

June 3, 2015

Patent Webinar Series

Understanding the International Design Registration (IDR) System

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Design Protection

- Focus is on appearance (ornamentation), not function
- 3-D objects, 2-D patterns (e.g., fabrics), fonts, icons, animations
- Scope of protection determined primarily by drawings
- Nexus between patent, trademark, and copyright policies

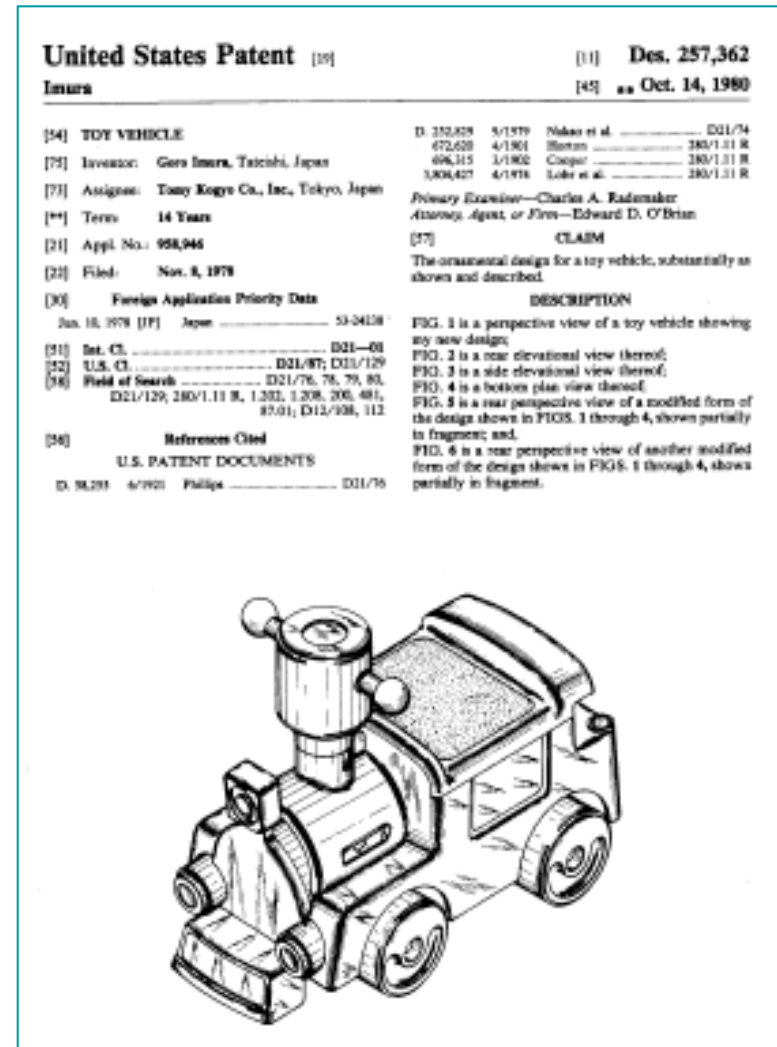
US Design Patent

Issued by the USPTO

Term of 15 years from grant

Examined against prior designs

No maintenance fees



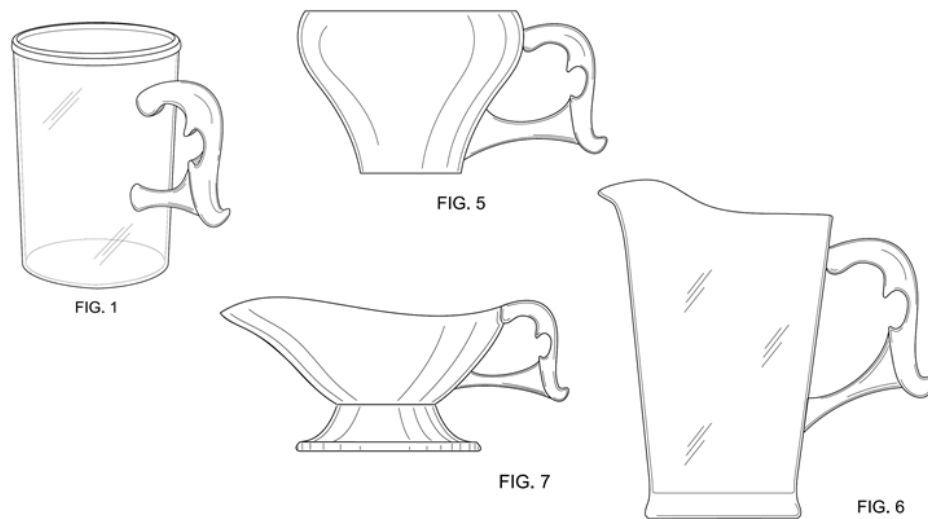
Patent v. Registration

United States

- Protect design concept
- Multiple embodiments
- Examined for validity
- Presumed valid

