

**UNITED STATES
PATENT AND TRADEMARK OFFICE**



The Hague Agreement Overview and Benefits

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UNITED STATES
PATENT AND TRADEMARK OFFICE



Agenda

- Industrial Design Basics and Industrial Designs Protection
- Overview of the Hague Agreement
 - International Application and roles of WIPO and IP Offices
- U.S. Implementation of the Hague Agreement (Geneva Act)
- Trends
- Benefits

What is Industrial Design?

- Making Products...
 - Intuitive
 - Easy to Use
 - Enjoyable
 - Desirable
 - Distinct or Interesting Visual Appearance



GEEKS HUT

uspto

What is Industrial Design?

- **Legal Sense**, an industrial design constitutes the ornamental or aesthetic aspect of an article
- An industrial design may consist of three dimensional features, such as the shape of an article, or two dimensional features, such as patterns, lines or color.





INDUSTRIAL DESIGN PROTECTION ACROSS THE GLOBE

TRIPS AGREEMENT



- **Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS)**
- **Article 25: Requirements for Protection**
 - Requires protection for any industrial design that is new or original, or that significantly differs from known designs or combinations of known design features.
 - Design dictated essentially by technical or functional considerations need not be protected.
- **Article 26: Term of Protection**
 - Term to amount to **at least 10 years.**

Industrial Designs Rights

- In principle, the owner of a registered industrial design or of a design patent has the right to prevent third parties from making, selling or importing articles bearing or embodying a design which is a copy, or substantially a copy, of the protected design, when such acts are undertaken for commercial purposes.

ID Protection Systems

- Unregistered Rights
- Registration System (Formality Examination)
- Substantive Examination System
- Quasi-Registration System (opposition triggers substantive examination)

HAGUE AGREEMENT

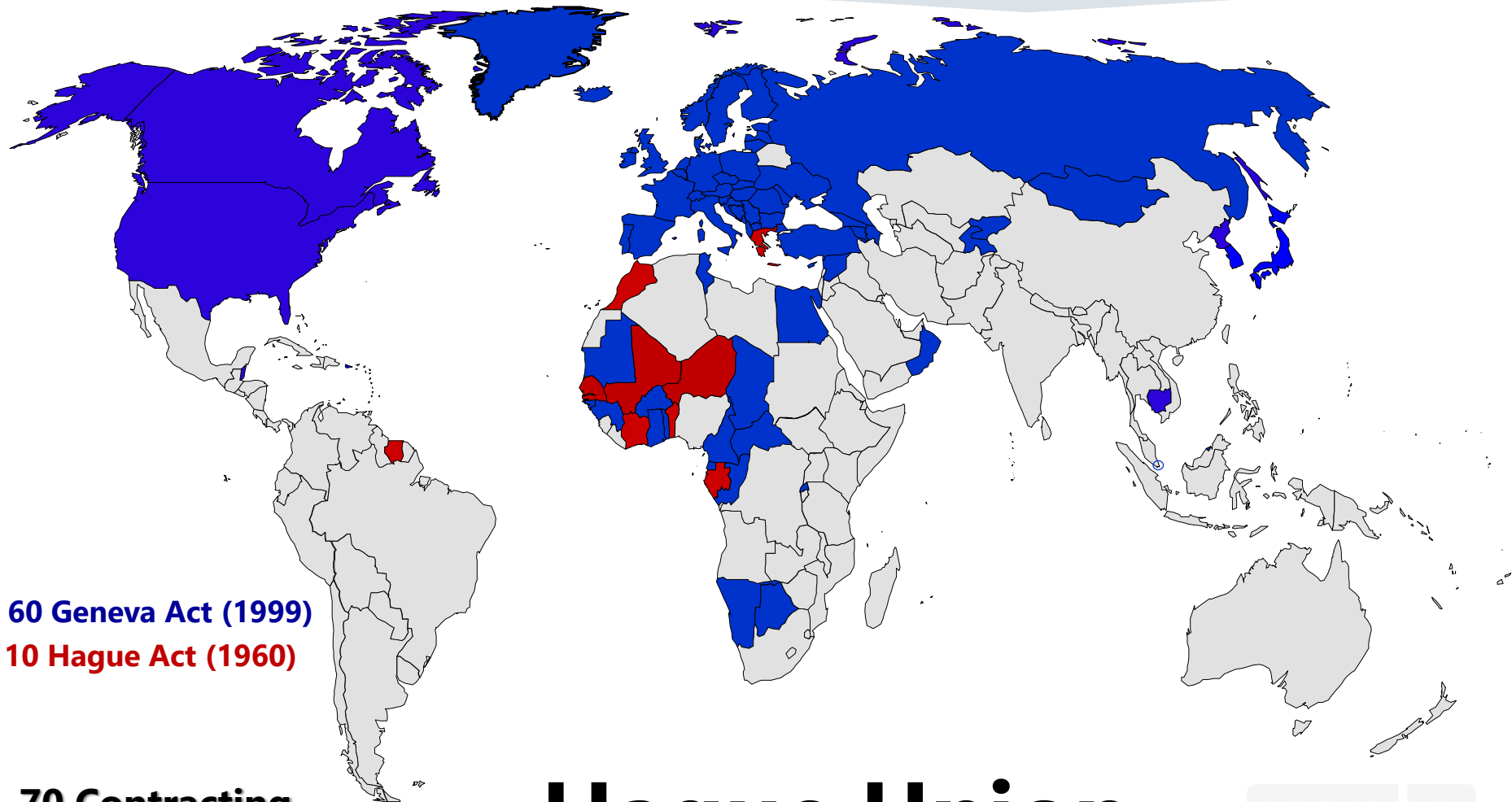
**THE HAGUE SYSTEM FOR THE INTERNATIONAL
REGISTRATION OF INDUSTRIAL DESIGNS**

