

# International Registration of Industrial Designs: The Hague System Post 2015

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# Agenda

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- An overview of International Protection for Designs
- Mechanics of the Hague System
- Status of the Hague System

# Hague Design Patent System

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- How familiar are you with design patents?
  - x = Very Familiar
  - x = Somewhat Familiar
  - x = What's A Design Patent?
- Can I file a Provisional design patent application?
  - x = Sure; PCT rules are still in place
  - x = No; PCT rules are still in place
  - x = No clue

# What the Hague?

## Comparison with PCT and Madrid

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- Like PCT and Madrid: a procedural treaty
- Like Madrid, unlike PCT: a registration treaty
- Unlike Madrid – it's a one-stop-shop
  - Filing directly with the WIPO

# What the Hague?

## Comparison with PCT Practice

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- Hague system
  - Requires the applicant to select the target countries when it files the IDA
  - IB conducts only a formalities examination
    - No examination on the design's merits
    - Formal examination conducted by and in accord with local country's patent office regulations
- PCT practice
  - Allows the applicant to delay selection for 30 months from the earliest claimed priority date
  - International examination phase
    - ISR, IPER, Written Opinion
  - National phase formal examination

# The Hague System Summary

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- Provides U.S. domestic priority
- Term of design patents increases to 15 years (from 14 years) from issuance
- Provides foreign priority - Paris Convention priority must be recognized
- International design applications that designate the US have the same effective filing date as a U.S. national design app.
- Provide provisional patent rights for published international applications that designate the U.S.
  - If issued U.S. design patent is substantially similar to published international application, patent owner is entitled to a reasonable royalty between publication and
- Establishes U.S. PTO as office through which international design applications can be filed

# Hague and Design Inventions in the US

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- The Hague system allows for applicants to include up to 100 designs in a single registration if all of the designs are in the same Locarno class
  - But, in the U.S., a design patent must be directed to a single invention
- U.S. PTO will issue a restriction requirement(s) if more than one patentably distinct design is shown in the drawings
  - Therefore, while the international application may contain many designs (up to 100), divisional applications may be required in the U.S.

# Hague and Design Inventions in the US

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- Recent U.S. Federal Circuit case (*Pacific Coast Marine Windshields, Ltd, v. Malibu Boats, LLC* (Fed. Cir. 2014)) held that prosecution history estoppel does apply to U.S. design patents when figures are cancelled due to a restriction requirement
- In order to avoid prosecution estoppel, and to secure protection for the cancelled figures, divisional applications must be filed directed to the non-elected embodiments



# Hague System – Issues to Consider

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- While Hague Agreement offers a simplified procedure for filing in all member countries, there are some disadvantages
  - Single set of drawings is used in all designated countries
  - Drawing requirements may be different in some countries
  - Local examination process and legal standard remains unchanged
- Advice: Carefully plan and Select countries where product is sold or sourced and consider strengths/issues for enforcement

# Hague System – Issues to Consider

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- U.S. practitioners must prepare filings with knowledge of idiosyncrasies of systems in member countries
  - Number and type of drawing figures and written description requirements vary widely among jurisdictions
  - Loss of novelty provisions may not be available
- Each Country has different standards and requirements of which applicant must be aware

# Hague System – Issues to Consider

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- Examples of Differing Laws
  - Shading; required, or optional
  - Grace periods
  - Numbers of required views
  - Portion Practice (Broken Lines)
  - Multiple embodiments
  - Color images, photos
  - Statement of novelty and/or usage
  - Functionality and Hidden-in-use
  - Tests for infringement / validity
  - Statutory subject matter (Graphical User Interfaces as one example)