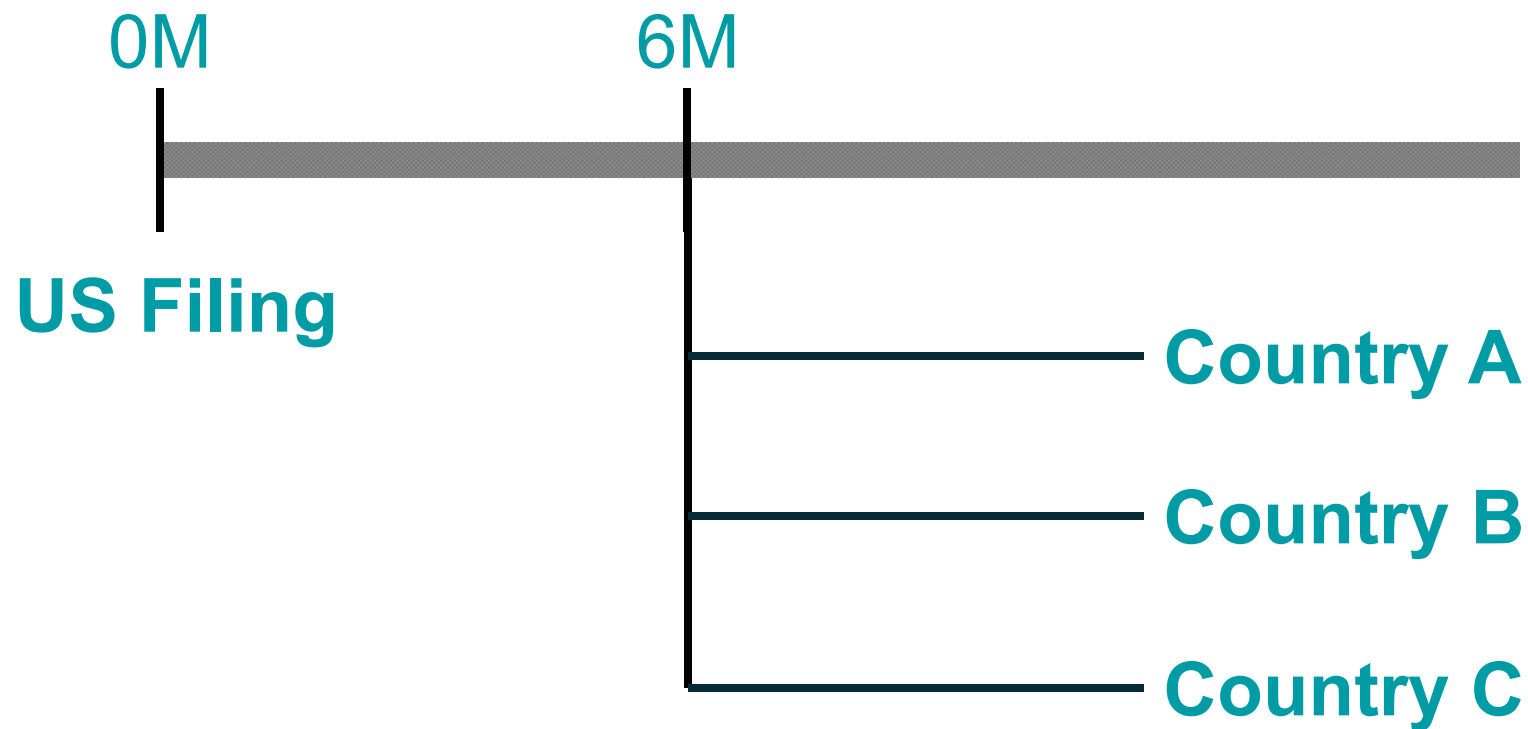
European Union

- Protect specific designs
- Multiple designs
- Unexamined
- Validity challenged when enforced