History of the Hague Agreement

- **Hague Agreement**
 - **London Act (1934)**
 - “frozen” as of Jan 1, 2010
 - **Hague Act (1960)**
 - Euro-centric membership
 - New members are not joining this act
 - **Geneva Act (1999)**

Summary of the Hague System

- Centralized acquisition and maintenance
- Industrial design rights
- Filing single international application
- Single international registration
- One or more designated contracting parties (member countries)



60 Geneva Act (1999)
10 Hague Act (1960)

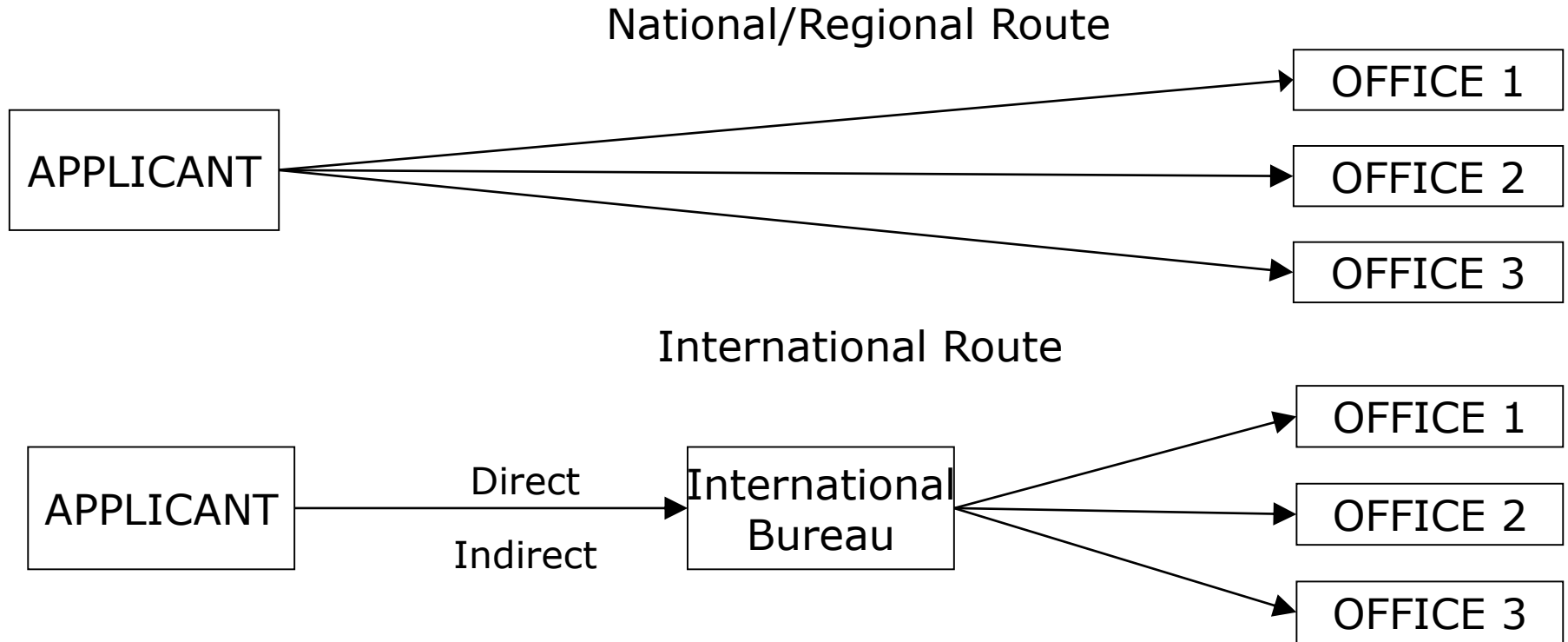
**70 Contracting
Parties**

Hague Union

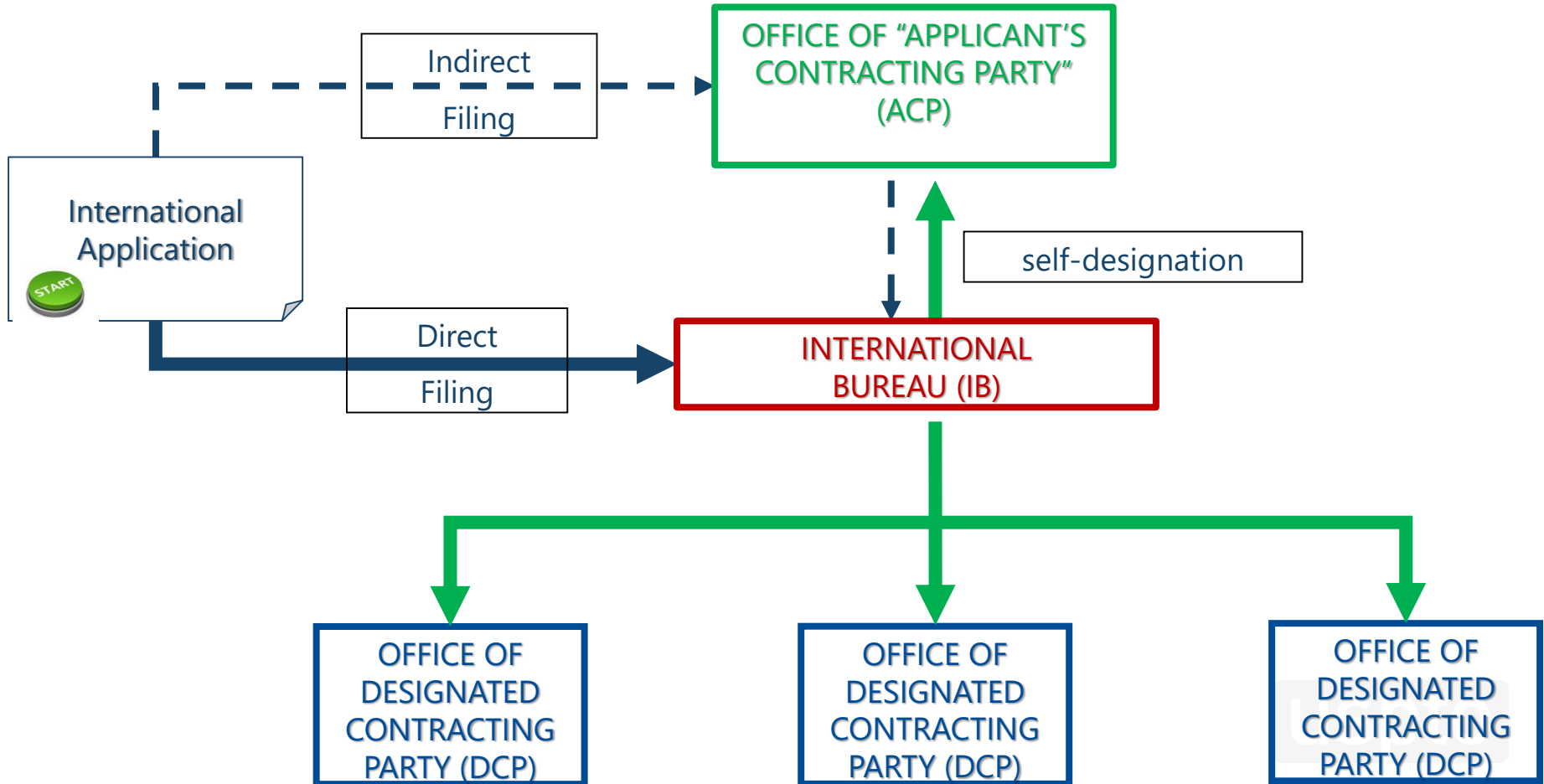


**NATIONAL APPLICATION
VS
INTERNATIONAL APPLICATION
(HAGUE)**

Filings: National vs Hague



Hague System Procedure



Roles in the Process

OFFICE OF "APPLICANT'S
CONTRACTING PARTY" (ACP)

- (Indirect Filing)
 - Sends international design application to IB
 - within one month of filing to retain filing date; or
 - within 6 months (US) for security clearance

Roles in the Process

INTERNATIONAL BUREAU (IB), WIPO

- Examines formalities
- Records in the International Register
- Issues a Registration Certificate to holder
- Publishes in WIPO Bulletin
- Notifies designated Contracting Parties
- Provides application for consideration
 - USPTO will then perform examination

Roles in the Process

OFFICE OF DESIGNATED CONTRACTING PARTY (DCP)

- Review the published international registration based on requirements of national law
- 2 Options for CP:
 - **No Refusal** -----international registration will have effect in that CP
 - **Refusal** -----applicant in contact with the CP directly

What Hague does not cover

- Hague Agreement is *primarily* a procedural treaty, accordingly certain issues are not addressed:
 - Conditions for protection
 - Refusal procedure to be applied in deciding whether protection should be granted
 - Rights that result from protection
- These issues are left to the laws of each of the Contracting Parties (member countries).