# Global Filing Requirements

	Broken lines	Shading	Consistency	Photographs	Views	Terminology	Term	Comments
United States	Allowed	"Should" be used	Consistency required but not exact	Allowed but not in combination with line drawings	Sufficient number to illustrate design	"Design Patent"	14 yrs from grant	Substantive Examination  Rarely rejected over prior art  Disclaimers allowed but limited and often rejected
China	Not Allowed	Not Allowed	Very Strict	Allowed but not in combination with line drawings	Six views minimum: Top, bottom, front, back, left, right.	"Industrial Design"	10 yrs from filing	Possibility for voluntary amendment
EU	Allowed	Allowed	Consistency required but not exact	Allowed but not in combination with line drawings	Up to seven different views. If complex design must include assemble view.	"Community Design"  Filed in Office of Harmonization in the Internal Market (OHIM) rather than EPO	5 yrs. Renewable 5 times for max 25 yrs	Multiple design application acceptable if same class. Ornamentation can be multi-class  Examination – as to conformance with rules  Registration i.e. date of registration is filing date
Japan	Allowed	Not Allowed	Consistency required but not exact	Allowed but not in combination with line drawings	Six views: Top, bottom, front, back, left, right. If recess or protrusion, then sectional views as well	"Design Right"	20 yrs from registration	
Australia	Allowed	Allowed	Consistency required but not exact	Allowed but not in combination with line drawings	No specific requirement	"Design Registration"	5 yrs from priority, renewable for additional 5 yrs for max 10 yrs	No substantive exam, only undergoes formalities check  Post allowance enforcement examination process required to enforce  Can be purely functional
Canada	Allowed	Allowed	Consistency required but not exact	Allowed but not in combination with line drawings	At least one drawing	"Industrial Design Registration"	10 yrs from issuance	

# The Hague System Upsides!

- US applicants can file international applications for design protection in Hague member countries/jurisdictions
- Potential Benefits: avoid some fees (e.g. retaining foreign associates in each country, translation, etc...)
  - avoid multiple filings – one Hague filing automatically starts application in the Hague countries
  - one fee to be paid (although similar total to what would be required if individual applications filed)
  - potentially lowers administrative burden
- Application will publish, which grants provisional rights

# Upsides Continued

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- A cost effective way to get design protection in many countries
- Overcome some shortcomings in national systems due to harmonization
- More simplified process for obtaining foreign design protection
- Refusal or invalidation in one member country based on local substantive examination or litigation does not directly affect parallel registrations/applications in other member countries.

# Welcome to the Dark Side

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- Attorneys will need to know laws in every jurisdiction
- Local associate is now out of the loop
  - + if national or regional office does not substantively examine
- Getting the best design rights
  - Should know the laws in every designated country
  - Minimize challenges for enforcement
- What could happen?
  - Wild Card - One country rejects all designs for lacking novelty with no meaningful explanation
  - Description issues – Potential for estoppel in other countries
  - False sense of security and paying for it
    - Unexamined Registrations

# Strategy Advice

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- Ability to file up to 100 designs per application can provide strategic options for addressing and complying with different jurisdictions' distinctive drawing requirements.
  - Not just for seeking to protect different embodiments of similar designs.
  - Drawings not compatible with a particular jurisdiction's requirements can be canceled upon entry and divisional applications can be used to pursue multiple designs/embodiments in jurisdictions like the US



# USPTO Issues with Hague Filings

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- Shading and section 112 issues
  - Inconsistency and CAD drawings
  - Different from Hague drawings?
- Duty of Disclosure
- Continuation Practice
- Multiple embodiments; multiple designs
  - Patentably distinct?
- Specification / Disclaimer Statement

# Missing in Action

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- Limited membership
  - Many important jurisdictions are not yet part of the system: Brazil, China, Canada, Mexico, Australia, Russia, India
  - These countries require a separate application directly with the respective nation state

# Registered Community Patent

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- For the European Union
- Registration is a mere formality
- Good for 25 years
- Unlimited number of designs in a “multipole application”
- Fewer grounds for invalidation
  - Obviousness is not a ground for invalidation
- However – nullification or invalidation in one country applies to all EU member countries

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Questions?