Foreign Protection for US Applicants

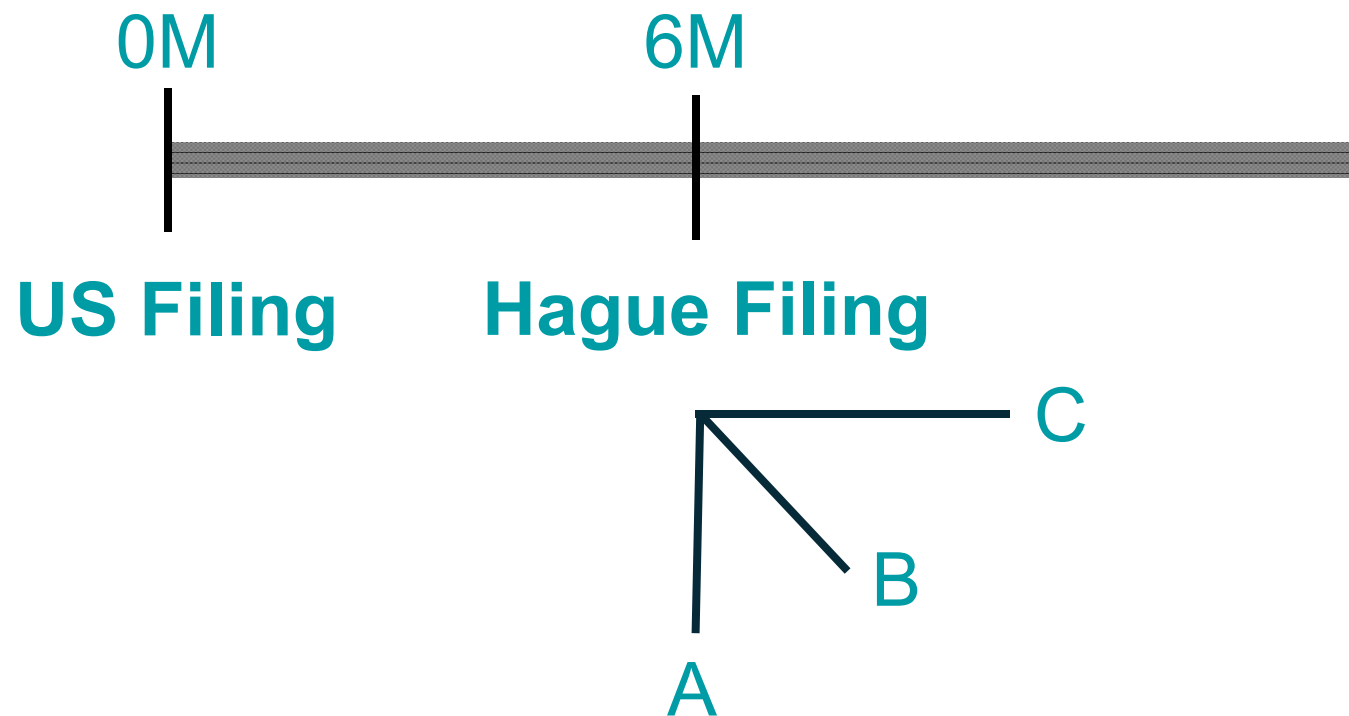
Paris Convention Priority



Hague Agreement

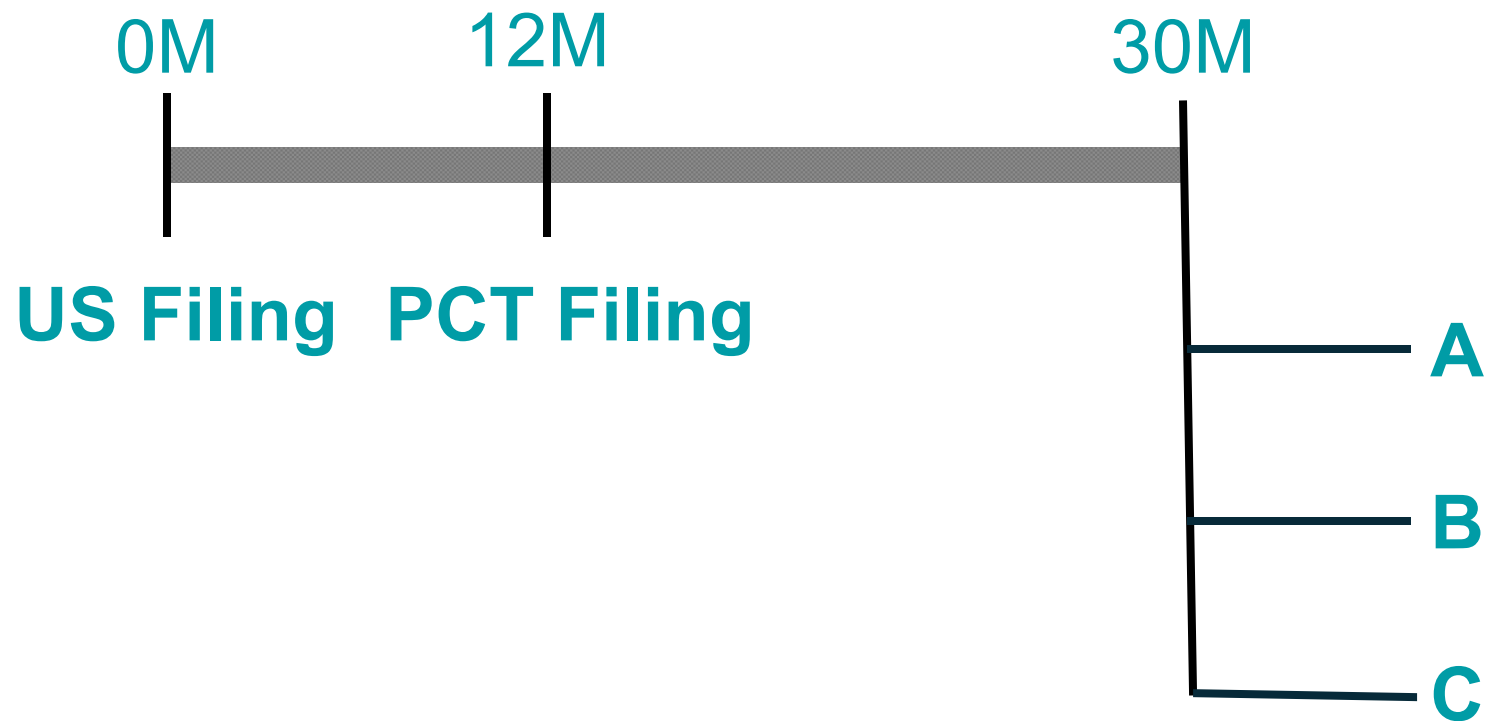
- Three separate multinational Acts – 1934, 1960, 1999
 - Each Act involved different countries (now 64)
 - US has now become a member to the 1999 Act
 - Key missing countries: CN, BR, AU, SG, RU, TW, IL, CA
- Allows for design protection in several countries through filing a single application with WIPO
- Each country must be designated when filing
- Countries may refuse protection
- Country levels:
 - 1 – Automatic protection following WIPO registration
 - 2 – Examination but not as to novelty
 - 3 – Full examination for validity