Hague System is a closed system

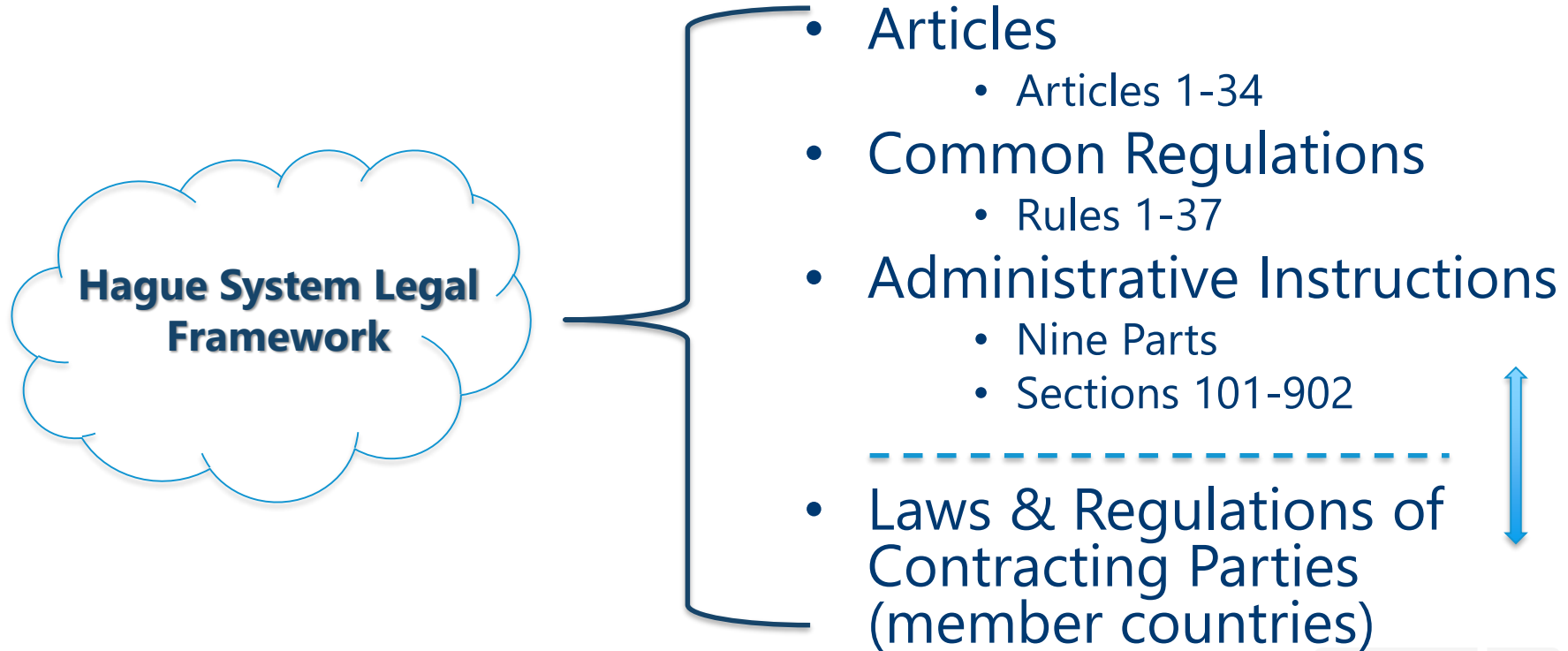
- Applicant must be entitled to file an International Application
 - “Entitlement” = connection with a contracting party
 - Nationality
 - Domicile
 - Habitual Residence
 - Real and Effective Industrial or Commercial Establishment
- Entitlement also needed to file through a contracting party as an office of indirect filing
- Applicant can only designate contracting parties with a common treaty membership. (e.g., 1999→1999 and not 1999→1960)
 - An applicant who’s entitlement is the U.S. cannot designate a country that is only a member of the 1960 Act. (Some are members of both 1960 & 1999)

UNITED STATES IMPLEMENTATION OF THE HAUGE AGREEMENT

History of the Hague Agreement

- Hague Agreement
 - London Act (1934)
 - “frozen” as of Jan 1, 2010
 - Hague Act (1960)
 - Euro-centric membership
 - New members are not joining this act
- ➔ **Geneva Act (1999)**
 - U.S. signed on July 6, 1999
 - U.S. deposited instrument of ratification on February 13, 2015
 - Took effect with respect to the United States on May 13, 2015

Geneva Act Legal Framework



Governing Provisions

- **Geneva Act of the Hague Agreement**
 - Took effect with respect to the United States on May 13, 2015.
- **Update to United States Law (Title 35 USC)***
 - Public Law 112-211 enacted Dec. 18, 2012 "*The Patent Law Treaties Implementation Act of 2012*" (Title I)
 - Took effect May 13, 2015.

