patent owner to a reasonable royalty for any person who makes, uses, offers for sale or sells in the U.S. the claimed invention, or imports the invention into the U.S., during the period between publication of the patent application and the date the patent issued.

Conclusion:

One item applicants should be aware of is that though the Hague IDA allows a maximum of one hundred (100) designs to be included in the application under one Locarno Class, some contracting parties (such as the U.S.) have a unity of design requirement. Division applications and additional fees may be required to register all of the designs in such jurisdictions. Overall, it appears that the ratification of the Hague System will be advantageous to U.S. organizations and those looking to register industrial designs in the U.S. and abroad thanks to the cost savings and improved efficiencies in the application process.

For more information or to discuss trademarks or design patents, contact Sean D. Detweiler.