Advisory

MAY 2015

If you have any questions about this Advisory, please contact:

GREGORY S. ROSENBLATT
203.498.4566
grosenblatt@wiggin.com

JONATHAN D. HALL
212.490.2616
jhall@wiggin.com

U.S. Ascension to the Hague Agreement Concerning the International Registration of Industrial Designs

Design patents allow patentees to protect the aesthetic appearance of articles, in contrast to utility patents that protect the utility of an inventive concept. While the scope of protection provided by a utility patent is delineated by one or more claims, the scope of a design patent is dependent on included drawings.

Effective May 13, 2015, applicants seeking to secure design protection in the United States and then extending that protection to foreign jurisdictions will have an option to file a single, unified industrial design application (IDA). IDAs will be examined by the respective national authorities of participating countries designated by the applicant, each of which will then make a determination whether to issue design protection. The United States is joining other countries in a centralized filing arrangement for design applications that is a rough parallel to the Patent Cooperation Treaty (PCT) process currently available for utility patent applications.

This change is the result of the Patent Law Treaties Implementation Act of 2012 (PLTIA), as well as the recent accession of the United States to the Geneva Act of the Hague Agreement in early 2015. The Hague Agreement provides an international filing regime for designs, and while the U.S. is only now becoming a participant, it has been in effect between other countries for many years.

THE PROCESS YOU SHOULD EXPECT

Beginning May 13, 2015, U.S. domiciled applicants may submit an IDA either to the United States Patent and Trademark Office (USPTO) or directly to the International Bureau of the World Intellectual Property Organization (WIPO). The IDA will include a list of designated countries in which the applicant wishes to pursue design protection. Applicants should expect the content required for an IDA to be roughly equivalent to that of a U.S. design patent application.

The IDA will then be examined by the respective national offices of the countries designated by the applicant. With respect to the United States, the USPTO will examine the IDA with the same criteria used for current U.S. design patent applications. If a favorable decision is reached, the IDA will issue as a U.S. design patent.

Applicants may still elect to file a traditional U.S. design patent application with the USPTO. For both U.S. design patent applications and IDAs filed after May 13, 2015, the enforceable term of a resultant U.S. design patent will be 15 years (opposed to the current 14 years), running from the date of issue.

WHAT YOU SHOULD CONSIDER

Prospective applicants contemplating an IDA should consider the factors discussed below and consult a qualified patent practitioner.

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Each IDA may contain up to 100 designs; however applicants should remember that the national rules of the designated countries will be applied when the patent offices of those countries consider the IDA. In the United States, an application containing disparate designs is likely to be subject to a restriction requirement. While an applicant could elect one design for examination and then file divisional applications directed to unelected designs, this process may be more cumbersome than simply filing separate applications initially.

We expect there will be instances where designated countries have criteria that do not overlap and may conflict. For example, U.S. law requires the inclusion of a single claim adhering to strict requirements, whereas other jurisdictions do not. Applicants should be prepared to make amendments to conform their applications to the regulations of each jurisdiction they designate and recognize that the assistance of local counsel may be required.

Not every country is a signatory to the Hague Agreement, and so applicants should consider whether an IDA will provide the desired scope of protection. As of May 13, 2015, notably absent are China, Russia, Canada and Israel. Where protection is sought in a non-signatory country, coordinated filings may be required.

IDAs are normally published by WIPO soon after filing, though a delay of up to 30 months may be requested. In contrast, U.S. design patent applications are not published until issue. This dynamic may serve as a double-edged sword. On the one hand, publication enables a party to assert provisional rights during the application pendency (discussed below in additional detail). On the other hand, maintaining secrecy until issue allows an applicant to maintain a design as a secret should the application not mature to a patent.

In some respects, IDAs will be treated no differently than other patent applications. For instance, published IDAs will serve as prior art once they are published, and may be relied upon for claims of priority.

NEWLY AVAILABLE PROVISIONAL RIGHTS

An interesting result of the law changes surrounding design patent applications is that published IDAs will allow applicants to assert "provisional rights" against infringers in the United States prior to issuance of a U.S. patent. Essentially, an applicant may recover damages from an infringer, after the patent eventually issues, for the period between when actual notice to the infringer of the pending application is established and the date of issuance. Such a remedy was previously only available in the United States for utility applications and not design applications. Importantly, this change does not apply to U.S. design patent applications filed in the traditional manner with the USPTO that are not published prior to issue.

Points To Remember:

- Beginning May 13, 2015, an IDA may be filed with either the International Bureau of WIPO or the USPTO;
- Nations that are not signature parties to the Hague Agreement may not be designated in IDAs;
- IDA applications will be published by WIPO, though a delay may be requested, whereas design patent applications filed with the USPTO will not be published until issue;
- Up to 100 industrial designs may be included in an IDA, but disparate designs may subject the IDA to restriction requirements during national examinations; and
- Both IDAs and U.S. design patent applications filed on or after May 13, 2015 will enjoy an expanded 15 year term running from the date a U.S. design patent is issued.