

## **CLIENT ALERT: Implementation of the Hague Agreement**

Implementation of the Hague Agreement in the United States occurs today, May 13, 2015. The Hague Agreement provides a system for obtaining international industrial design protection in the form of registrations in some jurisdictions, and patents in others (such as the U.S.). The following Client Alert provides a brief summary of important considerations of this new system, along with a few links to helpful websites containing additional information pertaining to participating countries and the filing requirements.

### **Summary of the New Process**

An international design application (IDA) may be filed directly with the International Bureau (IB) of WIPO, or indirectly through the United States Patent and Trademark Office (USPTO) or other member country. In order to file indirectly through the USPTO, an applicant must either be "domiciled" in the U.S., or have a "real and effective industrial or commercial establishment" in the U.S.

The IDA may designate countries that are members to the Hague Agreement. The IB conducts a formalities review before publishing the International Registration (IR) and forwarding the IDA to the designated countries, which will proceed to treat the IDA in accordance with their laws and procedures.

Once received by the USPTO from the IB, an IDA designating the U.S. is treated the same as a direct-filed U.S. design patent application, both requiring a declaration from the Inventor and other formal documents from the inventor and/or applicant (e.g. terminal disclaimers, petitions for submission of Drawings including color, etc.). An IDA that designates the U.S. must include a claim, and the IB will not accord an IR date until a claim is filed. If an IDA does not have a claim, the IB will invite the applicant to submit a claim within a prescribed time.

Similarly, any IDA forwarded to another country must comply with that country's procedures and formalities, for example with respect to formal documents and drawing requirements.

### **Considerations for the New Process, and U.S. Practice Following Implementation**

-There will be an increase from a 14 year term to a 15 year term (measured from issue date) for all U.S. design patents issued after May 13, 2015. This is the clearest advantage of Hague implementation. **This increase in term applies to both Hague filings and direct filings in the U.S.** As before, maintenance fees will also not be required for U.S. Design Patents.

-IDAs are likely to publish prior to grant (two months or so after filing) unless deferral is requested. Provisional rights to obtain royalties for infringement of one embodiment commence upon publication of IDA by WIPO. While this could present a strategic advantage in some circumstances, there are other circumstances in which early publication might be undesirable.



-Significant countries that do not currently belong to the Hague Agreement include China, India, Australia, Mexico, Canada, Hong Kong, and Taiwan.

-Continued Prosecution Applications (CPA) in the USPTO are not permitted for Hague filers. Unlike utility applications, there is no RCE practice for US design applications. As such, eliminating CPAs further eliminates the ability to 1) respond with amendment to a final office action, and 2) enter IDS material under certain circumstances. Instead, a continuation must be filed when 1) and 2) are necessary.

-Up to 100 designs can be filed in the same class in a single IDA; however, it is important to consider:

- Restriction still applies in the U.S. Failure to file divisional applications claiming non-elected embodiments may have adverse legal consequences

- Perhaps more importantly, many non-U.S. countries include a per embodiment/design fee that **must be paid at initial filing**. As such, these 100 designs are not free, and an Applicant will be paying for every embodiment in each of these per embodiment/design countries. For example, if an IDA includes 10 embodiments, five of which include shading (and are intended for the U.S.) and five of which do not include shading, we anticipate that an Applicant designating Korea would have to pay for all 10 embodiments, even though the shaded embodiments must be canceled in Korea. Thus, costs can increase significantly, and sometimes unnecessarily, with multiple embodiments in some countries.

## Our Recommendation

The purpose of the Hague Agreement is to simplify the process for filing a design application in many countries at once. While the new system implemented by the Hague Agreement may simplify the process, there are a few disadvantages to be mindful of.

**First**, the Hague Agreement does not harmonize international design practice. Each individual member country will maintain its current substantive practice, which includes much more variation than is found in its utility patent practice (i.e., patent vs. registration, shading vs. no shading, broken lines vs. no broken lines, etc.).

**Second**, although the Hague Agreement has been compared to the Patent Cooperation Treaty (PCT) for international utility patent applications, it differs in at least one key regard. That is, while the PCT offers a utility Applicant 30 months from the earliest priority filing to decide what member countries should be entered for National Stage filing and prosecution, the Hague Agreement forces a design Applicant to choose every member country to be entered **at the first filing**. The design Applicant must furthermore pay for all countries that are to be entered at this initial filing.

**Third**, while an IDA may be filed without initially retaining local counsel in each country of interest, we do not recommend proceeding without consulting appropriate local counsel. As mentioned above there is a good deal of variation in design practice from country to country, and guidance from local counsel prior to filing can be vital. Indeed, proceeding without such advice can significantly increase the possibility that figures are filed with fatal errors in certain designated member countries.



Thus, the Hague Agreement does not provide a mechanism for simplifying prosecution; and it does not provide any additional time to determine in which countries to file. Indeed, the Hague Agreement reduces the time to make this decision from six months after initial filing to **at initial filing**. Together with the fact that China, India, Australia, Mexico, Canada, Hong Kong, and Taiwan are not presently signatories, we recommend filing a Hague Application with caution.

**Links to Additional Information:**

[Main Features and Advantages of Hague Agreement \(WIPO\)](#)

[Members of the Hague Union](#)

**Contact Cantor Colburn LLP:**

To discuss these changes in relation to your IP, please contact your Cantor Colburn attorney or [Daniel Gibson, Co-Chair of our Design Patent Practice Group](#), for additional information at (860) 286-2929, ext. 1201 or at [dgibson@cantorcolburn.com](mailto:dgibson@cantorcolburn.com).

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