Foreign Protection via Hague



Foreign Utility Protection

PCT Priority



Rough Cost Comparison

National Patents

- Direct filing fees
- National prosecution
- Grant and annuity fees

Hague Registration

- One filing fee
- Designation fees
- Renewal fees

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Rough total cost – one design in 6 level 2 countries:

Rough Cost Comparison

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Hague Registration

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- Renewal fees

Rough total cost – one design in 6 level 2 countries:

\$45,000

\$1,500

Hague Procedure Overview

- WIPO formality examination
- WIPO publication in register – notice to countries
- Countries may notice refusal within 6 or 12 months (to WIPO)
 - Applicant resolves issues directly with refusing countries
 - Protection granted if not refused
- Renewal in 5-year increments, by fee to WIPO
 - Not necessary for full term protection in US

WIPO v. USPTO Filing – US Applicants Only

IB (WIPO)

- Direct filing
- Rapid processing/publication
- Competent for all applicants

USPTO

- Foreign filing license
- Filing date at mailing
- Application forwarded to IB
 - Extra \$120 Fee
- Required for later conversion

Either way, Applicant may:

- Claim priority from a US or foreign application (6M)
- Designate the US for protection

Filing Requirements Under the Hague Agreement

- **Who can file:** Any person who is a national of a member State that is a Contracting Party or of a State member of an intergovernmental organization that is a Contracting Party, or that has a domicile, residence or a real and effective industrial or commercial establishment in a Contracting State.
- **Where to file:** Directly with International Bureau or through the Office of applicant's Contracting Party (if available).
- The international design registration can claim priority of 6 months under the Paris Convention (Article 4) from an application filed in any Convention country. (37 CFR 1.1035(a))

Filing Requirements (continued)

- Mandatory Contents of Application:
 - a) Request;
 - b) Prescribed information concerning the Applicant;
 - c) Prescribed number of copies of a reproduction [drawing] of the subject design;
 - d) An indication of the product or products which constitute the design;
 - e) An indication of the designated Contracting States/Parties;
 - f) Prescribed fee; and
 - g) Any other prescribed particulars.

Filing as a US Applicant

- International design applications are subject to the secrecy provisions of Part 5 of the Rules (foreign filing license required prior to filing outside U.S.) (37 CFR 5.1(b))
- US Filing Options
 - Indirectly through USPTO filing, to IB after license grant
 - Directly:
 - US Design application, IDA filed directly (6 mo. Convention)
 - Obtain foreign filing license (e.g., without filing)
- Additional application requirements for designation of declared examining office (including US):
 - identity of the creator;
 - a brief description of the reproduction or of the characteristic features of the design which is the subject of the application; and
 - a claim.

Drawings Requirements

- US Rules (37 CFR 1.1026) provide that “reproductions” (drawings) shall comply with Rule 9 of the Common Regulations and Part Four of the Administrative Instructions (Hague Agreement). These WIPO rules specify:
 - a single copy of “reproductions”;
 - black and white or color;
 - pasted or printed on A4 paper (white and opaque) held upright;
 - maximum of 25 figures per page;
 - arranged in orientation for publication;

Drawings Requirements (continued)

- each figure must fall within a right-angled quadrilateral containing no other figure or part of figure and no numbering;
- the photos and reproductions shall represent the industrial design alone;
- representations may not exceed 16 x 16 cms, but with respect to at least one representation, one dimension must be at least 3 cms;
- at least a 5mm margin;
- technical drawings, particularly with axes and dimensions, and explanatory text or legend in the representation, shall not be accepted;
- matter shown in a reproduction but for which protection is not shown can be indicated in the textual description, or by means of dotted or broken lines, or coloring;

Drawings Requirements (continued)

- photographs must be of professional standard, and the pictured design must appear against a neutral background;
- retouching of photographs with ink or correcting fluid shall not be allowed;
- the industrial design may comprise shading or hatching to provide relief;
- numbering of reproductions shall appear in the margin, and may be accompanied by legends to indicate a specific view (e.g., front, top, etc.);
- when the same industrial design is represented from different angles, the numbering of the views shall take the form of, e.g. 1.1, 1.2, 1.3, etc. for the first design, 2.1, 2.2, 2.3 etc. for the second design, and so on; and
- the reproductions shall be presented in numerical order in the application.

USPTO Review of Indirect Application

The Office considers:

- Applicant's entitlement to file through the USPTO,
 - Payment of the transmittal fee,
 - Performs a national security review.
-
- If requirements met, application is transmitted to International Bureau.
 - Applicant receives notice of transmittal and international design application receipt date.
 - Invitations to applicant from IB.

The IB Process

- Up to 100 designs in a single application (all must belong to same class of International (Locarno) Classification).
- All fees (including designation fees) must be paid directly to WIPO (transmittal fee to USPTO).
- IB reviews international design applications for formal matters and, if appropriate, accords a filing date.

