

HAGUE TO BREAK IT TO YOU: INTERNATIONAL DESIGN APPLICATIONS ARE NOT A SILVER BULLET FOR MULTIJURISDICTIONAL PROTECTION

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Today, May 13, 2015, the Hague Agreement is fully implemented in the United States. There has been a significant amount of excitement regarding the U.S. accession to the Hague Agreement, which includes an extension of U.S. design patent term from 14 years to 15 years (from issuance). A plethora of attorney literature touts the advantages of filing under Hague, including a streamlined registration process, significant cost-savings, and the opportunity for provisional rights. However, applicants should be cognizant of the potential pitfalls and disadvantages of filing an international design application under the Hague Agreement.

Drawing Requirements

The Hague Agreement does not harmonize international design drawing requirements. Instead, Hague applications are examined under the “local rules” of each designated country (or region). For those unfamiliar with international design practice, drawing requirements vary remarkably among jurisdictions. This includes variable rules on shading, limitations regarding the number and types of views, and policies concerning the acceptance of photographs, color drawings, and unclaimed features. Thus, from a practical standpoint, a single international design application cannot be prepared to comply with the local rules of all Hague members.

Failure to prepare drawings that comply with a designated country’s local rules can be fatal. Many jurisdictions allow little leeway to amend the originally filed drawings—often because the required drawing change could add new matter that is unsupported by the originally filed drawings. Consequently, an incurable drawing issue may lead to a complete loss of design rights. To avoid such harsh consequences, applicants filing conventionally, on a country-by-country basis, will typically amend drawings to comply with local rules prior to filing each application. International design applications do not offer such flexibility because the originally filed international application is treated as if it were directly filed with each designated country. As such, any amendment made to the international application will be subject to the designated country’s local rules regarding amendments, thereby raising

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issues of new matter.

Cost Savings

Many Hague applications will not result in significant cost savings. Although certain efficiencies can be realized in strategically filing an international application, applicants still need to pay the applicable government fees for each designated jurisdiction, along with the costs to prepare and file the Hague application itself. An international application filed with the USPTO is also subject to an additional processing fee.

In theory, cost savings may be realized by avoiding translation costs and not engaging local counsel. However, unlike utility patent applications, design applications have little text to translate. In many cases, local counsel will still need to be engaged to attend to local formalities issues and to file in jurisdictions that have not joined the Hague Agreement, including China, Canada, Argentina, Australia, Brazil, Israel, Russia, and Taiwan. Despite the importance of cost savings, applicants who forego local legal advice regarding local nuances and changes in law may end up paying a much higher price in terms of lost protection.

Provisional Rights

Because international applications are published at six months from filing, provisional rights under 35 U.S.C. Section 154 (d) may be available for an issued U.S. design patent that was filed as an international application designating the United States. Provisional rights allow a patentee the opportunity to obtain damages for infringement occurring after publication but prior to the date of issuance of the patent if certain conditions are met. By contrast, conventionally filed U.S. design applications are not published prior to issuance and therefore do not provide an opportunity for provisional rights.

Provisional rights may seem attractive to applicants as the pendency time of design applications at the USPTO increases. However, if the international application is found to include more than one design (via a U.S. restriction requirement), provisional rights will only apply to the first-elected design. Ultimately, U.S. applicants will need to balance the value of having provisional rights in design drawings that are acceptable to multiple jurisdictions with the value of filing a conventional U.S. design application that leverages the intricacies of U.S. design practice, such as the use of disclaimed features or surface portions, depiction of multiple embodiments, and inclusion of views showing the design in multiple states or configurations.

Have A Plan

There are instances when filing under Hague can be advantageous and efficient—especially when a single international application can be tailored to meet the applicant's goals for protection. However, at present, a single international design application is likely impractical for most situations because the Hague Agreement does not harmonize international design practice. Until design practice becomes more consistent between jurisdictions, applicants should continue to carefully plan their international filings on a country-by-country basis to avoid pitfalls and to obtain the best scope of protection for their designs.