Seminar on the Hague System for the International Registration of Industrial Designs

USPTO FEEDBACK

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June 23, 2016
The Hague Agreement

- **May 13, 2015:** Hague Agreement in Effect in U.S.
  - Title I of PLTIA
  - USPTO Rules

- **June 20-22, 2016:** WIPO Hague Working Group
  - Sixth Session
The Hague Agreement

• Filing Statistics...


≈3000

4140
The Hague Agreement

• Helpful Information for Applicants & Representatives
  – USPTO Hague Implementation Page
    – http://www.uspto.gov/patent/initiatives/hague-agreement-concerning-international-registration-industrial-designs#tips
  – WIPO Hague System Page
The Hague Agreement

- USPTO Page
  - Forms
  - Fees
  - Resources
  - FAQ
  - Tips for Filing
  - Contacts

Hague Agreement Concerning the International Registration of Industrial Designs

Information concerning the Hague system, including geographic coverage and a guide for users, is available at WIPO's Web site http://www.wipo.int/hague/en/.

- International Design Application Forms
- Fees
- Resources
- Frequently Asked Questions
- Tips for Filing New International Design Applications
- Contact Us

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FILING AN INTERNATIONAL DESIGN APPLICATION

**Question HA1000:** Where can I file an international design application?

An international design application may be filed either directly with the International Bureau of the World Intellectual Property Organization (WIPO) or indirectly through the office of the applicant’s Contracting Party. The USPTO serves as an office of indirect filing for applicants having a sufficient connection to the United States. See Question **HA1020** for further information regarding filing an international design application through the USPTO. Please note that a foreign filing license may be required to properly file an international design application directly with the International Bureau. See 35 U.S.C. 184. WIPO provides an electronic filing system for filing international design applications. Likewise, international design applications can be filed electronically through the USPTO via EFS-Web. International design applications can also be filed in paper with either WIPO or the USPTO, though additional WIPO publication fees may apply for paper submissions. See Question **HA4000** for further information concerning fees.
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Tips for Filing New International Design Applications

IN GENERAL

1. Deciding where to file

U.S. applicants should consider whether to file the international design application through the USPTO or directly with the International Bureau (IB) based on their specific circumstances. Filing the application directly with the IB avoids having to pay a transmittal fee to the USPTO and enables the IB to perform a formalities review earlier, which may be important for applicants wanting immediate publication or a certified copy of the international design application quickly. In addition, for applications filed through the IB’s electronic filing (E-filing) interface on or after March 30, 2016, applicants will have the ability to send corrections of irregularities or defects (including corrected reproductions and documents) electronically to the IB via the E-Filing Portfolio Manager. See http://www.wipo.int/edocs/hagdoc/en/2016/hague_2016_5.pdf. The IB’s E-filing interface also provides for electronic entry of application data, thus eliminating the need for a separate DM/1 form, and the entered data is validated in real time to minimize errors in the application submission. Furthermore, filing through the USPTO is not possible if each applicant does not have at least one of a U.S. nationality or, a domicile, habitual residence, or real and effective industrial or commercial establishment in the United States.

It is important to note, however, that a foreign filing license may be needed to file an international design application directly with the IB. In addition, unlike filing an international design application through EFS-Web, reproductions in PDF format are not accepted by the IB’s E-filing system.

2. Ensure that applications filed through the USPTO meet the conditions for transmittal to the International Bureau (IB)

Even if the application contains, upon filing with the USPTO, all elements required under the Hague Agreement for a filing date, entitlement to the USPTO receipt date as the filing date is contingent upon the IB receiving the application from the USPTO within six months of the USPTO receipt date. See Hague Agreement Rule 13. The USPTO will not transmit the application to the IB if the transmittal fee has not been paid or the DM/1 application form fails to indicate, for each applicant, at least one of a U.S. nationality, or a domicile, habitual residence, or real and effective industrial or commercial establishment in the United States. (Box 2 of the DM/1 form). In addition, for each applicant, the United States must be indicated as the “applicant’s contracting party” (Box 3 of the DM/1 form).
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Considerations for Applicants

- Reproductions
- Description
- Creator
- Single Design
- Priority Claims
- Duty of Disclosure
- 1st Communication from USPTO
Considerations: Reproductions

• Fully disclose the claimed design
  – Full disclosure for each separate design
  – No fixed requirement for # of views
  – Orthogonal & perspective combos useful
  – Avoid ambiguity in reproductions
    • Consistent views
    • Clearly represent claimed subject matte
      – not left to conjecture
      – (e.g., convex vs concave)
Considerations: Description

- **Figure Descriptions are helpful:**
  - DM1 Form Box 9 & 10

  The broken line showing of the remainder of the shoe is for illustration purposes only and forms no part of the claimed design.

**DESCRIPTION**

FIG. 1 is a perspective view of a portion of a shoe upper showing our new design;

FIG. 2 is a side elevational view of one side of the portion of a shoe upper shown in FIG. 1;

FIG. 3 is a front elevational view of the portion of a shoe upper shown in FIG. 1;

FIG. 4 is a rear elevational view of the portion of a shoe upper shown in FIG. 1; and,

FIG. 5 is a top plan view of the portion of a shoe upper shown in FIG. 1.
Considerations: Creator

• Creator is a person(s).

• Creator is the designer(s) (inventor(s)).
Considerations: Single Design

• Only can claim **single design** in design patent.

• Refusal
  – if more than one patentably distinct designs in international registration.

• Non-patentably distinct designs
  – can be kept together as “embodiments” of the one design
Considerations: Priority

• Copy of Certified Priority Document
  – Must be filed with USPTO to perfect priority claim.

• When?
  – Before payment of second part designation fee (issue fee).

• Who?
  – Pro se creator (inventor) or representative registered to practice before USPTO.
Considerations: Duty of Disclosure

- Creators, applicants, representatives, etc., have an affirmative duty to provide certain information to USPTO.
  - “Material to Patentability”
    - 37 CFR 1.56
- Information Disclosure Statement (IDS)
Considerations: 1st Communication

• **USPTO Filing Receipt:**
  - Frequently first communication from the USPTO.
  - Indication that USPTO has received the international registration pursuant to its designation and role as a CP.
  - Provides info regarding U.S. identification of international registration.
  - Typically, no response needed.
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