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IPFRONTIERS

International design patent protection on horizon

On Dec. 19, 2012, President Obama signed the Patent Law Treaties Implementation Act of 2012 (Act of 2012) into law. The Act of 2012 serves to implement two patent law treaties: 1) the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs (Hague Agreement) and 2) the Patent Law Treaty.

By signing the Act of 2012 into law, President Obama paved the way for the U.S. to become a member of the Hague Agreement one year after enactment, or when the U.S. provides the World Intellectual Property Organization with its implementing legislation.

Although the president signed the Act of 2012 into law in December, the U.S. Patent and Trademark Office has not yet issued rules of practice in accordance with the Hague Agreement for international design applications. As the Hague Agreement gets closer to implementation, it is expected that the USPTO will issue the rules for filing and examining international design patent applications.

Once implementation of the Hague Agreement is completed, international design applications designating the U.S. will have the same legal effect as U.S. national design applications.

Following implementation of the Hague Agreement in the U.S., applicants will be able to file a single international design application to obtain protection in the selected member countries or regions of the Hague Agreement. The single design application may be filed indirectly through the USPTO or directly with WIPO.

The member countries and/or regional systems, such as the European Union, of the Hague Agreement cover many of the world's markets and as the U.S. works on implementing the Hague Agreement, other countries are also working to become members of the Hague Agreement.

Once the U.S. completes implementing the Hague Agreement, applicants from member countries or regions of the Hague Agreement will be able to file design patent applications in their home country and designate the U.S. for examination of their applications.

Under the Hague Agreement, there are generally two types of design patent systems: non-examination systems and substantive examination systems. In countries with non-examination systems, the applications are not substantively examined by the patent office based on available prior art. Rather, non-examination systems publish and register the design patent applications. Once a design patent is registered or issued in a non-examination system, the applicant obtains the right to enforce their rights against third party infringers.

Countries with substantive examination systems will each individually review the design patent applications under the countries' own laws. For example, in the U.S., design patent applications will be reviewed for novelty and non-obviousness with respect to the available prior art. Under the substantive examination systems, design applications that issue after the substantive examination will become enforceable against infringers upon publication.

As noted previously, a major benefit of the U.S. becoming a member country to the Hague Agreement is that applicants will be able to file a single design patent application either indirectly through the USPTO or directly with WIPO. The ability to file a single application to obtain protection in a number of countries may enable applicants to save money on design patent application filings.

The money savings arise due to the ability to file a single design patent application in English which designates a number of countries and/or regional systems. For example, a single application may save money by decreasing the fees paid to foreign attorneys for translating and filing design patent applications as well as possibly decreasing filing fees paid to foreign patent offices.

The cost savings will increase the more countries an applicant designates. However, if a patent office that performs a substantive examination on international design patent applications issues a rejection, the applicant will likely need to

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engage a foreign attorney to respond to the rejection. Thus, all foreign attorney fees may not be eliminated by the ability to file a single design patent application.

In addition to the ability to file a single design patent application under the Hague Agreement, there are several additional important changes to U.S. design patent law that will come into effect. One such change is that the U.S. design patent term will change from 14 years from issuance to 15 years under 35 U.S.C. §173.

Further, U.S. international design patent applications will be able to claim priority to domestic applications, foreign applications, and prior international design applications. International design patent applications may claim priority to another application filed within six months of the design patent application filing.

Further, international design patent applications will publish similar to how PCT patent applications currently publish and the design application publications will provide for provisional rights. When a design patent issues which is substantially similar to the international design patent application publication, the patent owner may be entitled to a reasonable royalty for any third party which infringed the design patent during the time between the date of publication of the design application and the date the design patent application issued.

When considering whether to file a single international design patent application, it is important to be cautious, as the laws in each designated country must be taken into consideration. For example, under the Hague Agreement an international design

application may include up to 100 designs as long as all the designs belong to the same international classification for industrial designs (i.e., Locarno classification).

However, in some countries, the patent laws include unity of design requirements which may make it so an application cannot include the up to 100 designs that are allowed under the Hague Agreement. For example, under U.S. patent law, design patents must be directed to a single design invention and if the application includes more than one patentably distinct design then the U.S. patent office will issue a restriction requirement.

In addition, when filing a single international design patent application it is important to know the drawing requirements for each designated member country or region. For example, some of the drawing requirements which vary between countries include the number of views needed or allowed and whether shading or broken lines may be included in the figures.

Further, the specification requirements for design patent applications may vary. For example, some countries require more robust descriptions in design patent applications than the descriptions required in other countries.

Once implementation of the Hague Agreement in the U.S. is completed, applicants wishing to file international design patent applications should ensure that the patent attorney filing their applications is well versed in the design patent laws of each country where the applicant is seeking protection in order to ensure costly mistakes are avoided.

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