



## Intellectual Property ADVISORY ■

**MAY 6, 2015**

### Developing Strategies for International Design Protection

The USPTO's final rules implementing the Hague Agreement's international application system for design patents are now here, but taking advantage of the new design protection regime requires careful planning and consideration.

On April 2, 2015, the United States Patent and Trademark Office (USPTO) published its final rules package implementing the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs ("the Hague Agreement"). As detailed in a previous [Alston & Bird IP Advisory](#), the Hague Agreement is an international treaty that allows the filing of international design applications eligible for protection in all of the now 64 member states and intergovernmental organizations, including the European Union. Taking advantage of the new system, however, will require more than ticking boxes.

#### **Beginning May 13, 2015: One Application for International Design Protection**

The new USPTO rules take effect on May 13, 2015, when new international design applications can be filed with the USPTO. The application can designate any or all of the 64 [Hague Agreement members](#), which include the European Union, South Korea and—also starting in May—Japan. In addition to its global reach, an application can include up to 100 industrial designs, provided they are in the same international design classification and can be filed in a single language: English, French or Spanish.

Procedurally, the USPTO will act as an application receiving office for the World Intellectual Property Organization (WIPO). Anyone who is a national of the United States—or who has a domicile, habitual residence or industrial or commercial establishment in the United States—can file indirectly through the USPTO's electronic filing system. Upon receiving an international design application, the USPTO will forward the application to WIPO's International Bureau, which will review the application for compliance with the applicable formal requirements under the Hague Agreement. If the requirements are met, the International Bureau will register the design, publish the registration and forward a copy of the application to each designated office for examination. However, if any co-applicant does not have a nexus with the United States or another country that is a member of the Hague Agreement, an international design application cannot be filed with WIPO, either directly or indirectly through the USPTO. All applicants must individually be entitled to file an international design application under the Hague Agreement.

Although international design applications are still subject to regional examination in each designated state's office (as well as the examination and issue fees imposed by each designated state), the promise of the Hague system

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has been a single-application, single-language system to reduce the time and expense associated with application preparation and filing. However, filing an industrial design application under the Hague Agreement is not a simple matter. And taking advantage of the Hague international design application filing system will require detailed strategy and counseling to ensure the originally filed application appropriately addresses numerous potential issues for all designated states.

## **Challenges & Strategies: Securing Global Protection Under the Hague System**

**Different Requirements for One Application.** While the USPTO's implementation of the Hague Agreement has forged a simpler, streamlined filing system for international design applications, the requirements for protection in each designated state remain the same. Each international design application will still be examined in the office of each designated state in accordance with that state's specific regulations for industrial designs. Many countries in the Hague system have nonsubstantive examination systems with only formal requirements for registration. By comparison, the United States has a substantive examination system, as well as formal and drawing requirements. As a result, international design applications must be crafted to meet the different requirements of any designated states.

As one example, the drawings in an application may be required to meet a variety of standards in different member states. In Europe, grayscale photographs are permissible. In the United States, black and white line drawings are preferred. South Korea does not permit surface shading in its drawings, while the United States requires it.

Other differences exist as well. International design applications designating the United States must include a claim and be filed with an inventor's oath or declaration (requirements not made in other regions). Certain other countries require the application to include a brief description of the industrial design. The absence of any such requirements in a designated state will result in rejections, delay and further expense to render the application suitable in a given region. For this reason, detailed familiarity with the specific regional requirements of any designated state will be critical to preparing a successful international design application.

**"Global" Protection ... But Only in Some Countries.** Applicants must also be mindful that international design applications under the Hague Agreement do not facilitate truly worldwide design protection. The Hague Agreement's membership lacks some of world's largest economies, including China, Canada, Brazil, Australia, Russia, Taiwan, Israel and Singapore. Although the implementation of the Hague system by the United States—as well as Japan, South Korea and Europe—is expected to inspire other nations to join, applicants should be aware of the countries that still require direct filing for industrial design protection.

An applicant seeking protection in both member and nonmember states, for example, must consider whether an application under the Hague system is advantageous in their situation. While protection in the member states could be sought in part via an international design application, separate applications in the nonmember states will remain necessary. The question for the applicant then becomes whether, and how, improved efficiency under the Hague Agreement can be achieved.

**A Learning Curve for Improving Efficiency.** For applicants considering filing under the Hague system, awareness of the various regional regulations and member countries is only half the battle. Applicants must also become adept at preparing effective Hague international design applications in an efficient manner and recognizing when an international design application might not be the most efficient route for protection of a design. An international design application filed under the Hague Agreement has the potential for several efficiencies, including potential cost efficiencies.

Pricing for certain aspects of international design applications can add up to costly filing fees. For example, each design included in an international design application requires additional fees. And, unlike the PCT international utility application, each designated state for an international design application requires additional fees. There are several other additional charges that may apply for various other factors, such as excess pages. Trying to satisfy the numerous drawing regulations of multiple designated countries may result in cumulative fees much higher than expected.

Preparation of international design applications by applicants and law firms accustomed to filing requirements of their country, but unfamiliar with requirements of all designated states, is likely to create many problems. If an international design application is prepared in accordance only with the local jurisdiction, it may not be possible to make changes, additions or corrections to accommodate requirements of other designated states. For example, Japan may permit an applicant to modify drawings to add unclaimed environment of a two-dimensional icon for a display screen, but the United States will consider such amendments to the drawings as introduction of new matter. Many applications filed by applicants and law firms not accustomed to the strict requirements of the United States may result in incurable defects for design protection in the United States or possibly severely limit the options or scope of protection in the United States. It is important that requirements of all designated states are taken into consideration before filing an international design application to prevent rejections, delay and possibly worse problems during prosecution, all of which will negatively impact the efficiency of using the Hague system for filing an international design application.

International design applications will also be subject to restriction or unity of invention practice in each designated state. Japan, for example, treats multiple designs in an international design application as multiple, single-design Japanese design applications for examination purposes. South Korea permits multiple designs in a single design patent application. Applications designating the United States must still comply with U.S. restriction practice and the single claim requirement for U.S. design applications. It follows that an international design application including a large number of industrial designs (up to 100) could require numerous domestic U.S. divisional applications in order to protect the full scope of its disclosure. The number of designs and embodiments included in an international design application will affect not only costs, but also different treatment and examination in different countries.

Applicants will need to evaluate whether satisfying all of the requirements for a given group of countries will remove the efficiency of filing a Hague application.

## **More Protection: Extended Patent Term and Provisional Rights**

To harmonize U.S. laws with the Hague Agreement, all U.S. design patents filed on or after December 18, 2013, now have a term of 15 years from their date of issue (increased from 14 years). The extended term will apply to all issued U.S. design patents, regardless of whether they were filed directly in the U.S. or under the international design application system.

Additionally, the comments to the final rules make clear that the publication of international design applications by WIPO will now entitle the applicant to provisional rights under 35 U.S.C. § 154(d). This publication could prove to be a powerful tool in discouraging would-be infringers and could even justify strategic Hague filings to obtain provisional rights. Even with the challenges presented by the Hague system, provisional rights will be a strong incentive for many applicants to file international design applications.

The final USPTO rules can be found here: <http://www.gpo.gov/fdsys/pkg/FR-2015-04-02/pdf/2015-06397.pdf>.

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