The IB Process (continued)

- No filing date accorded by IB if:
 - application not in prescribed language (English, French, or Spanish),
or
 - is missing:
 - 1) indication that international registration under the Hague Agreement is requested;
 - 2) a sufficient indication of the applicant's identity;
 - 3) a sufficient indication to allow the applicant or representative to be contacted
 - 4) a reproduction or specimen of each subject industrial design; and
 - 5) designation of at least one Contracting Party.

If the application does not contain an element(s) above, the filing date will be the date the International Bureau receives the omitted element(s), if timely furnished

The IB Process (continued)

- Publication of international registration by WIPO:
 - Standard: 6 months
 - Expedited: completion of preparations
 - Deferment: up to 30 months from the priority date (or filing date), but only if no designation of a Contracting Party not permitting deferred publication (e.g., U.S.)
- Notice of international registration communicated to designated offices upon publication.

Proceeding in Designated States

- Contracting Parties are permitted to adopt other requirements (these do not apply to the U.S.):
 - a) Specified elements;
 - b) Include two or more designs; and/or
 - c) Request for deferment of publication.
- Each Contracting Party must declare itself as:
 - “Level One” – no examination, IDR granted automatically in the territory;
 - “Level Two” - limited examination (no consideration as to novelty); and
 - “Level Three” – examination, including as to novelty.
- Each designated Contracting Party has the right to refuse the grant, in its territory, of protection to an international registration. Such refusal may be total or partial, i.e. applying to all or less than all designs in the international registration.

Post-IDR Proceedings in the US:

- Claim of priority benefit (37 CFR 1.78 and 1.1035(b))
- Lapse of an international design application for failure to act within prescribed time limits can be excused, if unintentional. (37 CFR 1.1051)
- International design applications designating the U.S. will be examined on the merits and may be refused but not on grounds relating to the form or content (37 CFR 1.1062)
- Only one independent and distinct design may be claimed (37 CFR 1.1064(a)); other designs subject to restriction. (37 CFR 1.1064(b))
- Any non-elected design(s) may be pursued through divisional applications. (37 CFR 1.1069)

Post-IDR Proceedings in the US (continued)

- IDS submittal deferred until publication of the international registration.
- Limitations on award of international filing date upon receipt date of international design application
- The international filing date in the U.S. is the date of international registration. (35 U.S.C. 384)
- The date of international registration is the later of:
 - the international filing date, or
 - the date required elements under Article 5(2) are received at IB.

Post-IDR Proceedings in the US (continued)

- Elements under Article 5(2) for designation of U.S.:
 - (i) an indication identifying the creator of the industrial design;
 - (ii) a brief description of the reproduction or of the characteristic features of the industrial design that is the subject of that application; and/or
 - (iii) a claim.
- Request for review of the U.S. filing date. (37 CFR 1.17(f))
- Expedited examination. (37 CFR 1.155)
- Conversion to U.S. design application under 35 U.S.C. chapter 16. (37 CFR 1.1052)
- Refusal by USPTO upon an examination of each international design registration designating the U.S. (37 CFR 1.1062, 1.1063)
- Communications related to refusal.

Design Filing Strategies

- Was there already a related filing?
- Where do you want to file?
- Was there public disclosure?
- Who else is interested in your design?
 - Watch
 - Search
- How do you want to file?
- Tricks and workarounds

“Minefield Applications”

No Use Requirement!



Was There Already a Related Filing?

Drawings used in utility patent applications?

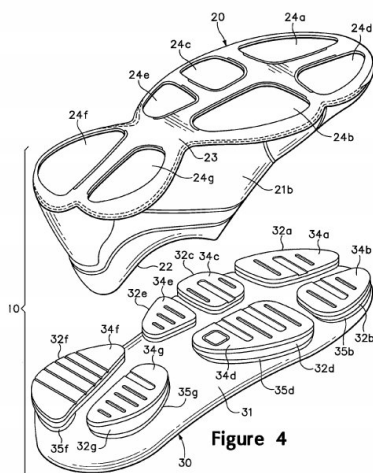
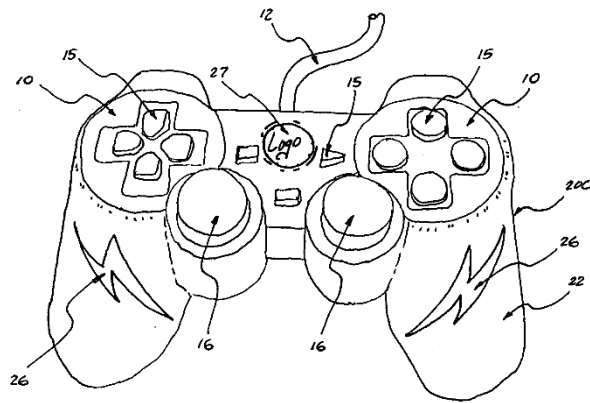