* <http://www.gpo.gov/fdsys/pkg/PLAW-112publ211/pdf/PLAW-112publ211.pdf>

Roles in the Process

OFFICE OF "APPLICANT'S
CONTRACTING PARTY" (ACP)

- (Indirect Filing)
 - Sends international design application to IB
 - IB (WIPO) to receive within one month of filing to retain filing date; or
 - ➡ within 6 months from the USPTO (for security clearance)

Roles in the Process

OFFICE OF DESIGNATED CONTRACTING PARTY (DCP)

- Review the published international registration based on requirements of national law
- 2 Options for CP:
 - **No Refusal** -----international registration will have effect in that CP

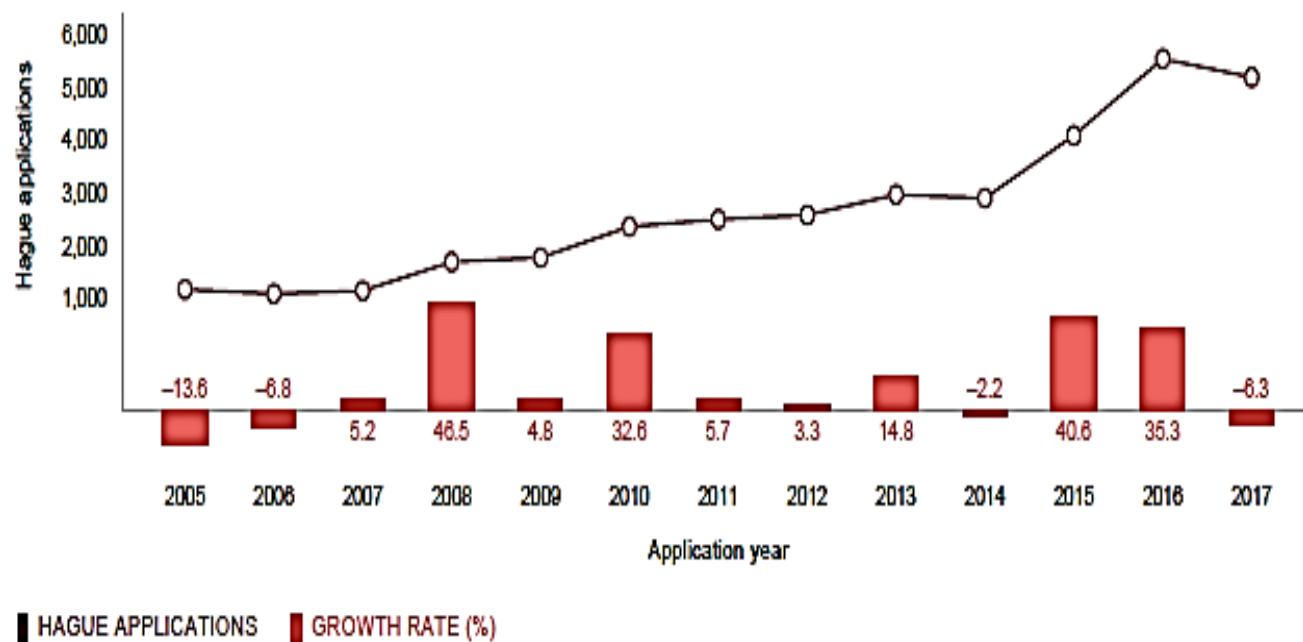
➡ **Refusal** ----applicant in contact with the CP directly

➡ USPTO will be issuing a design patent that gives effect to the design rights (republishing)

