

U.S. Adopts Hague Agreement for International Registration of Industrial Designs – Is an International Application Right for You?

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The Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs (Hague Agreement) went into effect in the United States on May 13, 2015. Therefore, it is now possible for U.S. applicants to file a single international design application either with the International Bureau of the World Intellectual Property Organization (WIPO) or through the United States Patent and Trademark Office (USPTO) to obtain protection in a number of countries worldwide that are also party to the Hague Agreement. Conversely, applicants filing international design applications worldwide will now be able to designate the United States for design protection. In adopting the Hague Agreement, the U.S. has ratified the Geneva Act of 1999, but not the Hague Act of 1960. The ramifications of this distinction are discussed below.

To better understand the process of international registration of industrial designs, it may be helpful to define what constitutes an industrial design. An industrial design registration may be obtained for the ornamental or aesthetic aspects of an article, and may consist of three-dimensional features such as shape, or two-dimensional surface treatment features such as patterns, lines, or color. These ornamental or aesthetic features are distinguished from the way in which an article *functions*, for which utility patent protection may be more appropriate.

The Structure of the Hague System

There are currently 64 contracting parties to the Hague Agreement, and in order to file an application under the Hague Agreement, an applicant must be a national of a Contracting Party (CP), be domiciled in a territory of a CP, or have a real and effective industrial or commercial establishment in a territory of a CP. Furthermore, protection may only be obtained in those CPs which are party to the same act (i.e., the 1960 Hague Act or the 1999 Geneva Act) as the CP through which the applicant has the necessary entitlement to file an international application. In other words, if the applicant claims entitlement through the United States, the applicant can only designate CPs who are party to the 1999 agreement.

Filing an international application for an industrial design under the Hague Agreement comes with a number of advantages. Fil-

ings may be made in one language only, which may be selected from English, Spanish, or French. The applicant does not need to make a separate application in each CP in which protection is sought, and is relieved of the duty to monitor renewal deadlines in multiple jurisdictions. Changes in ownership, changes in applicant information, and other formalities are simplified via one filing with the International Bureau (IB) that has effect in all designated CPs. The Hague Agreement also places time limits on designated CPs to refuse registration of the design, thus making prosecution times relatively uniform. The Hague Agreement allows CPs to choose between two different refusal time limits, depending on whether the CP's office examines for novelty and/or allows opposition to grant. As an office that examines for novelty, the USPTO has chosen a time limit of twelve months from publication of the design to issue a refusal, where publication is generally six months after the date of international registration. In other words, absent any unintentional delay in the USPTO, an applicant designating the U.S. will likely have a refusal or grant within 18 months from the date of international registration.

The Hague Agreement outlines a two-step examination process that includes formal examination by the IB, followed by substantive examination by the office of each CP. Formal examination by the IB includes checking for compliance with formal requirements, ensuring that the appropriate fees are paid, and preparing the design for publication. The IB does not examine the design for novelty or other substantive issues, and thus the date of the international registration is the later of the international filing date or the date on which certain mandatory requirements are met, which requirements differ based on whether the application is filed under the 1999 or the 1960 Act.

Substantive examination by the office of each CP includes determining whether the substantive conditions of the CP's laws are satisfied. However, a CP cannot refuse registration for non-compliance with formal requirements that have already been deemed to be satisfied by WIPO. The applicant may then respond to any refusal by corresponding directly with the CP's national office within time limits imposed by that particular CP's office.

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Filing an International Application Indirectly Through the USPTO

In the United States, applicants must include payment of a transmittal fee when submitting an international design application to the USPTO to avoid delay in transmitting the application to the IB. U.S. applicants should also be cautious when filing through the USPTO not to designate a CP that is only party to the 1960 Hague Act, as is discussed above. If a U.S. applicant wishes to designate a CP that is only party to the 1960 Hague Act, but also wishes to designate CPs who are party to the 1999 Geneva Act, the applicant should consider whether it can claim entitlement through a different CP that is party to both the 1999 Geneva Act and the 1960 Hague Act. If a U.S. applicant qualifies for this alternative route, a foreign filing license should be obtained before filing.

In the U.S., substantive examination of a Hague Agreement application will generally be the same as that for a regular design application filed in the United States, and will include examination for ornamentality, novelty, non-obviousness, enablement, and written description. Generally, for purposes of novelty and non-obviousness, the filing date of an international design application in the United States is the effective date of international registration, subject to nuances related to priority and specific requirements for designating the U.S. The U.S. has also elected to have additional requirements for Hague Agreement applications, and thus requires an indication identifying the creator of the industrial design, a brief description of the reproduction or of the characteristic features of the industrial design, and a claim. As with normal U.S. practice, only one independent and distinct design may be claimed in a given U.S. application. If more than one design exists in an application, a restriction requirement will likely issue, and the applicant may later file divisional applications if desired.

Regardless of whether an application is filed under the Hague Agreement, as a result of the U.S. becoming a contracting party to the Hague Agreement, a U.S. design patent resulting from an application filed on or after May 13, 2015, will now have a 15-year term from issuance, instead of the previous 14-year term.

Determining if an International Industrial Design Application is Worthwhile

There are many considerations that should be taken into account to determine if it is advisable to file an application under the Hague Agreement. For example, an applicant may want to weigh the costs of filing the international application and of designating CPs, and the ensuing costs for renewing the registration in each designated CP, against any administrative benefits. If only one or two CPs are designated, it may not be worth the extra cost to file an international application. However, if a number of CPs are designated, the ability to centralize renewal fee payments and changes in applicant infor-

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Christopher Scherer AV Preeminent® - Christopher Scherer recently received an AV Preeminent® 5/5 Martindale-Hubbell® Peer Review Rating™. This rating is an objective indicator of a lawyer's high ethical standards and professional ability.

Joseph Kuborn and Aaron Olejniczak Named IP Stars by Managing IP - Attorneys Joseph D. Kuborn and Aaron T. Olejniczak were selected for inclusion in *Managing Intellectual Property's* 2015 edition of *IP Stars* list.

Andrus Supports UPAF - In May, Andrus employees once again participated in a Workplace Giving Campaign in support of the United Performing Arts Fund (UPAF).

Andrus Ranked in Chambers USA 2015 - Andrus was selected as a ranked law firm in *Chambers USA 2015*, identifying our firm as one of the best firms in Wisconsin in the field of intellectual property law. In addition to the firm-wide ranking, Attorney Aaron Olejniczak was ranked as a notable professional.

Andrus Featured in List of Top Design Patent Firms - Andrus was included on the 2014 US Design Patent Toteboard assembled by the Ant-Like Persistence blog written by Carl Oppedahl of Oppedahl Patent Law Firm LLC.

mation may pay for itself.

Additionally, the jurisdictions in which design protection is desired should be taken into account, to determine if these jurisdictions are even CPs to the Hague Agreement in the first place. An applicant should also consider through which CPs it is able to claim entitlement, and whether it should claim entitlement under one CP versus another, depending on which jurisdictions the applicant intends to designate for protection. A list of the CPs and the Acts to which they are party can be found [here](#).

If it is advisable to file an international design application, care must be taken to ensure that an initial filing meets the substantive requirements of each designated CP, and that an international application is not fatally defective under the laws of a particular CP upon filing. For instance, it would likely not be difficult to remove a bracket or call-out from a drawing during prosecution before the European Union's OHIM, but it could potentially be impossible to fix a written description or new matter issue during prosecution before the USPTO.