Figure 4

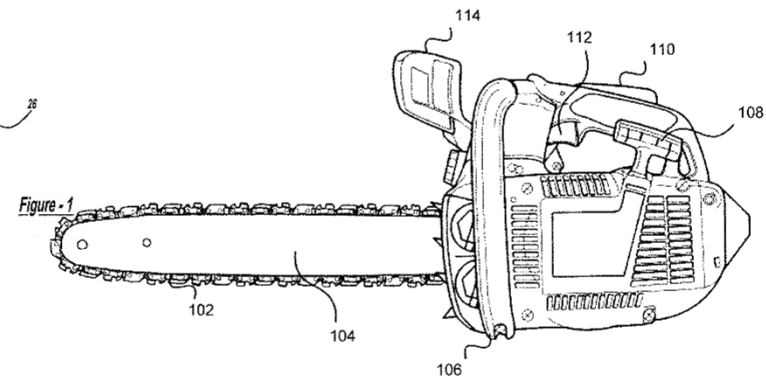
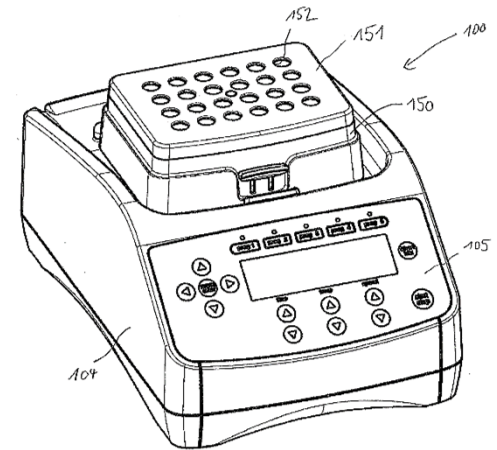
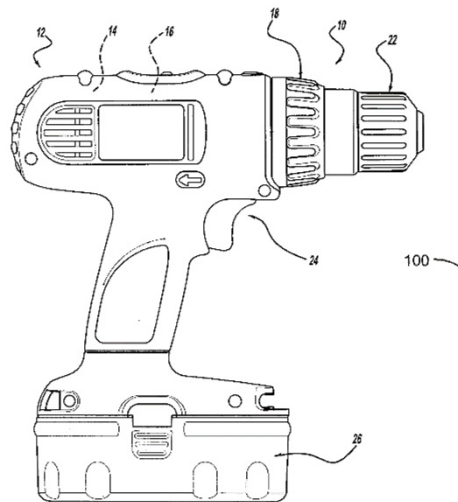


Figure - 1

Where do you want to file?

- **Which countries are relevant?**
 - Where you want to enforce
 - Where you expect manufacture, sales of counterfeits
- **Priority claims accepted?**
- **Deferment of publication possible?**
 - Avoid publication before product launch
 - Obtain enforceable right after product launch

21 000378641-0018
22 21/07/2005
15 21/07/2005
11 000378641-0018
73 The Procter & Gamble Company
One Procter & Gamble Plaza
Cincinnati, Ohio 45202
ESTADOS UNIDOS (DE AMÉRICA)



Was There Public Disclosure?

- **Has the design been made public?**
 - To possible manufacturer?
 - To potential customer?
 - To public?
 - Product launch?
- **If already public:**
 - Novelty grace period available?
- **If still confidential:**
 - Time of proposed product launch?

File for Public Design Where No Grace Period?

- **Cons:**

- Not new
- Where novelty examined: refusal possible
- Where novelty not examined: invalid, vulnerable to cancellation
- In any case: will not survive litigation
- May be seen as abusive, sanctions

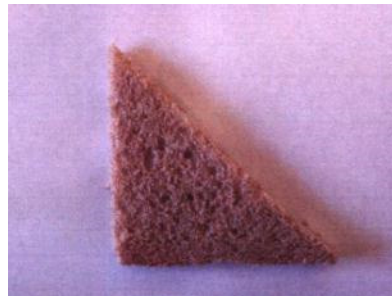
- **Pros:**

- Novelty not examined in many jurisdictions, and validity presumed
- Sufficient for enforcement, e.g. customs action
- Counterfeiters will not show up in court
- Validity often complex, both re novelty and further requirements

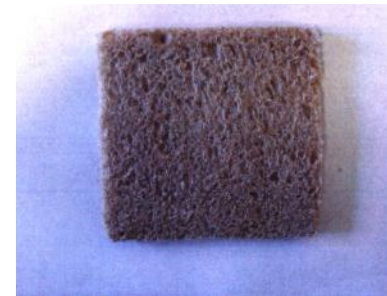
Defensive Filings?



RCD 5566-1 "Bread"



RCD 5566-2 "Bread"



RCD 5566-3 "Bread"

How Do You Want to File?

- **Filing options:**

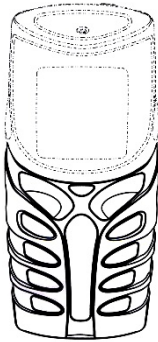
- National design application
- Regional design application (e.g. European Community design app.)
- International design application (designating countries or regions)

- **Issues to consider:**

- Costs?
- Sophisticated drawings allowed?
- Deferment of publication possible?
- How long does it take until enforceable right?
- Risk of central attack?