THE HAGUE AGREEMENT TRENDS

The Hague Agreement: Trends

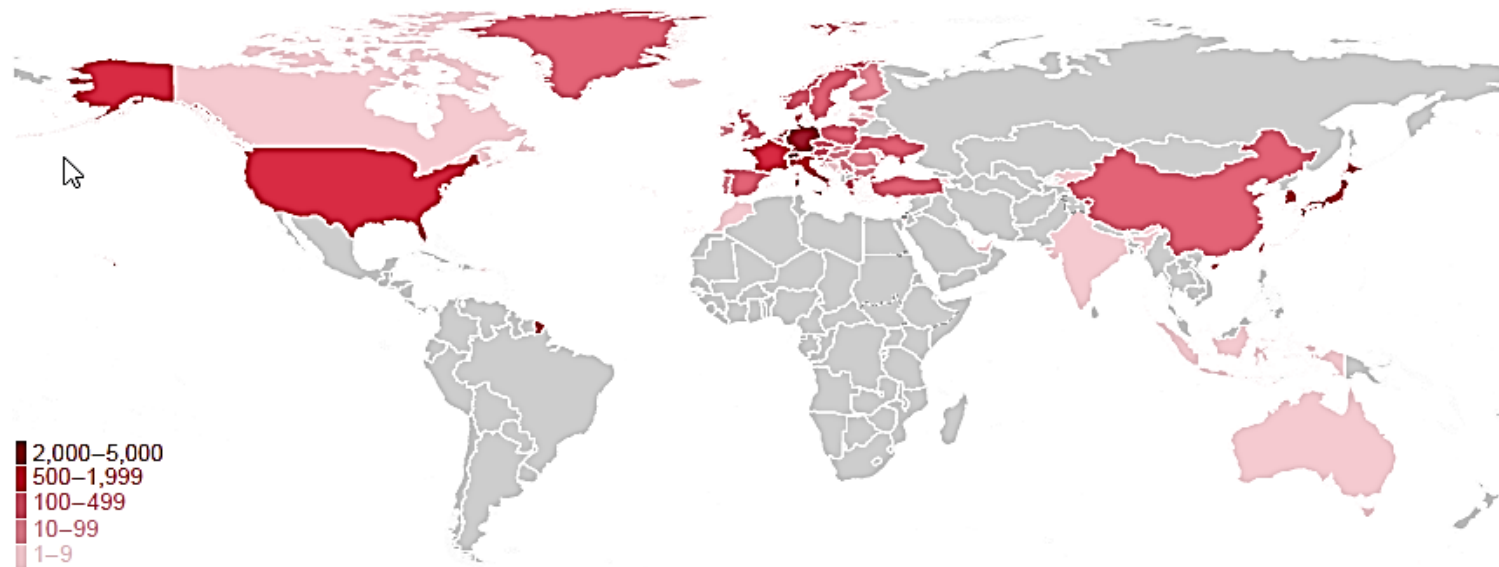
A1. Trend in international applications, 2005–2017



Source: WIPO Statistics Database, May 2018.

The Hague Agreement: Trends

A8. Designs contained in international applications by origin, 2017



Note: The origin of an application is defined as the country/territory of the stated address of residence of the applicant. Applicants residing in a non-member country can file applications for international registrations if they have a real effective industrial or commercial establishment within the jurisdiction of a Hague member.

Source: WIPO Statistics Database, May 2018.

Source: WIPO Hague Yearly Review 2018 –
International Registration of Industrial Designs

Source: WIPO Hague Yearly Review 2018 –
International Registration of Industrial Designs

Highlights of Trends

- Hague system continues to grow
 - Number of designs, membership and geographic participation, applicant use
- Significant variance in use depending on applicant's origin and designations.
- No priority claim in 47% of applications.
- Large examination offices/parties have the fewest designs per designation.

Benefits

- One International Application
 - No need to file multiple national applications
 - One language
 - Fee payment in one currency (Swiss francs) with one office
 - A bundle of national rights possible
 - Ease of subsequent management of the international registration --change in name and address of holder, or change in ownership—recorded at the IB.

The Hague Agreement

- **Helpful Information for Applicants & Representatives**
 - *USPTO Hague Implementation Page*
 - <http://www.uspto.gov/patent/initiatives/hague-agreement-concerning-international-registration-industrial-designs#tips>
 - *WIPO Hague System Page*
 - <http://www.wipo.int/hague/en/>