Sophisticated Drawings

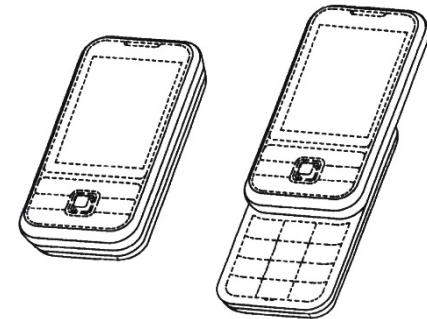
Broken lines



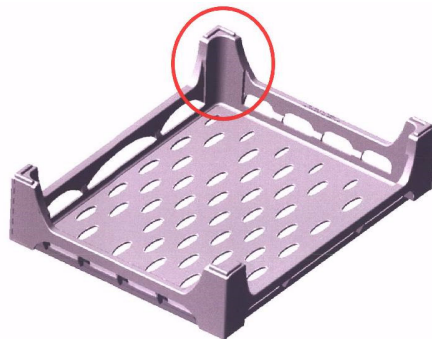
Color shading



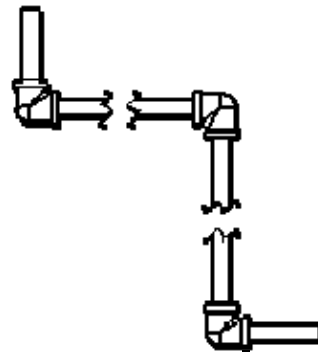
Alternative positions



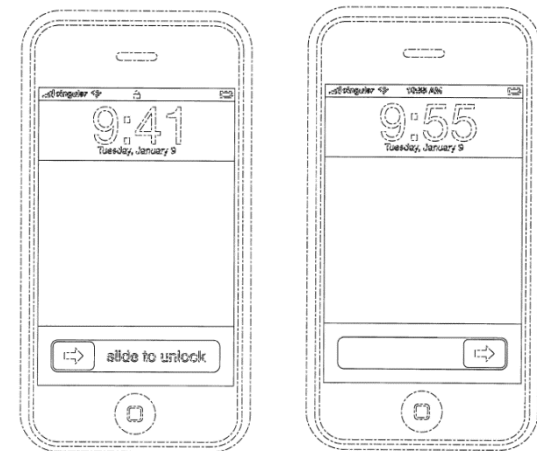
Boundaries



Separations



Graphic user interfaces (GUIs)



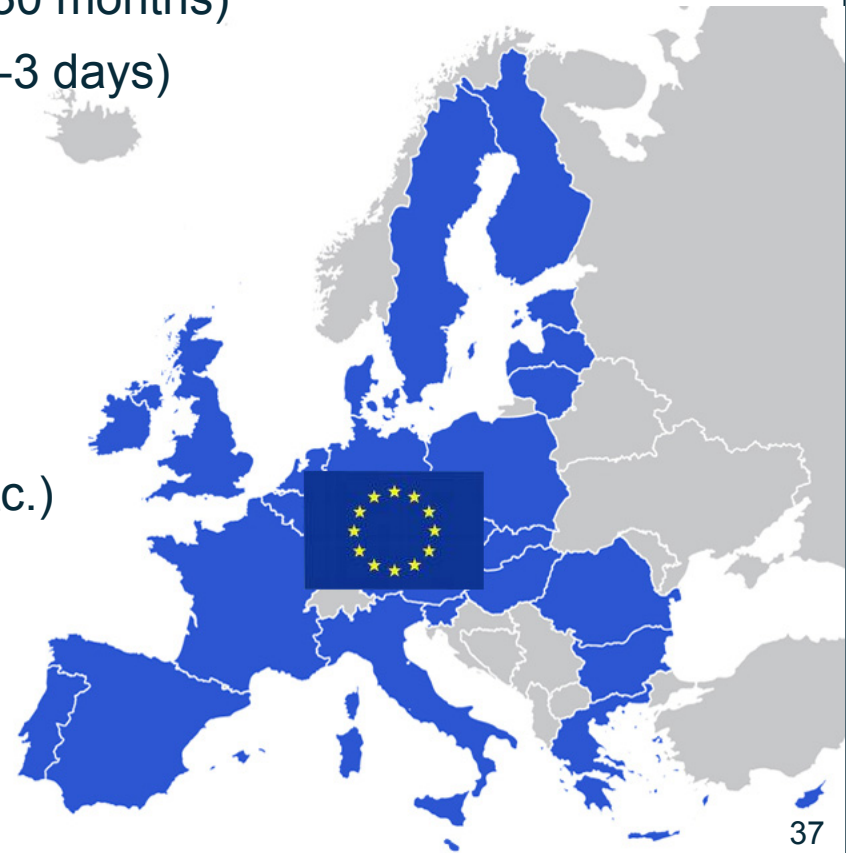
Community Design v. National Applications

- **Pros:**

- More cost effective (from the 3rd EU jurisdiction)
- Sophisticated drawings allowed
- Deferment of publication available (30 months)
- Registered and published quickly (2-3 days)
- EU wide right,
EU wide court decisions

- **Cons:**

- Only covers EU member states
(not Switzerland, Norway, Turkey, etc.)
- Risk of central attack:
EU wide cancellation



International Design v. National Applications

- **Pros:**

- More cost effective (from the 3rd jurisdiction)
- Registered and published quickly (1-2 weeks if requested)
- No risk of central attack (contrary to international trademarks)

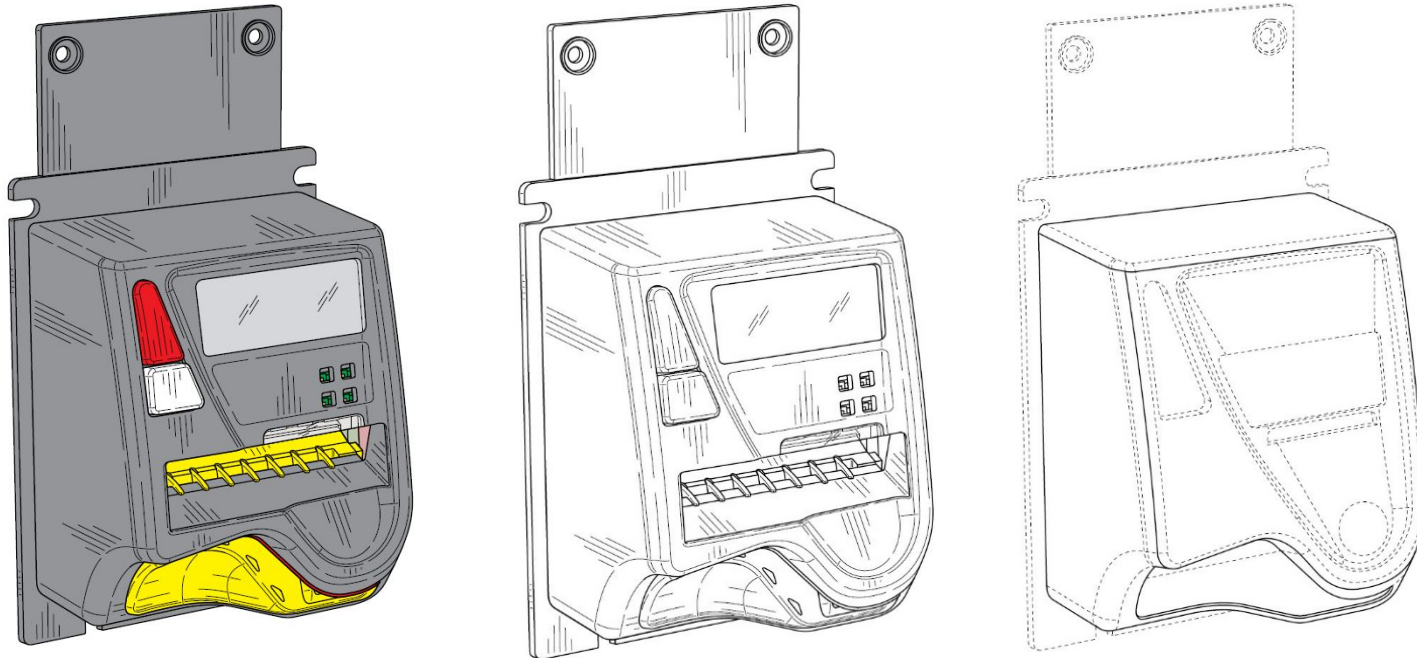
- **Cons:**

- Not available for all countries
- Drawings have to work for all countries*
- Deferment of publication only where available for all countries
- National offices may refuse protection, delay enforcement
- Registration does not guarantee enforceability, scope of protection

*workaround available

Workarounds for International Designs

- File one application with different drawings:



- File separate applications with different drawings on the same day

Design Filings for Trademarks?



RCD 754098-1 "Logos"



CTMA 6530406 "iPhone"



RCD 139860-1 "Logos"



CTMR 3121787 „ups“



RCD 150479-1 "Logos"



CTMR 3191533 (fig.)

Design Filings for Trademarks? (continued)



SONY

FONY



LINKS TO KEY REFERENCE PUBLICATIONS

- **GUIDE TO THE INTERNATIONAL REGISTRATION OF INDUSTRIAL DESIGNS UNDER THE HAGUE AGREEMENT** (updated January 2015)
(http://www.wipo.int/export/sites/www/hague/en/guide/pdf/hague_guide.pdf)
- **ADMINISTRATIVE INSTRUCTIONS FOR THE APPLICATION OF THE HAGUE AGREEMENT** (http://www.wipo.int/treaties/en/text.jsp?file_id=337315)
- **Hague Agreement Concerning the International Registration of Industrial Designs – List of Contracting States (Status of February 13, 2015)**
(<http://www.wipo.int/export/sites/www/treaties/en/documents/pdf/hague.pdf>)
- **GENEVA ACT OF 2 JULY 1999**
(<http://ec.europa.eu/world/agreements/downloadFile.do?fullText=yes&treatyTransId=13907>)
- **FEDERAL REGISTER: Changes to Implement the Hague Agreement Concerning International Registration of Industrial Designs; Final Rule (04/02/2015)** (<https://www.federalregister.gov/articles/2015/04/02/2015-06397/changes-to-implement-the-hague-agreement-concerning-international-registration-of-industrial-designs>)

LINKS TO KEY WEB SITES

- **Hague – The International Design System**
(<http://www.wipo.int/hague/en/>)
- **Payment of Fees under the Hague System**
(<http://www.wipo.int/about-wipo/en/finance/hague.html>)
- **Schedules of Fees under the Hague System**
(<http://www.wipo.int/about-wipo/en/finance/hague.html>)
- **List of Contracting Parties / States**
(<http://www.wipo.int/export/sites/www/treaties/en/documents/pdf/hague.pdf>)

Thank you!



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